Panel Decision for dispute CAC-ADREU-007127

Case number	CAC-ADREU-007127
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Domain names	google-statistics.eu

Case administrator

	Lada Válková (Case admin)

Complainant

Organization	Google Ireland Holdings

Respondent

Name	Alexander Bondarenko

INSERT INFORMATION ABOUT OTHER LEGAL PROCEEDINGS THE PANEL IS AWARE OF WHICH ARE PENDING OR DECIDED AND WHICH RELATE TO THE DISPUTED DOMAIN NAME

The Panel is not aware of any other pending or decided legal proceedings which relate to the disputed domain name.

FACTUAL BACKGROUND

Complainant, Google Ireland Holdings, is organized within the Community and has its registered office in Ireland and thus satisfies the requirements of Article 4(2)(b) of Regulation (EC) No 733/2002. Complainant states that it is related to the owner of the trademark GOOGLE, i.e. Google Inc., the Delaware Corporation located in Mountain View, California, USA. Complainant, Google Ireland Holdings, also states that it has rights to use the GOOGLE Mark through license from Google Inc.

Complainant's used trademark GOOGLE has acquired the evident notoriety and is famous internet search engine and related IT services brand in all over the world. The Respondent is the natural person who has no legitimate interest in the disputed domain name and clearly registered the domain to attract and divert consumers seeking Google's websites to rogue pharmacy websites, for Respondent's own commercial gain, by creating a likelihood of confusion between Google's protected marks and the Domain Name. Respondent also failed to provide the response in this administrative proceeding.

A. COMPLAINANT

Complainant, Google Ireland Holdings, presented that Google Inc. owns enforceable rights in the GOOGLE mark. Google Inc. is a Delaware corporation located in Mountain View, California, USA with offices and related entities throughout the world, including the European Union. Google Ireland Holdings ("Complainant") is an Ireland entity located in Dublin, Ireland and is related to Google Inc. Complainant through license from Google Inc. has rights to use the GOOGLE Mark. The GOOGLE name and company were created in 1997. Since that time, the Google search engine has become one of the most highly recognized and widely used Internet search services in the world. Google's primary website is located at www.google.com, and Google owns and operates websites at over 180 GOOGLE-formative domain names, including nearly every top-level country code domain consisting solely of the GOOGLE mark (e.g., google.eu, google.co.uk). The GOOGLE mark has been found to be one of the top five Most Valuable Global Brands since 2001, with BrandFinance Global 500 ranking Google's mark as one of the world's most valuable brands in 2014, valued at $68 billion. Google's website also has been recognized as one of the most popular destinations on the Internet since well before Respondent's registration of the google-statistics.eu domain name on February 11, 2015 (the "Registration Date"). Google owns numerous trademark registrations for the GOOGLE mark in the European Union, the United States, and in a wide range of jurisdictions throughout the world, many dating back to as early as 1998. Google's European Community trade mark registrations include numbers 001104306 (for GOOGLE in Classes 9, 35, 38, 42; filed March 12, 1999); 004316642 (for GOOGLE in Classes 16, 25, 35; filed March 29, 2005); and 010081073 (for GOOGLE-stylized in Classes 9, 35, 36, 42; filed June 28, 2011). Each such trademark registration remains valid and in full force and effect. The GOOGLE mark has been widely promoted among members of the general consuming public since 1997, and has exclusively identified Google. As a result, the GOOGLE mark and name symbolize the substantial goodwill associated with Google. Due to widespread and substantial

international use since well prior to the Registration Date, the GOOGLE mark and name have become famous.

Respondent registered the Domain Name on February 11, 2015. Complainant states and evidences that the search path of the google-statistics.eu domain name (i.e., <google-statistics.eu/search>) redirects to a rotating slate of websites that purport to offer for sale unregulated pharmaceutical goods (so-called "rogue" pharmacy websites). Some evidence also shows that the google-statistics.eu domain name might be used in a hack that attacks third-party websites and injects unauthorized and malicious content.

According to Complainant, the disputed domain name is confusingly similar to Google's GOOGLE mark. While registering the disputed Domain Name, Respondent has incorporated Google's mark in full and merely added a non-distinctive hyphen and the generic term "statistics." These additions do nothing to mitigate the confusing similarity between the Domain Name and Google's GOOGLE mark. This is particularly so given the strength and fame of the GOOGLE mark. When faced with similar circumstances, previous panels have found confusing similarity. Google Inc. v. Domain Admin / Whois Privacy Corp., FA1605239 (Nat. Arb. Forum March 22, 2015) ("The <google-status.com> domain name is confusingly similar to Complainant's GOOGLE mark. The domain name contains the Complainant's mark in full, inserts a hyphen, adds a generic word "status," and adds the generic top-level domain ".com" to the disputed name").

