

DISPUTE RESOLUTION SERVICE

D00016516

Decision of Independent Expert

Gorilla Sports GmbH

and

Mr David Harding

1. The Parties:

Complainant: Gorilla Sports GmbH
Address: Dr. Robert Murjahn-Str.7
64372 Ober
Ramstadt
Country: Germany

Respondent: Mr David Harding
Address: 58 Bywell Road
Sunderland
Tyne and Wear
SR6 7QT
Country: United Kingdom

2. The Domain Name(s):

gorillanutrition.co.uk ("Domain Name")

3. Procedural History:

I can 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.

16 September 2015	Dispute received
17 September 2015	Complaint validated and notification of complaint sent to parties
6 October 2015	Response reminder sent
9 October 2015	No Response received and notification of no response sent to parties

9 October 2015
16 October 2015

Respondent non-standard submission received
Expert decision payment received

The Respondent made a non-standard submission pursuant to §13b of the Procedure. Having considered the brief explanatory paragraph that was provided to me in accordance with the Procedure, I determined that there was an exceptional need for me to see the non-standard submission. I requested by email on 28 October 2015 that Nominet release the full non-standard submission to me and inform the Complainant that he should provide any reply to the non-standard submission by 5:00pm on 2 November 2015. Nominet informed the parties of my decision on 29 October 2015. The Complainant replied on 2 November 2015.

Definitions used in this decision have the same meaning as set out in the Nominet UK Dispute Resolution Service Policy Version 3, July 2008 (the “Policy”) and/or the Nominet UK Dispute Resolution Service Procedure Version 3, July 2008 (the “Procedure”) unless the context or use indicates otherwise.

4. Factual Background

The Complainant operates a business selling sports equipment and related products.

The Respondent uses the Domain Name in connection with the sale of third party branded sports nutrition goods.

The Respondent registered the Domain Name on 16 April 2013

5. Parties’ Contentions

The Complaint

Complainant’s Rights

The Complainant is the proprietor of registered rights for the marks GORILLA and GORILLA SPORTS:

1. Community Trade Mark Registration No. 10384642 - GORILLA in Class 28, registered on 26 November 2012;
2. UK Designation of International Registration No. 1189561 - GORILLA SPORTS in Classes 5, 25, 27, 28 and 41, with a date of protection in the UK of 10 July 2014.

The UK Designation of International Registration No. 1189561 covers “nutritional supplements” in Class 5.

The Complainant says that it has business operations in the UK, Germany, Austria, France and Scandinavia and has used the mark GORILLA SPORTS extensively. The Complainant says that its GORILLA SPORTS brand was established in 2005 and has been used in relation to the provision of professional quality gym equipment, accessories and nutritional supplements. The Complainant’s UK subsidiary is Gorilla Sports UK Ltd, a company incorporated in October 2011 and this company operates a website at www.gorillasports.co.uk. The Complainant also says that it operates a direct-to-the-public business model and does not supply its products to any other retailers or through third party websites.

The Complainant says it has sold nutritional supplements under the GORILLA SPORTS mark as evidenced by a print from <http://www.gorillasports.co.uk/c-47-supplements.aspx> and that these prints clearly show the GORILLA SPORTS mark as well as a black and white Gorilla Device used in

connection with gym equipment and various other related accessories including supplements and clothing.

The UK Facebook webpage for the Complainant's UK subsidiary can be found at www.facebook.com/gorillasportsuk. The Complainant notes that this webpage has 17,118 'likes', which represents the number of individual users that follow the Complainant's Facebook webpage. The Complainant says that its German page has 86,387 'likes'.

The Complainant publishes a blog at <http://www.gorillasports.co.uk/blog> bearing the GORILLA SPORTS mark and black and white Gorilla Device, which includes dietary/nutritional tips and healthy recipes, and evidences a print from the blog page.

The Complainant asserts that it enjoys goodwill under common law in the UK in respect of the name GORILLA SPORTS as a result of the use made of the mark.

The Complaint says that the Domain Name contains the whole trade mark GORILLA and the dominant and distinctive element of the GORILLA SPORTS trade mark, being the word GORILLA. Thus, the only differences between the Domain Name and the Complainant's registered trademarks are the addition of the non-distinctive element NUTRITION (when used in relation to the retail of foodstuffs) and the generic domain suffix ".co.uk".

The dominant and distinctive component of the Domain Name is the word GORILLA, which is identical to the Complainant's registered trade mark for GORILLA, similar to the Complainant's registered trade mark for GORILLA SPORTS, and similar to the Complainant's common law rights in the GORILLA SPORTS trade mark.

Having identified the existence of the Domain Name, the Complainant's representative wrote to the Respondent on 13 April 2015. The Complainant says that the Respondent did not reply to that letter and so a reminder containing the original letter was sent on 29 April 2015. The Complainant received a response from the Respondent on 10 July 2015.

