

DISPUTE RESOLUTION SERVICE

D00019734

Decision of Independent Expert

Groupon, Inc.

and

M&T Marketing

1. The Parties

Complainant: Groupon, Inc.
600 W. Chicago Ave.
Chicago
Cook
60654
United States

Respondent: M&T Marketing
14th HaAvoda St'
Holon
Tel Aviv
58501
Israel

2. The Domain Name

grouponcustomerservice.co.uk

3. Procedural History

I 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.

09 January 2018 07:46	Dispute received
09 January 2018 15:18	Complaint validated
09 January 2018 15:19	Notification of complaint sent to parties
15 January 2018 10:54	Response received
15 January 2018 10:54	Notification of response sent to parties
17 January 2018 12:15	Reply received
17 January 2018 13:38	Notification of reply sent to parties
22 January 2018 10:55	Mediator appointed
22 January 2018 10:57	Mediation started
05 February 2018 17:16	Mediation failed
05 February 2018 17:54	Close of mediation documents sent
08 February 2018 08:32	Expert decision payment received

4. Factual Background

The Complainant is a well-known global business that has been established for a number of years and is involved in e-commerce activities offering discount coupons, travel, goods and services all under the GROUPON name. In addition, it has various trade mark registrations of or comprising its GROUPON name.

The Domain Name was registered by the Respondent on 7 March 2016. Prior to the Complaint being filed and served on the Respondent, the Domain Name resolved to a website that purported to be the Complainant's customer service site and included a contact telephone number that was not associated with the Complainant.

Having received a copy of the Complaint, the Respondent sent a Response by way of an email confirming that the website had been deleted. The Respondent did not otherwise challenge or comment on the content of the Complaint.

5. Parties' Contentions

The Complaint

In summary, in its Complaint, which was supported by documentary evidence set out in various annexures, the Complainant stated as follows:

- Paragraph 2(a)(i) of the DRS policy (the "Policy") requires the Complainant to prove, on the balance of probabilities, that: "*The Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name*".
- The Complainant has rights in the Domain Name under the Policy and the Domain Name is identical to such rights.
- The rights must be enforceable rights, but there is no geographical/jurisdictional restriction.
- For the purposes of the first hurdle, nothing turns on the distinction between "identical" and "similar", but a name or mark will ordinarily be regarded as identical to the domain name if, at the third level, and ignoring the presence of hyphens and the absence of spaces and ampersands, they are the same.

- The Complainant has rights in its famous GROUPON mark under English law, European Union law, United States law, and the law of various other jurisdictions, by virtue of its longstanding use of the mark, its significant sales in connection with the mark worldwide and in the United Kingdom, and trademark registrations in the European Union, the United States and elsewhere. The Domain Name is confusingly similar to the Complainant's GROUPON trademark.
- The Complainant is a global leader of local commerce and the place you start when you want to buy just about anything, anytime, anywhere. By leveraging the company's global relationships and scale, the Complainant offers consumers a vast marketplace of unbeatable deals all over the world, including in the United Kingdom. As of Q1 2016, the Complainant operates in 27 countries and over 500 markets, including in the United Kingdom, with over 49.4 million active customers worldwide. It has more than 9,000 employees worldwide and has exceeded \$6 billion in trailing-twelve month gross billings. Its website at www.groupon.com has more than 150 million unique monthly visitors, and more than 127 million people worldwide have downloaded the Complainant's mobile apps. The Complainant has sold more than one billion units to date, including 52 million in Q1 alone. The Complainant also operates a website specifically targeted at consumers in the United Kingdom and Great Britain, where the Respondent is located, which is accessible at www.groupon.co.uk.
- The Complainant owns multiple trademark registrations for trademarks incorporating its world-famous GROUPON trademark with the United States Patent and Trademark Office ("USPTO") and in at least 50 other jurisdictions, including the European Union and Israel (where Respondent is purportedly located): The Complainant has used the GROUPON trademark since at least as early as 2008. Details of the registrations were set out in the Complaint and copies of the registration certificates and Registry printouts were exhibited.
- On the Complainant's websites at www.groupon.com and www.groupon.co.uk, the Complainant prominently uses its GROUPON trademark, and features general information regarding its various products and services. The Complainant also has a section on its website dedicated to providing customer support for its customers and users of its website, located at https://www.groupon.co.uk/customer_support.
- The Domain Name incorporates the Complainant's famous GROUPON mark in full, changing the mark only by adding the generic term "customer service" after the Complainant's GROUPON mark and the country code second level and top-level domain ".co.uk."
- The Domain Name, in the hands of the Respondent, is an Abusive Registration pursuant to Paragraph 1 of the Policy. Paragraph 3 of the Policy sets forth a non-exhaustive list of factors which may be evidence that the Domain Name is an Abusive Registration which includes:
 - 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 registrant 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.

