



NATIONAL ARBITRATION FORUM

DECISION

Google Inc. v. Blue Arctic LLC
Claim Number: FA1206001447355

PARTIES

Complainant is **Google Inc.** (“Complainant”), of Mountain View, California, USA, represented by **Anne H. Peck, Gavin L. Charlston and Morgan A. Champion** of **Cooley LLP**, Palo Alto, California, USA. Respondent is **Blue Arctic LLC** (“Respondent”), of Kissimmee, Florida, represented by **Zak Muscovitch** of **The Muscovitch Law Firm**, of Toronto, Ontario, Canada.

REGISTRAR AND DISPUTED DOMAIN NAME

The domain name at issue is **<oogle.com>**, registered with **Moniker**.

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.

Douglas M. Isenberg (chair), Reinhard Schanda and Professor David E. Sorkin as Panelists.

PROCEDURAL HISTORY

Complainant submitted a Complaint to the National Arbitration Forum electronically on June 5, 2012; the National Arbitration Forum received payment on June 6, 2012.

On June 8, 2012, Moniker confirmed by e-mail to the National Arbitration Forum that the <oogle.com> domain name is registered with Moniker and that Respondent is the current registrant of the name. Moniker has verified that Respondent is bound by the Moniker registration agreement and has thereby agreed to resolve domain disputes brought by third parties in accordance with ICANN's Uniform Domain Name Dispute Resolution Policy (the "Policy").

On June 12, 2012, the Forum served the Complaint and all Annexes, including a Written Notice of the Complaint, setting a deadline of July 2, 2012 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@oogle.com. Also on June 12, 2012, 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.

On July 2, 2012, Respondent submitted a Response.

On July 9, 2012, Complainant submitted an additional statement. On July 10, 2012, Respondent submitted an objection to Complainant's additional statement and, "in the alternative," an "Additional Response of the Respondent." The Panel determines that these additional documents were timely submitted pursuant to the National Arbitration Forum's Supplemental Rule 7 and, accordingly, the Panel accepts them.

On July 12, 2012, pursuant to Complainant's request to have the dispute decided by a three-member Panel, the National Arbitration Forum appointed Douglas M.

Isenberg as the Chair of the three-member Panel along with Reinhard Schanda and Professor David E. Sorkin as Panelists.

Having reviewed the communications records, the Administrative Panel (the "Panel") finds that the National Arbitration Forum has discharged its responsibility under Paragraph 2(a) of the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules") "to employ reasonably available means calculated to achieve actual notice to Respondent" through submission of Electronic and Written Notices, as defined in Rule 1 and Rule 2.

RELIEF SOUGHT

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

PARTIES' CONTENTIONS

A. Complainant

In its Complaint, Complainant contends, in relevant part, as follows:

- Complainant's search engine "has become one of the largest, most highly recognized, and widely used Internet search services in the world."
- "The GOOGLE name was created in 1997 by Stanford Ph.D. candidates Larry Page and Sergey Brin," and Complainant's "services have been publicly available under the GOOGLE mark since 1997."
- "As reflected in [Complainant's] trademark registrations and affirmed by [Complainant's] officers in filings made to the U.S. Patent & Trademark Office under penalty of perjury, [Complainant] has used the GOOGLE mark in U.S. commerce in connection with its services since September 1997 and in connection with other products and services since early 1999."

- The Disputed Domain Name was “originally registered on February 7, 1999” and “transferred to the current registrant in late 2004.”
- The Disputed Domain Name “resolves to a variety of adult websites” and “has previously been used to host websites that blatantly copy the Google logo, recreate the overall look and feel of the Google website, and create confusion as to whether the website is sponsored by, endorsed by, or affiliated with Google.”
- The Disputed Domain Name is currently being offered for sale “on a common domain name auction site” for \$300,000.
- The Disputed Domain Name is confusingly similar to the GOOGLE trademark because it “merely delete[s]” one letter from a famous mark and “appears intended to capitalize on frequent user misspellings or typographical errors.”
- Respondent has no rights or legitimate interests in respect of the Disputed Domain Name because, *inter alia*, “the GOOGLE Mark is so well known throughout the world that it is difficult to conceive of any purported rights or legitimate interests Respondent may claim in the Domain Name”; “Respondent is not commonly known as the Domain Name or any name containing Complainant’s GOOGLE Mark” because “there is no indication it is known by that name”; “Complainant has not authorized or licensed Respondent to use any of its trademarks in any way”; the Disputed Domain Name “currently resolves to a website offering sexual services and displaying pornographic and profane content”; the Disputed Domain Name is “an example of typosquatting”; and because “the Domain Name has historically resolved to websites mimicking the look and feel of Google’s home page . . . Respondent is now and has historically been capitalizing on the near identity between the Domain Name and Google’s famous trademark to generate revenue from consumers who are seeking Google’s services and arrive at Respondent’s website by mistake.”