The Complainant submits prints from www.ebay.com that show sports supplements which were made available for sale by the Respondent's trading entity, Gorilla Nutrition, via an eBay store. The Business Seller Information is given as "Gorilla Nutrition, David Harding". The Complainant also submits prints from the Respondent's Twitter account, showing 'retweeted' messages from a Twitter account at www.twitter.com/tweetgorillauk, and a Facebook page at www.facebook.com/gorillanutritionuk operated by the trading entity.

The Complaint says that following the Complainant's letters in April 2015, the eBay, Twitter and Facebook pages for the trading entity appear to have been removed. However, the Respondent continues to operate the Domain Name.

Abusive Registration

The Complainant has no known connection or commercial relationship with the Respondent who does not have the permission of the Complainant to use the trade mark GORILLA or variations of the trade mark including GORILLA NUTRITION.

Given the similarity between the Domain Name and the Complainant's earlier trade mark registrations, together with the fact that both parties have provided identical services, the retailing of nutritional supplements, there is a likelihood of confusion on the part of the average consumer encountering the Domain Name.

The Complainant quotes §3.3 of the DRS Experts' Overview in relation to initial interest confusion:

"Commonly, Internet users will visit web sites either by way of search engines or by guessing the relevant URL. If the domain name in dispute is identical to the name of the Complainant and that name cannot sensibly refer to anyone else, there is bound to be a severe risk that a search engine, which is being asked for the Complainant, will produce high up on its list the URL for the web site connected to the domain name in issue. Similarly, there is bound to be a severe risk that an Internet user guessing the URL for the Complainant's web site will use the domain name for that purpose."

In such cases, the speculative visitor to the Respondent's website will be visiting it in the hope and expectation that the website is a website "operated or authorised by, or otherwise connected with the Complainant". This is what is known as "initial interest confusion" and the overwhelming majority of Experts view it as a possible basis for a finding of abusive registration, the vice being that even if it is immediately apparent to the visitor to the website that the site is not in any way connected with the Complainant, the visitor has been deceived. Having drawn the visitor to the site, the visitor may well be faced with an unauthorised tribute or criticism site (usually the latter) devoted to the Complainant; or a commercial website which may or may not advertise goods or services similar to those produced by the Complainant. Either way, the visitor will have been sucked in/deceived by the domain name."

Consumers looking for the Complainant's goods are likely to search the term 'GORILLA' in combination with a number of potential elements including: 'SPORTS', 'GYM', 'EQUIPMENT', 'NUTRITION', 'SUPPLEMENTS' etc. Given the Complainant's registered and unregistered rights, the Complainant says that it is inconceivable that consumers would not expect the Domain Name to be directly connected to the Complainant and its business, in particular in relation to the sale of nutritional supplements and the Domain Name is liable to be construed by consumers as indicating an authorised trade connection with the Complainant where there is no such connection.

The Complainant sells sports goods which have included sports supplements, making use of a prominent black and white gorilla device and the words GORILLA SPORTS. The Respondent also sells nutritional supplements where the website at the Domain Name displays prominently the wording GORILLA NUTRITION alongside a black and white logo consisting of a gorilla. The Complainant asserts that retail services relating to sporting equipment, nutritional products, and the provision of information on sports nutrition are intrinsically linked.

Given the similarity between the Complainant's trademarks (both word and logo forms) and the Domain Name, and the similarity of the goods and the retail services connected with those goods, the Complainant asserts that there exists a likelihood of confusion on the part of the consumer; a consumer visiting the Domain Name, or encountering the website via internet searches, is likely to believe the retail services being offered by the Respondent are being offered by the Complainant, or that the Respondent and the Complainant are economically linked, when no such link exists.

Furthermore, the Complainant says, consumers looking for the Complainant may enter the Domain Name into an internet browser with the realistic expectation that it would retrieve the Complainant's website, or a website associated with the Complainant. Thus, the Respondent is using the Domain Name in a way which is likely to confuse people into believing that the Domain Name is registered to, operated by, or authorised by, or otherwise connected with the Complainant. The fact that the Domain Name connects to a website which also bears gorilla imagery compounds the likelihood of consumers being misled into believing there is a connection between the parties which does not exist.

The complainant quotes the Appeal Panel in scoobydoo.co.uk (DRS 00389):

"Moreover, the panel is unanimous in the view that the purpose of Paragraph 4.b is to dissuade people from taking the name of another without adornment and without permission and with a view to making direct reference to that person whether for attribute or criticism. The clear meaning of the rule is that such a registration is prima facie abusive, unless the Respondent can show otherwise. Accordingly, the burden is on the Respondent to show that the domain name is not an abusive registration."

The Complainant says that in response to the Complainant's letters in April 2015, the Respondent has not advanced any reason as to why the Respondent deemed it necessary to register, and use, a domain name which is confusingly similar to the registered and unregistered rights of the Complainant. Furthermore, the Domain Name is not a descriptive term but rather it incorporates the name of a well-known provider of gym equipment, accessories and supplements. Thus, the Domain Name in the hands of the Respondent undermines the Complainant's ability to exploit its

registered rights in the GORILLA and GORILLA SPORTS trade mark, as well as its unregistered rights in the GORILLA SPORTS mark.