- There is ample evidence that the registration of the Domain Name by the Respondent took unfair advantage of or was unfairly detrimental to the Complainant's Rights and has been used in a manner which has taken unfair advantage of or has been unfairly detrimental to the Complainant's Rights, including that: (i) the Domain Name consists of the Complainant's famous GROUPON trademark followed by the generic term "customer service", and thus initial interest confusion is likely to occur; (ii) the Domain Name is being used in a way that is likely to confuse people; and (iii) the Respondent is engaged in a pattern of registrations where the Respondent is the registrant 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.
- The Domain Name consists of the Complainant's famous GROUPON trademark followed by the generic term "customer service", and the GROUPON element of the Domain Name cannot sensibly refer to anyone else. The Respondent in this case is M&T Marketing, so the Domain Name clearly does not refer to the Respondent. Furthermore, the Complainant is not aware of anyone other than the Complainant using the name GROUPON anywhere else in the world. In fact, a search on Google for "Groupon" did not return any results that did not refer to the Complainant. Thus, at a minimum, initial interest confusion is likely, which, according to an overwhelming majority of the DRS Experts as set out in Section 3.3 of the Expert's Overview, is the basis for a finding of Abusive Registration.
- In addition to the presence of initial interest confusion, the Respondent is also using the Domain Name in a manner that is likely to create confusion as to whether the Domain Name is affiliated with, or owned by the Complainant. The Respondent has used the Domain Name to resolve to a website prominently displaying the GROUPON trademark and logo, and purports to be the Complainant's customer service department (the "Imposter Website"). In addition to prominently displaying the Complainant's logo, the Imposter Website is titled "*Groupon Customer Service*". The landing page of the Imposter Website has sections entitled "*The Beginning of Groupon UK*", "*The Background*", "*Services Rendered by Groupon UK*", and "*Getting in Touch with Groupon*" that all refer to the Complainant and create the impression that the Imposter Website is operated by the Complainant. There is even a link to a Groupon commercial on YouTube. There is also a prominent call to action to "*Call Groupon: 0844 306 9179*". This phone number is not associated with the Complainant. This type of behavior has been found to be evidence of Abusive Registration [See DRS 07991 (toshiba-laptop-battery.co.uk)]
- The Respondent is also engaged in a pattern of registrations where the Respondent is the registrant 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. In addition to registering the Domain Name, the Respondent has also registered other domain names that incorporate well-known and protected brands in the United Kingdom including AO, EE and British Telecom, and set up similar fake customer service and contact websites.

The Response

The Respondent responded to the Complaint by way of a very short email sent to Nominet but in which he addressed the Complainant's lawyer as follows:

"Subject: Response

Hi Marc

I hope your [sic] well!

I deleted this site.

Best Regards

Mike"

The Reply

The Complainant sent a Reply, also in the form of an email, stating as follows:

"Our response would be that the Respondent has not denied any of the substantive allegations in our complaint, and as such the Respondent should be deemed to have acknowledged them as true. Furthermore, the fact that Respondent may have removed the Infringing Website from the Domain Name in an attempt to avoid an unfavorable ruling in this proceeding does not change the fact that the Domain Name was registered and used abusively and in bad faith."

