

**THE GAP, INC.  
GAP (ITM), INC.**

= v =

**CYBERNET VENTURES LIMITED**

**T/A**

**GEORGE FORSYTH**

Nominet UK Dispute Resolution Service

DRS 00820

Decision of Independent Expert

Dated this 7<sup>th</sup> day of May 2003

**1. Parties:**

**Complainant**

Complainant: The Gap, Inc and Gap (ITM) Inc  
Address: 900 Cherry Avenue  
San Bruno  
California  
Postcode: 94066  
Country: US

**Contact Details**

Contact: Mr Garry Mills  
Business Name: Clifford Chance LLP  
Address: 200 Aldersgate Street  
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Reference: GEM/G1230/586/VGM

## **Respondent**

Respondent: Cybernet Ventures Limited  
Address: 128 Knollmead  
Surbiton  
Surrey  
Postcode: KY5 9QW  
Country: GB  
Email:

## **2. Disputed Domain Name**

Gap-online.co.uk

This domain name is referred to below as the "Domain Name".

## **3. Procedural Background**

The Complaint was lodged with Nominet on 24 January 2003. Nominet validated the Complaint and notified the Respondent on 29 January 2003. The Respondent lodged its response with Nominet in time on 12 February 2003 and this was followed by the Complainant's reply which was lodged in time on 24 February 2003. In accordance with the Nominet Dispute Resolution Procedure ("the Procedure") the dispute was referred to mediation on 19 March 2003. The mediation process was unsuccessful. On 2 April 2003 the Complainant paid Nominet the appropriate fee for a decision of an Expert pursuant to paragraph 6 of the Nominet Dispute Resolution Service Policy ("the Policy").

Sallie Spilsbury, the undersigned ("the Expert") has confirmed to Nominet that she knew of no reason why she could not properly accept the invitation to act as Expert in this case and further confirmed that she knew of no matters which ought to be drawn to the attention of the Parties which might appear to call into question her independence and impartiality.

## **4. Formal/procedural issues**

On reviewing the Complaint, the Response and the Complainant's Reply the Expert sought additional information from the Respondent pursuant to clause 13 of the Procedure. The Expert's request, which was dated 14 April 2003, required the Respondent to provide the additional information within 5 working days of receipt of the

request. The Complainant was given a further 5 working days to respond to the additional information which the Respondent provided. The Respondent provided the additional information in time on 18 April 2003. The Complainant made a response by in time by letter dated 29 April 2003.

There has also been additional correspondence between the Parties and Nominet following the filing of the Complainant's Reply as follows:

- The Respondent sent a letter to Nominet dated 14 March 2003. The Respondent requested that this letter should be made available to the Expert.
- The Complainant's solicitors sent a letter to the Respondent (copied to Nominet) dated 28 March 2003 in which they stated that their letter should be regarded as "open" and reserving the Complainant's right to make the letter available to the Expert. Nominet has informed the Expert that the Complainant has requested that its letter be placed before the Expert.
- The Complainant made a written response dated 11 April 2003 to the Respondent's 14 March letter and requested that the letter should be forwarded to the Expert.
- The Respondent sent a response dated 12 April 2003 to the Complainant's 11 April letter and enclosed a letter of the same date to the Complainant's solicitors.

This additional correspondence ("the Letters") constitute submissions which are additional to the requirements of the Procedure. Clause 13 of the Procedure provides as follows:

In addition to the complaint, the response and if applicable the reply and any appeal, the Expert may request further statements or documents from the Parties. *The Expert will not be obliged to consider any statements or documents from the Parties which he or she has not received according to the Policy or this procedure or which he or she has not requested [italics for emphasis].*

As a preliminary issue the Expert must therefore consider whether to accept the submissions made in the Letters.

The Expert has decided that as an exception to the general procedure she will take the content of the Letters submitted to Nominet into account in reaching her decision where the content is relevant to the Policy. The determining factor in her decision is that the Respondent does not appear to have had legal assistance in formulating its submissions. The Complainant on the other hand is legally represented. Some of the content of the Respondent's letters is relevant to the matters raised by the Complainant in its submissions. In the circumstances it would be inequitable to disregard relevant submissions made by an un-represented party which may not have appreciated the full impact of the Procedure when preparing its initial Response. In order to ensure consistency in relation to this matter the Expert finds that the additional submissions made on behalf of the Complainant should also be considered.

In reaching this decision the Expert has borne in mind that negotiations which take place during the mediation process are confidential under clause 7 of the Procedure. The Expert will accordingly disregard those parts of the Letters which may refer to the confidential negotiations in mediation unless *both parties* have made reference to them on an "open" basis in the Letters.

