



## NATIONAL ARBITRATION FORUM

### DECISION

Google Inc. v. Jennifer Burns  
Claim Number: FA0606000726096

#### **PARTIES**

Complainant is **Google Inc.** ("Complainant"), represented by **Terri Y. Chen**, of **Google Inc.**, 1600 Amphitheatre Parkway, Mountain View, CA 94043. Respondent is **Jennifer Burns** ("Respondent"), 3105 Dolphin Dr, Austin, TX 78704.

#### **REGISTRAR AND DISPUTED DOMAIN NAMES**

The domain names at issue are <**googlecheckout.com**>, <**googlematching.com**>, <**googleoutdoors.com**>, all registered with **Go Daddy Software, Inc.** ("Registrar").

#### **PANEL**

The undersigned certifies that he or she has acted independently and impartially and to the best of his or her knowledge has no known conflict in serving as Panelist in this proceeding.

Mr. Peter L. Michaelson, Esq. as Panelist.

#### **PROCEDURAL HISTORY**

The Complaint was brought pursuant to the Uniform Domain Name Dispute Resolution Policy ("Policy"), available at <[icann.org/services/udrp/udrppolicy24oct99.htm](http://icann.org/services/udrp/udrppolicy24oct99.htm)>, which was adopted by the Internet Corporation for Assigned Names and Numbers (ICANN) on August 26, 1999, and approved on October 24, 1999, and in accordance with the ICANN Rules for Uniform Domain Name Dispute Resolution Policy ("Rules") as approved on October 24, 1999, as supplemented by the National Arbitration Forum Supplemental Rules for Uniform Domain Name Dispute Resolution Policy then in effect ("Supplemental Rules").

Complainant submitted a Complaint to the National Arbitration Forum ("Forum") electronically on June 2, 2006; the National Arbitration Forum received a hard copy of the Complaint on June 8, 2006, together with Exhibits 1-17.

On June 5, 2006, the Registrar confirmed by e-mail to the Forum that the <**googlecheckout.com**>, <**googlematching.com**>, <**googleoutdoors.com**> domain

names are registered with the Registrar and that Respondent is the current registrant of each of those names. The Registrar also verified that Respondent is bound by the Go Daddy Software, Inc. registration agreement and has thereby agreed to resolve domain-name disputes brought by third parties in accordance with the Policy.

On June 9, 2006, a Notification of Complaint and Commencement of Administrative Proceeding (the "Commencement Notification"), setting a deadline of June 29, 2006 by which Respondent could file a Response to the Complaint, was transmitted by the Forum to Respondent via e-mail, post and fax, to all entities and persons listed on Respondent's registration as technical, administrative and billing contacts, and to postmaster@googlecheckout.com, postmaster@googlematching.com and postmaster@googleoutdoors.com by e-mail.

A timely Response, together with Exhibits 1-3, was received by the Forum and on July 13, 2006 determined to be complete.

Thereafter and pursuant to Supplemental Rule 7, Complainant timely filed an Additional Submission with the Forum on July 18, 2006. Subsequently, on July 24, 2006, Respondent timely filed its Additional Submission with the Forum.

On July 19, 2006, pursuant to Complainant's request to have the dispute decided by a single-member Panel, the National Arbitration Forum appointed Mr. Peter L. Michaelson, Esq. as Panelist and set a deadline of August 2, 2006 to receive the decision from the Panel.

In light of unexpected time conflicts experienced by the Panel -- which amounted to exceptional circumstances, the Forum, at the Panel's request, extended the deadline for the decision to August 16, 2006.

## **RELIEF SOUGHT**

Complainant requests that all the disputed domain names be transferred from Respondent to Complainant.

## **PARTIES' CONTENTIONS**

### **A. Complainant**

#### **1. Confusing similarity/identity**

Complainant contends that each of the disputed domain names, <googlecheckout.com>, <googlematching.com>, and <googleoutdoors.com>, is confusingly similar to Complainant's GOOGLE Marks inasmuch as each of these names incorporates Complainant's mark GOOGLE.

Hence, for each of these names, Complainant concludes that it has met the requirements of paragraph 4(a)(1) of the Policy.

## 2. Rights and legitimate interests

Complainant contends that Respondent has no rights or legitimate interests in any of the disputed domain names under paragraph 4(a)(2) of the Policy.

First, Complainant contends that Respondent's use of these names to resolve to web sites that are exclusively devoted to serving advertisements for commercial gain, particularly sponsored link advertising, and which competes with Complainant does not constitute a *bona fide* offering of goods or services.

