

**CLIFFORD
CHANCE**

**CLIFFORD CHANCE
LIMITED LIABILITY PARTNERSHIP**
200 ALDERSGATE STREET
LONDON EC1A 4JJ

TEL +44 (0)20 7600 1000
FAX +44 (0)20 7600 5555
DX 606 LONDON
www.cliffordchance.com

YOUR REFERENCE

IN REPLY PLEASE QUOTE
GEM/G 1230/586/VGM
DIRECT DIAL
020 7006 4500

DATE
22 January 2003

Cybernet Ventures Limited
128 Knollmead
Surbiton
Surrey
KY5 9QW

Attn: George Forsyth Esq

Dear Sirs

The Gap, Inc. your “gap-online.co.uk” domain name

We refer to your letter dated 23 November 2002.

We do not propose to deal at length with the points made in your letter. Suffice it to say that our client does not agree with your analysis.

Our client’s GAP brand is one of the world’s leading clothing brands. You will, no doubt, have been aware of our client and its GAP brand when you registered the “gap-online.co.uk” domain name.

For the reasons we have already explained, it is our and our client’s view that the domain name ‘gap-online.co.uk’ is one which visitors, particularly those based in the UK who are looking for our client’s website, are bound to try. This must have been apparent to you when you registered the domain name. In fact, as you have stated on your website and in correspondence, you have indeed found that people looking for our client or its products are arriving at the gap-online.co.uk website.

Notwithstanding this, you are deliberately directing those visitors (including our client’s potential customers) to third party websites offering a wide range of products including clothing and baby care items as well as, for example, games, art, toys, comics, sports items, food and drink and flowers and other gifts. We assume you earn a fee for any sales made to

these customers as a result of your introduction.

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Until our initial letter to you, you were, in addition, using our client's GAP and BABY GAP logos to direct those visitors to your "BUY CLOTHES" page with links to retailers selling third party clothing and related items.

As we have indicated, we have advised Gap that the activities you are carrying out on your "gap-online.co.uk" website amounts to a clear infringement of its trade marks and an actionable passing off.

Specifically, your use of the GAP mark in relation to clothing and other goods in respect of which our client's mark is registered is an infringement under section 10(1) of the Trade Marks Act 1994 ("the Act"). You are using an identical mark in relation to goods identical to those covered by our client's registered trade marks. Under section 10(1) of the Act, it is **not** a requirement for our client to demonstrate a likelihood of confusion on the part of the public.

So far as other goods and services are concerned, your use of the GAP mark is an infringement under sections 10(2) and/or 10(3) of the Act. For the reasons explained above, your use of the mark, to attract visitors to your site and then direct them to other third party websites, clearly takes unfair advantage of our client's distinctive mark

Furthermore, as we have already indicated, we believe customers are bound to be confused or misled by your site notwithstanding the 'disclaimer' on your 'BUY CLOTHES' page. Your activities amount to an actionable passing off.

For the same reasons, we and our client remain firmly of the view that your domain name constitutes an "abusive registration" within the meaning of the Nominet UK DRS Policy and Procedure. To register and use a domain name which you know is attracting visitors looking for our client and to direct those visitors to third party sites offering clothing, accessories, related items and other goods and services of interest to them can only, in our view, be taking unfair advantage of and be unfairly detrimental to Gap's rights.

The purpose of this letter is to inform you that we have been instructed to file a complaint with Nominet under the Nominet DRS Policy and Procedure. This has been filed today and a copy of the Complaint (without enclosures) is enclosed. You will be formally notified of the Complaint and will be sent a full copy of the Complaint and Exhibits by Nominet in due course.

In the circumstances, we would invite you to reconsider your position and to provide the undertakings previously requested.

Yours faithfully

A handwritten signature in green ink that reads "clifford chance". The signature is written in a cursive, lowercase style.

Nominet UK DRS Complaint Form

Complaint Reference Number: 1767

(IMP OR TANT: please quote this temporary number on any annexes which you send. Once your complaint has been validated and processed, Nominet will assign a DRS reference number to the complaint, which should be quoted on all correspondence.)

