

DISPUTE RESOLUTION SERVICE

Decision of Independent Expert

Gumtree.com Limited

and

Deepthi Degala

1. The Parties:

Complainant: Gumtree.com Limited
107 Cheapside
London
EC2V 6DN
United Kingdom

Respondent: Deepthi Degala
Plot No.317 Sriharsha Apartments
Krishna Nagar
Guntur 522006
Guntur
India

2. The Domain Name:

gumtreefreeads.co.uk

3. Procedural History:

I confirm that I am independent of each of the parties. To the best of my knowledge and belief, there are no facts or circumstances, past or present, or that could arise in the foreseeable future, that need be disclosed as they might be of such a nature as to call in to question my independence in the eyes of one or both of the parties.

20 May 2014 11:20 Dispute received
20 May 2014 12:15 Complaint validated
20 May 2014 12:32 Notification of complaint sent to parties
09 June 2014 02:30 Response reminder sent
12 June 2014 09:04 No Response Received
12 June 2014 09:04 Notification of no response sent to parties
20 June 2014 08:59 Expert decision payment received

4. Factual Background

The Complainant is a wholly owned subsidiary of eBay Inc. It operates an online classified advertisement and community website available at www.gumtree.com. Since it was founded in London in 2000, the term GUMTREE has developed considerable goodwill and reputation throughout the world in connection with online classified advertisements, particularly in the United Kingdom.

The Complainant owns a number of domain names consisting of the term GUMTREE (for instance gumtree.com, gumtree.co.uk, gumtree.com.au) through which millions of its users avail themselves of its services. These domain names point to websites directly associated with the Complainant.

The Complainant invests substantial resources on advertising and promotion of its GUMTREE trade mark through a variety of media. It has made substantial investments to develop a strong presence online by being active on different social media forums including Facebook, Twitter, YouTube and LinkedIn using dedicated GUMTREE pages.

In addition to a strong online presence, the Complainant has registered trade mark rights in the term GUMTREE in several jurisdictions around the world, including the UK, in connection with online classified advertisements. These include Community Trade Mark (word) No. 003930989, for GUMTREE (for services in Class 35, 39 and 43), registered on 23 September 2005 and also Community Trade Mark (figurative) No. 012090924, (for services in Class 35, 48 and 32), registered on 21 January 2014.

Nothing is known of the Respondent other than that he is the registrant of the domain name <gumtreefreeads.co.uk>, (the "Domain Name") which was registered on 15 October 2011.

The Domain Name points to a website in English offering classified advertisements and containing advertising banners and links. On 2 April 2014, the Complainant sent a cease and desist letter to the Respondent requesting that he transfer the Domain Name and refrain from using the Complainant's GUMTREE name. The Respondent did not reply.

5. Parties' Contentions

The Complainant

Rights

The Complainant submits that it has rights in respect of a name which is similar to the Domain Name.

The Complainant's trade mark rights significantly pre-date the registration of the Domain Name. The Complainant submits that the Domain Name is identical or similar to a name in which it has Rights. The Domain Name, at the third level, incorporates the Complainant's GUMTREE word mark with the addition of the generic terms 'free' and 'ads', which are descriptive of the Complainant's services. The distinctive element of the Domain Name is GUMTREE and the addition of the descriptive terms 'free' and 'ads' does not detract from that distinctiveness.

Indeed, it is submitted that the terms 'free' and 'ads' reinforce the similarity with the Complainant's trade marks as they refer precisely to the same services for which the Complainant's trade marks have been registered.

Abusive Registration

It is submitted that the Domain Name was both registered and has been used in an abusive manner which is taking unfair advantage of and/or is causing unfair detriment to the Complainant's Rights.

Registration

The Complainant submits that it has not authorised, licensed or otherwise allowed the Respondent to use its GUMTREE trade mark in a domain name or otherwise, and that the Respondent is not connected to the Complainant in any way.

Given the extensive use of the GUMTREE trade mark since at least 2000, it

has acquired considerable goodwill and renown throughout the world in connection with online classified advertisements. It is therefore inconceivable that the Respondent did not have knowledge of the Complainant and its Rights by the time of registration of the Domain Name. This is particularly so given the use of the terms 'free' and 'ads' which are descriptive of the Complainant's core services. The Respondent registered the Domain Name in full knowledge of the Complainant and its Rights with the intention of opportunistically and unfairly taking advantage of the Complainant's goodwill and renown.

The Respondent registered the Domain Name with the intention of creating a false association with the Complainant with the intention of profiting from the considerable goodwill and reputation attached to the Complainant's Rights.

