

DISPUTE RESOLUTION SERVICE

D00021406

Decision of Independent Expert

eBay Inc

and

Auto Claims UK Ltd

1. The Parties:

Lead Complainant: eBay Inc
2025 Hamilton Avenue
San Jose
California
95125
United States

Complainant: Gumtree.com Limited
107 Cheapside
London
EC2V 6DN
United Kingdom

Respondent: Auto Claims UK Ltd
Claims House
Hay Road
Birmingham
West Midlands
B25 8HY
United Kingdom

2. The Domain Name(s):

ebuygumm.co.uk (the "Disputed Domain")

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 a such a nature as to call in to question my independence in the eyes of one or both of the parties.

16 May 2019 13:52 Dispute received
17 May 2019 14:48 Complaint validated
17 May 2019 14:50 Notification of complaint sent to parties
06 June 2019 02:30 Response reminder sent
11 June 2019 10:30 Response received
11 June 2019 10:31 Notification of response sent to parties
14 June 2019 02:30 Reply reminder sent
20 June 2019 10:25 Reply received
20 June 2019 10:26 Notification of reply sent to parties
20 June 2019 10:26 Mediator appointed
11 July 2019 17:43 Mediation started
26 July 2019 15:21 Mediation failed
30 July 2019 12:51 Close of mediation documents sent
09 August 2019 02:30 Complainant full fee reminder sent
12 August 2019 09:12 Expert decision payment received
15 August 2019 Michael Silverleaf appointed as expert

4. The Legal Framework

4.1 The complaint is brought under the Nominet DRS Policy which applies to all .uk registrations by virtue of the terms and conditions of registration. By clause 9.1 of those terms and conditions all registrants agree to be bound by the DRS Policy and by clause 13.6 that Policy forms part of the terms and conditions of registration of a .uk domain.

4.2 The DRS Policy applicable to this dispute is Version 4 in force since 1 October 2016. Paragraph 1 defines an Abusive Registration 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) is being or has been used in a manner which has taken unfair advantage of or has been unfairly detrimental to the Complainant's Rights".

In the same paragraph Rights are defined 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".

4.3 Paragraph 2 of the DRS Policy provides as follows:

"2 Dispute to which the DRS applies

2.1 A Respondent must submit to proceedings under the DRS if a Complainant asserts to us, according to the Policy, that:

2.1.1 The Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name; and

2.1.2 The Domain name, in the hands of the Respondent, is an Abusive Registration.

2.2 The Complainant is required to prove to the Expert that both elements are present on the balance of probabilities."

4.4 Paragraph 5 of the DRS Policy contains a non-exhaustive list of factors which may be evidence that a domain name is an Abusive Registration. They include the following factors which are relied upon by the complainants in the present case:

"5.1.1 Circumstances indicating that the Respondent has registered or otherwise acquired the Domain Name primarily:

...

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

5.1.1.3 for the purpose of unfairly disrupting the business of the Complainant.

5.1.2 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 by, or otherwise connected with the Complainant."

4.5 It has been said many times in relation to DRS Disputes that they are not trade mark disputes and are to be resolved not in accordance with trade mark law but under the rules and procedures of the DRS. It is, nevertheless, inevitable in a

DRS Dispute which turns on the perception of brand names and their alleged transposition into a domain name which is neither identical to nor differs only by a minor typographical change from a trade mark or marks relied upon by a complainant as giving it Rights that the principles applicable to the analysis and comparison of trade marks are likely to prove helpful to the adjudicator. This particularly the case when considering whether the public is likely to confuse two names or to make a link or association between them. It is clear that the parties to the present dispute consider that there are principles of trade mark law which are relevant here as they have referred to and relied on them. I agree that this approach is appropriate in the present case and have applied such principles in this decision where it seems to me that they are of assistance in resolving the issues which arise.

5. Factual Background

5.1 The first complainant operates the online marketplace, ebay. It was founded in 1995 and has grown to become a very substantial business. Ebay is extremely well-known both in the UK and elsewhere through its global website ebay.com and its UK website ebay.co.uk. It enables the sale and purchase of goods and services by individuals and businesses. Its initial business model is that of an auction site but it has long hosted listings for immediate purchase and online stores for third party businesses. The first complainant first registered UK customers on its ebay.com website in March 1996 and on its ebay.co.uk website in September 1998. It is said to be a leading e-commerce destination for consumers shopping on the internet, a proposition which does not seem open to serious dispute.

5.2 The second complainant was founded in 2000 to operate as an online classified advertisement and community portal under the name Gumtree. According to Wikipedia it was originally set up by Michael Pennington and Simon Crookall to connect Australians, New Zealanders and South Africans who had recently moved or were contemplating moving to London. It has since expanded its business and now operates in many towns and cities both in the UK and elsewhere. It was acquired by the first complainant in 2005 and the complainants have since then been in common control. Gumtree is also well-known.

5.3 The complainants have put forward considerable material to demonstrate the extent of their respective reputations and goodwill under their respective names. Thus, in the UK alone, the first complainant explains that more than US\$70 billion gross merchandise value was sold on the eBay platform between 2012 and 2016, with US\$12 billion being sold in 2016. In that year nearly 500 million transactions were carried out in the UK through eBay and there were nearly 25 million users of the site. The previous year, 2015, there were more than 4 billion page views of the eBay platform from the UK. The second complainant is not as large or well-known as the first complainant but explains that it promotes itself on Facebook (half a million “likes”), Twitter (40,000 followers), YouTube (a number of videos which have been viewed tens of thousands of times) and LinkedIn (5000 followers). In 2016 its website received an average of 17.8 million visits a month and it produces a number of reviews from various app ranking services showing that it is

highly ranked in the UK in the lifestyle and shopping categories. As early as 2010 it was receiving 14 million visits a month and by May 2017 this had risen to over 60 million.