The Complainant concludes that there can be no explanation of the Respondent's actions other than to suggest that it is taking unfair advantage of the goodwill of the Complainant in connection with GORILLA and GORILLA SPORTS. In effect, the Respondent has and continues to "ride on the coat tails" of the Complainant by seeking to divert parties seeking out the Complainant's goods and towards a website entirely unconnected to the Complainant. The Respondent must have been aware, and has been since being put on notice of the Complainant's rights by letters in April 2015, that its activities amount to a misappropriation of the rights of the Complainant.

Thus, consumers entering the domain name into a URL would suffer initial interest confusion, legitimately expecting to find the business of the Complainant, and actual confusion, on encountering the Respondent's website, believing that the retail services provided by the Respondent are the retail services of the Complainant, or are being provided by an entity which is economically linked to the Complainant.

Finally, the Complainant says that it has made considerable sales in relation to its sporting products, including supplements, such that unauthorised use of the name GORILLA NUTRITION and/or use of the Domain Name amounts to a misrepresentation that could reasonably be expected to damage the Complainant through loss of the opportunity to exploit its rights through the tarnishment or dilution of the Complainant's goodwill. Thus, in terms of *Spalding v Gamage* [1915] 32 RPC 273 and *Reckitt & Coleman Products Ltd v Borden Inc* [1990] RPC 341, action by the Complainant under the common law of passing off based on its goodwill and reputation can reasonably be expected to succeed against such misrepresentation and unauthorised use.

The Response

The Respondent did not submit a response by the required deadline of 8 October 2015. The Respondent contacted Nominet on the morning of 9 October and Nominet asked the Complainant if it would agree to allow the Respondent to submit the response on 9 October; the Complainant refused.

The Respondent's non-standard submission

On 9 October 2015, the Respondent submitted a non-standard submission pursuant to §13b of the Procedure with the following explanatory paragraph:

"I'm self-employed; I have worked tirelessly and invested hours and hours of time on this response. I have had only 22 days to prepare it having no prior knowledge of the Nominet DRS or their policies. I've had to sacrifice a lot of time and effort that has been needed in other areas of my business to deal with this misleading and ultimately incorrect complaint from a larger company with the luxury of hiring a lawyer to draft their case for them. We have had previous legal contact with the Complainant and hadn't received a response in 5 months. I believe this Nominet complaint was lodged as part of a deliberate wider strategy in an attempt to 'wear down' a self-employed sole-trader. I started the process of submitting the response at 23:55 last night without realising there were multiple stages to submitting the response. By the time I was finally able to click to submit the response it had just passed midnight and I received the message that the deadline had now past.

Having considered the Complaint and the explanatory paragraph, I determined that there was an exceptional need for me to see the non-standard submission and on 28 October 2015 I requested that Nominet release the full non-standard submission to me and to inform the Complaint that it should provide any reply by 5:00pm on 2 November 2015.

In the non-standard submission, the Respondent says that he started the business in September 2014 after developing the idea with the Sunderland Business and Innovation Centre and was granted a loan from Virgin. The business, Gorilla Nutrition, traded through eBay and an

ecommerce store at the website resolving to the Domain Name and sold third-party branded sports supplements.

The Respondent says that the gorilla branding was to symbolise size and strength with the intention of appealing to male gym-goers and bodybuilders. The logo was drawn by hand and converted to a digital form by the web development company.

The Respondent says that the business grew rapidly and he realised during the first 6 months that customers were every-day gym users, including a significant female customer base, and not just male gym enthusiasts. In March 2015 the Respondent considered rebranding the retail store to "Supplements Delivered" to appeal more to the mass market and with a more neutral transactional branding. Before taking any steps to rebrand, the Respondent received the Complainant's first letter on 13 April demand that the Respondent cease and desist all use of Gorilla Nutrition and any other sign containing Gorilla, surrender the Domain Name registration, delete the Facebook page, Twitter feed and the eBay store, and undertake not to commence or resume any such use of marks, domains, trading names, company names, social media activity, or otherwise which contain the word Gorilla, or anything similar thereto. The Complainant demanded a response within two weeks.

The Respondent contacted a law firm and provides a copy of a response letter from that law firm addressed to the Complainant's representatives dated 5 June 2015. The Respondent says that he received no response to this letter.

The Respondent says that he continued with his plan to rebrand the business to Supplements Delivered and that this had nothing to do with the Complainant's letter. Accordingly, he had a new website built at www.supplementsdelivered.co.uk which went live on 25 July 2015. At the same time he changed the eBay store name to Supplements Delivered, the Facebook page name to Supplements Delivered and the Twitter account name to Supplements Delivered. The Instagram account name was also changed to Supplements Delivered. The Respondent also notes that he has a Trustpilot page (an independent review website) under the name of Supplements Delivered.