## **5. The facts**

### *The Complainant*

The Complainant is a well known clothing brand and speciality retailer selling its products through its GAP, GAPKIDS, BABYGAP, GAP BODY and GAP OUTLET stores, of which there are 2,900 worldwide. In addition, in over 35 countries where the Complainant has not yet opened stores, GAP products have been sold through selected third party retailers.

The first GAP store in the United Kingdom opened in April 1987. There are currently 232 stores located throughout the United Kingdom, all of which trade as "GAP", "GAPKIDS", "BABYGAP", "GAP BODY" and/or GAP OUTLET. The Complainant also has three websites at "www.gap.com", "www.gapkids.com" and "www.babygap.com". Information which the Complainant has on the "hits" on its websites indicates that a very significant number originate in the United Kingdom.

Virtually all merchandise sold in GAP stores is and always has been sold under the GAP mark. The mark is used on all GAP merchandise by way of, for example, logos on merchandise, price tags, neck labels, hang tags, price tickets, receipts, boxes and carrier bags. The Complainant's GAPKIDS, BABYGAP and GAP OUTLET products and stores demonstrate how it often combines "GAP" with other words to form composite marks. There are numerous other examples, such as "GAP SCENTS", "GAP SUN", "GAP SHOES", "GAP KHAKIS" and "GAP DENIM".

Although GAP began as an apparel brand, the product range has expanded to include, for example, shoes, bags, hats, accessories, jewellery, toys, leather goods and personal care products.

Details of the Complainant's various UK trade mark applications and registrations for GAP and composite GAP marks were exhibited to the Complaint and number approximately 47 UK trade mark registrations.

The Complainant spends substantial amounts on advertising both in the UK and across the world. The Complainant has placed a large number of advertisements in UK circulation publications since the time of the opening of the first GAP store in the United Kingdom and has received very substantial press coverage. Over recent years, the Complainant has carried out extensive television and cinema advertising in the UK for its merchandise. Its advertisements have recently been featured on various ITV regions

(including London), nationally on Channel 4 and Channel 5, and also on Sky, MTV and Nickelodeon, as well as bus side and print advertising.

On the basis of fully consolidated sales figures, in 2001, the Complainant's turnover in the UK was over £400m.

### *The Respondent*

The Respondent was incorporated on 30 March 1999 in England and Wales under company registration number 03743978. A search carried out at Companies House shows the company secretary to be George Forsyth.

In its Response to the Complaint the Respondent states that it has a strategy “to assist webmasters” and as part of this strategy it says that it developed a website for a business venture called Global Affiliate Programs. In a letter of 23 November 2002 to the Complainant (annexed to the Complaint at Exhibit 3) the Respondent describes the website as “a collection of links to other websites who provide services or sell goods via the Internet with the intention of providing information concerning such services to other webmasters”.

The Response filed by the Respondent states that

“Global Affiliate Programs has grown into possibly the largest directory of affiliate programs on the Internet. It has many frequent visitors and provides a very useful service for webmasters looking to add advertising to their websites, as well as companies seeking to increase their online presence through banner advertising. It is linked to by numerous affiliate referral sites and achieves a high ranking in the popular search engines” (paragraph 3 of the Response).

The website has hosted an affiliate directory since it began and with two exceptions the website has not diversified from this primary role. The two exceptions relate to the development of two webpages accessed via the Respondent’s website at “goshopping.htm” and “buyclothes.htm”. The “buyclothes.htm” page provides links to the websites of certain businesses who sell items of clothing. The Respondent describes the “buyclothes.htm” page as an ancillary service to assist misdirected visitors who were searching for the Complainant’s website.

The buyclothes.htm page is described by the Respondent in its letter to the Complainant of 23 November as having been conceived and created in 2002. In its Response the Respondent describes its inception in the following terms:

The “buyclothes.htm” page was conceived and created approximately six months ago only after repeated applications to join your clients’ [i.e. the Complainants] affiliate program ... had been rejected..... It had been our intention to add a suitable link to your clients’ site on our website’s home page to permit the easy redirection of any visitors who had come to our site in error looking for your

client's operations. We reiterate that the necessary approval to do this was refused by your clients. Only after these actions on our part, together with your client's rejections of our approaches and in the knowledge that Gap, Inc. did not permit visitors from the UK to purchase goods online from their site, we decided to create the "buyclothes.htm" to redirect visitors seeking to buy clothes to suitable alternative online retailers willing to deliver to UK consumers.