Second, Complainant contends that Respondent has not been commonly known by any of the disputed domain names and is not making any legitimate, noncommercial or fair use of any of these names without intending to mislead and divert consumers or to tarnish Complainant's mark GOOGLE for commercial gain. Also, Respondent is not nor has ever been licensed by Complainant to use the GOOGLE Marks or otherwise authorized to so use those marks.

## 3. Bad faith use and registration

Complainant contends that, for various reasons, Respondent has registered and is using all the disputed domain names in bad faith, hence in violation of paragraph 4(a)(3) of the Policy.

First, Complainant contends that Respondent's registration and use of the names, being primarily for the purpose of selling those names to Complainant for well in excess of her costs of registration, evidenced bad faith. Specifically, Complainant points to Respondent's initial offer of US \$ 1.25 Million and then her subsequent offer of US \$ 375,000.

Second, Complainant contends that bad faith use is shown by Respondent's actions in using the names, which contained Complainant's mark GOOGLE, to intentionally attract, for commercial gain, Internet users to Respondent's website by creating a likelihood of confusion with that mark as to the source, sponsorship, affiliation and endorsement of Respondent's website. Incorporating that mark into the names increased Respondent's pecuniary return more than would have otherwise occurred.

Third, Complainant further contends that inasmuch as Respondent knew of Complainant's mark GOOGLE prior to having registered the disputed names, Respondent's actions in having done so -- in spite of her evident knowledge of

Complainant's prior exclusive rights in that mark -- and her eventual use, for her own financial gain, of those names in offering sponsored link advertising competitive with Complainant evidences opportunistic bad faith.

Lastly, Complainant contends that bad faith is also shown by virtue of the fact that Respondent has engaged in a pattern of registering other domain names that incorporate third-party trademarks in an effort to prevent their owners from reflecting those marks in corresponding domain names. In particular and in addition to registering names that incorporated Complainant's mark GOOGLE, Respondent has also registered domain names incorporating marks such as STARBUCKS and HILTON. In that regard, Complainant has provided copies of WhoIS records of some of Respondent's other domain name registrations, which incorporate third-party marks, in Exhibit 17 to the Complaint.

## B. Respondent

### 1. Confusing similarity/identity

Respondent argues that none of the disputed domain names is confusingly similar to Complainant's SAFEGUARD Marks.

Specifically, Respondent states that her intended business name is not "GOOGLE Checkout," which ostensibly is identical to the disputed domain name <**googlecheckout.com**>, but rather the term "*Go Ogle Checkout*," which Respondent contends is not. She intends to use this term in conjunction with an online dating service.

As to the other disputed domain names, and as best understood by the Panel, Respondent intends to use <**googlematching.com**> and <**googleoutdoors.com**>, also in conjunction with her dating service, as the terms "*Go Ogle Matching*" and "*Go Ogle Outdoors*," respectively, where the word "ogle" commonly means "to glance amorously."

Respondent states that her intention is not to use any of the disputed names in conjunction with any business competitive with those then being conducted by Complainant under its mark GOOGLE.

### 2. Rights and legitimate interests

Contrary to Complainant's view, Respondent contends that, for several reasons, that she has rights and legitimate interests in each of the disputed domain names.

In that regard, she states that she purchased numerous domain names, including the disputed names, all of which she intends to "link under one umbrella" and use in conjunction with an online dating service.

Further, Respondent concedes that she is not commonly known by any of the names inasmuch as she has "not completely fleshed out every idea" and does not have "all the financial resources or time to get the dating site up and running just yet".

Though Respondent acknowledges she has not yet used the names, she states her intention is to make fair use of the names without intent for commercial gain and or to misleadingly divert consumers or to tarnish the trademark or service mark of Complainant.

She also acknowledges that she was never licensed by Complainant to use its GOOGLE Marks.

### 3. Bad faith use and registration

Respondent contends that she has neither registered nor used any of the disputed domain names in bad faith.

Specifically, Respondent states that her intention in registering each of the names was to use them in conjunction with an online dating service. She states that she never intended to sell the names, nor did she contact Complainant to do so. Further, she states that her intention was to use the sites for her online dating service, a business that would not compete against Complainant and, in that regard she never, contrary to Complainant's view, "made a cent off any ads or websites." Furthermore, she states that she never heard of Complainant's "Google Checkout" service at the time she registered the names.