The Respondent's Domain Name points to a website offering identical or similar services to those of the Complainant. This supports the contention that it was the Respondent's intention to take advantage of the Complainant's Rights by way of false association. To the best of the Complainant's knowledge, the Respondent has always used the Domain Name to point to this website, the earliest screen captures being dated 13 March 2012.

It is clear that the Domain Name was registered in an abusive manner with the intention of taking unfair advantage of the Complainant's Rights.

Use

It is submitted that the Respondent is using the Domain Name in a way which has confused or is likely to confuse people or businesses into believing that it is registered to, operated or authorised by, or otherwise connected with the Complainant, with the intention of profiting from the Complainant's goodwill and renown.

The Respondent is using the Domain Name to confuse Internet users searching for the Complainant by using the Complainant's GUMTREE mark in conjunction with the terms 'free' and 'ads', which are descriptive of the Complainant's services. Internet users would expect to find a website connected in some way to the Complainant at a domain name incorporating the Complainant's trade mark in conjunction with terms descriptive of the Complainant's services.

The Respondent is using the Domain Name to deliberately mislead Internet users into believing that it is connected to, or operated by the Complainant, with the intention of diverting internet traffic originally intended for the Complainant, to the Respondent's website.

Moreover, it is likely that Internet users searching for the Complainant's

services, will enter into a search engine the Complainant's trade mark GUMTREE and key descriptive terms reflecting the Complainant's services, such as 'freeads'. Entering the search term 'gumtreefreeads' into the Google search engine produces results showing the Respondent's website ranked second, after the Complainant's www.gumtree.com website and before the Complainant's www.gumtree.co.za website. It is submitted that this is strong evidence that Internet users will be misled into believing that the Domain Name and associated website are in some way connected to the Complainant.

Research undertaken on behalf the Complainant shows that the Respondent's website has over 1,100 visitors per month which, it is said, is evidence that the Respondent is effectively capturing considerable traffic no doubt originally intended for the Complainant.

The fact that the Respondent is using the Domain Name to point to a website offering identical or similar services to those of the Complainant, further increases the likelihood of confusion and association. Indeed, it is likely that the Complainant's consumers are being tricked into placing their adverts with the Respondent's website, thinking that it is the Complainant.

There is no legitimate reason that could explain the use that has been made of the Domain Name by the Respondent. Such use not only takes unfair advantage of the Complainant, it is also unfairly detrimental to the Complainant as it detracts business from it.

The Respondent's website displays numerous banners and sponsored links which are clearly commercial in nature. It is therefore clear that the Respondent is obtaining financial gain. The Respondent is using the Domain Name to attract traffic to his website with the intention of profiting from the Complainant's goodwill and renown.

Furthermore, the Respondent is damaging the Complainant's business and reputation in that his website is not of the same quality as that of the Complainant. Some of the adverts appear bogus and it is likely that Internet users of the Respondent's website will not obtain the same quality of service or guarantees they would receive when dealing with the Complainant. For instance, unlike the Complainant, the Respondent does not have any abuse reporting features in place.

The Respondent is unable to invoke any of the circumstances set out in paragraph 4 of the Policy, which provides a non-exhaustive list of factors which may evidence that a domain name is not an Abusive Registration.

The Respondent

The Respondent did not respond to the Complaint.

6. Discussions and Findings

Under the provisions of the Policy, for a Complaint to succeed, a Complainant is required to prove, on the balance of probabilities, that it has rights in respect of a name or mark which is identical or similar to the domain name in issue and that the domain name in the hands of the Respondent is an Abusive Registration. Both elements are required.

Complainant's 'Rights'

The meaning of 'Rights' is defined in the Policy as follows: *'Rights means rights enforceable by the Complainant, whether under English law or otherwise, and may include rights in descriptive terms which have acquired a secondary meaning'*.

The Complainant clearly has Rights by virtue of its registered trade mark, GUMTREE.

The Domain Name encapsulates the GUMTREE trade mark in its entirety. It is the first and dominant part of the Domain Name, followed by descriptive or generic terms that an Internet user might readily associate with the Complainant i.e. 'free' and 'ads', or 'freeads'.

Accordingly, the Panel is satisfied that the Complainant has Rights in a name or mark that is similar to the Domain Name.

The Panel must now therefore consider whether the Domain Name is an Abusive Registration in the hands of the Respondent.