In the additional information provided in compliance with the Expert's request, the Respondent stated that it received no payment for featuring the sites which are linked to the buyclothes.htm page. The Respondent states that the sites featured on the page were chiefly selected because they supply the UK market. Also relevant were their customer service reputations and the quality of their goods.

The Respondent states that it earns commission on the sales generated by customers who visit the featured sites by clicking on the links on the Respondent's site. It does not itself sell clothes. Commission is paid to the Respondent whether the sales are generated from the buyclothes.htm page or from other links to these sites contained within the Global Affiliate Programs Directory Listings (the Respondent states that it is not possible to say with certainty whether a sale was generated through the buyclothes.htm page or by a page within the main directory). The Respondent has supplied a table of the percentage commission which would accrue on any sales made as a result of the use of such a link. The commission ranges from 3% in some cases through to 12% in others.

### *The Domain Name*

The Respondent registered the Domain Name on 9 April 2000. The registration was last updated on 14 June 2002. The Domain Name is in use as the website for Global Affiliate Programs.

## **6. The Parties' contentions**

### *Complaint Form*

The Complainant contends that the Domain Name is an Abusive Registration in the hands of the Respondent.

The Domain Name first came to the attention of the Complainant's in-house legal team on or around 8 November 2002. When the Complainant's in-house legal department became aware of the Domain Name, they were concerned by it and the manner of its use because:

- (i) "www.gap-online.co.uk" consists exclusively of its GAP mark followed by the suffix "online" (a descriptive word in the context of businesses operating over the Internet).

Further, it is a domain name which the Complainant believes visitors (particularly those based in the UK) are bound to try to locate the Complainant's on-line presence. The Complainant contends that this must have been apparent to the Respondent at the time that the Domain Name was registered and points to the fact that the Respondent acknowledges on the website (see below for details) and in correspondence (for example the letter of 23 November 2002 exhibited to the Complaint Form) that it has found people looking for the Complainant or its products on arriving at the Respondent's website.

- (ii) The Respondent is actively using the website/Domain Name to attract visitors to its "BUY CLOTHES" page containing links to third party websites offering clothing, baby clothing and baby care items, accessories and other consumer goods likely to be of interest to customers or potential customers of the Complainant. The Complainant assumed that the Respondent would earn a fee from its "introductions" (the Respondent has subsequently confirmed this point-as set out above).
- (iii) The Complainant contends that the "look and feel" of the Respondent's "buyclothes.htm" page is similar to the Complainant's website. It cites the following examples of similarity: use of similar colour typeface, use of similar size fonts, product categories appearing in columns with similar size/spacing, use of "gap-online" header.
- (iv) The Respondent was making prominent unauthorised use of the Complainant's well-known "GAP" and "BABY GAP" logos as links to the Respondent's "BUY CLOTHES" page and was (and is) also making numerous references to the Complainant on its site.

The Complainant has provided the following details to support its submission at point (iv) above:

The Complainant's UK lawyers visited the "www.gap-online.co.uk" website during November 2002. Relevant webpages were exhibited to the Complaint Form. At that time the "home page" had a heading "Welcome to Global Affiliate Programs - Online". Immediately adjacent to this heading there appeared the Complainant's "GAP" logo. When this GAP logo was "clicked", visitors were taken not to the Complainant's "www.gap.com" website, but to a page on the Respondent's website headed "Gap-online - buy clothes here" .

In addition on a page entitled "Which Program to Pick", the websites advertised as operating "affiliate programs" were broken down into categories by business/product type. These categories included "Babycare/children" and "Clothes" as well as others such as games, art, toys and sports items. The "Babycare/children" and "clothes" pages made use of the Complainant's logos.

Immediately under the headings on the "Babycare/and children" and "Clothes" pages there were the following statements: [on the Babycare/children page] "If you came here looking for [BABY GAP LOGO] CLICK HERE" [on the Clothes page] "If you came here looking for [GAP LOGO] CLICK HERE"

Visitors who clicked these links were taken, not the relevant GAP website, but to the Respondent's "BUY CLOTHES" page ("buyclothes.htm") on which there were links to third party websites offering men's, women's and children's clothing and accessories. On the "BUY CLOTHES" page, the Respondent acknowledged that it was aware that a number of visitors were arriving at its site as a result of looking for clothes, in particular, GAP clothes. It also acknowledged that the similarity in web addresses was thought to be "the most likely cause of this search engine confusion". The page also contained the statement "THIS IS NOT GAP", those words appearing in white elongated lettering against a blue rectangular background strongly reminiscent of the Complainant's logos.

