



NATIONAL ARBITRATION FORUM

DECISION

Google Inc. v. Goggle.com, Inc. / David Csumrik
Claim Number: FA1108001403690

PARTIES

Complainant is **Google, Inc.** ("Complainant"), represented by **Gavin L. Charlston** of **Cooley LLP**, California, USA. Respondent is **Goggle.com, Inc. / David Csumrik** ("Respondent"), represented by **Zak Muscovitch** of **The Muscovitch Law Firm**, Ontario, Canada.

REGISTRAR AND DISPUTED DOMAIN NAMES

The domain names at issue are <**goggle.com**> registered with **ENOM, INC.**, <**goggle.net**> registered with **NETWORK SOLUTIONS, LLC.**, and <**goggle.org**> registered with **Domain Name Inc.**

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.

David E. Sorkin and Sandra J. Franklin as Panelists and Bruce E. O'Connor as Chair.

PROCEDURAL HISTORY

This decision is being rendered in accordance with ICANN's Uniform Domain Name Dispute Resolution Policy (the "Policy"), the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules"), and the National Arbitration Forum's UDRP Supplemental Rules (the "Supplemental Rules").

Complainant submitted a Complaint to the National Arbitration Forum electronically on August 17, 2011; the National Arbitration Forum received payment on August 18, 2011.

On August 17, 2011, ENOM, INC. confirmed to the National Arbitration Forum that the <**goggle.com**> domain name is registered with ENOM, INC., and that Respondent is the current registrant of the name. ENOM, INC. has verified that Respondent is bound by the ENOM, INC. registration agreement and has thereby

agreed to resolve domain disputes brought by third parties in accordance with the Policy.

On August 18, 2011, NETWORK SOLUTIONS, LLC. confirmed by e-mail to the National Arbitration Forum that the <goggle.net> domain name is registered with NETWORK SOLUTIONS, LLC. and that Respondent is the current registrant of the name. NETWORK SOLUTIONS, LLC. has verified that Respondent is bound by the NETWORK SOLUTIONS, LLC. registration agreement and has thereby agreed to resolve domain disputes brought by third parties in accordance with the Policy.

On August 18, 2011, Domain Name Inc. confirmed by e-mail to the National Arbitration Forum that the <goggle.org> domain name is registered with Domain Name Inc. and that Respondent is the current registrant of the name. Domain Name Inc. has verified that Respondent is bound by the Domain Name Inc. registration agreement and has thereby agreed to resolve domain disputes brought by third parties in accordance with the Policy.

On August 23, 2011, the Forum served the Complaint and all Annexes, including a Written Notice of the Complaint, setting a deadline of September 12, 2011 by which Respondent could file a Response to the Complaint, via e-mail to all entities and persons listed on Respondent's registration as technical, administrative, and billing contacts, and to postmaster@goggle.com, postmaster@goggle.net, and postmaster@goggle.org. Also on August 23, 2011, the Written Notice of the Complaint, notifying Respondent of the e-mail addresses served and the deadline for a Response, was transmitted to Respondent via post and fax, to all entities and persons listed on Respondent's registration as technical, administrative and billing contacts.

A timely Response was received and determined to be complete on September 13, 2011.

Complainant submitted an Additional Submission on September 19, 2011 in compliance with Supplemental Rule 7. Respondent submitted an Additional Submission on September 21, 2011 in compliance with Supplemental Rule 7.

On September 27, 2011, pursuant to Complainant's request to have the dispute decided by a three-member Panel, the National Arbitration Forum appointed David E. Sorkin and Sandra J. Franklin as Panelists and Bruce E. O'Connor as Chair.

RELIEF SOUGHT

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

PARTIES' CONTENTIONS

A. Complainant

Complainant submits that it began operating under the GOOGLE name and mark in 1997. Complainant alleges that it uses its GOOGLE mark for its search engine and other Internet related services through its official <google.com> domain name and website. Complainant presents numerous trademark registrations for its GOOGLE mark that it owns with governmental trademark authorities worldwide. Below is a sampling of such registrations:

United States Patent and Trademark Office ("USPTO") (Reg. No. 2,806,075 registered January 20, 2004);
IP Australia ("IPA") (Reg. No. 1,049,124 registered April 4, 2005);
Barbados Corporate Affairs and Intellectual Property Office ("CAIPO") (Reg. No. 81/20986 registered January 19, 2007); and
Canadian Intellectual Property Office ("CIPO") (Reg. No. TMA539,576 registered January 12, 2001).