The Respondent says that he was still getting a significant number of orders through the Domain Name and so decided to keep the website at the Domain Name active as a "branch" of Supplements Delivered. The Respondent provides copies of pages showing social media links and Trustpilot links displayed at the Domain Name website which direct users to the Supplements Delivered social media and Trustpilot pages. Also, the Respondent says that on the eBay and Trustpilot pages there is a direct reference to ownership of the Gorilla Nutrition website, whilst on Facebook and Twitter the reference is to Supplements Delivered as the 'Supplements Delivered Group'. In the 'About Us' section of the Domain Name website, it is clearly stated in the first paragraph that the website is part of the Supplements Delivered Group.

In response to the Complainant's allegation that the Respondent's use of the Domain Name is taking unfair advantage of or it is unfairly detrimental to the Complainant's Rights and that internet users will therefore believe that the Domain Name belongs to the Complainant or it will catch customers who are searching for the Complainant's store, the Respondent says that:

1. The crux of this argument hinges on the fact that the Complainant believes it has rights over the word 'Gorilla' with regards to the sale of nutritional supplements. However, the Complainant's two trademarks are completely explicit in that the trademark for the word GORILLA in respect of gym equipment only, and for GORILLA SPORTS in respect of the sale of nutritional supplements, clothing, and gym mats.
2. The Respondent does not sell any products in the class covered by the trade mark GORILLA. The accessories on his website are directly associated with supplements i.e. protein shakers to mix supplements; these are not gym accessories but are nutritional supplement accessories.
3. The Respondent sells nutritional supplements and some clothing products from the supplement brands in the classes covered by the trade mark GORILLA SPORTS.

The Respondent does not believe that the Complainant has rights over the word 'Gorilla' with regards to nutritional supplements. If this was the case, the Respondent asks why the Complainant needed to register a separate trademark GORILLA SPORTS for the sale of nutritional supplements.

In support of the Complainant claims to have sold nutritional supplements it has evidenced old versions of its website with a single nutritional supplement product for sale. The Respondent notes that this is an 'own brand' product and that it is a single product. The Respondent also notes that the Complainant has since updated its website and there is no longer a supplement category or any type of nutritional product.

In respect of the word 'Gorilla', the Respondent says that it is a generic English word in reference to an animal and is widely used in brands across the globe; the Respondent doubts that the Complainant has acquired goodwill in respect of this word. This is particularly true in the fitness industry where the animal's connotations of strength make it a popular choice of name. The Respondent has not used the phrase 'Gorilla Sports' at all. The Complainant has the trademark GORILLA SPORTS including the word 'Gorilla' in reference to the sale of gym equipment, but the Respondent asserts that it has not taken on a secondary meaning and notes the following:

1. A google search of websites using the word 'Gorilla' in the fitness industry results in hundreds of websites including companies using the word 'Gorilla' with regards to the sale of gym equipment, such as:
 - a. <http://www.gorilafitness.ca>
 - b. <http://gorilla-fitness-equipment.myshopify.com/>
 - c. <http://imagorilla.com>
 - d. <http://grillafitness.com/>
 - e. <http://www.gorillaworkoutapp.com/>
 - f. <http://www.gorillaplayground.com/>
 - g. <http://www.thegorillapitmembers.com>
 - h. <http://www.gorillawarfare.co/>
 - i. <http://www.gorillapressfitness.com/>
 - j. <http://www.gorillawear.com/>
 - k. <http://gorillagym.kg/>
 - l. <http://www.gorillaaesthetics.com/>
 - m. <http://www.thegorillapit.com.au/>
 - n. <http://www.gorillagym.training/>
 - o. <http://www.gorillastrength.us/>
 - p. <http://www.gorillabench.com/>
2. There is a very well-known fitness/ bodybuilding clothing brand based in the Netherlands called 'Gorilla Wear' which uses the word 'Gorilla' with regards to the sale of fitness clothing. <http://www.gorillawear.com/>. This is contrary to the complainant's assertion that its trademark 'Gorilla Sports' covering nutritional supplements, clothing, and gym mats, means that they have a right over the 'dominant' word 'Gorilla' for brands selling in those categories. Not only is Gorilla Wear selling clothing, it is specifically fitness clothing and has 64,715 'likes' on its Facebook page at <https://www.facebook.com/GorillaWearUSA/>. Also, its logo is a black and white 'gorilla device'.
3. Outside of the fitness industry there are very large brands using the word 'Gorilla'.

The Respondent rejects the Complainant's assertion that an internet user would type the Domain Name into their web browser's address bar rather than www.gorillasports.co.uk. Also, the example search engine terms that the Complainant says users might use to search for the Complainant have the following results:

1. 'gorilla sports' – the Complainant's website is the first result; the Domain Name does not appear within the first 10 pages of Google (the Respondent did not look at further);
2. 'gorilla gym' – the first result is a US fitness equipment site; the Complainant's website is the 5th result; the Domain Name does not appear within the first 10 pages of Google (the Respondent did not look at further);
3. 'gorilla equipment' - the Complainant's website is the first result; the Domain Name does not appear within the first 10 pages of Google (the Respondent did not look at further);
4. 'gorilla nutrition' – the Domain Name is the first result; the Complainant's website does not appear in the first 10 pages (the Respondent did not look at further);
5. 'gorilla supplements' - the Domain Name is the first result; the Complainant's website does not appear in the first 10 pages (the Respondent did not look at further);

Thus, the Respondent says, there is no overlap between the two companies when it comes to using search engines in respect of their names and/or products because they are in separate markets selling different types of product. The fact that the Respondent is ranked number 1 when searching for 'gorilla' along with 'nutrition' or 'supplements' illustrates dominance over the word 'Gorilla' when it comes to the sale of nutritional supplements.

