

SINGAPORE DOMAIN NAME DISPUTE RESOLUTION SERVICE

Administrative Panel Decision

Case No. SDRP-2002-0003(F)

Google, Inc. v Googles Entertainment

1. The Parties

- 1.1 The Complainant is Google, Inc., a US California company whose registered address and principal place of business is 2400 Bayshore Parkway, Mountain View, California, USA. It was represented by Mrs Ang Su Lin and Mr. Christopher Woo of Harry Elias Partnership.
- 1.2 The Respondent is Googles Entertainment, a sole proprietorship registered under the law of Singapore and having its place of business at 173-B, Telok Ayer Street, Singapore 068622. It was represented by its sole proprietor, Ms Teo Tian Ki.
- 1.3 In this decision, the Complainant and the Respondent will be referred to collectively as “the Parties”.

2. The Domain Names and Registrar

- 2.1 The domain names at issue are “google.com.sg” and “googles.com.sg” (“the Domain Names”).
- 2.2 The Registrar for the Domain Names is Singapore Network Information Centre (“SGNIC”) Pte Ltd of 8 Temasek Boulevard, #14-00 Suntec Tower 3, Singapore 038988.

3. Procedural History

- 3.1 The Complainant submitted this complaint (“the Complaint”) pursuant to the Singapore Domain Name Dispute Resolution Policy (“the Policy”) and the Rules for the Singapore Domain Name Dispute Resolution Policy (“the Rules”).
- 3.2 The Secretariat for the Singapore Domain Name Dispute Resolution Service (“Secretariat”) received the Complaint via e-mail and hard copy on 25 September 2002. After checking the Complaint for administrative compliance with the Policy and the Rules, the Secretariat forwarded the Complaint, together with a covering minute and the prescribed Complaint Notification Instructions, to the Respondent on 26 September 2002.
- 3.3 The Respondent submitted its Response on 16 October 2002.
- 3.4 Upon receipt of the Response, the Secretariat notified the Parties of the appointment of the Administrative Panel on 18 October 2002, formally appointing Mr. Tan Tee Jim, S.C. as the sole panellist. The panellist received the Complaint with supporting documents and the Response on the same date.

4. Factual Background

- 4.1 The Complainant registered the domain name google.com on 15 September 1997. The name “GOOGLE” is a play on the word “googol”, meaning the number

represented by 1 followed by 100 zeros. The choice of the name was intended to reflect the Complainant's mission to organise the immense amount of information available on the web.

4.2 The Complainant develops and operates a search engine service and web site under the name. The search engine has an index of more than 1.5 billion web pages and offers Internet users an easy-to-use interface, advanced search technology, and a comprehensive array of search tools. It allows users to search for and find content in many different languages concerning such matters as news headlines, stock quotes, dictionary definitions, street maps and web page translations. In addition to its web site located at www.google.com, the Complainant operates web sites at numerous ccTLDs, including www.google.co.uk (United Kingdom), www.google.fr (France), www.google.ch (Switzerland) and www.google.co.jp (Japan)

4.3 The search engine has received extensive media publicity in Singapore and elsewhere as well as several awards and accolades, as evidenced by the documents exhibited at Annexures "G" and "M" of the Complaint. Currently, it responds to more about 150 million search queries per day worldwide. In Singapore, the number of hits per month was 250,000 in July 1999 and rose to 17,511,360 in July 2002.

4.4 The Complainant has registered the trade mark "GOOGLE" in many countries, including Australia, Canada, China, Japan, Korea, New Zealand, Switzerland and Taiwan. In Singapore, the mark is registered under T00/20972I in class 9 for

"computer hardware; computer software for searching, compiling, indexing and organizing information within individual workstations, personal computers or computer networks; computer software for electronic mail and facilitating workgroup communications over computer networks; computer software for creating indexes of information, web sites and other resources."

The application for the registration was filed in December 2000 and granted on or about 22 July 2002 when the certificate of registration was despatched.