Complainant states that it had previously filed a UDRP proceeding against the original registrant of the disputed domain names. Complainant states that the parties entered into a confidential settlement agreement and the proceeding was dismissed. Complainant further states that since the domain names have been subsequently transferred to a third-party with whom it has no prior dealings, the agreement was not set forth in the Complaint. Those trademark rights, in any event, predate the transfer to Respondent.

Complainant contends that the disputed domain names are confusingly similar to Complainant's GOOGLE mark. Those domain names contain a misspelled version of the GOOGLE mark where the domain names simply replace the letter "o" with the letter "g" and add a generic top-level domain ("gTLD").

Complainant contends that it has not authorized Respondent to use or register the disputed domain names. Further, Complainant argues that Respondent is not commonly known by the disputed domain names even though the WHOIS information indicates that the registrant is "Goggle.com, Inc." because an Internet search does not return any results for that company name as a legitimate business.

Complainant further argues that Respondent cannot claim to be offering legitimate goods and services through the domain names because it is diverting Internet users to a website that intends to copy the look and feel of Complainant's website and deceiving users into signing up for expensive text messaging plans. Complainant contends that such use is invariably a "phishing" scam in which Respondent receives the personal and financial information of unsuspecting Internet users, and turns around to turn a profit with such information. Further, Complainant submits screen shot evidence to show that the website resolving from the <goggle.com> domain name looks and feels just like Complainant's official <google.com> website while using a close variation of Complainant's logos.

Complainant alleges that Respondent gained possession of the disputed domain names in 2007 or early 2008. Complainant argues that Respondent acquired the domain names in order to effectuate some kind of phishing scheme in which Internet users are made offers for devices such as an “iPad 2” so long as they give personal information and sign up for text message plans for cellular phones.

Lastly, Complainant contends that Respondent could not have registered and used the disputed domain names without actual or constructive knowledge of Complainant and its rights in the GOOGLE mark.

B. Respondent

Respondent states that

[T]he Complainant has failed to disclose that it entered into a Co-existence

[\[1\]](#)

Agreement which entitled the Respondent to register and use the disputed domain names subject to certain terms and conditions which were complied with

Respondent asserts that it purchased and registered the domain names in good faith and on reliance of the Co-existence Agreement. Respondent attaches the Co-existence Agreement (between Complainant and Knowledge Associates, the original registrant) and a Purchase and Assignment Agreement² (between the original registrant and a company identified as 1158860 Alberta, Ltd).

Further, Respondent submits a letter, which was sent to Complainant before the purchase giving Complainant the right of first refusal as required under the terms of the Co-existence Agreement. Respondent states that it purchased the domain names from the original registrant based upon the Co-existence Agreement that was expressly placed within the Purchase and Assignment agreement, and that it has followed the required sections of that agreement. Lastly, Respondent states that the very terms of the Co-existence Agreement expressly and specifically contemplated such a future sale of the domain names and permitted such, so long as certain aspects of the agreement were also agreed to by the new purchaser.

Respondent argues that the domain names all contain the separate and unique term “goggle,” and cannot be found to be confusingly similar to Complainant’s good mark. Further, Respondent references the Co-existence Agreement that states, “the word goggle will not be considered as a misspelling of the word google.”

Respondent argues that the term “goggle” of the domain names is a real and separate word from Complainant’s mark, therefore permitting the Panel to find that the domain names are not confusingly similar to Complainant’s mark.

Respondent also references the Complaint that states that “the manner in which

Respondent is using the Domain Names” is the issue here. Respondent contends that such a statement is an admission by Complainant that the domain names are not similar to the GOOGLE mark, and that Complainant is trying to prove confusing similarity by bringing in Respondent’s use of the domain name instead of an objective analysis of the mark’s and the domain names’ similarities.

Respondent argues that, contrary to Complainant’s assertions, it is in fact known as “Goggle” because its corporate name is “Goggle.com, Inc.,” and that it has carried out business under this name for nearly four years. Respondent submits its corporate registration as part of its annexes to show that it is in fact registered as a business under the “Goggle.com, Inc.” name. Respondent further notes that its banking information is under the “Goggle.com Inc.” name and that it receives all payments from third-party advertisers under its corporate name.

Respondent contends that it is using the disputed domain names in the same manner as the previous registrant did for advertising and marketing solicitations. Respondent argues that such uses were known, accepted, and condoned by Complainant before it signed the Co-existence Agreement with the prior registrant. Respondent notes that it is able to conduct the same type of business activity under the disputed domain names because the Co-existence Agreement that Complainant signed contemplated such use by future purchasers.