Complainant's Details

Complainant Type: Business
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
London
Postcode: EC1A 4JJ
Country: GB
Daytime Tel No.: 020 7006 4500
Mobile Tel No.:
Fax: 020 7006 5555
Email: garry.mills@cliffordchance.com
Reference: GEM/G1230/586/VGM

All correspondence will be by post and email

Respondent's Details

Respondent: Cybernet Ventures Limited
Respondent Name: Mr George Forsyth
Business Name: Cybernet Ventures Limited
Address: 128 Knollmead
Surbiton
Postcode: KY5 9QW
Country: GB

Email:

Disputed Domain Names

gap-online.co.uk

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The Complaint

I confirm that Domain Name(s) in dispute are identical or similar to a name or mark in which I have Rights.

I confirm that Domain Name(s) in the hands of the Respondent is an Abusive Registration. The Complainant 1. The Complainant's first store opened under the name "the gap" in California, USA, in August, 1969. Over the years, the Complainant has enjoyed phenomenal success and, is, today, one of the world's best known clothing brands and speciality retailers. 2. The Complainant sells its products through its GAP, GAPKIDS, BABYGAP, GAP BODY and GAP OUTLET stores, of which there are over 2,900 worldwide. Its stores are located throughout the United States, the United Kingdom, France, Germany, Canada and Japan. In addition, in over 35 countries where the Complainant has not yet opened stores, GAP products have been sold through selected third party retailers. 3. The first GAP store in the United Kingdom opened in April 1987 in Richmond, Surrey. There are currently 232 stores located throughout the United Kingdom, all of which trade as "GAP", "GAPKIDS", "BABYGAP", "GAP BODY" and/or "GAP OUTLET". 4. The Complainant also has three innovative 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. Sample pages from the Complainant's "gap.com" website are at Exhibit 1. The Complainant's Names and Logos 5. 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. 6. The Complainant's GAPKIDS, BABYGAP and GAP OUTLET products and stores demonstrate how it often combines "GAP" with other words to form distinctive "composite" marks. There are numerous other examples, such as "GAP SCENTS", "GAP SUN", "GAP SHOES", "GAP KHAKIS", "GAP DENIM", "GAP ATHLETIC", "GAP BODY" and "GAP JEANS". Details of the Complainant's various UK trade mark applications and registrations for GAP and composite GAP marks are at Exhibit 2. As can be seen, the Complainant has registrations for, in particular, its distinctive "GAP", "BABYGAP" and "GAPKIDS" logos in elongated white lettering against a dark blue rectangular background. 7. As these marks reflect, although GAP began as an apparel brand, the product range has greatly expanded to include, for example, shoes, bags, hats, accessories, jewellery, toys, leather goods and personal care products. Advertising 8. The Complainant spends substantial amounts on advertising both in the UK and worldwide. 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. Articles written about the Complainant and GAP products appear regularly in UK and non-UK publications. GAP merchandise is also often featured in newspapers and magazines alongside fashion editorials. 9. 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. UK Sales 10. Sales of the Complainant's products through its UK stores have risen substantially. On the basis of fully consolidated sales figures, in 2001, the Complainant's turnover in the UK was over £400m. 11. For all the above reasons, the Complainant believes that the GAP brand (including GAPKIDS and BABYGAP) is and was, as at the date of application for the Domain Name, extremely well-known among customers in the UK and worldwide in relation to an ever expanding range of consumer products. The Respondent and the Domain Name 12. The Domain Name was

registered on or about 9 April 2000. It first came to the attention of the Complainant's in-house legal team on or around 8 November 2002 (the Respondent has indicated that it had earlier applied to join the Complainant's GAP Affiliate Program - not accepted because the program