The Complainant states that this statement would not serve to remedy the confusion which was bound to be caused by the use of the Domain Name or its name and logos. Notwithstanding the statement, visitors might still be led to believe, for example, that the site is the Complainant's UK site or one which offers the Complainant's merchandise.

The Respondent made further reference to the Complainant on its website as follows: "Unfortunately, GAP do not operate an online shopping service in the UK. To assist visitors we at Global Affiliate Programs have compiled some of the finest online fashion outlets which deliver in the UK".

On 19 November 2002, The Complainant's solicitors wrote to the Respondent to object to the use of the Domain Name and the use of the Complainant's name and logos. The Respondent replied on 23 November 2002 indicating that it would make certain changes to its website but that it would not cease using the Domain Name as requested by the Complainant.

The Respondent has subsequently made certain changes to the manner in which it operates its site. The revised pages from the Respondent's website are also exhibited to the Complaint Form.

Where, previously, the site incorporated the Complainant's GAP and BABYGAP logos, these have been replaced with: "If you are looking for clothes click here". In addition, the "BUY CLOTHES" page now reads "Not connected with The Gap, Inc. in any way" instead of "THIS IS NOT GAP".

The Complainant contends that apart from these changes, the website is substantially the same as before. The website, it is submitted, is still bound to attract visitors looking for the Complainant. These visitors are still being directed to the Respondent's "BUY CLOTHES" page and the Respondent continues to

make references on its site to the Complainant. The Complainant states that it continues to believe there is a risk that the Respondent's site will cause customers to believe that it is somehow connected with the Complainant or offering GAP products when this is not the case.

In summary the Complainant submits that to register and use a domain name which the Respondent knows is attracting visitors looking for the Complainant or its products and to deliberately direct those visitors to third party sites offering clothing, accessories, related items and other goods and services of interest to them for financial gain can only be taking unfair advantage of and be detrimental to the Complainant's Rights in its GAP mark, particularly given also the Respondent's misuse of the Complainant's logos. It, therefore, submits that the Domain Name is (irrespective of any changes which may have been made to the Respondent's website since the Complainant's letter of 19 November 2002) an Abusive Registration as defined in paragraph 1(i) of the DRS Policy.

### *Response*

In its response the Respondent makes the following submissions:

Its use of the acronym "gap" for the Global Affiliate Programs website was made to make the URL shorter and easier for visitors to remember and that the use of initials in URLs is a well established practice.

There are other URLs which contain the word gap or the letters "g", "a" and "p" which are not associated with the Complainant (a schedule of these marks was enclosed with the Respondent's letter to the Complainant of 23 November 2002 and annexed to the Complaint Form). It would therefore have been unrealistic to expect the Respondent to assume prior to registration that the Complainant would express any interest in the Domain Name.

The Respondent's website clearly states the full name of the site and explains its purpose on its homepage in letters 24 points high, with the words "Welcome to Global Affiliate Programs". In the Respondent's view anyone visiting the site in the mistaken belief that it had anything to do with the Complainant would instantly realise their mistake.

The Respondent had applied to join the Complainant's affiliate programme in 2001 and had accordingly drawn the website to the Complainant's attention at that time.

The Respondent rejects the Complainant's view that the look and feel of the "buyclothes.htm" page was similar to the Complainant's website. It also refutes the suggestion that it is claiming any connection with the Complainant and points to the disclaimer on its website stating that "This is not GAP" in this regard. It rejects the Complainant's assertion that the disclaimer is not sufficient to dispel customer confusion.

The fact that the Domain Name was attracting the attention of customers looking for the Complainant only became apparent when the website was in operation and the Respondent's hosting company showed details of the referrals to the Respondent's site from search engines.

The website is not used to promote third party websites but to direct "lost souls" who arrive at the site looking to buy clothes online. The third parties' websites are clearly branded. The visitors who are referred to them would at no time be under the impression that they are making a purchase from the Complainant.

Changes were made to the website following receipt of the Complainant's letter of 19 November to address the Complainant's concerns.

*Additional points arising from the Respondent's letter of 14 March 2003*

The Respondent did not register the Domain Name primarily for the purposes of unfairly disrupting the Complainant's business. It would never wish to prevent the Complainant from conducting legitimate business.

The word GAP has meanings beyond bring a trademark of the Complainant.

*Additional points arising from the Complainant's Reply*

The Respondent set up an Internet related business and deliberately adopted a name the initials of which (G.A.P) spell the name of one of the best known retailers in the world. Given that the Respondent must have known that it was going to be using the site to provide links to third party websites offering clothing and other items offered by the Complainant it should have avoided adopting GAP as its URL.