6. Discussions and Findings

General

In order to succeed the Complainant must prove, on the balance of probabilities, two matters, i.e. that:

1. the Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name; and
2. the Domain Name, in the hands of the Respondent, is an Abusive Registration.

These terms are defined in the Nominet DRS Policy as follows:

- **Rights** means rights enforceable by the Complainant, whether under English law or otherwise, and may include rights in descriptive terms which have acquired a secondary meaning.
- **Abusive Registration** means 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.

Before dealing with the details of the dispute I would like to make one general comment about the Complaint. It relies upon and purports to set out various parts of the DRS Policy published on the Nominet website and the DRS Experts' Overview, which is also published on the Nominet website to assist all participants or would-be participants in disputes under the DRS Policy by explaining commonly raised issues and how Experts, the members of Nominet's panel of independent adjudicators, have dealt with those issues to date and identifying any areas where Experts' views differ. However, the Complaint refers to paragraph numbers and content from the previous version of the DRS Policy which was replaced and superseded with effect from 1 October 2016. That is made clear on the Nominet website. Further, the Complaint expressly refers to and quotes sections from Version 2 of the DRS Experts' Overview. But Version 2 was replaced and updated by Version 3 with effect from December 2016 and that is also made clear on the Nominet website.

Whilst a lot of the paragraph numbering has changed, most of the relevant content of the DRS Policy and Experts' Overview relied upon by the Complainant is materially the same in both the previous and current versions. However, there are some differences. For example, the Complainant relies upon the concept of 'initial interest confusion' and in support quotes what is said in Version 2 of the Experts' Overview. But the current Version 3 that the Complainant should have been addressing goes on to consider the effect of an important case that had been decided after the publication of Version 2 and the case of *Och-Ziff Management Europe Ltd v Och Capital LLP* referred to in it. The subsequent case was *Interflora v Marks and Spencer [2014] EWCA Civ 1403*. The UK Court of Appeal judgement in that case criticised the use of "initial interest confusion" as a concept relevant to English trade mark law and, as mentioned in Version 3 of the Experts' Overview, its potential impact for the Nominet DRS was discussed by the Appeal Panel in DRS 15788 (starwars.co.uk).

Does the Complainant have Rights?

The Complainant claims to have both registered and unregistered Rights in the GROUPON name. The Complainant set out details of its numerous trademark registrations of and comprising its GROUPON name and provided copies of the registration certificates or Registry print outs. It has also provided printouts from its website and various details of the scale and nature of its business under the GROUPON name in terms of numbers of employees, numbers of customers and website visitors, and the number of "units" it has sold etc. Those details were not challenged by the Respondent in its Response.

I am also generally aware, without having to make any specific enquiries of my own, of the existence and nature of the Complainant's business and consider that the

Complainant could lay claim to being a well-known or even a ‘household name’ at least in the UK and possibly many other parts of the world as well.

In the circumstances, I find that the Complainant has proved on the balance of probabilities that it does have Rights in the GROUPON name for the purposes of the Nominet DRS.

Is the Domain Name identical or similar to the GROUPON name?

In assessing whether a domain name is identical or similar to a name or mark the “.co.uk” suffix can generally be ignored. The Complainant points out that it is not aware of anyone else using the GROUPON name anywhere in the world, which makes the name highly distinctive. The Domain Name merely adds the descriptive words “customer service” to it. Where the domain name in issue solely comprises the addition of wholly descriptive words like “customer services” to the Complainant’s distinctive and well-known GROUPON name, such an addition does not sufficiently distinguish the Domain Name from the Complainant’s name.

In the circumstances, I find that the Domain Name is similar to the GROUPON name or mark in which the Complainant has Rights.

Is the Domain Name an Abusive Registration?