- Respondent registered and is using the Disputed Domain Name in bad faith because, *inter alia*, “[t]he fame and unique qualities of the GOOGLE Mark, which was adopted and registered by Complainant years prior to the registration of the Domain Name by Respondent, make it extremely unlikely that Respondent registered the Domain Name without independent knowledge of Google”; “even constructive knowledge of a famous mark like GOOGLE is sufficient to establish registration in bad faith”; “[p]rior use and registration of the Domain Name by a third party is irrelevant for purposes of evaluating Respondent’s bad faith”; “Respondent’s current use of the Domain Name to divert Google’s users to a fee-based sexual networking site that contains pornographic and vulgar content establishes Respondent’s bad faith”; “Respondent’s recent use of the Domain Name to obtain users’ personal information through scam survey sites is evidence of phishing and represents bad faith” (internal punctuation omitted); “it is impossible to conceive of any potential legitimate use of the Domain Name”; “[w]here a domain name is so obviously connected with such a well-known name and products, its very use by someone with no connection with the products suggests opportunistic bad faith” (internal punctuation omitted); “Respondent’s use of Complainant’s famous trademark in the Domain Name, combined with the offer to sell the domain for hundreds of thousands of dollars, amounts to bad faith use of the Domain Name”; and ““registration and use of a domain name that differs from Complainant’s mark by only the deletion of one letter indicates ‘typosquatting’, which is evidence of bad faith registration and use” (internal punctuation omitted).

B. Respondent

In its Response, Respondent contends, in relevant part, as follows:

- A declaration provided by Christopher Neuman states that he is “the sole member and manager of” Respondent and that he “personally registered” the Disputed Domain Name on or about February 7, 1999, when, at the age of 13, he “carried on business under a fictional unregistered business name, namely Fusion3k Designs, and accordingly registered the Domain Name under Fusion3k Designs.”
- In the declaration, Neuman states that he has “been the continuous and uninterrupted beneficial owner of the Domain Name since I originally created it on February 7, 1999,” and that the “only reason why I ever changed the nominal registrant details was to reflect my current business name, which evolved from Fusion3k Designs to Blue Arctic (another unregistered business name) to most recently Blue Arctic LLC, a registered company.”
- The declaration further states: “My reason for registering the Domain Name was because in or about 1998 or 1999, I had become acquainted through the online world of software programming and website design, with another young programmer named Justin Tunney, who went under the online moniker of ‘Oogle’ or ‘Criminal Oogle’.”
- The declaration further states: “Through my friendship with Oogle, I learned that Oogle had a personal website associated with the domain name, [<oogle.net>], which Oogle had selected due to Oogle’s online moniker of ‘Oogle’. I noticed that Oogle had not registered [<oogle.com>] and proceeded to register the Domain Name with the intention of collaborating on a website with Oogle.”
- The declaration further states: “At no time prior to my registration of the Domain Name did I ever for even a second consider that [<oogle.com>] was an attractive domain name due to the existence of [<google.com>] or the Complainant’s trademarks.”