There was no reason for the Respondent to abbreviate its name for the purposes of the choice of its URL.

The existence of other sites including the word "gap" is of no relevance. The Complainant's concerns are based not solely on the registration of the Domain Name but also the use made of it.

The Complainant does not accept that the homepage of the Respondent' site would dispel confusion for the following reasons:

The Domain Name is so strongly indicative of the Complainant and its products that visitors will assume that it is the Complainant's site particularly when the home page featured the Complainant's logo (removed following the Complainant's letter of 19 November). This would be reinforced by the numerous references to the products sold by the Complainant and by the links to web pages offering clothes online. Visitors may, for example, assume that the third parties to

whose websites there are links are in some way connected or affiliated with the Complainant.

It would appear that the Respondent's "buyclothes.htm" page was set up to benefit from the mistaken visits the site was attracting from people looking for the Complainant or its products. The fact that the Respondent was refused entry to the Complainant's affiliate programme is no justification for setting up the webpage to target such mistaken visitors.

## **7. Discussion and findings**

Clause 2 of the Policy provides that a Complainant must prove that:

- (i) The Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name; and
- (ii) The Domain Name, in the hands of the Respondent, is an Abusive Registration.

The onus of proving both of the above elements is borne by the Complainant who must prove them on the balance of probabilities (Clause 2b of the Policy).

The term "Rights" is defined by the Policy to include, but not be limited to, rights enforceable under English law but the term does not extend to a name or term which is wholly descriptive of the Complainant's business.

Abusive Registration is defined in Clause 1 of the Policy to mean;

A Domain Name which either:

- (i) was 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
- (ii) has been used in a manner which took unfair advantage of or was unfairly detrimental to the Complainant's Rights.

*The first criterion under clause 2 of the Policy- the Complainant's Rights*

The Complainant has supplied evidence of 47 trade mark registrations in the UK. These include registrations for the word mark GAP (for example registration B1, 265, 985 registered on 29 April 1986 for various items of clothing in Class 25 of the register) and registrations for "GAP" (registration number 2.242,808), "BABYGAP"(registration number 2,242,816) and "GAPKIDS" (registration number 2,242,809) logos in elongated white lettering against a dark blue rectangular background ("the Gap Logos"). Each of these logo marks was registered from 11 August 2000 in Class 35 of the register.

The Expert is satisfied that in addition to the trade mark registrations the Complainant will also have rights in the goodwill generated by the substantial (and successful) marketing of the GAP mark and the Gap Logos referred to above.

The Complainant is accordingly able to establish that it owns rights in the GAP mark and the GAP logos in connection with the marketing and sale of items of clothing and other products sold by the Complainant.

However the word “gap” is used widely in everyday speech. Although the word has acquired a “secondary meaning” which is distinctive of the Complainant in certain contexts the Complainant’s rights will not necessarily extend to a monopoly in the GAP word mark in every context. This is a point which the Expert shall consider further in relation to whether the Respondent’s registration of the Domain Name was abusive.

The next point for consideration is whether the Domain Name is identical or similar to the GAP word mark in respect of which the Complainant has established that it has rights.

The Domain Name `www.gap-online.co.uk` consists of the Complainant’s GAP mark followed by the suffix “online”. The “on-line” suffix is a generic and descriptive term when used in relation to the Internet and in the view of the Expert it adds nothing of substance to the Gap prefix. Accordingly the Expert finds that the Domain Name is sufficiently similar to the Complainant’s GAP mark to give rise to the possibility of an Abusive Registration.

In support of this the Respondent itself has indicated on its website that the Domain Name is sufficiently similar to have been caused confusion amongst the public who mistakenly visit its website when in search of the Complainant’s site.

#### *The second criterion under clause 2 of the Policy- Abusive Registration*

Abusive Registration is defined in the Policy by reference to two alternative limbs relating to (a) registration or acquisition of the Domain Name on the one hand and (b) to use made of the Domain name on the other.

#### Registration or acquisition

In relation to the registration or acquisition of a Domain Name the Policy defines Abusive Registration as follows: (clause 1)

- (i) Registration or acquisition in a manner which at the time when the registration or acquisition took place took unfair advantage or was unfairly detrimental to the Complainant's Rights.

The Domain Name was registered on 9 April 2000. The Expert must therefore consider whether the registration in April 2000 took unfair advantage or was detrimental to the Complainant's Rights in the GAP mark.