The Complainant relies upon paragraph 5.1.3 of the Policy, being one of the non-exhaustive list of factors which may be evidence that the Domain Name is an Abusive Registration i.e.:

“The Complainant can demonstrate that the Respondent is engaged in a pattern of registrations where the Respondent is the registrant 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;”

In support of this, the Complaint refers to three other domain names being AOCustomerService.co.uk, EE-CustomerService.co.uk, and BTSportContact.co.uk and the websites to which each resolve. The WHOIS registration details of the domain names and screenshots of the relevant websites were provided by the Complainant. Each of these domain names was registered in the name of the Respondent on 7 March 2016, the same date the Domain Name was registered. As with the website to which the Domain Name previously resolved, each of the websites to which the other domain names resolve i) purport to be the customer service department of the relevant company, including www.BTSportContact.co.uk where one of the headings is “BT Sports Customer Service”; and ii) prominently display a telephone contact number commencing “0844 306 91” followed by a two digit number. 0844 telephone numbers include a service charge per minute that is paid to the recipient of the call.

In the circumstances, I am satisfied that the Respondent is engaged in a pattern of domain name registrations 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.

The Complainant also relies upon paragraph 5.1.2 of the Policy i.e.

“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;”

The Complainant described in its Complaint and provided a screenshot of the content of the website to which the Domain Name previously resolved. It purported to be the Complainant’s customer service website. I have no hesitation in concluding that such use of the Domain Name would confuse people or businesses into believing that the Domain Name is registered to, operated or authorised by, or otherwise connected with the Complainant and that the Domain Name is an Abusive Registration, notwithstanding the fact that the Respondent deleted the website after receiving the Complaint.

In my view, such use of the Domain Name took unfair advantage of and was unfairly detrimental to the Complainant's Rights in its GROUPON name and such use of the Domain Name is clearly abusive.

The Complainant also alleged that the Domain Name was an Abusive Registration as it 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. In support of this contention the Complainant relied upon the concept of ‘initial interest confusion’ and section 3.3 of the Experts’ Overview.

As discussed by the Appeal Panel in DRS 15788 (starwars.co.uk), notwithstanding the UK Court of Appeal’s judgement in *Interflora v Marks and Spencer* being critical of the use of “initial interest confusion” as a concept relevant to English trade mark law, initial interest confusion remains an applicable principle in determining whether or not a domain name registration was abusive for the purposes of the Nominet DRS.

The Experts’ Overview says that, where the names are identical and cannot sensibly refer to anyone other than the Complainant, there is bound to be a severe risk that a search engine will return the URL for a website connected to the Domain Name. The Experts’ Overview does not say that such a situation is the only time there will be a severe risk of initial interest confusion, just that such a risk is bound to happen in that situation. Clearly, there can be situations where the names are merely very similar and there will still be a real risk that when an Internet user searches for the Complainant’s name, the search engine will also return the URL for the website connected to the Domain Name and that may lead a substantial proportion of such Internet users to become victims of initial interest confusion. That is particularly so as search engines like Google are programmed to pick up common variations to the term being searched and website addresses that comprise the term being searched along with additional descriptive words. In this case, the Domain Name is not identical to the Complainant’s name and mark, but it is very similar, merely having the descriptive words “customer service” added to the well-known GROUPON name.

If an Internet user looking for one of the Complainant’s websites arrives by mistake at a website to which the Domain Name resolved, the user may be faced with a parking

page, a blank page, a “*this site can’t be reached*” message, or, as in the previous actual use, a website that actively purports to be the Complainant’s customer service operation but displays an incorrect contact number. Any such use would be unfairly detrimental to the Complainant, particularly given that such an Internet user may be trying to reach the Complainant to raise a customer service complaint or other issue that the Complainant would rightly want to deal with.

I cannot conceive of any legitimate use that the Domain Name could be put to by anyone other than the Complainant or an entity connected with and authorised by it. The risk of initial interest confusion is therefore a real one and I have no doubt that the Respondent knew of and had the Complainant in mind when registering the Domain Name and when using it in the manner described above.

In the circumstances, I am satisfied that the Domain Name 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.

7. Decision

For the reasons outlined above I find that 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 and that the Domain Name, in the hands of the Respondent, is an Abusive Registration.

In the circumstances I order that the Domain Name be transferred to the Complainant.

Signed:

Chris Tulley

Dated: 5 March 2018