- The declaration further states that Neuman previously used the Disputed Domain Name in connection with an “online shopping website” and later intended to use it as “a forum for programmers.”
- The declaration further states: “In 2010 there were a few weeks where the Domain Name displayed a certain logo which was created and uploaded by a friend of mine, David Shiffman. This logo resembled the Google logo but it had originally had a playful tag line of, ‘Due to the economy the G has been laid off’. At the time we thought it was a funny and innocent usage, however upon reflection, I had it taken down after only a matter of weeks.”
- The declaration further states: “The Domain Name was also temporarily used in connection with adult matchmaking services, but I thought that this was lawful and permissible.”
- The name “Oogle” “has been used by numerous parties and business for many years, in connection with all manner of goods and services that have absolutely nothing to do with the Complainant.” In support thereof, Respondent cites the following U.S. trademark registrations: Nos. 820,267; 1,329,546; 1,392,389; 2,496,755; 3,889,157; and 2,883,240.
- “Harvard University has published a study which shows that over 15% of Americans use the term ‘Oogle’ as a word to describe gawking at someone, and 4.5% of Americans use the term ‘ogle’ and ‘oogle’ interchangeably.”
- With respect to paragraph 4(a)(i) of the Policy: “The Respondent acknowledges that the Complainant has several registered trademarks for GOOGLE in connection with its widely known search engine and related services” and “[t]he Respondent further acknowledges that the Domain Name is sufficiently ‘confusingly similar’ to the Complainant’s current trademark rights for the purposes of meeting this part of the three-part test under the UDRP, based upon the Complainant’s date of first use of its registered trademarks.”

- With respect to paragraph 4(a)(ii) of the Policy: “Years before any notice of this dispute, the Domain Name was used in connection with a bona fide offering of goods and services, namely the shopping website from 2000-2002 . . . and the programming related website from 2002-2003.”
- With respect to paragraph 4(a)(iii) of the Policy: The Disputed Domain Name could not have been registered in bad faith because “the evidence shows that there can be no doubt that the genuine reason for registering the Domain Name in the first place, had nothing to do with the Complainant, who was barely known at that time in 1999”; changes in the name of the registrant of the Disputed Domain Name since 1999 are irrelevant and do not constitute a new registration because “Christopher Neuman has had uninterrupted and continuous beneficial ownership of the Domain Name from its original creation to-date.”

C. Additional Submissions

In its additional submission, Complainant contends, in relevant part, as follows:

- “[O]ther than the testimony of Mr. Christopher Neuman, self-identified as the ‘sole member and manager’ of Respondent, Respondent provides no documentary evidence setting forth the ownership of the Domain Name prior to December 13, 2002, or the transfer of ownership from Fusion3k Designs, the owner of the Domain Name as of that date, to Respondent.”
- “[T]he uncontroverted evidence establishes that Respondent has, since coming into possession of the Domain Name in late 2004, repeatedly and willfully used the Domain Name to take advantage of Google’s users and to trade off the goodwill in and extensive investment Google has devoted to the protection of the famous GOOGLE Mark.”
- “[W]hile Respondent goes to great efforts to cast itself in a positive light, its knowing and willful abuse and deception of Google’s users over the

course of many years, for its own financial gain, demonstrates a pattern of behavior that undermines its claims of good faith and makes clear its wrongful intent and motivation in registering and using the Domain Name.”

- Complainant sent a demand letter to Respondent in September 2009; initially, Respondent offered to sell the Disputed Domain Name for \$600,000 and, later, Respondent stopped using the Disputed Domain Name. Then, in March 2010, Neuman contacted Complainant and indicated that he was “very interested in setting up a parking page for [**<ooogle.com>**],” which would “give Google full access to the contents displayed on [**<ooogle.com>**].”
- “[T]he GOOGLE Mark had become very well known and recognized far prior to February 1999,” so “Respondent’s attempt to deny bad faith on this basis is therefore without merit.”
- “Mr. Neuman avers that, even as a thirteen-year-old child, he was a ‘programmer and website designer’ and participated in ‘online chats and forum postings’ relating to ‘software programming and website design.’ . . . An individual with such experiences was likely to be highly aware of all available internet search engine options in 1999, and in particular, the well-regarded and highly publicized Google search engine.”

In its additional submission, Respondent contends, in relevant part, as follows:

- “[T]he earliest available historical Whois information from 2002... clearly shows that Christopher Neuman was the administrator of the Domain Name, with identical address as the registrant, which was an unregistered business name that Christopher adopted at the age of 13.”
- “[T]here is no reasonable basis for creating the fiction that the name was registered ‘like new’ by a stranger” in 2004.
- A letter from Respondent’s attorneys dated September 21, 2009, in response to the demand letter sent by Complainant, states: “Our client

registered [**<oogle.com>**] in February 1999 based on the nickname of one of our client's friends, a programmer who went by the name 'oogle' on various message boards in the 1990's In registering the domain name [**<oogle.com>**], our client was not in any way referring to Google, Inc."

