

Nominet UK

DRS Reply Form

Case reference: 820
(*IMPORTANT: Quote this number on all documents and communications*)

Reference Domain Name: gap-online.co.uk

The Reply

Reply 1. This Reply is made in response to the letter dated 8 February 2003 from the Respondent to Nominet UK. 2. At paragraph 1, Mr Forsyth seeks to justify the Respondent's adoption of the acronym "GAP" on the basis that he wished to make the URL for his site shorter and easier to remember. He seeks to rely on the fact that other companies and organisations use their initials in their URLs. 3. It is submitted that the arguments put forward by Mr Forsyth provide no justification whatsoever for the adoption by the Respondent of the "gap-online.co.uk" domain name. Of the examples cited by the Respondent, entities such as the Automobile Association and British Broadcasting Corporation became known by their initials long before the advent of the Internet. In this case, the Respondent has set up (or purports to have set up) an Internet related business and has deliberately adopted a name the initials of which (G.A.P) spell the name of one of the best known retailers in the world. 4. There is and was no need for the Respondent to have adopted the name chosen. On the Respondent's own home page he says that "affiliate programs" are also known as, for example, "partner programs" or "referral plans". Accordingly, the Respondent could, quite reasonably, have adopted "Global Partner Programs", "Global Referral Plans" or some other name with a similar meaning to the name chosen which did not have initials spelling a well-known third party brand name. It is submitted that, in this case, given that the Respondent must have known that he was going to be using the site to provide links to third party websites offering clothing, accessories, baby care items and other items offered by the well known retailer GAP, he should have avoided adopting "GAP" as the URL for his site. To suggest (at paragraph 2) that the Respondent had no reason to suppose that the Complainant would object to registration and use of such a domain name is simply not credible. 5. Furthermore, even if the Respondent wished to use the name "Global Affiliate Programs", there is no need for him to have abbreviated the name for the purposes of the choice of URL. There is no reason why the Respondent could not have adopted and used the domain name "globalaffiliateprograms.co.uk". The Respondent states that the use of initials is "well established" web practice. However, looking just at some of the websites promoted on the Respondent's site, it can be seen that this practice is by no means universal. There are many organisations or entities with similarly lengthy names using their full names as their URL. Examples taken from the Respondent's site include "marksandspencer.com", "nursingmothersupplies.com", "surpriseyourwoman.com" and "nationalbusinessfurniture.com". 6. In any event, even if the Respondent wished to use the name "Global Affiliate Programs" and to abbreviate the name for the purposes of the

choice of URL, there is and was no need for him to have done so by adopting initials. Numerous entities or organisations with lengthy names, for example, shorten them by registering URLs comprising the first or most distinctive part of their name. Again, from the Respondent's own site it can be seen that one of the sites promoted by the Respondent is "Gardener's Supply Company" which has adopted the domain name "gardeners.com". There is no need for the Respondent to have adopted "gap-online.co.uk". 7. Given that the Respondent's site name is "Global Affiliate Programs", it is difficult to see how the domain name "gap-online.co.uk" makes the URL easier to remember. Given that the word "online" does not form part of the full name of the Respondent's site, this means that visitors wishing to remember the domain name not only have to recall the initials of the full site name but also remember that the initials are followed by the word "online" and also remember that the words are separated by a hyphen. It is submitted that for visitors wishing to revisit "Global Affiliate Programs", the domain name "gap-online.co.uk" is, if anything, more difficult to remember (and more likely to be mis-typed) than, for example, "globalaffiliateprograms.co.uk" (which the Complainant believes is currently available for registration). 8. The Respondent refers (at paragraph 2) to other websites that include the word "gap" as part of the URL. It is submitted that the existence of such sites is of little (if any) relevance. The Complainant's concerns and also this Complaint are based not solely on the registration of the domain name "gap-online.co.uk" but also on the use that has been made of it. So far as the Complainant is aware, no other sites with "GAP" as the URL have used the domain name to offer clothing, accessories, babycare or similar merchandise nor have any of them made prominent use of the Respondent's well known logos for the purpose of offering such products. 9. The Respondent says (at paragraph 4) that on its home page, the full name "Global Affiliate Programs" appears in prominent lettering and that anyone wishing to visit their site "in the mistaken belief that it had anything to do with Gap, Inc or any other organisation would instantly realise that it did not". The Complainant does not accept this. 10. Firstly, it is submitted that the domain name "gap-online.co.uk" is so strongly indicative of the Complainant and its products that visitors to the site will assume it is the Complainant's site particularly when, as was the case until recently, the home page features prominent use of the Complainant's well-known GAP logo. Secondly, this will be reinforced by the numerous references to clothes, accessories, babycare and similar items for which the Complainant is so well known in the UK and elsewhere and by the links to web pages offering clothing 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. 11. In this regard, it is submitted that clothing, accessories, babycare and other items for which the Complainant is so well known comprise an extremely substantial part of the Respondent's "directory". For example, the "Clothing" page contains around 65 links (excluding the separate "BUY CLOTHES" page), "Babycare" around 16 links, "Retail sales" 27 links, "Sports" 31 links, and "Health and fitness" 49 links. By comparison, of the pages which do not comprise core goods or services for the Complainant, "Astrology", for example, has only 4 links, "Property/real estate" has only 4 links, "Search engines" has only 4 links, "Business Services" has only 8 links and "Finance and investing" has only 30 links. 12. At paragraph 6, the Respondent submits that the BUY CLOTHES page was only set up two years after the site's inception. He provides no documentary evidence to support this. In any event, it is clear from the above that even not taking into account the BUY CLOTHES page, links to clothing and related pages comprise by far the largest single category of products listed on the site. 13. Even if Mr Forsyth's explanation of the background to the BUY CLOTHES page (at paragraph 12-13) were accurate, it would appear that this page was clearly set up to benefit from the mistaken visits his site was