Moreover, Respondent states that she did not acquire or register any of the disputed domain names:

(a) for the purpose of selling, renting, or giving the domain names to Complainant or to a competitor of Complainant for any consideration. In that regard, she had "her own plans" for these names.

(b) to prevent Complainant from reflecting its mark in a corresponding domain name, let alone through a pattern of such registrations.

(c) primarily to disrupt Complainant's business, or to attract, for commercial gain, Internet users to her web sites by creating a likelihood of confusion with Complainant's GOOGLE Marks as to source, sponsorship or affiliation or endorsement of her sites with those marks. Respondent specifically contends that neither of these situations exist since she does not yet have any operational web sites to which any of these names resolves.

### C. Additional Submissions

Each party filed an Additional Submission which the Panel has fully considered.

For the most part, both submissions reiterated and amplified the same allegations each party previously made in its initial pleadings. However, each party did raise certain additional arguments. Hence, for the sake of brevity, the Panel will dispense with separately summarizing these submissions, but will briefly note those additional arguments, it believes to be most salient, as follows:

#### 1. Complainant

Complainant alleges that the addition of the common terms “checkout,” “matching,” and “outdoors” to its mark GOOGLE to form the disputed domain names do not sufficiently distinguish those names from that mark.

As to the lack of any rights and legitimate interests, Complainant contends that Respondent has failed to provide any concrete proof whatsoever that substantiates her claim that she planned to use the names in conjunction with a dating service. In that regard, Respondent’s failure to provide any documentary evidence, such as business plans or declarations, to support her assertion effectively admits the truth of Complainant’s contentions. Further, just some six days after Respondent registered the <**googlecheckout.com**> name, the media widely reported that Complainant planned on launching its online payment service -- as indicated by the articles, a copy of which appear in Exhibit A to Complainant's Additional Submission, that appeared in, e.g., *The New York Times*, *The Wall Street Journal*, and the *Associated Press*.

With respect to bad faith, Complainant points to the \$ 1.25 Million price at which Respondent offered the names for sale as evidencing bad faith. Complainant contends that Respondent's reply, in and of itself, to Complainant's cease and desist letter is not bad faith, rather Respondent's unsolicited offer, in response, to sell the names is. Further, once Complainant rejected this offer, Respondent then reduced her offer to \$ 375,000 which again shows Respondent's bad faith. Even apart from these offers, even if Respondent was not responsible for posting the advertising content on the GoDaddy parked pages and she did not earn any revenue therefrom, her passive holding of those names, which prevented Complainant from registering them, also constitutes bad faith.

#### 2. Respondent

As to confusing similarity, Respondent states:

'Google' is now a verb in the dictionary. 'Go' and 'Ogle' are also generic terms in the dictionary, as is 'checkout', 'matching,' and 'outdoors.' I took three common names out of the dictionary and put them together and coincidentally they happen to spell GOOGLE in them, which is also a common word in the dictionary. Therefore, my domain names do provide a basis for distinguishing them from Complainant's mark.

With respect to having rights and legitimate interests, Respondent states:  
All three domain names were registered for this idea I have. The ideas are in my head for my business and that is how my business style has always been for me. For example, with my real estate lots I have purchased, as well as not necessarily having all the finances to build on them yet, my mind is still at work with exactly what I will do with two of the commercial lots for instance. I have ideas for them, but do not have any of my business plans on paper. However, I do have a concrete idea of what I am going to do with them, just as I do with the domain names. Should domain names be taken from me when I have legitimate interests in them, yet not ready for improving them just yet, and not have my business plans on paper to date? Again, remember, when Complainant contacted me, I had only owned the domain names for less than a year. That is preposterous to expect me to have all my business plans on paper and a crude demand. ...  
My intentions are to take a class on creating websites sometime within the next year, or as soon as I can get time to do that, and then I will be implementing my own websites at a lower cost than having someone else do it for me since my business plans for this are also nonprofit.

With respect to bad faith, Respondent states that she never demanded, ostensibly on her own volition, \$ 1.25 Million to sell the disputed domain names, but rather Complainant solicited the offer from her.

## **FINDINGS**

A copy of the WhoIs registration record for each of the disputed domain names appears in Exhibit 1 to the Complaint. As indicated on these records, Respondent registered all three disputed domain names on June 26, 2005.