Clause 3 of the Policy provides a non-exhaustive list of factors which may be evidence that the Domain name is an Abusive Registration. The factors which may be relevant to the registration or acquisition of the Domain Name are as follows:

There are circumstances indicating that the Respondent has registered or otherwise acquired the Domain Name:

A primarily for the purposes of selling, renting or otherwise transferring the Domain Name to the Complainant or to a competitor of the Complainant, for valuable consideration in excess of the Respondent's documented out-of-pocket costs directly associated with acquiring or using the Domain Name;

B as a blocking registration against a name or mark in which the Complainant has Rights; or

C primarily for the purpose of unfairly disrupting the business of the Respondent.

There is no evidence before the Expert that the Respondent has offered to transfer the Domain Name to the Complainant or to its competitors. There is also nothing before the Expert to indicate that the Domain Name registration was secured as a blocking registration to prevent the Complainant from securing the registration.

In relation to the wider issue of whether the registration of the Domain Name took unfair advantage of or was detrimental to the Complainant's rights the Complainant asserts that the Respondent must have been aware of the potential to exploit the Complainant's well known mark at the time when it registered the Domain Name and points to the fact that in its view there was no other reason for it to have selected the acronym GAP for its domain name. The Respondent on the other hand states that the existence of the Complainant was not a factor in the naming of the site and that the focus of its business at least at the time of registration was the cataloguing of affiliate sites rather than an involvement (direct or indirect) in the sale of clothes and related items.

The Expert is mindful that there was a legitimate reason for the Respondent's choice of the Domain Name for its business. The Domain Name is an acronym of the Respondent's full corporate name. If the Complainant asserts that there was no reason for the Respondent to use an acronym; there is equally no reason why it should not do so. The word "gap" is in everyday usage and there is no evidence before the Expert to support a finding that it would be associated with the Complainant in areas which have no connection to the Complainant's business. There is also no evidence before the Expert to

support a finding that at the time of registration of the Domain Name in 2000 the Respondent had any intention to become involved directly or indirectly in the same type of business as the Complainant. Indeed the Respondent's evidence suggests that the "buyclothes.htm" page was not developed until some time after the website began operating.

The Expert finds on the evidence currently before her that the mere choice of a domain name which chiefly consists of the word GAP cannot in itself give rise to an inference that the Domain Name will take unfair advantage of or be unfairly detrimental to the Complainant's rights. The Expert is unable to locate anything in the Parties' submissions which shows on the balance of probabilities that the Respondent acted in bad faith at the time of the registration of the Domain Name. There is nothing to suggest that it was seeking to disrupt the Complainant's business by registering the Domain Name or to take advantage of the Complainant's status.

The Expert accordingly finds on the basis of the evidence which is currently available that the registration of the Domain Name was not abusive. Similarly there is no evidence before the Expert that the Respondent is engaged in making a pattern of Abusive Registrations.

#### Use of the Domain Name

The second way in which a registration of a Domain Name may be abusive relates to the use made of the Domain Name. The Policy states as follows in relation to Abusive Registration of a Domain Name:

- (ii) has been used in a manner which took unfair advantage of or was unfairly detrimental to the Complainant's Rights.

Clause 3 of the Policy provides a non-exhaustive list of factors which may be evidence that the Domain Name is an Abusive Registration. In relation to the way in which the Domain Name is used the Policy states at Clause 3 (a) (ii):

Circumstances indicating that the Respondent is using the Domain Name in a way which has confused people or businesses into believing that the Domain Name is registered to, operated or authorised by, or otherwise connected to the Complainant.

It should be remembered that this is a non-exhaustive example of an instance of use which takes unfair advantage of or is unfairly detrimental to the Complainant's Rights.

#### Use up to November 2002

The Expert finds that the use made of the Domain Name by the Respondent before receipt of the 19 November letter from the Complainant's solicitors clearly took unfair advantage of and was unfairly prejudicial to the Complainant's rights. Although, for the

reasons stated above, the Complainant's rights in its marks are not all encompassing they are strong in relation to the areas in which the Complainant does business- notably the sale of clothes. The onus was on the Respondent to avoid taking unfair advantage of or causing prejudice to the Complainant's rights through its operation of the website under the Domain Name. This is particularly the case given that the Respondent's own website records that it is aware that visitors visit its site looking for clothes and that "similarity in our web addresses is thought to be the most likely cause of this search engine confusion". In the period until November 2002 the Respondent did not take sufficient steps to achieve this. The Respondent's abortive application to join the Complainant's affiliate programme is of no relevance to this question.

