

# **.nz Dispute Resolution Service**

**DRS Reference: 1185**

**Google Inc.**

**v**

**Ravi Singh**

## **Key words -**

Registered mark – similar – likely to confuse, mislead or deceive – unfairly disrupting business – blocking registration – pattern of registrations

## **1. Parties**

### **Complainant:**

Google Inc.  
Andy Abrams  
1600 Amphitheatre Parkway  
Mountain View  
California  
United States

**Represented by:** Mr Martin Henshall, Cooley (UK) LLP

### **Respondent:**

Ravi Singh  
C18 FF 8  
Shalier Garden Ext 2,  
Sahibabad GZB  
Ghaziabad  
IN (INDIA)

## **2. Domain Name/s**

gmailsupportnz.co.nz  
gmailsupportnewzealand.co.nz

## **3. Procedural history**

The Complaint was lodged on 15 August 2016 and Domain Name Commission (DNC), notified the Respondent of the validated Complaint on 17 August 2016. The domain/s were locked on 16 August 2016, preventing any changes to the record until the conclusion of these proceedings.

No response was received.

The Complainant paid Domain Name Commission Limited the appropriate fee on 28 September 2016 for a decision of an Expert, pursuant to Paragraph 9 of the .nz Dispute Resolution Service Policy ("the Policy").

Barry Paterson QC, the undersigned, ("the Expert") confirmed to the DNC on 03 October 2016 that he knew of no reason why he could not properly accept the invitation to act as expert in this case and that he knew of no matters which ought to be drawn to the attention of the parties, which might appear to call into question his independence and/or impartiality.

#### **4. Factual background**

- 4.1. The Complainant is Google Inc. (Google) an internationally known multi-national technology company based in the United States of America and specialising in Internet-related services and products.
- 4.2. The evidence of Google is that since 1998 it has used the mark GMAIL in connection with the provision of email services. The GMAIL service has become one of the premier free, web-based email services in the world, with over one billion monthly active users as of February 2016.
- 4.3. Google has registered many trade marks for the term GMAIL throughout the world. In New Zealand it has registered Trade Mark No 727345 for GMAIL, which was filed on 29 March 2005 and registered on 29 September 2005 and which has a renewal due date of 29 March 2025. The mark is the name GMAIL and is registered in Class 38, the description of which is for telecommunication services; electronic mail services.
- 4.4. Google's primary website for the GMAIL service is gmail.com. It has registered many domain names which include the name GMAIL but has not asserted that it has registered such a domain name in New Zealand.
- 4.5. Google asserts that as a result of its extensive use, promotion and advertising of the GMAIL service, the mark GMAIL would be associated with Google by almost all Internet users. It draws attention to and has provided evidence of the following:
  - (a) In 2005 the GMAIL service was ranked second in PC World's 100 Best products, received an Honourable Mention in the Bottom Line Design Awards of 2005 and was declared best webmail by Forbes Magazine in 2006.
  - (b) The app for the GMAIL service has been downloaded by more than one billion users.
  - (c) ALEXA, a web traffic and ranking analysis company, currently ranks Google's website at gmail.com in the top 2500 most visited websites on the Internet globally.
  - (d) Google's GMAIL page on the social media platform Facebook has received more than 2 million likes. Google prominently features the GMAIL mark on its Facebook page.
- 4.6. The respondent, Mr Singh registered the Domain Names on 21 April and 9 June 2015 respectively.



- 4.7. The websites of both Domain Names clearly state that the domains have no connection with Google. The wording is common on both websites and an example on the gmailsupportnz.co.nz website reads:

*"Gmailsupportnz.co.nz is not a Google company and is not associated with Gmail in any manner. As Gmail does not have a phone support for free email account users, we have this premium phone support to resolve Gmail issues. Our services are chargeable. We not only fix Gmail related issues but also provide extended support warranties on computer & laptops. Our support warranty covers windows & software related issues (no hardware fault is covered under support warranty). We are available round the clock on our New Zealand."*

- 4.8. The same website contains the following:

***"Gmail Support Nz team is available For Quick Service***

*Defined as the most promising ways to get acquainted with other clients and friends through emailing procedure, we, at Gmail support New Zealand, are ready to offer you with the most proficient **Gmail support NZ**, for your needs. It does not matter whether you are facing any problem with your password or want to reset it for a new password; we are ready to help you in the most proficient manner. Give us a call at our number, at **+64-92805568** and we are ready to help you with various forms of gmail support, which you want from our side. Moreover, we would also like to help your account from preventing it from hackers, without making a fuss."*

- 4.9. The two websites contain many references to Gmail and in many respects are similar. Headings include:

Call Us At Gmail Support Number NZ And Give Relief Instantly

We Are Here With Grade A Gmail Custom Support NZ

Just Contact Gmail NZ And Increase Your Gmail Protection

Our Gmail Technical Support team is Available Round The Clock

Scope of Support for Gmail Accounts.