### **A. Complainant's GOOGLE Marks**

Complainant owns numerous United States and foreign trademark registrations for the term "GOOGLE " and on which this dispute is based. Complainant has provided, in Exhibit 5 to the Complaint, a copy of the registration certificate for each of the US marks and in Exhibits 6, 6a and 6b a copy of the registration certificate for various ones of its foreign registrations. Details of its US registrations are as follows:

- a) GOOGLE (block letters)  
United States registration 2,954,071; registered: May 24, 2005  
filed: September 18, 2001

This mark was registered for use in connection with "mouse pads, calculators" in international class 9; "flashlights, lamps" in international class 11; "license plate frames and holders" in international class 12; "books, namely children's books, books on the subject of computers, notebooks, pens, greeting cards, stickers, decals" in international class 16; "bags, namely, tote bags, duffel bags, backpacks; luggage tags; umbrellas" in international class 18; "mugs, tumblers" in international class 21; "clothing, namely, shirts, T-shirts, vests, hats, caps, boxer shorts; children's clothing, namely, T-shirts" in international class 25; "sporting equipment, namely, plastic exercise balls" in international class 28; and "electronic retailing services via computer featuring mouse pads, flashlights, lamps, license plate frames and holders, books, notebooks, pens, greeting cards, stickers, decals, tote bags, duffel bags, backpacks, luggage tags, umbrellas, mugs, tumblers, shorts, T-shirts, modem cords, vests, caps, hats and other clothing items" in international class 35. The registration states that for the goods in classes 9, 11, 12, 16, 18, 21, 25 and 28 first use of the mark commenced as of January 31, 1999 and first use in commerce commenced as of July 31, 1999; and for the goods in class 35 both first use and first use in commerce of the mark commenced as of September 30, 1999.

- b) GOOGLE (block letters)  
United States registration 2,884,502; registered: September 14, 2004  
filed: September 16, 1998

This mark was registered for use in connection with "computer hardware; computer software for creating indexes of information, indexes of web sites and indexes of other information resources" in international class 9. The registration states that both first use and first use in commerce of this mark in conjunction with these services commenced as of January 26, 2000.

- c) GOOGLE (block letters)  
United States registration 2,806,075; registered: January 20, 2004  
filed: September 16, 1999

This mark was registered for use in connection with the "providing electronic mail and workgroup communications services over computer networks; providing multiple user access to proprietary collections of information by means of global computer information networks" in international class 38, and "computer services, namely, providing software interfaces available over a network in order to create a personalized on-line information service; extraction and retrieval of information and data mining by means of global computer networks; creating indexes of information, indexes of web sites and indexes of

other information sources in connection with global computer networks; providing information from searchable indexes and databases of information, including text, electronic documents, databases, graphics and audio visual information, by means of global computer information networks" in international class 42. The registration states that first use and first use in commerce of this mark in conjunction with the services in class 38 commenced as of September 30, 1997, and for class 42 first use commenced as of March 31, 1997 and first use in commerce commenced as of September 30, 1997.

## B. Complainant and its activities

Complainant was created in 1997 by Stanford Ph.D. candidates Larry Page and Sergey Brin. Since that time, Complainant has become one of the largest, most highly recognized, and widely used Internet search services in the world, particularly through its primary web site at <google.com>.

Currently, Complainant's GOOGLE search engine has an index of over 8 billion web pages, and offers Internet users an easy-to-use interface, advanced search technology, and a comprehensive array of search tools. In addition, through that engine, Internet users can search for and find content in many different languages; access stock quotes, maps, and news headlines; access telephone book listings for every city in the United States; and retrieve more than 22 million Adobe PDF documents.

Complainant's website is one of the most popular destinations on the Internet. In that regard, Nielsen NetRankings (excerpts of which appear in Exhibit 3 to the Complaint) ranked Complainant, for the month of January 2006, as number 3 of the Top 10 US Parent Companies for Internet users at work, and as number 4 of the Top 10 US Parent Companies for Internet users at home.

Complainant also offers co-branded web search solutions for information content providers and has partnerships with 130 companies in more than 30 different countries, including with some of the Internet's most prominent players, such as: AOL, Earthlink, Amazon.com, The New York Times, T-Online (Europe), Yahoo! Japan, AT&T WorldNet, InfoSpace, Eniro (Scandinavia), Nifty, NEC BIGLOBE, Ask Jeeves (U.S. and U.K.), MapQuest, NTL (UK), Free.fr, Libero (Italy), Virgilio (Italy), Jumpy (Italy), F2 (Australia), News Interactive (Australia).