The use of the Gap Logos by the Respondent on its site (for example its use on the home page and then also next to the link to the "buyclothes.htm" page) in conjunction with the Domain Name give rise to a probability that people or businesses would be confused into believing that the Domain Name and website were connected to the Complainant. The Expert finds that this is the case even taking into account the headline on the site stating "Welcome to Global Affiliate Programmes- Online". Visitors to the website may not necessarily have been confused into believing that the website was the Complainant's official site. Their confusion could have taken the form of a belief that the Complainant had approved the site and licensed the use of its Gap Logos. This confusion is damaging to the Complainant's Rights as it served to reduce and blur the Complainant's exclusivity in its Gap mark and Gap Logos and this would in itself be sufficient for a finding of Abuse.

If a visitor to the Respondent's pre-November site had proceeded to the "buyclothes.htm" page at that point he would have had sight of the disclaimer on the website which sought to clarify that the site has no connection with the Complainant. However the Respondent has made clear in its response to the Expert's request for additional information that certain sales of clothing are concluded without visitors linking to the third party seller via the "buyclothes.htm" page. In other words not every party seeking to buy clothes would have sight of the disclaimer.

The Respondent points out that the third party businesses which are listed on its site are branded so that it is unlikely that customers will think that they are dealing with the Complainant if they decide to purchase clothes via the site. It may be the case that customers may not think that the businesses are the same entity as the Complainant but they may well be mistaken into believing that there is a commercial arrangement between the Complainant and the third party business especially in the light of the appearance of the Gap Logos.

Before November 2002 the disclaimer on the "buyclothes.htm" page consisted of the phrase THIS IS NOT GAP. However this phrase was stylised to resemble the Gap Logos and, as such, would have been unlikely to correct the misleading impression that the Complainant had a commercial connection of some kind with the website. In smaller lettering the "buyclothes.htm" page went onto state:

At Global Affiliate Programs we have noticed that a number of our visitors come to us as a result of searches for clothes, in particular GAP clothes in the UK. The Similarity in our web addresses is thought to be the most likely cause of this search engine confusion.

Unfortunately, **GAP do not operate an online shopping service in the UK**, and although they run an affiliate program they only accept sites based in the USA or Canada. To assist visitors we at Global Affiliate Programs have compiled some of the finest online fashion outlets which deliver in the UK.

The Expert accepts that at this point a visitor to the site who had proceeded to the “buyclothes.htm” page and who took the time to read the small type may at that stage have any mistaken belief that the site had a connection to the Complainant corrected. But it would be asking a great deal of the casual visitor to the website to follow this process and the overwhelming likelihood is that some visitors to the website would remain under the illusion that the website was connected to the Complainant.

For the reasons set out above the Expert finds that the use of the Domain Name pre 19 November 2002 was abusive in that it took unfair advantage of and was unfairly detrimental to the Complainant’s Rights.

The Complainant also complains that the look and feel of the Respondent’s website is similar to its own website. For completeness the Expert does not accept this argument. The look and feel of the Respondent’s page consists of a commonplace layout and makes no use of specific features which are associated with the Complainant either alone or in combination.

*Can historic use be taken into account by the Expert?*

On receipt of the letter from the Complainant’s solicitors the Respondent made certain changes to the website, in particular by removing the Gap Logo which was responsible for much of the confusion.

This raises the question whether it is permissible for the Expert to find against the Respondent on the basis of historic abuse of the Domain Name. The Policy defines Abusive Registration as a Domain Name which “*has been used* in a manner which took unfair advantage of or was unfairly detrimental to the Complainant’s Rights” [italics for emphasis]. In the view of the Expert the Domain name has been used in this way historically and would fall within the definition of Abusive Registration.

On the other hand the Policy could be interpreted differently in that clause 3, which gives non exhaustive examples of factors which can evidence Abusive Registration, refers to “circumstances indication that the Respondent *is using* the Domain Name in a way which has confused people or businesses into believing that the Domain Name is registered to, operated or authorised by, or otherwise connected to the Complainant [italics for emphasis]. This would suggest that the use must be current.

On balance the Expert is of the view that historic use can in itself be sufficient to support a finding of Abusive Registration. The definition of the term in the Policy should take precedence over a non-exhaustive example of a type of Abusive Registration. This is supported by the decision of the Appeal Panel in DRS case 00389 *Hanna-Barbera Productions, Inc, v Hay*. In that decision the panel were of the view that Expert is entitled to look at ALL use of the Domain Name from commencement to the date of the adjudication even where the manner of use of the Domain name had changed. The panel went onto provide “it may be that less weight will be given to any changes in that use made following intimation to the Respondent of the Complainant’s objections”. Although this finding is not binding on the Expert in this current decision it is useful guidance and is in line with the Expert’s own conclusions set out above.

