

ADMINISTRATIVE PANEL DECISION

Google LLC v. Tu Ng
Case No. DIO2023-0008

1. The Parties

Complainant is Google LLC, United States of America (“United States”), represented Perkins Coie, LLP, United States.

Respondent is Tu Ng, United States.

2. The Domain Name and Registrar

The disputed domain name <goog.io> (the “Domain Name”) is registered with Sarek Oy (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on February 13, 2023. On February 14, 2023, and February 28, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On March 7, 2023, and March 10, 2023, the Center contacted the Registry requesting for registrar verification. On April 7, 2023, the Registry transmitted by email to the Center its verification response disclosing registrant and contact information for the Domain Name which differed from the named Respondent (REDACTED FOR PRIVACY) and contact information in the Complaint. The Center sent an email to Complainant on April 11, 2023, providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. Complainant filed an amended Complaint on April 11, 2023.

The Center verified that the Complaint together with the amended Complaint satisfied the formal requirements of the .IO Domain Name Dispute Resolution Policy (the “Policy”), the Rules for .IO Domain Name Dispute Resolution Policy (the “Rules”), and the WIPO Supplemental Rules for .IO Domain Name Dispute Resolution Policy (the “Supplemental Rules”).

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified Respondent of the Complaint, and the proceedings commenced on April 12, 2023. In accordance with the Rules, paragraph 5, the due date for response was May 2, 2023. Respondent sent an email to the Center on April 18, 2023, but did not formally submit any response. On May 5, 2023, the Center informed the Parties of the Commencement of Panel Appointment Process.

The Center appointed Robert A. Badgley as the sole panelist in this matter on May 22, 2023. The Panel finds that it was properly constituted. The Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Center to ensure compliance with the Rules, paragraph 7.

4. Factual Background

Founded in 1998, Complainant has developed and operated an Internet search engine known as GOOGLE. Complainant's search engine is among the best known and most widely used search engines. Complainant owns numerous trademark registrations for the mark GOOGLE, including United States Patent and Trademark Office Reg. No. 4,202,570, registered on September 4, 2012, in connection with, among other things, "computer services".

There is little doubt that GOOGLE is a famous trademark. According to the 2022 survey by Brand Finance Global 500, GOOGLE is the third most valuable brand in the world.

Among Complainant's offerings are photo editing services (including Artificial Intelligence or AI-powered services) under the brand GOOGLE PHOTOS.

Complainant also hosts, at its corporate headquarters, an annual "developer conference" known as GOOGLE I/O, which boasts roughly 5,000 attendees each year.

The Domain Name was registered on November 2, 2008. As of September 2022, Respondent used the Domain Name for a website liberally using Complainant's GOOGLE word mark and Complainant's stylized GOOGLE logo. The site also made use of a purported brand "GOOGIO". The site purported to offer GOOGLE search engine users "advanced" search techniques and other services related to the GOOGLE search engine.

On November 23, 2022, Complainant's counsel sent a cease-and-desist missive to Respondent, demanding that Respondent cease using the marks GOOGLE and "GOOGIO" and cease using the Domain Name. Respondent made a few alterations over the following weeks, and the Parties remained in contact, but Respondent was still hosting a website via the Domain Name. At one point, Respondent offered to transfer the Domain Name to Complainant, but the transfer code information Respondent supplied did not work.

On or around January 8, 2023, the Domain Name was registered under a new Registrar, and the Domain Name thereafter resolved to a website offering AI-powered photo restoration services.

Complainant's counsel attempted to make contact the purported new owner of the Domain Name, and on January 23, 2023, received an email response from this purported new owner:

"Hey. I am the domain owner for goog.io. Any arrangements you had with the previous owner are no longer valid. If you would like the domain goog.io, we can come up with a new purchase agreement. Otherwise, please stop contacting me. Thank you."

On January 26, 2023, Complainant's counsel sent a fresh cease-and-desist missive to the purported new owner. Complainant received no response to this missive.

5. Parties' Contentions

A. Complainant

Complainant contends that it has established all three elements required under the Policy for a transfer of the Domain Name.

B. Respondent

Respondent did not reply to Complainant's contentions. On April 18, 2023, Respondent sent the Center an email stating, "I've received a Notification of Complaint and Commencement of Administrative Proceeding for a domain I don't own".