of the Complainant's in-house legal department). As soon as the Complainant's in-house legal department became aware of this domain name, they were extremely 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 word completely descriptive 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 (indeed the Respondent on its website and in correspondence has confirmed that such confusion is occurring - see below). (ii) Notwithstanding the Respondent is aware of this confusion, it 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. (iii) 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. 13. The matter was immediately referred to the Complainant's UK lawyers, Clifford Chance LLP. 14. At Exhibit 3 are sample pages from the "www.gaponline.co.uk" website as at November 2002. As can be seen, the website claimed to provide information about websites operating "affiliate programs" (i.e. those offering commission on purchases made by referred customers etc.). The "home page" (page 1 of Exhibit 3) had a heading "Welcome to Global Affiliate Programs - Online". Immediately adjacent to this heading there appeared, very prominently, the Complainant's well known "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" (the "BUY CLOTHES" page - see page 11 of Exhibit 3). 15. On a page entitled "Which Program to Pick", the websites advertised as operating "affiliate programs" were (and are) 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. As can be seen from the copies of the "Babycare/children" and "clothes" pages (pages 2 and 8 of Exhibit 3), these pages, again made prominent use of the Complainant's logos. 16. Immediately under the headings on the "Babycare/and children" and "Clothes" pages it can be seen that there were the following statements: I] [on the Babycare/children page] "If you came here looking for [BABY GAP LOGO] CLICK HERE" E] [on the Clothes page] "If you came here looking for [GAP LOGO] CLICK I-HERE" Again, visitors who clicked these links were taken, not the relevant GAP website, but to the Respondent's "BUY CLOTHES" page. 17. As can be seen, the Respondent's "BUY CLOTHES" page had (and has) a veiy similar "look and feel" to the Complainant's website (for example, use of similar colour typeface, use of similar size fonts, product categories appearing in columns with similar size/spacing, use of "gap-online" header). There were, again, links to third party websites offering men's, women's and children's clothing and accessories. It is assumed that the Respondent obtained (and still obtains) commission payments in respect of purchases by customers visiting these websites via the "gap-online.co.uk" website. 18. It can be seen that 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. 19. The Complainant's view was that this statement would not in any way 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, which is not the case. 20. The Respondent made further reference to the Complainant: "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". 21. On 19 November 2002,

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Clifford Chance wrote to the Respondent to object to the use of this domain name and, in particular, the use of the Complainant's name and logos. The correspondence between the parties is at Exhibit 4. As can be seen, the Respondent replied on 23 November 2002 indicating that it would make certain changes to its website (referred to below) but that it would not cease using the "gap-online.co.uk" domain name as requested by the Complainant. 22. The revised pages from the Respondent's website are at Exhibit 5. As can be seen, the changes which have been made are minor. 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 (see page 13 of Exhibit 5) now reads "Not connected with The Gap, Inc. in any way" instead of "THIS IS NOT GAP". 23. 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 actively being directed to the Respondent's "BUY CLOTHES" page and the Respondent continues to make prominent references on its site to the Complainant. As before, the Complainant believes there is a real 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. Abusive Registration 24. In summary: El The Respondent registered a domain name which (apart from the descriptive suffix "online") is identical to the Complainant's GAP mark and one ~ customers, particularly UK customers looking for the Complainant, are bound to try. El This must have been apparent to the Respondent at the time of registration. In fact, as the Respondent has stated on its web site and correspondence, it has found that people looking for the Complainant or its products are arriving at its website. El The Respondent is using the website to promote third party websites offering a wide range of products including clothes and baby care items as well as, for example, games, art, toys, comics, sports items, food and drink and flowers and other gifts. It actively seeks to attract visitors to its "BUY CLOTHES" page. It is assumed that the Respondent earns a fee for any sales made by these third parties to such customers resulting from its "introductions". El Until Clifford Chance's initial letter, the Respondent was, furthermore, using the Complainant's well known "GAP" and "BABY GAP" logos to direct visitors looking for the Complainant or its products to its "BUY CLOTHES" page with links to these third party retailers. 25. 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. 26. It, therefore, submits that the Domain Name is (irrespective of any changes which may have been made to the Respondent's website since 19 November 2002) an Abusive Registration as defined in paragraph 1(i) of the DRS Policy.

Remedies Requested

Transferred

Legal Proceedings

As far as I am aware no legal proceedings have been issued or terminated in connection with the Domain Name.

Jurisdiction

Nominet Uk – DRS Complaint Form

I confirm that by submitting a complaint under Nominet's Dispute Resolution Service, I submit to the exclusive jurisdiction of the English courts with respect to any legal proceedings seeking to reverse the effect of a Decision requiring the suspension, cancellation, transfer or other amendment to a domain name registration(s), and I agree that any such legal proceedings will be governed by English law.

Declarations

I agree and accept that,

my claims and remedies concerning the registration of the domain name(s), the dispute, or the dispute's resolution shall be solely against the Respondent and that neither Nominet UK nor its directors, officers, employees or servants nor any Expert shall be liable for anything done or omitted in connection with any proceedings under the Dispute Resolution Service unless the act or omission is shown to have been in bad faith.

The information contained in this complaint is to the best of my knowledge true and complete. This complaint is not being presented in bad faith and the matters stated in this complaint comply with the Procedure and applicable law.

The information provided in this submission may be sent out of the European Economic Area in the event that a party involved in the Dispute Resolution Service is situated outside the EEA.

Documentation in Support of Complaint

I am submitting documentation with this complaint

Signed by

Authorised Representative

Date of submission: 22/01/2003