4.5 In addition, the Complainant filed an application for the mark in December 2000 in Singapore in class 42 for

"computer services, namely, on-line personalized information services; information extraction and data mining; providing access to proprietary collections of information; creating indexes of information, web sites and other information sources; providing information concerning a wide range of text, electronic documents, databases, graphics and audiovisual information; providing electronic mail and workgroup communications services."

The application, bearing number T00/20973G, is still pending.

4.6 The Respondent is a firm which is in the business of convention, conference, event and concert organisation. It was incorporated on 3 July 2002 and registered the Domain Names "google.com.sg" and "googles.com.sg" on 5 and 16 July 2002 respectively.

4.6 On 31 July 2002, the Complainant's solicitors, Harry Elias Partnership, issued a cease and desist letter to the Respondent, asking it, amongst others, to transfer

the domain name "google.com.sg" to the Complainant. The Respondent did not respond to the letter.

5. Parties' Contentions

5.1 The Complainant contends that

- (1) the Domain Names are identical or confusingly similar to a name, trade mark or service mark (namely, "GOOGLE") in which it has rights;
- (2) the Respondent has no rights or legitimate interests in respect of the Domain Names; and
- (3) the Domain Names have been registered or are being used in bad faith by the Respondent.

5.2 The Complainant further contends that it has satisfied these elements and requests that the Domain Names be transferred to it.

5.3 The Respondent denies these contentions and essentially asserts that

- (1) there is no passing off because the nature of its business is different from the Complainant's, the spelling in its domain name "googles.com.sg" is different, there is a disclaimer and its name is prominently stated in the web site such that any reasonable person can see clearly that its site is not the Complainant's;
- (2) there was no bad faith on its part because "googles" is not a registered trade mark in Singapore, there was no prior use of the word in Singapore, it registered the domain name "googles.com.sg" according to its firm name, it had incurred expenditure in registering the firm and the Domain Names, web site hosting and pointing as well as making preparations for launching the business next year, and its site under "google.com.sg" is redirected to the one under "googles.com.sg"; and
- (3) the Complainant has no rights to the word "googles" as there is another entity (namely, The Googles Children's Workshop) which owns the domain name "googles.com";

6. Discussions and Findings

6.1 Paragraph 15(a) of the Rules instructs the Panel to decide the Complaint "on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of the law of Singapore as it deems applicable". Accordingly, to the extent that it would assist the Panel in determining whether the Complainant has met its burden as established by paragraph 4a of the Policy, the Panel will look to the principles of the law of Singapore as it deems applicable.

6.2 Paragraph 4a of the Policy requires the Complainant to prove each of the following conjunctive elements:

- (i) the Respondent's domain name is identical or confusingly similar to a name, trade mark or service mark in which the Complainant has rights;
- (ii) the Respondent has no rights or legitimate interests in respect of the domain name; and

- (iii) the Respondent's domain name has been registered or is being used in bad faith.

- 6.3 If the Complainant successfully proves all three elements on the balance of probabilities in respect of the Domain Names, it shall be entitled to either of the remedies set out in paragraph 4i of the Policy, namely, cancellation of the Domain Names or transfer of the Domain Names to the Complainant.