In respect of supplements, the Respondent says that he sells only third-party branded supplement products which have huge customer bases in their own right whereas the Complainant has only provided evidence of a single 'own-brand' supplement product branded 'Gorilla Sports'. Furthermore, the vast majority of the Respondent's sales through the Domain Name arrive through Google Shopping, which is a service that displays products to customers who search for an exact product. Thus, in a search for 'PhD Nutrition Diet Whey 1kg' the Respondent's offering appears in the google search. These brands are international brands owned by major pharmaceutical firms; the Respondent's best-selling brand's Facebook page has over 1,000,000 likes.

The Respondent says that he has fulfilled over 9,183 orders under the name Gorilla Nutrition, to approximately 8,341 unique customers. This is entirely nutritional supplement products and consists of 3,436 orders via the Domain Name and approximately 6,377 orders via the eBay store whilst the name was Gorilla Nutrition. The Respondent has 1,614,118 impressions in Google Searches for the Domain Name; that is, the name Gorilla Nutrition coupled with information about the sale of supplements, or individual supplement products has appeared on 1,614,118 Google Searches. Thus, the Respondent asserts that in the supplement market he owns the name Gorilla Nutrition and that customers would not be searching for the Gorilla Sports website when trying to purchase supplements. So it follows that customers wouldn't believe that the Domain Name website was affiliated with the Complainant.

The Respondent believes that the Complainant has tried unsuccessfully to launch an 'own brand' of supplements through gorillasports.co.uk and, based on the fact that they no longer sell supplements, that launch has failed. The Complainant has seen the growing success of the Domain Name and wants to take control to launch its own retail store selling supplements, benefitting from the brand name that the Respondent has built up over the past year. The Respondent evidences data from Google Analytics that since January 12 2015 he has had 53,510 individual sessions on his website (periods of time in which a user has browsed the store), which consists of 38,483 individual internet users viewing 151,157 pages. The Respondent would like to see evidence of the period over which the Complainant sold nutritional supplements and how many nutritional supplements were sold and asks the Complainant to demonstrate sales of nutritional supplements.

The Complainant's references to 'likes' in respect of its website that are related to nutritional supplements is 0 as the Complainant no longer sells nutritional supplements.

As the Complainant is a retailer of gym equipment, its blog relates to fitness, and diet plays a big role in fitness so its blog would naturally include nutritional tips. The retail sectors of gym equipment, sports nutrition, and the provision of information on sports nutrition are all part of the fitness sector, however in respect of sales the sectors aren't as linked as the Complainant claims.

The Respondent also challenges the Complainant's statement that it is a well-known provider of gym equipment; the Complainant's UK Facebook page has only 17,000 likes. The Respondent had not heard of Gorilla Sports previously. The Respondent notes also that the Complainant is primarily in the German market.

The Respondent asserts that the 'nutrition' part of the Domain Name is the distinctive and descriptive part as it describes what he sells – nutritional supplements. 'Gorilla' is a generic English word that has developed no secondary meaning.

The Respondent notes that the quotation from the experts' overview put forward by the Complainant's refers to a domain name that is identical to the name of the Complainant. As the Domain Name is not identical to the Complainant's trade mark, it is not correct that the Domain Name that name cannot sensibly refer to anyone else.

In respect of the Complainant's assertion that the Respondent has not offered any explanation as to its registration of the Domain Name, the Respondent points to his response to the Complainant's April letters which it says it received on 10 July 2015 (which the Respondent says was sent on 5 June), and to which the Respondent never received a response. The Respondent letter put significant questions, including evidential questions, to the Complainant in respect of its allegations, which the Complainant has failed to answer.

The Respondent concludes that there would be no initial interest confusion as a user entering the Domain Name into a browser would be expecting to find the Respondent. This is based on the evidence of website usage figures and the number of orders fulfilled. There would be no actual confusion as it is very clear that the Domain Name is owned by Supplements Delivered and the internet user would likely never have heard of the Complainant due to its small presence in the UK market and the fact that it doesn't sell supplements.

The Respondent then turns to section 4 of the Policy and how a respondent may demonstrate that a domain name is not an Abusive Registration. The Respondent asserts that his response satisfies the following:

§4aiA of Policy in that before being aware of the Complainant's cause for complaint (not necessarily the 'complaint' under the DRS), the Respondent had used or made demonstrable preparations to use the Domain Name in connection with a genuine offering of goods or services by operating a business that has fulfilled over 9,183 orders under the name Gorilla Nutrition with over 3,436 orders fulfilled through the Domain Name.