Respondent has no legitimate interest in the disputed domain name because there is no evidence that, prior to the dispute, Respondent used google-statistics.eu or a name corresponding to the Domain Name in connection with the offering of goods or services. Nor was Respondent "commonly known" as Google or Google-Statistics prior to its registration of the Domain Name. Google has not authorized Respondent to register or use the Domain Name, nor is Respondent affiliated with, associated with, or otherwise endorsed by Google. Respondent also is not making a bona fide offering of goods or services or a legitimate noncommercial or fair use of the Domain Name. Complainant adds that Google Inc. recently filed a domain name dispute regarding the google-status.com domain name, which originated from the same IP address as google-statistics.eu and similarly redirected to a rotating slate of rogue pharmacy websites. In that case, the National Arbitration Forum found that the respondent lacked rights and legitimate interests in the domain. Google Inc. v. Domain Admin / Whois Privacy Corp., FA1605239 (Nat. Arb. Forum March 22, 2015). The National Arbitration Forum's decision in that case is highly relevant to this proceeding. Based on the foregoing, Respondent lacks any rights or legitimate interest in the Domain Name because Respondent has not used the domain name or a name corresponding to the domain name in connection with the offering of goods or services and has not made demonstrable preparation to do so, nor has Respondent been commonly known as Google or Google-Statistics, nor has it made a legitimate and non-commercial or fair use of the domain name without intent to mislead consumers or harm the reputation of Google's recognized and protected rights in the GOOGLE mark.

Article 21(3) of Regulation (EC) No. 874/2004, as implemented by § B11(f) of the ADR Rules, states that Complainant can demonstrate Respondent's bad faith by showing "the domain name was intentionally used to attract Internet users, for commercial gain to the Respondent's website or other on-line location, by creating a likelihood of confusion with a name on which a right is recognized or established, by national and/or Community law or a name of a public body, such likelihood arising as to the source, sponsorship, affiliation or endorsement of the website or location or of a product or service on the website or location of the Respondent.". According to Complainant, the evidence overwhelmingly shows that Respondent registered and is using the Domain Name opportunistically and in bad faith. Given the fame of the GOOGLE mark, the extensive media coverage of Google and its GOOGLE mark, and Google's worldwide trademark filings, it is inconceivable that Respondent registered the disputed domain name independently for legitimate use and without bad faith. Complainant refers to previous ADR decisions which shows that "it is extremely unlikely" or "practically impossible" that the registrant created the domain name, consisting GOOGLE mark, independently (Google Inc. v. Publica, FA1294447 (Nat. Arb. Forum Jan. 11, 2010); IM PRODUCTION v. Heinrich Groothuizen, CAC 6877 <isabelmarant-outlet.eu>. Therefore, a finding that a respondent knew or should have known about the GOOGLE mark, is sufficient to establish registration in bad faith. Respondent plainly registered the domain to attract and divert consumers seeking Google's websites to the rogue pharmacy websites, for Respondent's own commercial gain, by creating a likelihood of confusion between Google's protected marks and the Domain Name. This constitutes bad faith under § B11(f) of the ADR Rules. Respondent's likely use of the disputed domain name to carry out a hacking attack that injects unauthorized and malicious content into third-party websites likewise constitutes bad faith. Google, Inc. v. Petrovich, FA1339345 (Nat. Arb. Forum Sep. 23, 2010) (finding that disputed domain names which distribute malware to Internet users' computers demonstrate Respondent's bad faith). Complainant additionally refers to <google-status.com> domain name dispute, which involved the same sort of rogue behaviour at issue in this case where the National Arbitration Forum found that the respondent was using the domain in bad faith (Google Inc. v. Domain Admin / Whois Privacy Corp., FA1605239 (Nat. Arb. Forum March 22, 2015). Therefore, when NAF panels confront distinctly similar fact patterns to the case at hand, CAC Panels are entitled to take those decisions under advisement.

B. RESPONDENT

No response was provided.