Respondent contends that Complainant’s recent objection about the recent use of “an arguably similar graphic logo” does not nullify Respondent’s long-standing use of the domain names for its advertising and marketing solicitations. Respondent also states that it removed the allegedly infringing logo from its website since that time, and that it has only been used for a short period of time. Respondent maintains that it has not violated the terms of the Co-existence Agreement, and that it has rights in the domain names.

Respondent also argues that the term “goggle” of the disputed domain names is common and generic, and therefore, Complainant does not have an exclusive monopoly on the term on the Internet.

Respondent alleges that Complainant has acted in bad faith and is engaging in reverse domain name hijacking by initiating this dispute. Respondent contends that Complainant is attempting to deprive Respondent, the rightful, registered holder of the disputed domain names, of its rights to use those names.

Respondent contends that Complainant

buried the fact of the existence of the Co-existence Agreement. The only reference to the fact of its existence was hidden away in the only footnote to its entire 15-page Complaint.

Respondent notes that the terms of the Co-existence Agreement were all followed, and that Complainant had the right to purchase the domain names per that agreement and chose to let Respondent register them instead. Respondent further notes that Complainant's possible motive in bringing this UDRP claim is that it has recently launched a new mobile service called "Google Goggles," and wishes to use the domain names for its own gain. Therefore, Respondent contends that Complainant knew at the time of filing this Complaint that Respondent did not register or use the domain names in bad faith.

C. Additional Submissions

1. Complainant

Complainant contends that the two agreements referred to by Respondent have no bearing on the resolution of this dispute. First, there is no evidence that the agreements create and govern a relationship between Complainant and Respondent. Second, Respondent is a bad faith actor who acquired the disputed domain names with a clear intent to profit from and associate them with the Google mark and who is using the domain names in a fraudulent manner.

Complainant asserts that merely using a corporate name identical to one of the disputed domain names is not sufficient to establish that Respondent is commonly known by the disputed domain names. Complainant further argues that Respondent even admits that the only reason it established its corporate name is for owning the domain names.

Complainant contends that Respondent's assertion of the proposition that it can use a generic term in a domain name to establish a legitimate interest therein is not accepted. Complainant contends that Respondent's cited cases for such a proposition all deal with a descriptive term that is being used for its descriptive qualities, which is not the case here. Complainant asserts that Respondent is not posting any content related to eye wear or goggles, but is using the domain names to defraud Internet users who believe they may be on Complainant's website.

Complainant notes that uses of confusingly similar domain names for "survey sites" are part of growing schemes to generate revenue. Complainant argues that Respondent has increasingly used the domain name and the content within its website to confuse Internet users into believing that Complainant is associated with the domain name.

Complainant notes that Respondent

even adopted a logo so closely similar to Google's famous mark (and well known 'doodles') that it gave rise to numerous complaints by Google's consumers who had been deceived into believing Respondent's website was affiliated with Google.

Complainant argues that Respondent's use of the domain names to commercially profit in such a manner is evidence that Respondent registered and is using the domain names in bad faith.

Complainant argues that Respondent's allegation of reverse domain name hijacking is "no more than a desperate effort by Respondent to maintain its illegal and highly profitable enterprise." Further, Complainant asserts that Respondent cannot bring in the previous agreement that Complainant had with the original registrant because it was not a party to such an agreement, and either way the agreement is confidential in nature and should not be disclosed.

2. Respondent

Respondent contends that there is no provision in the Policy for a "reply." Rule 12 confines the submission of additional material beyond the Complainant and the Response to submissions provided at a Panel's request only. Supplemental Rule 7, providing for the filing of Additional Submissions, must be viewed in accordance with the National Arbitration Forum's statement on its website that it is up to the Panel, in accordance with Rule 10, to decide whether such Additional Submissions will be considered.

Respondent contends that Complainant does not even mention its un-exercised right of first refusal or its status as a Third Party Beneficiary under the Co-existence Agreement. Because Respondent has not breached the Co-existence Agreement, Complainant has no recourse thereunder and is thus proceeding under the Policy.

Respondent contends that it is an Assignee and permitted beneficiary under the original Co-existence Agreement above thereby granting Respondent standing to bring in the contract. Respondent attaches an Assignment and Assumption Agreement (between 1158860 Alberta. Ltd. and the Respondent).

Therefore, Respondent contends that this contract needs to be interpreted, which falls outside the scope of the UDRP.