Accordingly the Expert is making a finding of Abusive Registration based on the pre-November 2002 use of the Domain Name.

However the issue would be of academic interest only if the post November 2002 use of the Domain name also amounts to an Abusive Registration.

#### *Post November changes*

Following the Complainant’s 19 November letter the Respondent removed the Gap Logos from its site, re-styled its disclaimer on the “buyclothes.htm” page so that it did not resemble the Gap Logo and positioned its own name (Global Affiliate Programs) above this disclaimer in relatively large type. Each of these changes reduced the likelihood of confusion once visitors had accessed the site- in particular the “buyclothes.htm” page. Insofar as the Expert can make out the only specific references to the Complainant which now appear on the site are in the disclaimer on the “buyclothes.htm” page and are made in the context of explaining that the Respondent is not connected to the Complainant.

However it must be kept in mind that the strength of the Complainant’s rights in its marks in connection with clothes and related products is so strong that the use of the GAP mark in the Domain Name in connection with these products will almost invariably give rise to an expectation of a commercial connection with the Complainant. The Expert is concerned that the disclaimer only appears on the “buyclothes.htm” page when according to the Respondent’s evidence some visitors make use of the links to other sites and conclude sales without visiting that page. The position would be more satisfactory if the disclaimer appeared on every webpage- including the homepage in order to minimise the risk of confusion.

It should also be borne in mind that confusion is only a non-exhaustive example of the type of conduct that may amount to abusive use of a Domain Name. Any use which takes unfair advantage of the Complainant’s Rights or which is unfairly prejudicial may be abusive.

There is a real issue here about whether the Respondent is taking advantage of the Complainant's goodwill for its own ends by redirecting customers who visit the site because they are looking to buy clothes to third parties from whom the Respondent receives commission for sales. Both Parties recognise that confusion is arising from the use of the Domain Name such that the Respondent's website is attracting hits from people searching for the Complainant. The Respondent's "buyclothes.htm" page is a deliberate attempt to redirect these customers to competitors of the Complainant. The Respondent seeks to justify this by stating that UK customers cannot do business with the Complainant online (the Complainant does not refute this assertion) and accordingly by redirecting customers to businesses which can supply them online, the Respondent is offering a valuable service in the consumer's interests. The Respondent acknowledges that it receives a commission in return for this service where sales are concluded. But the Respondent neglects to mention that a potential effect of this service is to divert customers who visit the site looking for the Complainant's products away from the Complainant to its competitors. If the redirection did not occur the customer might decide to visit a real (as opposed to a virtual) Gap store to buy the product they want. The net result is that the Complainant could lose sales to competitors whilst the Respondent secures a pecuniary advantage in the form of commission as a result of business brought in by its use of the Gap name.

In the view of the Expert this diversion of this business constitutes abusive use of the Domain Name. It is immaterial whether the Respondent actively seeks to attract this business to its site or not. The Respondent is making use of its Domain Name to take unfair advantage of the Complainant's rights by exploiting the misdirected hits it receives for its own gain on the one hand and to the detriment of the Complainant on the other hand.

In the interests of clarity the Expert wishes to make clear that the abuse is not

- (a) the use of a Domain Name incorporating the letters "g" "a" "p" taken in isolation, nor
- (b) the provision of affiliate links taken in isolation

The abuse lies in the combination of these factors. Once the Respondent became aware that its website was attracting those people interested in the Complainant the Respondent ought not to have taken advantage of the situation in a way which diverted customer interest and business from the Complainant – including business which might have been concluded offline if no online facilities were available.

## **Decision**

The Expert finds as follows:

- (a) The Complainant has proved 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.
- (b) The Complainant has proved on the balance of probabilities that the Domain Name is an Abusive Registration in the hands of the Respondent for the purposes of the Policy because
- The pre-November use of the Complainant's Gap Logos in conjunction with the Domain Name was confusing and thus took unfair advantage of and was unfairly prejudicial to the Complainant's Rights, and
  - The redirection of customers takes unfair advantage of the Complainant's Rights for the Respondent's potential gain.

Accordingly the Expert finds for the Complainant in relation to this Complaint.

### **Order**

Accordingly the Expert finds in favour of the Complainant and directs that the Domain Name be transferred to the Complainant.

**Sallie Spilsbury**

**7 May 2003**