## **5. Parties' contentions**

### **(a) Complainant**

- 5.1. Google's contention is that the GMAIL brand has come to represent extremely valuable goodwill owned by Google and GMAIL is a well-known mark, particularly in relation to the provision of email and electronic messaging services. In the electronic messaging services field, the GMAIL mark has come to be recognised as in indicia of origin exclusively identified with Google.
- 5.2. The Domain Names are said to be confusingly similar to the GMAIL mark as the GMAIL mark is the dominant and distinctive element of both Domain Names. The addition of the word "support" in both Domain Names does not



change the confusing similarity between the Domain Names and the GMAIL mark. Nor do the addition of the letters "NZ" in one domain name and the words "newzealand" in the other alter the similarity between the Domain Names and the GMAIL mark. It is Google's position that it is beyond doubt that the Domain Names are confusingly similar to the GMAIL mark in which Google has rights.

- 5.3. Google says that the registration of the Domain Names, at a time when the respondent would have known that Google was using the GMAIL mark around the world and in New Zealand in connection with the provision of email and electronic messaging services, was an unfair registration in view of Google's trade mark registered 10 years earlier.
- 5.4. Google supports its unfair registration submission with the following further submissions:
  - (a) Mr Singh is using the Domain Names to direct to websites that purport to offer technical support, including password recovery services, to users of Google's GMAIL service based in New Zealand and instructs those users to call a phone number for assistance, namely a New Zealand phone number.
  - (b) The services offered by Mr Singh including a "password recovery solution" suggests that Mr Singh is likely engaged in phishing schemes, a practice intended to defraud customers into revealing personal and proprietary information. It is also submitted that the websites might also be a subterfuge to get users to allow hackers masquerading as support engineers, access to install malware and demand rents and payments for removing alleged viruses.
  - (c) Mr Singh would have known that Internet users would assume that any website at the Domain Names is operated or authorised by, or otherwise connected with Google. Obviously the Domain Names were selected and registered with Google's GMAIL mark and GMAIL service in mind.
- 5.5. Google relies upon the following provisions of the Policy in support of its complaint:
  - (a) Paragraph 5.1.1(b) – blocking registrations. Registration of the Domain Names has prevented Google from incorporating domain names into a portfolio of domain names that closely reflect its GMAIL mark.
  - (b) Paragraph 5.1.1(c) – disrupting Google's business. This ground is supporting by the phishing scheme suggestion which is said is aimed to defraud users into revealing their confidential GMAIL password and/or is a scam designed to get users to allow hackers access to install malware and demand rents and payments for removing alleged viruses.
  - (c) Paragraph 5.1.2 – confusion. It is inevitable that given the association of the GMAIL mark with Google, Internet users who perform a WHOIS search against the Domain Names will assume that Mr Singh's registration and/or the use of the Domain Names has been authorised



by Google. There is a significant risk that search engines asking information about support services for Google's GMAIL service would produce high on their list the websites at the Domain Names. It is immaterial that consumers may realise that the websites are not upgraded or authorised by Google once they are on the website. The initial interest confusion that is likely to have occurred as a result of Mr Singh's registrations and use of the Domain Names is sufficient for the Domain Names to be considered Unfair Registrations.

- (d) Paragraph 5.1.3 – patterns of registration corresponding to well-known marks. Google provided a schedule of searches which suggest that Mr Singh has registered a number of other domain names containing well-known marks. There are over 43 domain names on the list in the United Kingdom all attributed to Ravi Singh although whether it is actually the same person who is registered, each domain name is not certain. The registrant in respect of many of these domain names gives an address outside India. One of those trade names is "nortonsupportuk" which is registered to Mr Singh's Indian address. NORTON is a well-known anti-virus and security software product. Google also produced copies of two WIPO decisions in which Ravi Singh was one of the respondents. In one of these cases, where the complainant was Yahoo! Inc., Ravi Singh had a similar address to the address given when he registered the Domain Names. The WIPO panel in that case determined that Mr Singh had no rights or legitimate interests in the relevant domain names and that they were registered and used in bad faith. In the other case, the address given by Mr Singh was an Australian address but he used the same email address that he provided when registering the Domain Names.
- (e) Paragraph 6.1 – no legitimate right to register or use the domain names. The registration of the Domain Names was not in support of a genuine offering of goods or services but was registered to perpetrate a fraud on users of Google's GMAIL service. In April 2016, Google's representative wrote to Mr Singh expressing concern regarding the unauthorised use of the GMAIL mark in respect of several domain names in the United Kingdom, Australia and New Zealand. Mr Singh did not respond. As noted below this provision cannot be relied upon by Google.

**(b) Respondent**

- 5.6. The Respondent has not responded to this Complaint. Consequently the Expert can only consider the information and submissions provided by Google which are therefore undisputed. The Expert is entitled to make appropriate inferences from that information.