Identity and Confusing Similarity

- 6.4 The first question is whether the Complainant has rights in the name or mark "GOOGLE". In the Panel's view, the meaning of the word "rights" in paragraph 4a(i) is wide enough to encompass rights arising from trade mark registration as well as the common law tort of passing off. The Complainant must have the rights as at the date of the commencement of the Administrative Proceeding, if not earlier. This interpretation is supported by the use of the present tense in the word "has" in paragraph 4a(i) and the words "is being used" in paragraph 4a(iii). The date of commencement of the Administrative Proceeding is the date on which the Secretariat completes its responsibilities under paragraph 2(a) of the Rules in connection with forwarding the Complaint to the Respondent (see paragraph 4(c) of the Rules). In the present case, that date is 26 September 2002.
- 6.5 Under the Trade Marks Act (Cap. 322, 1999 ed.) ("the Act"), rights in relation to a trade mark stem from registration. Upon registration, the proprietor of the trade mark has the exclusive rights to use the trade mark and to prevent others from using a mark which is identical with or similar to the trade mark in relation to identical or similar goods or services (see sections 26 and 27 of the Act).
- 6.6 The mark "GOOGLE" was registered under T00/209721I on or about 22 July 2002, which is the date when the certificate of registration was despatched. The Complainant therefore has rights at the commencement of this Administrative Proceeding. Although the registration is in respect of the class 9 goods set out in paragraph 4.4 above, for purposes of determining the scope of the rights under paragraph 4a(i) of the Policy, it is irrelevant that the Complainant's business, goods or services are different from the Respondent's (see, e.g., the recent case of *J.D. Edwards & Company v Nadeem Bedar*, WIPO Case No. D2002-0693).
- 6.7 Further, the Complainant has rights under the tort of passing off in Singapore. To succeed under the tort, a plaintiff must prove three elements: (1) goodwill in a business, (2) misrepresentation by the defendant which leads or is likely to lead the public into believing that the defendant's goods or services are those of the plaintiff's or that there is a business connection between the plaintiff and the defendant, and (3) damage or a likelihood of damage as a result of the misrepresentation. The essence of the tort is that

"...nobody has the right to pass off his goods as the goods of somebody else." (Spalding & Bros. v A.W. Gamage Ltd (1915) 32 RPC 273 at 283)

This essence has also been adopted by the Singapore courts (see, e.g., *CDL Hotels International Ltd v Pontiac Marina Pte Ltd* [1998] 2 SLR 550 at 583).

- 6.8 Ordinarily, goodwill is acquired by use, preferably extensive use. There has been such use of the mark "GOOGLE" by the Complainant in Singapore. As mentioned above, the number of monthly search requests from Singapore was 250,200 in July 1999 and this grew to 17,511,360 in July 2002. These figures indicate a

substantial number of Internet users in Singapore of the Complainant's search engine. The engine and its popularity have been the subject of media attention in a number of countries, including Singapore. The Complainant has received many awards and accolades and this has been reported in a several prominent magazines such as "Forbes" and "PC Magazine" which are available in Singapore. Although the Respondent doubts that the word "GOOGLE" is well-known in Singapore, the likely reality is that it is widely known to a substantial number of Internet users in Singapore. Such users would associate the mark with the web site and online search engine services provided by the Complainant. This Panel is therefore of the view that the Complainant has goodwill in Singapore in respect of the business of providing online search engine services.

- 6.9 The use of the mark by the Respondent in relation to its business is likely to mislead people to believe that its services are those of the Complainant's or that there is a business connection between the Complainant and the Respondent. The Complainant's search engine provides access to over 1.5 billion web pages. These pages provide a very diverse range of services, such as translation services, stock quotes and street maps. In addition, it displays numerous mail order catalogues selling everything from industrial adhesives to clothing and home furnishings. The use of the Domain Names in relation to the service of organising convention, conference, event or concert is liable to lead to the erroneous belief that the Complainant is also promoting or selling such service or is otherwise connected to such service.
- 6.10 The Respondent says that its business is clearly different from the Complainant's goods or services, the suggestion being that the erroneous belief is unlikely. Even if this were so, there is an important distinction between the use of the domain name and the use of the web site. Specifically, the use to which the site is put has no bearing on the issue whether the domain name is confusingly similar to the trade mark. This is because, by the time Internet users arrive at the Respondent's site, they would already have been misled by the similarity between the Domain Names and the Complainant's mark into thinking that they are on the way to the Complainant's site and search engine. In these circumstances also, the use of the disclaimer would not dispel the confusion because when users get to read the disclaimer, the Domain Names have already diverted them from the Complainant's site. As stated in *Estee Lauder Inc. v estalauder.com, estalauder.net and Jeff Hanna* (WIPO Case No. D2000-0869),

"The fact that the users, once so diverted or attracted, are confronted with numerous disclaimers does not cure the initial and illegitimate diversion."