In addition to being accessible from desktop PCs, Complainant's search technology can also be accessed from various wireless platforms. As a result of Complainant's mobile partnerships, customers of AT&T Wireless, Cingular Wireless, Sprint PCS, Handspring, Vodafone, and Yahoo! Inc. can access Complainant's 8 billion Internet web pages through their telephones and/or other wireless devices.

Complainant also offers software and hardware products. For example, the GOOGLE Toolbar is a free, downloadable software program which appears as a toolbar along with

the Internet Explorer toolbar and which allows users to quickly and easily use Complainant's search services from any website location without having to return to Complainant's home page to begin another search. The GOOGLE Search Appliance is an integrated software and hardware product, marketed to both small and large companies, that provides Complainant's search services, including indexing, for use in internal corporate networks and intranets.

Complainant also offers the most comprehensive image search on the web with billions of images (GOOGLE Image Search), a very large Usenet message archive on the Internet (GOOGLE Groups), a news site (GOOGLE News), a catalog search site (GOOGLE Catalogs), a product search site (FROOGLE), a site where Internet users can have their questions answered by researchers (GOOGLE Answers), an index of book content that enables Internet users to search the full text of millions of books (GOOGLE Book Search), and a video search site where Internet users can search and purchase a wide range of video content (GOOGLE Video).

#### C. Respondent's activities

Since the date she registered all three disputed domain names, Respondent has not used any of them in conjunction with an operative web site.

Respondent has parked all these domain names with the Registrar which, in turn, uses these names to resolve to corresponding home pages, each of which displays sponsored link advertising and offers search boxes. Internet users who click on any of the sponsored links or enter terms in any such search box are shown ads labeled as "sponsored search results." A copy of these home pages, as they existed on May 15, 2006, appears in Exhibit 9 to the Complaint.

#### D. Interactions between the parties

On April 20, 2006, Complainant sent a cease and desist letter (a copy of which appears in Exhibit 10 to the Complaint) to Respondent via email requesting the transfer of the disputed domain name <**googlecheckout.com**>. No response was received. Thereafter, on May 15, 2006, Complainant sent a follow up letter (a copy of which appears in Exhibit 11 to the Complaint), also by email, to Respondent requesting the transfer of the same domain name.

On May 16, 2006, Complainant also sent a cease and desist letter (a copy of which appears in Exhibit 12 to the Complaint) to Respondent via email requesting the transfer of the other two disputed domain names <**googlematching.com**> and <**googleoutdoors.com**>.

Then, on May 22, 2006, Complainant received a reply email (a copy of which appears in Exhibit 13 to the Complaint) from Respondent through which Respondent stated:

Hi there. I have received your email and do not actively have these domain names in use. ... I am the proud owner of these domain names and others. I am willing to do a transfer of these domain names to the google property rights at a cost of my expenses and time and future loss of business. I would possibly be willing to accept an offer of \$ 1,250,000.00 as a package deal for all three domain names.

Through an email dated May 23, 2006 (a copy of which appears in Exhibit 14) sent to Respondent, Complainant declined to offer to purchase the names for \$1.25 million dollars and again requested that Respondent transfer all the disputed names.

Later, through an email dated May 23, 2006 (a copy of which appears in Exhibit 15), Respondent offered to sell the names to Complainant as a package deal for \$375,000, and in so doing specifically stated:

I have done enough research to notice many other domain names with google's name (not owned by google) and they have active websites, making incomes off of these sites. ...

I am willing to transfer these names over without any further discussion for \$ 375,000.

Subsequently, and through a further email dated May 23, 2006 (a copy of which appears in Exhibit 16), Complainant declined Respondent's reduced offer of sale and again requested transfer of all the disputed names.

Complainant received no further communication from Respondent.

## **DISCUSSION**

Paragraph 15(a) of the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules") instructs this Panel to "decide a complaint on the basis of the statements and documents submitted in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable."

Paragraph 4(a) of the Policy requires that Complainant must prove each of the following three elements to obtain an order that a domain name should be cancelled or transferred:

- (i) the domain name registered by Respondent is identical or confusingly similar to a trademark or service mark in which Complainant has rights;
- (ii) Respondent has no rights or legitimate interests in respect of the domain name; and
- (iii) the domain name has been registered and is being used in bad faith.

### **Identical and/or Confusingly Similar**

The Panel finds that confusion is likely to arise as a result of Respondent's use of the

disputed domain names.