**6. Discussion and findings**

- 6.1. A Complainant under paragraph 4.1 of the Policy is required to establish:
  - (a) The Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name; and
  - (b) The Domain Name, in the hands of the Respondent, is an Unfair Registration.



- 6.2. The Right relied upon by Google is the trade mark GMAIL. Both Domain Names include gmail in lower case. The addition of the suffix .co.nz is to be ignored in respect of both Domain Names. The issue is whether the adding of the words "supportnz" and "supportnewzealand" in the Domain Names means that the trade mark GMAIL is not identical or similar to the Domain Names. The addition of those words does not in the Expert's view alter the similarity between the trade mark and the Domain Names. It has been accepted that the test for similarity is not particularly high. The Expert is satisfied that Google's Right in respect of the trade mark GMAIL is similar to the Domain Names. The Complaint satisfies the requirements of paragraph 4.1.1 of the Policy, namely that its Right under the registered trade mark is in a name identical or similar to the Domain Names.
- 6.3. Google did not rely upon an unregistered mark. It is therefore not necessary to make a finding on the point but the Expert notes that the evidence suggests that Google may be entitled to rely upon an unregistered common law right in the word GMAIL.
- 6.4. Google seeks to establish Unfair Registration under several provisions of the Policy. The Expert is satisfied that it succeeds on more than one of these provisions. The Policy provides that one of the factors which may be evidence that a domain name is an Unfair Registration is where the "circumstances demonstrate that the Respondent is using the Domain Name in a way which is likely to confuse, mislead or deceive people or businesses into believing that the Domain Name is registered to, operated or authorised by, or otherwise connected with the Complainant" (paragraph 5.1.2 of the Policy).
- 6.5. As noted above, the websites associated with both Domain Names clearly state that the Domain Name "is not a Google company and not associated with GMAIL in any manner". However, if there is a likelihood of confusion, the presence on the websites of the "disclaimer" does not negate the likelihood of confusion. In the WIPO Domain Name Decision D2016-0013 (*Yahoo! Inc. v Ravi Singh*), the sole panellist made such a finding on the basis that the disclaimer text was placed relatively inconspicuously at the bottom of the website pages and in such a manner that the typical visitor to the website would not read it. Further, the panellist considered that by the time an Internet user reaches and reads any disclaimer on a web page to which the domain name resolves, any respondent objective of attracting visitors for financial advantage to its website through use of the trade mark in the domain name will generally have been achieved. Similar provisions apply in this case. The disclaimers are relatively inconspicuous when compared with the provisions offering services. Further, the initial interest confusion would have already occurred before a reader read the disclaimer if in fact the disclaimer was read.
- 6.6. In this case the disputed Domain Names, when the suffixes are ignored, include the entirety of Google's registered trade mark GMAIL. The inclusion in the Domain Names of the descriptive words "supportnz" and "supportnewzealand" do not in the Expert's view reduce the confusion of the Domain Names with Google's trade mark. This finding is supported by the fact that Google does provide online support to its customers. The expert therefore finds that on the ground stated in paragraph 5.1.2 of the Policy the registration of the Domain Names is an Unfair Registration. The use of the



Domain Names as is evidence from the websites already referred to, is likely to confuse, mislead or deceive people or businesses into believing that both Domain Names are registered to, operated or authorised by, or otherwise connected with Google.

6.7. While it is unnecessary to refer to the other grounds relied upon, the Expert notes that there are other grounds which make the registration of the Domain Names an Unfair Registration. In summary:

- (a) The evidence discloses that Mr Singh has registered many domain names around the world in similar circumstances to the registration of the Domain Names. Including the Domain Names there have been 12 registrations which include the word "support" and another which includes the word "help". The Expert draws the inference that the registration of the Domain Names is a blocking registration against the name GMAIL (paragraph 5.1.1(b)).
- (b) For similar reasons an inference can be drawn that one of the purposes of the registration of the Domain Names was to unfairly disrupt the business of Google (paragraph 5.1.1(c)).
- (c) The provisions of paragraph 5.1.3 of the Policy are also relevant. The evidence does establish that Mr Singh is engaged in a pattern of registration where he registers domain names around the world which correspond with well-known names or trade marks in which he has no apparent rights. The registration of the Domain Names is part of that pattern.
- (d) The provisions of paragraph 6.1 relied upon by Google are in fact not relevant. That provision allows a respondent to provide evidence that the registration was not an Unfair Registration. As Mr Singh has taken no part in this Complaint, he cannot raise as evidence that the registrations were not unfair by alleging that he had a legitimate right to register or use the Domain Names.

## 7. Decision

It is directed that the Domain Names are to be transferred to the Complainant.

<b>Place of decision</b>	Auckland
<b>Date</b>	12 October 2016
<b>Expert Name</b>	Barry Paterson QC
<b>Signature</b>	