DISCUSSION AND FINDINGS

1. Trademark status and license issue

In the current case the Panel has no any doubts that Google Inc., a Delaware corporation located in Mountain View, California, USA, is a rightful owner of GOOGLE Mark. However, Google Inc. itself is not a Complainant, Therefore, it is important to verify whether Google Ireland Holdings (the Complainant) is the legitimate licensee of the GOOGLE mark. The Complainant stated in its Complaint, that "Google Ireland Holdings ("Complainant") is an Ireland entity located in Dublin, Ireland and is related to Google Inc. Complainant through license from Google Inc. has rights to use the GOOGLE Mark." However, Complainant did not present any direct documentary evidence, which would clearly show to the Panel that the latter contention is true. Simple license declaration for a GOOGLE Mark would be sufficient evidence of the license arrangement between the Google Inc. and Complainant (see .eu ADR Case No. 4108 (YOUNGLIFE) or .eu ADR Case No. 4925 (NYU), allowing the licensee to enforce a trademark right according to Article 10(1) of Regulation (EC) 874/2004 and to permit transfer of the domain name to the complainant/licensee according to Article 4.2(b)(iii) of Regulation (EC) 733/2002.

Nevertheless, the Panel is of the view that the formalistic approach in this specific case is most likely against the essence of justice. Simple rejection of the Complaint just because Complainant failed to provide written license arrangement between the Google Inc. and Complainant would be formally correct, however, most likely wrong in its essence. Therefore, this situation leads the Panel to the need of "Formal v. Substantive" analysis in this case. It should be reminded that in Sunrise .eu ADR cases against EURid, a lot of difficult formal .eu domain name registration issues where dealt with in favour of substantive approach. Famous and highly experienced WIPO ADR and CAC .eu ADR panelist Dr. Richard Hill proposed the theory that "there is nothing in the ADR Procedural Rules prohibiting the Panel from deciding an ADR Proceeding based also on arguments and findings which had not been submitted by the Parties, provided that such a decision and its reasons would not be surprising to the parties." (Dr. Richard Hill in his January 2007 e-mail correspondence to CAC referred this "Formal v. Substantive" decision making idea based on Swiss jurisprudence in the matter of "iura novit curia"). Therefore, Panel in this case is of the view that strong indirect evidence suggests that license arrangement between Complainant and Google Inc. is most likely inevitable and that such a decision and its reasons should not be surprising to the parties in this case.

As Dr. Richard Hill further in his theory of "Formal v. Substantive" suggested, "[S]hould the Panel believe that a decision and its reasons not based on submissions by the Parties might be surprising, then the Panel should submit its reasoning to the Parties for comment and take the comments into account when forming its final decision. In all cases such additional arguments or verifications must of course be well argued, very carefully verified and clearly formulated." Panel in this case came to the view that its decision and its reasons, which are not based on submissions by the Parties, should not be surprising to the Parties. Therefore, Panel is of no obligation to submit its reasoning to the Parties for comment.

However, as dr. Richard Hill has admitted, Panel must very carefully verify and clearly formulate such additional arguments which led Panel to the final decision that Complainant satisfied the requirements of EU Regulations. Indeed, Panel finds in this case a lot of indirect evidence which leads to the conclusion that Complainant is entitled to enforce GOOGLE mark right according to Article 10(1) of Regulation (EC) 874/2004 and to permit transfer of the domain name to the complainant/licensee according to Article 4.2(b)(iii) of Regulation (EC) 733/2002.

First, Complainant is using company name "Google Ireland Holdings" which shows that Complainant was most likely allowed to use GOOGLE Mark in its company name based on some type of license arrangement. It is very unlikely that Google Inc. would tolerate independent Irish company usage of GOOGLE Mark for more than ten years without any license arrangement.

Second, Complainant has already once demonstrated to CAC Panel that it is entitled to enforce GOOGLE mark right according to Article 10(1) of Regulation (EC) 874/2004. This was stated in the .eu ADR case No 4809 Google Ireland Holdings Ltd. v. Pablo Bello Garcia, CAC 4809 <googles.eu>: "The Complainant - contrarily to what happened in the prior ADR Proceeding nº 04113- has properly explained the relationship between GOOGLE IRELAND HOLDINGS LTD, and GOOGLE INC. (which is the titleholder of the trademarks below referred that are implied in this proceeding)." The CAC Panel in the case No 4809 decided that "the Complainant has sufficiently evidenced that it has a prior right".

Third, Complainant provided such documentary evidence, which would be very difficult to obtain without having effective communication with Google Inc., i.e. CTM Certificates of Registration dated 29/12/2015, just a week before the provision of the complaint; other publicly unavailable data about GOOGLE Mark usage, etc.

Fourth, the Respondent did not raise any doubts about possible lack of Complainant's prior rights to the GOOGLE Mark.

Having regard to what was said above and in accordance with Paragraphs B7 (a) and B10 (a) of the ADR Rules, Panel is of the view that Complainant satisfies the definition of the holder of prior rights recognized or established by national and/or Community law.