As a preliminary matter, it is absolutely immaterial under the UDRP and hence to this proceeding what Respondent intends to call her business, whether it is "GOOGLECHECKOUT" or, "Go Ogle Checkout," or something else. What concerns this Panel and what it assesses are registered domain names and specifically in the exact manner in which those names are registered. Here, those names are <googlecheckout.com>, <googlematching.com>, and <googleoutdoors.com>. These are the particular names which Respondent registered; hence, these are the names -- the only names -- which this Panel considers in ascertaining identity or confusingly similarity under paragraph 4(a)(1) the Policy.

Given that, each of the disputed domain names is formed by appending a generic term, specifically "checkout," "matching" and "outdoors" to Complainant's mark "GOOGLE" to respectively form the terms "googlecheckout," "googlematching" and "googleoutdoors," and with ".com" gTLD appended to each resulting term -- though the addition of any gTLD is completely ignored in assessing identity/similarity under paragraph 4(a)(i) of the Policy.

It is now very well-established in UDRP precedent, including numerous decisions previously rendered by this Panel, that minor variations, such as adding short letter or number groups or even generic words to a mark, are each insufficient in and of itself, when used in forming a domain name that results from modifying the mark, to confer requisite and sufficient distinctiveness to that name to avoid user confusion. "Checkout," "Matching" and "Outdoors" are certainly such generic words. These specific words, like other generic words, when added to the mark GOOGLE simply fail to impart such requisite and added distinctiveness to the resulting domain names and, from what this Panel sees, probably never will. *See, e.g., The Cheesecake Factory Inc. and The Cheesecake Factory Assets Co., LLC v. Say Cheesecake*, D2005-0766 (WIPO September 12, 2005); *Napster, Inc. v. Vinscani*, D2005-0531 (WIPO July 19, 2005); *Caesars Entm't, Inc. v. Nova Internet Inc*, D2005-0411 (WIPO June 22, 2005); *Lockheed Martin Corp. v. The Skunkworx Custom Cycle*, D2004-0824 (WIPO January 18, 2005); *Lockheed Martin Corp. v. Teramani*, D2004-0836 (WIPO December 1, 2004); *National Collegiate Athletic Association v. Brown*, D2004-0491 (WIPO August 30, 2004). This result follows from a simple comparison of each of the disputed domains name against Complainant's mark GOOGLE.

Such confusion, should it occur, would undoubtedly cause Internet users intending to access Complainant's web site, but who were to reach Respondent's site resolvable through any of the disputed domain names (were Respondent to ever establish such an operational site) or to the corresponding parked page currently maintained by the Registrar, to think that an affiliation of some sort exists between Complainant and Respondent or its third-party transferee, or the owner of each parked page, when, in fact, no such relationship would exist at all. *See, e.g., Cheesecake Factory, Napster, Caesars*

*Entertainment, Lockheed v. Skunkworx, and Lockheed v. Teramani, supra; see also Register.com, Inc. v. Reile*, FA 208576 (Nat. Arb. Forum Jan. 27, 2004); *Caesars World, Inc. and Park Place Entertainment Corp. v. Japan Nippon*, D2003-0615 (WIPO September 30, 2003); *Leiner Health Services Corp. v. ESJ Nutritional Products*, FA 173362 (Nat. Arb. Forum, September 16, 2003); *American Family Life Assurance Company of Columbus v. defaultdata.com aka Brian Wick*, FA 123896 (Nat. Arb. Forum October 14, 2002); *AT&T Corp. v. Abreu*, D2002-0605 (WIPO Sept. 11, 2002); *L.F.P., Inc. v. B and J Properties*, FA 109697 (Nat. Arb. Forum, May 30, 2002); *Peter Frampton v. Frampton Enterprises, Inc.*, D2002-0141 (WIPO April 17, 2002); *Spence-Chapin Services to Families and Children v. Stanley Wynman*, FA 100492 (Nat. Arb. Forum Dec. 10, 2001); *Meijer, Inc. v. Porksandwich Web Services*, FA 97186 (Nat. Arb. Forum, July 6, 2001); *MPL Communications, Limited et al v. IWebAddress.com*, FA 97092 (Nat. Arb. Forum, June 4, 2001); *American Home Products Corporation v. Malgioglio*, D2000-1602 (WIPO February 19, 2001); *Surface Protection Industries, Inc. v. The Webposters a/k/a Mark's Paint Store, Inc.*, D2000-1613 (WIPO February 5, 2001); *Dollar Financial Group, Inc. v. VQM NET*, FA 96101 (Nat. Arb. Forum, Jan. 25, 2001); *eBAY Inc. v. G L Liadis Computing, Ltd. and John L. Liadis d/b/a G L Liadis Computing Ltd.*, D2000-1463 (WIPO Jan. 10, 2001); *Treeforms, Inc. v. Cayne Industrial Sales Corp.*, FA 95856 (Nat. Arb. Forum, Dec. 18, 2000); *Pep Boys Manny, Moe and Jack of CA v. E-Commerce Today, Ltd.*, AF-0145 (eResolution, May 3, 2000). Moreover, this Panel firmly believes that the substantial worldwide recognition and notoriety, if not fame, now enjoyed by Complainant's mark GOOGLE would only exacerbate that confusion. As the strength of a complainant's mark increases over time -- as is certainly true case here, it becomes correspondingly more difficult, in some factual instances nearly impossible, for any respondent who later incorporates that mark into a domain name to avoid inevitable user confusion that results from the similarity of the ensuing name to the mark.