§4aiB of Policy in that before being aware of the Complainant's cause for complaint (not necessarily the 'complaint' under the DRS), the Respondent had been commonly known by the name or legitimately connected with a mark which is identical or similar to the Domain Name as illustrated by over 53,510 individual internet sessions on the domain in question.

Finally, the Respondent refers to §4.9 of the experts' overview:

'Can use of a purely generic or descriptive term be abusive?

Yes but, depending on the facts, the threshold level of evidence needed to establish that this is the case is likely to be much higher. It may well often depend upon the extent to which such a term has acquired a secondary meaning, which increases the likelihood that any registration was made with knowledge of the rights that existed in the term in question. In many such cases where there is little or no evidence of acquired secondary meaning the Respondent is likely to be able to show that the domain name in question has been arrived at independently and accordingly cannot have been as a result of an

Abusive Registration. A helpful discussion is found in DRS 04884 (maestro.co.uk) where the Appeal Panel observed "Where a domain name is a single ordinary English word, the meaning of which has not been displaced by an overwhelming secondary meaning, the evidence of abuse will have to be very persuasive, if it is to be held to be an Abusive Registration under the DRS Policy".

The word in dispute is the word 'Gorilla', a single ordinary English word, the meaning of which has not been displaced by an overwhelming secondary meaning. This means that the Complainant must prove an abusive registration above and beyond the normal required standard of proof set out in §2.1 of the Experts' Overview.

The Respondent refers to DRS10593: workbox.co.uk (no action) and DRS10075 (appeal): philosophy.co.uk (no action) as relevant cases supporting his assertion that 'Gorilla' is a purely generic word, therefore the threshold level of evidence needed to establish that use of this word constitutes an abusive registration is much higher.

The Respondent asserts that the Complainant has provided no evidence of Abusive Registration and no evidence of an acquired secondary meaning. The Respondent has, on the other hand, illustrated that he arrived at the domain name independently because of the animal's connotations of size and strength and the relationship of these traits to bodybuilding nutritional supplements. Accordingly, the Domain Name cannot be an Abusive Registration.

The Reply

The Complainant replied to the Respondent's non-standard submission within the required timeframe. The reply was short and dealt with the following points:

1. Many of the Respondent's comments are not supported by evidence and revolve around speculation as to the Complainant's activities.
2. The Complainant invites the Expert to dismiss the submission as it was not filed within the set time period.
3. The Complainant says that the evidence that the Respondent has submitted as to his preparation and use of the Domain Name for a legitimate business offering postdates the Complainant's letter of 13 April after the Respondent was put on notice.
4. The Complainant maintains that the Domain Name is confusing similar to its registered and unregistered rights to GORILLA and GORILLA SPORTS. These trademarks relate to goods including gym equipment and nutritional supplements. The Complainant has evidenced the sale of nutritional supplements under the mark GORILLA SPORTS and was doing so at the time of writing to the Respondent. Gym equipment and nutritional supplements are products which are intrinsically linked with users of gym equipment being possible purchasers of supplements to assist.
5. The Respondent's use of the Domain Name in combination with the use of a prominent black and white gorilla logo is likely to confuse people into believing the Domain Name is registered to, operated by, authorised by or otherwise connected with the Complainant.

6. Discussions and Findings

General

To succeed in this Complaint, the Complainant has to prove to the Expert on the balance of probabilities, pursuant to §2a of the Policy, both limbs of the test 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.*

Complainant's Rights

Rights is defined in §1 of the Policy as *"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 wholly generic suffixes ".co.uk" and ".uk" are discounted for the purposes of establishing whether a complainant has Rights in a name or mark which is identical or similar to a domain name.

The Complainant has set out details of two trade marks in the name GORILLA and GORILLA SPORTS the first of which pre-dates the registration of the Domain Name. The Complainant also claims unregistered rights in the names. §2.2 of the Experts' Overview sets out the evidence that a complainant is expected to provide to establish unregistered rights, such as: evidence that the complainant has used the name or mark for a not in significant period and to a not insignificant degree (by way of sales figures, company accounts etc.); evidence that the name or mark is recognised by the purchasing trade/public as indicating the goods or services of the complainant (such as advertising, promotional literature, orders/invoices, editorial matter and search engine results). On the papers before me there are no sales figures, accounts or third party editorials to establish unregistered rights in the name GORILLA and GORILLA SPORTS and little or no evidence bearing dates prior to the registration of the Domain Name in the papers provided by the Complainant.

The Complainant's trade mark and the Domain Name are clearly not identical and so the question is whether they can be said to be "similar" within the meaning of the Policy. Section 2.3 of the Experts Overview states:

"Those responsible for the drafting of the Policy were aware of some of the difficulties arising under the UDRP (the policy covering disputes in the gTLDs) as a result of its wording, "identical or confusingly similar". The wording of the Policy is broader and less restrictive, which matches the reality that the first hurdle (i.e. proving the existence of rights in a relevant name or mark) is intended to be a relatively low-level test. Issues relating to confusion are best addressed under the second hurdle. The objective behind the first hurdle is simply to demonstrate a bona fide basis for making the complaint."