- "[T]here is nothing inherently wrongful in offering to sell a domain name for in excess of out of pocket expenses, when the domain name was registered in good faith to begin with, i.e. was not registered because someone else's trademark rights."

FINDINGS

The record does not support a finding that the Disputed Domain Name has been registered and is being used in bad faith. As a result, and for the reasons set forth below, the Panel makes no findings with respect to whether the Disputed Domain Name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights or whether Respondent has rights or legitimate interests in respect of the Disputed Domain Name.

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.

Where a complainant does not prove one or more of these elements, the panel is compelled to issue a decision denying the complaint, regardless of the complainant's ability to prove the other element(s) required by the Policy. Accordingly, under such circumstances, any discussion by the panel with respect to such other element(s) would be unnecessary in reaching a decision to deny the complaint. *See, e.g., Admerex Limited v. Metyor Inc.*, D2005-1246 (WIPO June 7, 2012) (“[s]ince the Complainant must prove all three elements of the Policy, and since the Complainant fails under the third element . . . it is not necessary to make a finding under the second element of the Policy”); *Micro Electronics, Inc. v. MicroCenter*, D2005-1289 (WIPO Jan. 31, 2006) (finding that, where the complainant failed to prove the second element of the Policy, “there is no need for the Panel to address the third element of the Policy”). Therefore, given that the Panel in the instant case finds, as discussed below, that the Complainant has failed to prove the third element of the Policy – that is, paragraph 4(a)(iii) – with respect to the Disputed Domain Name, the Panel makes no findings with respect to the first or second elements of the Policy.

Identical and/or Confusingly Similar

Given that, for the reasons set forth above, it is unnecessary for the Panel to make a finding with respect to the first element of the Policy, paragraph 4(a)(i), the Panel refrains from doing so.

Rights or Legitimate Interests

Given that, for the reasons set forth above, it is unnecessary for the Panel to make a finding with respect to the second element of the Policy, paragraph 4(a)(ii), the Panel refrains from doing so.

Registration and Use in Bad Faith

The Panel initially addresses the issue raised by Respondent that it has been the “beneficial owner”¹ of the Disputed Domain Name since it was created on February 7, 1999, even though the current registrant is identified as Blue Arctic LLC and the original registrant appears to have been Fusion3k Designs.

The WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Second Edition (“WIPO Overview 2.0”), para. 3.7, states:

Panels have tended to the view that formal changes in registration data are not necessarily deemed to constitute a new registration where evidence clearly establishes an unbroken chain of underlying ownership by a single entity or within a genuine conglomerate, and it is clear that any change in Whois registrant data is not being made to conceal an underlying owner's identity for the purpose of frustrating assessment of liability in relation to registration or use of the domain name.

This consensus view has been adopted in at least a few decisions that have referred to the concept of a “beneficial owner” of a domain name, including

¹ The concept of “beneficial owner” in this proceeding (where the registrant identified in the Whois database has changed *prior to* the filing of the complaint) is distinct from the concept of “beneficial owner” in cases in which a complaint was filed against a privacy or proxy service (and the identity of the registrant changed *after* the filing of the complaint). See, e.g., *Baylor Univ. v. Domains by Proxy, Inc.*, FA. 1145651 (Nat. Arb. Forum Apr. 11, 2008).

Intellogy Solutions, LLC v. Schmidt, D2009-1244 (WIPO Dec. 24, 2009). In that case, the panel found that a “transfer did not effect any material change in the beneficial ownership of the domain name” given the relationship that one individual had to both registrants, including serving as a sole proprietor “doing business as” one registrant and as CEO of another registrant.

The beneficial owner concept also arose in *Justin.tv, Inc. v. Amador Holdings Corp*, FA 1436777 (Nat. Arb. Forum May 17, 2012). There, the panel said:

When assessing bad faith registration, one normally need only trace the registration date back to the most recent transfer of the domain name . . . [but] [t]he strictness of the rule may be relaxed where a respondent can demonstrate that there has been no change in beneficial ownership between initial date of registration and last transfer.