Therefore, the Panel finds that each of the disputed domain names sufficiently resembles Complainant's GOOGLE Marks as to cause confusion; hence, Complainant has shown sufficient similarity between each of those names and Complainant's marks under to meet its burden under paragraph 4(a)(i) of the Policy.

### **Rights or Legitimate Interests**

The Panel believes that not only has Respondent not provided any basis that would legitimize any claim she has to any of the disputed domain names, but also it is extremely unlikely that Respondent could ever make such a claim.

The simple reason is that each of the disputed domain names contains Complainant's mark GOOGLE under which Complainant provides its goods and services and has continuously so provided those goods and services since at least September 1997 -- which is well prior, by some 8 years, to the date (June 26, 2005) on which Respondent has registered each of the names. Moreover, the substantial worldwide recognition which Complainant had developed in its GOOGLE Marks well prior to June 2005 -- where

certainly by that date, these marks have nearly become household words -- supports this Panel's view that Respondent was very likely to have been well aware of Complainant's goods and services and its marks prior to having registered the disputed domain names.

Furthermore, Complainant has never authorized Respondent to utilize any of its GOOGLE Marks or any mark confusingly similar thereto in conjunction with the specific goods and services which Complainant provides under its marks, nor does Complainant have any relationship or association whatsoever with Respondent.

Hence, any use to which Respondent were to put the mark GOOGLE or one confusingly similar thereto, in connection with the goods and services provided by Complainant or those similar thereto would directly violate the exclusive trademark rights now residing in Complainant. *See, e.g., Cheesecake Factory, Napster and Caesars Entertainment, supra; Pelmorex Communications Inc. v. weathernetwork*, D2004-0898 (WIPO December 18, 2004); *Sybase, Inc. v. Analytical Systems*, D2004-0360 (WIPO June 24, 2004); *Caesars World, Inc. and Park Place Entertainment Corporation v. Japan Nippon*, D2003-0615 (WIPO September 30, 2003); *Leiner Health Services Corp., AT&T Corp., and MPL Communications, supra; Am. Online, Inc. v. Fu*, D2000-1374 (WIPO Dec. 11, 2000); and *Treeforms, Inc., supra*. Consequently, Respondent could not legally acquire any public association between it and the mark GOOGLE and hence could never be commonly known or recognized by that mark and thus could never fall within paragraph 4(c)(ii) of the Policy.

Furthermore, though the Policy, through paragraph 4(c)(ii), permits a respondent to establish that it has rights and legitimate interests in a domain name through adequate proof of having undertaken "demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services," having mere intentions, without more, simply fails to constitute demonstrable preparations. Respondent can simply not rely on having intended to establish a business in which the disputed domain names would be used. More is needed. By requiring those preparations to be "demonstrable", the Policy clearly mandates, to at least this Panelist, that a respondent prove that (s)he took concrete actions in furtherance of any such intentions and particularly actions which that respondent can sufficiently corroborate through persuasive, independent documentary (or other tangible) evidence. Clearly, the quantum of those actions that are deemed sufficient in any one instance is a factual determination that rests, as it must, on a case-by-case analysis. What is eminently clear is that intentions alone -- as is the case with the present Respondent -- are simply not enough for this Respondent to avail herself of the "safe harbor" provisions of paragraph 4(c)(i) of the Policy.

Lastly, given that Respondent has never used any of the disputed domain names -- and expressly concedes as much, she simply can not show that she has made a legitimate non-commercial or fair use of any such name under paragraph 4(c)(iii).