- 6.11 The erroneous belief could also cause damage to the Complainant in various ways. As Warrington, LJ said in *Ewing v Buttercup Margarine Co. Ltd* [1917] 2 Ch. 1 at 13-14:

"The quality of goods I sell, the kind of business I do, the credit or otherwise which I enjoy are all things which may injure the other man who is assumed wrongly to be associated with me."

This is especially so in respect of the content of a web site over which the Complainant has no control. This Panel therefore finds that the second and third elements of passing off have also been established and that the Complainant also has rights under the tort of passing off.

- 6.12 The second question is whether the Domain Names are identical or confusingly similar to the name or mark "GOOGLE". It is indubitable that they are. In particular, as regards the domain name "googles.com.sg", the addition of one

letter “s” in the word “googles” does not avoid confusing similarity with the name or mark in terms of sight and sound (see also *InfoGear Technology Corporation v iPhones*, NAF FA 0094369 where “iphones.com” was held to be similar to “Iphone”). Also, the addition of the generic identifier “com.sg” is without significance in determining similarity (see e.g., *Diageo plc v John Zuccarini*, WIPO Case No. D2000-0541).

- 6.13 The Panel therefore finds that Complainant has discharged the burden of proof in respect of paragraph 4a(i) of the Policy.

Rights or Legitimate Interests

- 6.14 Paragraph 4a(ii) of the Policy requires the Complainant to prove that the Respondent has no rights or legitimate interests in respect of the Domain Names. It is stated in paragraph 4c of the Policy that such rights or interests may be demonstrated by showing that:

- (1) before any notice of this dispute, the Respondent used, or demonstrably prepared to use, the Domain Names or a name corresponding to each of the Domain Names in connection with a bona fide offering of goods or services;
- (2) the Registrant has been commonly known by either of the Domain Names, even if it has acquired no trade mark or service mark rights; or
- (3) the Respondent is making a legitimate non-commercial or fair use of the Domain Name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trade mark or service mark in issue.

- 6.15 Typically, rights and interests in respect of a domain name arise from use or active preparations to use. For instance, in *Phone-N-Phone Services (Bermuda) Ltd v Schlomi (Salomon) Levi* (WIPO Case No. D2000-0040), the respondent submitted evidence that before it received notice concerning its registration of the domain name “phonenphone.com”, it was involved in a project to create an international telephone network and had jointly promoted the name “Phone-N-Phone” in connection with another project. It was held that the respondent had rights and interests in the domain name because it had made active preparations to use a name corresponding to the domain name in connection with a bona fide offering of services.

- 6.16 In the instant case, the Respondent has not shown any use or any preparation to use either of the Domain Names in connection with a bona fide offering of goods or services. It was registered as a firm on 3 July 2002 but the Respondent has not indicated or adduced any evidence that it has commenced the business of convention, conference, event or concert organisation. It says that it is making preparations to launch the business next year, but no information is provided at all concerning the preparations. Moreover, its two web sites are inactive. A search of the google.com.sg site automatically leads one to the googles.com.sg site which is itself stated to be under construction.

- 6.17 The Respondent has not asserted that it has been commonly known by either of the Domain Names prior to the registration of the names. Given that it was registered only days before the registration of the Domain Names in July 2002 and has evidently not commenced any business, it would be difficult to support such an assertion. It has also not registered either of the words “google” and “googles” as a trade or service mark. It says it should not be excluded from using the word “googles” because there is no precedent use of it in Singapore and the word appears in the domain name “googles.com” of an entity known as “The

Googles Children's Workshop". These are hardly reasons which would confer rights or interests in the word upon the Respondent itself.

- 6.18 Accordingly, this Panel is unable to find that the Respondent has rights or legitimate interests in the Domain Names.