6. Discussion and Findings

Paragraph 4(a) of the Policy lists the three elements which Complainant must satisfy with respect to the Domain Name:

- (i) the Domain Name is identical or confusingly similar to a trademark or service mark in which Complainant has rights; and
- (ii) Respondent has no rights or legitimate interests in respect of the Domain Name; and
- (iii) the Domain Name has been registered or is being used in bad faith.

A. Identical or Confusingly Similar

It is well accepted that the first element of the UDRP functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between Complainant's trademark and the Domain Name. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, ("[WIPO Overview 3.0](#)"), section 1.7.

The Panel concludes that Complainant has rights in the trademark GOOGLE through registration and use demonstrated in the record. The Panel also concludes that the Domain Name is confusingly similar to that mark. The elimination of the last two letters of the mark ("LE") does not overcome the fact that the visually and aurally dominant part of the mark ("GOOG") is recognizable within the Domain Name.

Complainant has established Policy paragraph 4(a)(i).

B. Rights or Legitimate Interests

Pursuant to paragraph 4(c) of the Policy, Respondent may establish its rights or legitimate interests in the Domain Name, among other circumstances, by showing any of the following elements:

- (i) before any notice to you [Respondent] of the dispute, your use of, or demonstrable preparations to use, the Domain Name or a name corresponding to the Domain Name in connection with a *bona fide* offering of goods or services; or
- (ii) you [Respondent] (as an individual, business, or other organization) have been commonly known by the Domain Name, even if you have acquired no trademark or service mark rights; or
- (iii) you [Respondent] are making a legitimate noncommercial or fair use of the Domain Name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

The Panel concludes that Respondent lacks rights or legitimate interests in respect of the Domain Name. On this undisputed record, it is plain that GOOGLE is a famous trademark and that Complainant has never authorized Respondent to use that mark in any manner, including in a Domain Name confusingly similar to the famous mark.

Even assuming that Domain Name actually changed hands on or around January 8, 2023, when it was registered to a new Registrar, and therefore that there were two separate owners, the Panel finds that neither person has any rights or legitimate interests in respect of the Domain Name.

As for the “first owner,” his use of the Domain Name to host a website liberally using Complainant’s famous word mark and logos, and clearly trying to impersonate Complainant or, at a minimum, falsely implying an affiliation between his site and Complainant, is manifestly illegitimate.

As for the “second owner,” his use of the Domain Name to host a site purportedly offering AI-powered photo-related services (while Complainant offers similar services under its famous GOOGLE mark and its GOOGLE PHOTOS brand), is also illegitimate.

Complainant has established Policy paragraph 4(a)(ii).

C. Registered or Used in Bad Faith

Paragraph 4(b) of the Policy provides that the following circumstances, “in particular but without limitation,” are evidence of the registration or use of the Domain Name in “bad faith”:

- (i) circumstances indicating that Respondent has registered or has acquired the Domain Name primarily for the purpose of selling, renting, or otherwise transferring the Domain Name registration to Complainant who is the owner of the trademark or service mark or to a competitor of that Complainant, for valuable consideration in excess of its documented out of pocket costs directly related to the Domain Name; or
- (ii) that Respondent has registered the Domain Name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that Respondent has engaged in a pattern of such conduct; or
- (iii) that Respondent has registered the Domain Name primarily for the purpose of disrupting the business of a competitor; or
- (iv) that by using the Domain Name, Respondent has intentionally attempted to attract, for commercial gain, Internet users to Respondent’s website or other online location, by creating a likelihood of confusion with Complainant’s mark as to the source, sponsorship, affiliation, or endorsement of Respondent’s website or location or of a product or service on Respondent’s website or location.

Although a transfer may occur under the Policy (for .io domain names) with a showing of either bad faith registration or bad faith use, the Panel concludes on this record that Respondent has both registered and used the Domain Name in bad faith. The Panel incorporates here its discussion above in the “Rights or Legitimate Interests” section.

Given the fame of the GOOGLE mark, and the use to which “both” versions of Respondent put the Domain Name, it is clear that Respondent had the GOOGLE mark in mind when registering the Domain Name.

Respondent’s use (again, whether one looks at the “first owner” or the “second owner” after January 8, 2023) constitutes bad faith use within the meaning of the above-quoted Policy paragraph 4(b)(iv).

Complainant has established Policy paragraph 4(a)(iii).

7. Decision

For the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the Domain Name <goog.io> be transferred to Complainant.

/Robert A. Badgley/

Robert A. Badgley

Sole Panelist

Date: June 5, 2023