Although the panel in *Justin.tv* refused to accept that the current registrant of the disputed domain name had been the beneficial owner since its creation, this refusal was based in part on the presence of “various registrants” through the years, the “repeated use of privacy services” and [s]kepticism at th[e] [Respondent’s] explanation . . . invited by the copycat nature of the Respondent’s website.”

Similarly, in *Int’l Truck Intellectual Prop. Co., LLC v. B*, D2011-0599 (WIPO June 7, 2011), “the Respondent allege[d] that it has always been the underlying owner of the disputed domain name.” But, the panel refused to accept this because “the evidence of record does not clearly establish an unbroken chain of underlying ownership” and “[t]here is in fact scant evidence in the record regarding the original registrant’s actual or intended use of this disputed domain name.”

Despite these mixed outcomes, the WIPO Overview 2.0 and the decisions cited above seem consistent on the following: With adequate explanation and in the absence of efforts to conceal a domain name registrant's identity, the current registrant of a domain name may be considered to have been the beneficial owner of the domain name since its creation date, despite changes in the WHOIS record. This Panel adopts this view, although it cautions that the rule should be applied only in narrow circumstances where the explanation is not unbelievable and is supported by appropriate evidence.

In light of the above, this Panel finds that the Respondent in this proceeding, Blue Arctic LLC, has been the beneficial owner of the Disputed Domain Name since it was created on February 7, 1999.

Accordingly, the Panel must determine whether the Disputed Domain Name "has been registered" in bad faith when registration occurred on February 7, 1999, despite the Respondent's subsequent activities. *See, e.g., RapidShare AG v. //ya*, D2010-1105 (WIPO Aug. 17, 2010) ("[T]he Complainants have failed to show that there was registration in bad faith").

It is unclear whether, on February 7, 1999, Complainant had rights in the GOOGLE trademark. For example, although the Complaint states that "Google has used the GOOGLE mark in U.S. commerce in connection with its services since September 1997," Complainant apparently did not own any trademark registrations for the mark on February 7, 1999, and Complainant had received only limited media attention by that time.

In any event, regardless of whether Complainant had obtained any common law trademark rights as of February 7, 1999, Respondent has provided a declaration clearly stating that it (as beneficial owner of the Disputed Domain through

registration by Mr. Neuman) registered the Disputed Domain Name not “due to the existence of Google.com or the Complainant’s trademarks” but instead due to his relationship with a “young programmer named Justin Tunney, who went under the online moniker of ‘Oogle’ or ‘Criminal Oogle’.”

Despite the Panel’s extreme suspicions about this explanation, the Policy and the Rules do not provide the Panel with any authority to ascertain the Respondent’s credibility given the limitations on filings, the absence of discovery and the procedural efficiencies that are a part of (although admittedly occasionally detrimental to) this process. *See, e.g., Jumblatt v. SlantMedia*, D2012-1011 (WIPO June 28, 2012) (“The Panel takes into account that the Policy was designed to deal with a certain limited category of abusive registration of domain names, but not as a means of litigating all disputes involving domain names”); *Thump Records, Inc. v. WebPros*, FA 446911 (Nat. Arb. Forum May 11, 2005) (referring to “[t]he limited scope of the Policy”); and *Shedrick v. Princeton*, FA 236575 (Nat. Arb. Forum) (referring to “the very narrow scope of the UDRP procedure”).

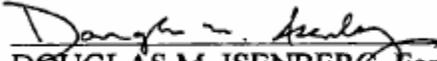
In light of these concerns, this Panel notes that “[i]t may be that Complainant could develop evidence of bad faith and lack of legitimate interest in a legal proceeding that would allow more evidentiary development. The Policy, however, was not designed to transfer domain names in every case that a trademark owner might ultimately win.” *Trans Continental Records, Inc. v. Compana LLC*, D2002-0105 (WIPO Apr. 30, 2002).

In any event, on the record before it, the Panel finds that Complainant has not prevailed in showing that the Disputed Domain Name “has been registered” in bad faith.

DECISION

Having not established all three elements required under the ICANN Policy, the Panel concludes that relief shall be **DENIED**.

Accordingly, it is Ordered that the <oogle.com> domain name **REMAIN WITH** Respondent.


DOUGLAS M. ISENBERG, Esq.
Panelist

Douglas M. Isenberg (chair), Reinhard Schanda and Professor David E. Sorkin,
Panelists

Dated: July 25, 2012