DRS8527 (Ihateryanair.co.uk) is also helpful in recognising that *"countless previous decisions under the Policy have held that domain names containing a trade mark in its entirety are similar to that trade mark, no matter what the addition. It has to be said, however, that more often than not the additional element is a descriptive word relating to the Complainant's trade mark (see for example DRS 06973 in relation to <veluxblind.co.uk>)."*

Following the established principle leads to the inevitable conclusion that the Domain Name is similar to the Complainant's GORILLA mark.

However, in the case of GORILLA SPORTS, the Domain Name does not contain the trade mark in its entirety. Instead part of the mark is replaced by the dictionary word 'nutrition'. The Complainant has not shown that the mark GORILLA is in itself distinctive enough, or has acquired a secondary meaning, such that use of the name GORILLA, whether prefacing the word 'sports' or the word 'nutrition', would nevertheless bring the Complainant to mind.

After some deliberation I have decided that a finding that the complaint falls at the first hurdle in respect of GORILLA SPORTS would be contrary to general practice under the Policy and go against the stated aim of the Experts' Overview, which provides that paragraph §2 (a)(i) of the Policy should merely be a low-level test to ensure that the Complainant has a bona fide basis for making the Complaint.

Accordingly, for the purposes of the first limb of the test in §2a of the Policy, I find that the Complainant has Rights in the names GORILLA and GORILLA SPORTS which are similar to the Domain Name.

Abusive Registration

Before dealing with question of Abusive Registration, I will deal with two points.

First, the Complainant relies upon, at least as part of its case, what it says would be the position in relation to the tort of passing off. In this regard, I would agree with the approach set out on the first page of the Experts' Overview, and the following paragraphs in particular:

"The Policy is intended to be an alternative to litigation. ... Litigation is expensive for both winners and losers and, in common with most responsible ccTLD registries, Nominet believes it appropriate that an efficient, cost-effective alternative dispute resolution policy should be in place to handle domain name disputes in its domain, the '.uk' domain.

Disputes are decided by reference to the terms of the Policy, not the law, so the fact that a domain name registration and/or the registrant's use of it may constitute trade mark infringement, for example, will not necessarily lead to a finding of Abusive Registration under the DRS Policy. Nonetheless, if the DRS Policy and the law are too far apart, the DRS Policy will inevitably lose some of its value."

The Complainant is required to establish Rights and Abusive Registration under the terms of the Policy with guidance from the Experts' Overview. The Complainant refers to a *"misrepresentation that could reasonably be expected to damage the Complainant through loss of the opportunity to exploit its rights through the tarnishment or dilution of the Complainant's goodwill. Thus, in terms of Spalding v Gamage [1915] 32 RPC 273 and Reckitt & Coleman Products Ltd v Borden Inc [1990] RPC 341, action by the Complainant under the common law of passing off based on its goodwill and reputation can reasonably be expected to succeed against such misrepresentation and unauthorised use."*

In the present case I do not think this approach is helpful in seeking to establish the position under the Policy. Whether it is correct is a matter for the courts, but I do not consider that the limited evidence the Complainant has put forward establishes its case under the Policy.

Secondly, I refer to the Complainant's invitation in the Reply that I should dismiss the Respondent's submission as it was not filed within the set time period. The Complainant has misunderstood the DRS Procedure; this is not litigation, the dispute is resolved by reference to the Policy and the Procedure.

The Respondent did not file the response within the set period. Nominet invited the Complainant to allow the response to be submitted on the morning following the expiry of that period; the Complainant refused. There is, therefore, no response and so the dispute proceeded on that basis under the terms of the Procedure, meaning that there was no opportunity for Nominet to conduct informal mediation to attempt to reach an amicable resolution.

The Respondent then filed a non-standard submission, which he is entitled to do under §13b of the Procedure. I am also entitled, under §13b, to consider the explanatory paragraph and, if I

consider there to be exceptional circumstances, I may allow that submission. I decided that there were exceptional circumstances and I allowed the non-standard submission. The non-standard submission is in play and cannot now be “dismissed”. The Complainant has had the opportunity to reply to the non-standard submission and I have taken its reply into consideration in reaching my conclusions.