Thus, the Panel finds that Respondent has no rights or legitimate interests, within paragraph 4(a)(ii) of the Policy, in any of the disputed domain names

### **Registration and Use in Bad Faith**

The Panel believes that Respondent's actions constitute bad faith registration and use of each of the disputed domain names.

As discussed in the preceding section, the Panel believes – and it strains belief to think otherwise, that Respondent was fully aware of Complainant's mark GOOGLE when Respondent registered all the disputed domain names on June 26, 2005 and particularly the reputation and substantial worldwide recognition which that mark had attained as a result of Complainant's operations starting some 8 years earlier.

In fact, this Panel believes that Respondent not only knew of Complainant's prior and ongoing activities but also intentionally chose each of the disputed domain names due to its inclusion of Complainant's mark GOOGLE in order to trade off Complainant's then-existing and obviously substantially increasing reputation and eventually, once her web sites became operational to which those names would resolve, those names would act to divert users, then seeking Complainant's site, to Respondent's sites instead and imply in the minds of those users that a relationship or affiliation of some sort existed between it and Complainant – when no such relationship or affiliation then existed in actuality. Such conduct violates paragraphs 4(b)(iv) of the Policy. If that was not the case, then why else would Respondent have registered names that included that particular mark? The Panel can think of no credible reason.

Furthermore, the written correspondence between the parties clearly shows that Respondent, contrary to her assertions of having been induced or solicited, in some fashion, by Complainant to make an offer to it to sell the names for an amount well in excess of her costs to register each of the names, actually took the initiative on her own and put forth two such offers, first for US \$ 1.25 Million and later US \$ 375,000. Obviously, doing so clearly violates paragraph 4(b)(i) of the Policy. These actions only serve to confirm the Panel's view as to Respondent's true intent behind registering these names and her bad faith on connection therewith.

Moreover, the Panel finds that Respondent's continued retention and non-use of each of the disputed domain names for approximately 12 months (as of the date of the Complaint), and particularly in light of Complainant's rights in mark GOOGLE, amounts to passive holding which here also reflects bad faith use. Various panels, including this one, have held that passive holding, coupled with a respondent's knowledge of trademark rights of a complainant in the name being so held – as is clearly the case here, can amount to bad faith use under paragraph 4(a)(iii) of the Policy. *See, e.g., Cheesecake Factory, supra; Bayer Aktiengesellschaft v. Henrik Monssen*, D2003-0275 (WIPO May 30, 2003); *Lake at Las Vegas Joint Venture v. Principal Equiti, Inc.*, D2002-0758

(WIPO Oct. 4, 2002); *Am. Online, Inc. v. Curtis Woods*, D2001-0555 (WIPO June 13, 2001); *Awesome Kids LLC and/or Awesome Kids L.L.C. v. Selavy Communications*, D2001-0210 (WIPO April 16, 2001); *402 Shoes, Inc. d/b/a Trashy Lingerie v. Jack Weinstock and Whispers Lingerie*, D2000-1223 (WIPO January 2, 2001); *Liberty Public Limited Company v. Thomas Guarrera*, FA 95103 (Nat. Arb. Forum August 17, 2000); *V & S Vin & Spirit Aktiebolag v. Gunnar Hedenlans Peev*, FA 95078 (Nat. Arb. Forum August 9, 2000); *Revlon Consumer Prods. Corp. v. Yosef*, D2000-0468 (WIPO July 27, 2000) *Telstra Corporation Limited v. Nuclear Marshmallows*, D2000-0003 (WIPO February 18, 2000); *Mary-Lynn Mondich and American Wine Biscuits, Inc. v. Shane Brown d/b/a Daddy's Antiques*, D2000-04 (WIPO February 16, 2000).

Hence, the Panel views Respondent's actions, with respect to each of the disputed domain names, as constituting bad faith registration and use in violation of paragraph 4(a)(iii) of the Policy.

Accordingly, the Panel concludes that Complainant has provided sufficient proof of its allegations to establish a *prima facie* case under paragraph 4(a) of the Policy upon which the relief it now seeks can be granted.

## **DECISION**

In accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the relief sought by Complainant is hereby **GRANTED**.

Accordingly, the Panel orders that the disputed domain names, <**googlecheckout.com**>, <**googlematching.com**> and <**googleoutdoors.com**>, are to be **TRANSFERRED** from Respondent to Complainant.

Peter L. Michaelson, Esq., Panelist

Dated: August 16, 2006