FINDINGS

Admissibility of Additional Submissions

As correctly noted by Respondent, there is a conflict between Rule 12 (which allows the Panel to request further statements and documents beyond the Complaint and Response) and Supplemental Rule 7 (which provides for the automatic fee-based filing of Additional Submissions). As in previous cases, this conflict is usually resolved by the Panel, which has the discretion under Rule 10(d) to "determine the admissibility... of the evidence."

In this matter, the Panel finds that the Additional Submissions help the Panel in its resolution of the matter and therefore has considered them, at least to the extent that they contain material that could not reasonably have been included in the Parties'

initial submissions.

Policy

The Panel declines jurisdiction in this matter, as discussed below, and therefore makes no findings.

DISCUSSION

Paragraph 15(a) of 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:

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

The evidence and arguments relied on by the Parties, relating to the Policy, are extensive and ably done.

But, the Panel finds that this case is foremost a business and/or contractual dispute between two companies that falls outside the scope of the Policy.

In *Love v. Barnett*, FA 944826 (Nat. Arb. Forum May 14, 2007), the panel stated:

A dispute, such as the present one, between parties who each have at least a *prima facie* case for rights in the disputed domain names is outside the scope of the Policy ... the present case appears to hinge mostly on a business or civil dispute between the parties, with possible causes of action for breach of contract or fiduciary duty. Thus, the majority holds that the subject matter is outside the scope of the UDRP and dismisses the Complaint.

When the parties differ markedly with respect to the basic facts, and there is no clear and conclusive written evidence, it is difficult for a Panel operating under the Rules to determine which presentation of the facts is more credible. National courts are better equipped to take evidence and to evaluate its credibility.

The panel in *Luvilon Industries NV v. Top Serve Tennis Pty Ltd.*, DAU2005-0004 (WIPO Sept. 6, 2005) concurred with this reasoning:

[The Policy's purpose is to] combat abusive domain name registrations

and not to provide a prescriptive code for resolving more complex trade mark disputes. ... The issues between the parties are not limited to the law of trade marks. There are other intellectual property issues. There are serious contractual issues. There are questions of governing law and proper forum if the matter were litigated. Were all the issues fully ventilated before a Court of competent jurisdiction, there may be findings of implied contractual terms, minimum termination period, breach of contract, estoppels or other equitable defenses. So far as the facts fit within trade mark law, there may be arguments of infringement, validity of the registrations, ownership of goodwill, local reputation, consent, acquiescence, and so on.

The GOOGLE mark in this case is the very one that is the subject of the Co-existence Agreement. The disputed domain names in this case appear to be the very ones that are the subject of the Co-existence Agreement.

That agreement set forth the rights and obligations of the original registrant and Complainant regarding the Google Mark and the disputed domain names. Those rights include a consent by Complainant to the original registrant's ownership and/or use of the domain names therein on the terms and conditions of the Co-existence Agreement. This consent appears to continue beyond the effective date of that agreement.

Respondent states that it is entitled to the rights of the original registrant (by reason of either being an assignee or a third party beneficiary), and that it is complying with the obligations of the original registrant.

Complainant in essence says that the Co-existence Agreement is irrelevant to its present claim under the Policy, and that the agreement is confidential.

The Purchase and Sale Agreement purports to transfer the rights and obligations of the original registrant under the Co-existence Agreement to a third party. The Assignment and Assumption Agreement purports to transfer those rights and obligations to the Respondent. The Co-existence Agreement includes a provision restricting public statements by both parties.

Does the Co-existence Agreement apply to the disputed domain names? Does Respondent stand in the shoes of the original registrant? Does the consent of Complainant extend in time to the current actions of Respondent and in person to the Respondent? Has the Respondent complied with the obligations of the original registrant? Does the "no public statements" provision in the Co-existence Agreement prohibit its disclosure or use as a defense by Respondent?

These are factual and legal issues that go far beyond the scope of the Policy.

These are factual and legal issues that must be resolved *before* any consideration of confusing similarity, legitimate rights and interest, and bad faith under the Policy can be made.

And they are issues of considerable complexity, best addressed by a court or other body equipped to take and consider evidence related to their resolution.

DECISION

The Panel declines jurisdiction over this Complaint and over Respondent's related claim of Reverse Domain Name Hijacking.

The case is thus dismissed.

David E. Sorkin and Sandra J. Franklin as Panelists and Bruce E. O'Connor as Chair
Dated: October 11, 2012

[1]

The agreement is actually entitled "Settlement Agreement."

2

The agreement is actually entitled "Domain Name Purchase and Sale Agreement and Assignment Agreement."

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