receiving from people looking for the Complainant or its products. The fact that the Complainant was unable, for commercial reasons, to allow the Respondent to join its affiliate program is no justification for the Respondent setting up a BUY CLOTHES page to target even more directly such mistaken visitors nor to use the Complainant's logos and name for that purpose. 14. At paragraph 16, the Respondent asserts that it has at no time sought to benefit financially from the use of the URL. In the Complaint and in correspondence it has been submitted that the Complainant assumes (amongst other things) that the Respondent obtains a fee for sales made via his introductions. So, for example, if a customer wishing to visit the Complainant's site accidentally arrives at "gap-online.co.uk" and is thereby directed to a third party clothing page listed on the BUY CLOTHES page from which he makes a purchase, it is assumed the Respondent obtains a commission. The Respondent apparently does not deny this. Accordingly, it is submitted that the Respondent's assertion at paragraph 16 is inaccurate and that he clearly benefits financially from the confusion caused by the misuse of the complainant's well-known GAP trade mark. 15. Finally, at paragraph 10, the Respondent refers to the changes made to his website following complaint by the Complainant (Clifford Chance's letter of 19 November 2002). The Respondent has (for the time being at least) removed the Complainant's logos from his site. However, had the Complainant not objected, the Respondent would still likely be using those logos. The Complainant is, it is submitted, entitled to rely on this misuse of its well-known logos in support of its claim that the domain name has been used in such a manner to constitute an "abusive registration" (even if those logos are not at present being used). In any event, it is submitted that even in its current form, the Respondent's site is such that the "gap-online.co.uk" domain name constitutes an abusive registration. 16. To reiterate: · The Respondent registered a domain name which (apart from the descriptive suffix "online") is identical to the Complainant's GAP mark and one which customers, particularly UK customers looking for the Complainant, are bound to try. There is and was no credible legitimate reason for the choice of domain name by the Respondent. · It must have been apparent to the Respondent at the time of registration that confusion was likely to occur. In fact, as the Respondent has stated on its website and correspondence, it has found that people looking for the Complainant or its products are arriving at its website. · 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. These goods are the core goods of the Complainant or so closely related that visitors are bound to assume they are the Complainant's goods. 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". This is apparently not denied by the Respondent. · 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. 17. 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 19 November 2002) an Abusive Registration as defined in paragraph 1(i) of the DRS Policy.

Complainant's Warranties

I agree and accept that,

The information contained in this reply is to the best of my knowledge true and complete.

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 Reply

I am not submitting documentation with this reply

Signed by
Complainant/Authorised Representative (*please delete as appropriate*)

Date of submission: 21/02/2003