2. Similarity of the disputed domain name

It is obvious that the disputed second level domain name <google-statistics> is confusingly similar to the GOOGLE Mark. The top level domain <.eu>, which is attached to <google-statistics>, does not create any distinctiveness of the disputed domain name. Panel fully agrees with Complainant's contentions that adding a non-distinctive hyphen and the generic term "statistics" does nothing to mitigate the confusing similarity between the disputed domain name and GOOGLE mark. Moreover, previous panels have already found confusing similarity in very similar case of Google Inc. v. Domain Admin / Whois Privacy Corp., FA1605239 (Nat. Arb. Forum March 22, 2015) ("The <google-status.com> domain name is confusingly similar to Complainant's GOOGLE mark. The domain name contains the Complainant's mark in full, inserts a hyphen, adds a generic word "status," and adds the generic top-level domain ".com" to the disputed name").

3. Respondent's lack of rights or legitimate interests in the name

The Panel considers that the Complainant sufficiently presented and proved the Respondent's lack of rights or legitimate interests in the disputed domain name. The Panel fully agrees with the Complainant's contentions that Complainant has never authorized Respondent to use GOOGLE mark nor to use the disputed domain name and the Complainant does not have any type of business relationship with the Respondent.

4. Respondent's bad faith

Panel agrees with the Complainant that the Respondent registered the disputed domain name in bad faith because he could not have known of the strong notoriety of the GOOGLE Mark. Respondent evidently registered the domain to attract and divert consumers seeking Google's websites to the rogue pharmacy websites, for Respondent's own commercial gain, by creating a likelihood of confusion between Google's protected marks and the disputed domain name. Respondent's likely use of the disputed domain name to carry out a hacking attack that injects unauthorized and malicious content into third-party websites was not denied by Respondent. This does constitute bad faith. Panel agrees with Complainant's reference to <google-status.com> domain name dispute, which involved the same sort of rogue behaviour at issue in this case where the National Arbitration Forum found that the respondent was using the domain name in bad faith (Google Inc. v. Domain Admin / Whois Privacy Corp., FA1605239 (Nat. Arb. Forum March 22, 2015).

DECISION

For all the foregoing reasons, in accordance with Paragraphs B12 (b) and (c) of the Rules, the Panel orders that

the domain name GOOGLE-STATISTICS be transferred to the Complainant.

PANELISTS

Name	**Dr. Darius Sauliunas**

DATE OF PANEL DECISION 2016-04-08

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

I. Disputed domain name: google-statistics.eu

II. Country of the Complainant: Ireland, country of the Respondent: Portugal or Russia.

III. Date of registration of the domain name: February 11, 2015.

IV. Rights relied on by the Complainant (Art. 21 (1) Regulation (EC) No 874/2004) on which the Panel based its decision:
1. word and figurative trademarks registered in the Community and the worldwide, Google's European Community trade mark registrations include numbers 001104306 (for GOOGLE in Classes 9, 35, 38, 42; filed March 12, 1999); 004316642 (for GOOGLE in Classes 16, 25, 35; filed March 29, 2005); and 010081073 (for GOOGLE-stylized in Classes 9, 35, 36, 42; filed June 28, 2011).

V. Response submitted: No.

VI. Domain name is confusingly similar to the protected rights of the Complainant

VII. Rights or legitimate interests of the Respondent (Art. 21 (2) Regulation (EC) No 874/2004): No.

VIII. Bad faith of the Respondent (Art. 21 (3) Regulation (EC) No 874/2004):
1. Yes.
2. Why: the domain name was intentionally used to attract Internet users and divert consumers seeking Google's websites to the rogue pharmacy websites, for Respondent's own commercial gain, by creating a likelihood of confusion between Google's protected marks and the disputed domain name. Respondent's likely use of the disputed domain name to carry out a hacking attack that injects unauthorized and malicious content into third-party websites was not denied by Respondent.

IX. Other substantial facts the Panel considers relevant: The similar domain names have been already cancelled or transferred by CAC and NAF panels in last eight years.

X. Dispute Result: Transfer of the disputed domain name to the Complainant.

XI. Procedural factors the Panel considers relevant: Yes: Complainant did not present direct documentary evidence, which would clearly show to the Panel that Complainant is related to trademark owner on the basis of license arrangement. Nevertheless, the Panel was of the view that the formalistic approach in this specific case would be against the essence of justice, as strong indirect evidence suggested that such license arrangement is most likely inevitable. This situation led the Panel to the need of "Formal v. Substantive" analysis in this case. Therefore, Panel based this decision also on arguments and findings which had not been submitted by the Parties in accordance with, however, Panel was of the view that that such a decision and its reasons should not be surprising to the parties (based on Swiss jurisprudence in the matter of "iura novit curia").

XII. Is Complainant eligible? Yes.