Bad Faith

- 6.19 Paragraph 4a(iii) of the Policy requires the Complainant to prove that the domain name was registered or is being used in bad faith. Paragraph 4b of the Policy sets out the following circumstances which shall be evidence of bad faith:

- (1) the Respondent registered the domain name primarily for the purpose of selling, renting or otherwise transferring the registration to the Complainant or its competitor for a consideration in excess of the Respondent's out-of-pocket costs directly related to the name;
- (2) the Respondent registered the domain name in order to prevent the Complainant from reflecting the mark in a corresponding domain name, provided the Respondent has engaged in a pattern of such conduct;
- (3) the Respondent has registered the domain name primarily for the purpose of disrupting the business of a competitor; or
- (4) by using the domain name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to his site, by creating a likelihood of confusion with the Complainant's mark or name as to the source, sponsorship, affiliation or endorsement of the Respondent's site or of a product on his site.

- 6.20 There is no evidence of any activity by the Respondent from which to draw any conclusion as to its intent to sell or otherwise profit from the Domain Names. Nor is there any evidence that it has engaged in a pattern of conduct of registering domain names to prevent trade mark proprietors from reflecting their marks in corresponding domain names. It cannot also be said that it is a competitor of the Complainant. Nevertheless, it is clear from the words "in particular but without limitation" in paragraph 4b that the circumstances are not intended to be exhaustive and are merely provided for guidance. It does not mean that the absence of any or all of these circumstances would indicate absence of bad faith. All the circumstances of the case would have to be taken into account.

- 6.21 One of the circumstances to be taken into account is that the Respondent has made no use of the Domain Names. It has been held on a number of occasions that such non-use amounted to bad faith. For instance, in *Telstra Corporation Limited v Nuclear Marshmallows* (WIPO Case No. D2000-0003), the panellist concluded that bad faith could be inferred from the respondent's passive holding of the domain name, especially as the mark "telstra" was widely known in Australia and other countries and the respondent had provided no evidence whatsoever of any actual or contemplated use of the domain name. The same conclusion can be drawn in the present case.

- 6.22 Another circumstance is the Respondent's failure to explain why it chose the word "GOOGLES", being a word that is not naturally associated with its business. It has also not asserted that it was unaware of the Complainant's search engine when it registered the Domain Names in July 2002. Indeed, it is unlikely that it was unaware, given that (1) the search engine has been on the Internet since September 1997 and has garnered widespread use and notoriety in Singapore and elsewhere, and (2) the Respondent appears to be a knowledgeable Internet user since it knows of a web site operated under the domain name "googles.com" by another entity. It is also unlikely that it did not cross the Respondent's mind

when it registered the Domain Names on separate occasions in July 2002 that the Domain Names are substantially similar to, if not identical with, the name of a widely known search engine and that there is a possibility of confusion.

6.23 Further, the mark "GOOGLE" is an invented word in relation to online search engine services and is distinctive of the Complainant's search engine. As such, one would hesitate choosing to use it (or a mark substantially similar to it), unless there is an intention to create an association with the search engine. While the Complainant has provided no evidence to demonstrate the Respondent's purpose in registering the Domain Names, it is not unreasonable to infer that the Respondent intended the natural consequences of its acts, particularly where, as in this case, the Respondent has not provided any explanation for the choice of the word. In the circumstances, it is reasonable to conclude that the Respondent intentionally registered the Domain Names for the purpose of attracting Internet users to its web sites for commercial gain by creating a likelihood of confusion with the Complainant's name or mark "GOOGLE".

6.24 It is also of significance to note that the Respondent registered the Domain Names shortly after the firm was registered on 3 July 2002. There appears to be some haste in obtaining the Domain Names, which is curious and to be contrasted with the inexplicable delay in developing and providing content to the sites. It is also not helpful that the Respondent failed to respond to and address the claims made in the Complainant's solicitors' letter dated 31 July 2002. This failure has been held on a number of occasions to be indicative of bad faith (see, e.g., *News Group Newspapers Limited and News Network Limited v Momm Amed la*, WIPO Case No. D2000-1623).

6.25 Taking into account all of the above, this Panel concludes that the Domain Names have been registered or are being used in bad faith.

7. Conclusion

7.1 In the result, the Panel finds that the Complainant has discharged the burden of proving all the elements in paragraph 4a of the Policy and requires that the Domain Names be transferred to the Complainant.

Tan Tee Jim, S.C.
Sole Panellist

30 October 2002