Turning to the question of Abusive Registration, it is defined in §1 of the Policy as 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 has taken unfair advantage of or has been unfairly detrimental to the Complainant’s Rights.*

A non-exhaustive list of factors which may be evidence that a domain name is an Abusive Registration is set out in §3a of the Policy:

- i. Circumstances indicating that the Respondent has registered or otherwise acquired the Domain Name primarily:
 - A. 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. for the purpose of unfairly disrupting the business of the Complainant;**
- ii. Circumstances indicating that the Respondent is using or threatening to use 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;*
- iii. The Complainant can demonstrate that the Respondent is engaged in a pattern of registrations where the Respondent is the Respondent of domain names (under .uk or otherwise) which correspond to well-known names or trademarks in which the Respondent has no apparent rights, and the Domain Name is part of that pattern;*
- iv. It is independently verified that the Respondent has given false contact details to us; or*
- v. The Domain Name was registered as a result of a relationship between the Complainant and the Respondent, and the Complainant:
 - A. has been using the Domain Name registration exclusively; and*
 - B. paid for the registration and/or renewal of the Domain Name registration.**

The Complainant alleges Abusive Registration under §3a ii of the Policy and quotes §3.3 of the Experts’ Overview in support of its assertion of initial interest confusion. The Complainant’s case falls at the first hurdle in this respect as §3.3 refers specifically to a disputed domain name that is identical to the name of the Complainant and cannot sensibly refer to anyone else.

The Complainant's marks are not identical to the Domain Name and there is no evidence in the papers before that the name GORILLA has acquired a secondary meaning and/or that it refers exclusively to the Complainant.

The word 'gorilla' is an everyday term and dictionary word. The DRS process has considered whether such a term can be abusive and it is well established that the threshold of evidence needed is much higher and may often depend upon the extent that the term has acquired a secondary meaning (see the appeal decision in DRS 04884 (maestro.co.uk) and §4.10 of the Experts' Overview). The Complainant has not presented evidence that GORILLA or GORILLA SPORTS have acquired a secondary meaning

The Complainant refers to 'considerable sales in relation to its sporting products, including supplements, but provides no evidence of such sales.

The Respondent lists several uses of the word 'gorilla' by third parties, and refers to the use of gorilla logos, some of which are in the sports and gym industry. The Complainant has not responded to the apparent extensive use of the word 'gorilla' or logos by third parties.

The Complainant argues that the Respondent's sales and evidence of the development and use of the Domain Name postdate the Complainant's April 2015 letters when he was on notice of the Complainant's Rights. However, the Complainant has failed to evidence Rights, save in the trademark GORILLA, prior to the Respondent's registration of the Domain Name and has not evidenced goodwill and/or secondary meaning, or in the mark GORILLA SPORTS.

These were areas that the Complaint should have appreciated were necessary to establish given that they had been clearly raised in correspondence from the Respondent.

The position with regard to the timing of the correspondence between the parties is not completely clear. The Complainant says that it wrote to the Respondent on the 13 April 2015 and having received no response a reminder containing the original letter of 13 April 2015 was sent on 29 April 2015. The Respondent says that his solicitors wrote to the Complainant's representatives on 5 June 2015 and exhibits a copy of that letter. The Complainant says no response was received from the Registrant until 10 July 2015. This would appear to be a reference to the Respondent's solicitor's letter of 5 June 2015 as that is the only letter sent on behalf of the Respondent to the Complainant's representatives. In any event the Complainant in its reply to the Respondent's non-standard submission does not dispute receiving the 5 June 2015 letter, nor does it challenge the Respondent's allegation that no reply was ever received to that letter. The 5 June 2015 letter stated, amongst other things, that:

"Your client claims to have an action for both Trade Mark infringement and Passing Off.

A search on 'Google' demonstrates that the word 'Gorilla' is used by numerous other businesses.

The use of the word 'Nutrition' in our client's business name, is clearly distinct and your client's 'strapline' makes it very clear that it sells professional gym equipment, whereas as our client sells no such hardware.

Patently, the gorilla mark itself is distinct in both style and posture. Has your client any evidence of likely, or indeed actual, confusion? Has it received documented complaints?

We note that your client's potential customers cannot currently purchase any nutritional products via your client's website. Taking 'Whey Protein' for example, the website states 'There are currently no products in this category.' This has been the case since we first visited your client's website.

Our client does not sell any of the products that your client appears to sell. Given this, we struggle to see how your client will be able to prove any profits are being diverted and hence it has suffered any loss? If your client has evidence however, we would be obliged if you could confirm this and provide this to us.

.....”

The points raised by the Respondent’s solicitors are of direct relevance to the case the Complainant seeks to establish. The Complainant for whatever reason did not reply to this letter but instead commenced this Complaint some months later. In doing so it has not however addressed these points. Taken all of the evidence into account I do not consider the Complainant has established, on the balance of probabilities, that the Respondent’s registration and use of the Domain Name is Abusive.

In light of the foregoing, the remainder of the Complainant’s case, and the Respondent’s non-standard submission, do not need to be considered any further.

Accordingly, I find that the Respondent’s registration and use of the Domain Name has not taken unfair advantage of and has not been unfairly detrimental to the Complainant’s Rights, and is not an Abusive Registration.

7. Decision

In light of the foregoing findings, namely that the Complainant has Rights in a name which is similar to the Domain Name, but that the Domain Name, in the hands of the Respondent, is not an Abusive Registration, I direct that no action is taken.

Signed Steve Ormand

Dated: 12 November 2015