Abusive Registration

Paragraph 1 of the Policy defines Abusive Registration as a domain name which was either *'registered or otherwise acquired in a manner which, at the time when the registration or acquisition took place, took unfair advantage of or was unfairly detrimental to the Complainant's Rights'* or which *'has been used in a manner which has taken unfair advantage of or was unfairly detrimental to the Complainant's Rights;'*

A useful guide as to what might constitute an Abusive Registration is contained in paragraph 3(a) of the Policy. It contains a non-exhaustive list of factors which may indicate that a domain name is an Abusive Registration. Such factors include circumstances indicating that the respondent has registered or otherwise

acquired the domain name primarily for the purposes of selling, renting or otherwise transferring it to the complainant (or a competitor) for valuable consideration in excess of the respondent's out-of-pocket costs, as a blocking registration against a name or mark in which a complainant has rights, or for the purpose of unfairly disrupting the business of a complainant.

Other factors suggesting an Abusive Registration include a respondent using or threatening to use a domain name in a way which has confused or is likely to confuse people or businesses into believing that it is registered to, operated or authorised by, or otherwise connected with the complainant.

A non-exhaustive list of countervailing factors is set out in paragraph 4 of the Policy. This paragraph contains a useful guide as to what does not constitute an Abusive Registration.

The Complainant contends that registration of the Domain Name took unfair advantage of the Complainant's Rights and that its subsequent use took both unfair advantage and was unfairly detrimental to the Complainant's business.

Registration

It is extremely unlikely that the Respondent was unaware of the Complainant and its Rights in the GUMTREE name at the time of registration of the Domain Name. This is particularly so given the generic or descriptive terms the Respondent chose to use in conjunction with the Complainant's GUMTREE trade mark, terms which are readily associated with the Complainant's business. That such knowledge was held by the Respondent at registration, is supported by the use to which the Domain Name was put, at the latest, a matter of months after registration. The use of the Complainant's trade mark in conjunction with other words reinforcing the appearance of association where no such association exists, absent legitimate explanation, suggests a clear intention to take unfair advantage of the Complainant's Rights.

Use

The Complainant has made out a convincing case that the Respondent is using the Domain Name in a way which has confused or is likely to confuse people or businesses into believing that the Domain Name is registered to, operated or authorised by, or otherwise connected with the Complainant.

Internet users may well use all elements of the Domain Name to search for the Complainant, with search results displaying links to both the Complainant's websites as well as that of the Respondent but without it being in any way obvious that the Respondent's website is not associated with the Complainant. The fact that the Respondent's website offers similar or identical services to those offered by the Complainant, does nothing to ameliorate the confusion, but

rather may cause actual damage to the Complainant's business and reputation. Internet users may well purchase services from the Respondent instead of the Complainant. Furthermore, to the extent that any Internet user has a negative experience as a result of visiting the Respondent's website, having been confused into believing that it is, or is associated with the Complainant, they will obviously think less of the Complainant.

The Complainant has made out a convincing case of Abusive Registration, a case to which, if there were the possibility of an answer, one would have expected it to have been forthcoming. Yet the Respondent has chosen to take no part in these proceedings. Moreover, a cursory review of the non-exhaustive list of the countervailing factors set out in paragraph 4 of the Policy (suggesting that a registration is not abusive), provides no obvious answer to the Complainant's case. Thus, for instance, it would seem difficult for the Respondent to argue that he has used or made demonstrable preparations to use the Domain Name in connection with a genuine offering of goods or services (given that the Respondent is clearly taking unfair advantage of the Complainant's Rights); or that he has been commonly known by the Domain Name or legitimately connected with a mark which is identical or similar to the Domain Name (given there is no supporting evidence but only countervailing evidence i.e. the Respondent's name); or that he has made legitimate non-commercial or fair use of the Domain Name (given the use to which the Domain Name has been put, being clearly commercial in nature and taking advantage of the goodwill and renown of the Complainant's GUMTREE mark).

The Domain Name is inherently confusing. It incorporates a well-known trade mark together with descriptive or generic terms that an Internet user might readily associate with the business of the trade mark owner. The Respondent has set out to take unfair advantage of the Complainant's Rights (of which he was aware) and by doing so may well also damage the Complainant's business and/or its reputation. The Respondent has not explained his registration or use of the Domain Name but in any event, it is unlikely that there is anything that could be said that would refute the allegation of Abusive Registration.

Accordingly, the Expert finds that the Domain Name was registered in a manner which took unfair advantage of or was unfairly detrimental to the Complainant's Rights and has been used in a manner which has taken unfair advantage of and is unfairly detrimental to the Complainant's Rights.

7. Decision

The Expert finds that the Complainant has rights in a name or mark which is similar to the Domain Name and is satisfied on the evidence before him that the Domain Name in the hands of the Respondent is an Abusive Registration. Accordingly, the Expert directs that the Domain Name, gumtreefreeads.co.uk be transferred to the Complainant.

Signed: Jon Lang

Dated: 14 July 2014