5.4 Both complainants have trade mark registrations for their respective brands. The first complainant's registrations include EU and UK registrations for the word EBAY in Classes 35, 38 and 41 which it registered between 1998 and 2000. Although I have not been given the detailed specifications of these marks it is reasonable to infer that they include online retail services. The second complainant has an EU registration for the word GUMTREE in classes 35, 39 and 43 registered in 2005 which is said to include online classified advertising. Both complainants also have figurative marks but these are not asserted to add anything for the purposes of the present dispute. Both complainants also point to the fact that they have many additional domain name registrations which incorporate their primary brands. Again, it does not seem to be suggested that these add anything for the purposes of the present dispute. The complainants do not say that they promote the fact that they are commercially related and there is no evidence before me that this fact is generally known to the public. Indeed, the only direct evidence of public perception probably indicates that the member of the public concerned was not aware of the connection (see the comment at 6.5 below and the discussion of it at 7.1 and 7.11).

5.5 The respondent registered the Disputed Domain on 19 May 2016. The domain has since been used by Ebuygumm Limited with the respondent's consent to operate a buying and selling website for UK residents. There appears to be no relevant distinction between the respondent and Ebuygumm Limited and I shall therefore not distinguish between them in this decision. The respondent explains that the Ebuygumm website was developed to overcome perceived disadvantages of other online marketplace sites, including but not limited to those operated by the complainants. The respondent explains that Ebuygumm does not charge fees and includes a secure payment mechanism where, as I understand it, the site holds payment until the purchaser has safely received the goods. It is clear from the respondent's explanation that it was aware of the complainants when the Disputed Domain and its website were developed and that it is a competitor to the complainants' websites. They are all forms of online marketplace even though the way in which each of the sites operates is slightly different.

5.6 The respondent explains that it has invested hundreds of thousands of pounds developing the Ebuygumm website and marketing the site by radio advertising and a UK tour bus, the pictures of which show it to be a signwritten trailer advertising the site which has cartoon drawings of the site's "mascots", Ernie, Buddy and Gummy on one side. These are described by the respondent respectively as a pigeon, a ferret and a whippet although the pictures on the trailer do not look much like their descriptions to me. There are also pictures of human costume versions of the ferret and the pigeon in the evidence which are much more recognisable. The respondent explains that the bus has staff who both explain and sell the respondent's services. The respondent's evidence also shows that it has this year acted as a sponsor for an event called Chance2Dance.

5.7 The mascots (pigeon, ferret and whippet) have some significance in the dispute as the respondent explains that they embody the northern ethos of the Yorkshire phrase “eeh bah gum” or “ee by gum” (generally understood to mean “oh my God” or “by God”) on which the respondent’s name is said to be based. The respondent explains the derivation as follows. The letter “E” is used in place of “eeh” or “ee” as a reference to e-commerce and “buy” in place of “by” or “bah” as a reference to buying and selling which is the purpose of the site. These combine to produce EBUY. The “gumm” element was originally in what the respondent describes as “Google type colours” (that is a partial rainbow with the successive letters being coloured blue, yellow, green and red) to bring to mind the worldwide web. It is clear from the parties’ submissions that the colours have already been the cause of complaint by the complainants (the letters of ebay on its website are respectively red, blue, yellow and green) as a result of which the “gumm” element of the website hosted at the Disputed Domain was changed in November 2018 so that it now appears in blue, a change which the respondent says was made without admission of liability. The complainants respond that there would have been no need to make the change if the respondent’s explanation for the choice of the rainbow colours were true. I do not agree: the change could have been made simply in order to have a quiet life. I note also that the complainants’ assert that the typeface of the GUMM element is copied from that of the EBAY logo but no change has been made to that in the revised EBUYGUMM logo.

5.8 The respondent has given no trading figures. Although it appears that the ebuygumm.co.uk site has been operating for some time, there is no evidence as to the extent of its operations. The evidence shows that it has Instagram and Facebook pages but again there is no evidence of the extent of their usage or public recognition. The respondent says that “the public are extremely interested to learn about the Ebuygumm brand” which suggests that the business remains in its relatively early stages although the complainants assert that it is an online marketplace allowing users to buy and sell a wide range of goods.

5.9 The respondent has a trade mark registration for the mark ebuygumm which appears to be for the stylised form of the name used as a logo with the GUMM element in the rainbow colours to which the complainants have objected. The complainants did not oppose this registration but have since filed an invalidation action against it. Neither party has indicated the stage this proceeding has reached or the arguments advanced in it.

6. Parties’ Contentions

Rights

6.1 The complainants assert that they have Rights as defined in the Nominet DRS Policy in both their primary brands on the basis of the facts summarised above. As I explain further below, they also suggest that they have rights in the two brands combined.

The Origin of the Disputed Domain

6.2 The complainants assert that the selection of the name ebuygumm is “a reference to the complainants’ EBAY and GUMTREE trade marks”. They claim that this is demonstrated by two factors. First, is the presentation of the ebuygumm name on the website which has copied the colour combination and font of the EBAY mark. This is said to show that it is the respondent’s intention to create a link in the minds of users with the complainants. Second is negative commentary on the respondent’s website about “other” online marketplace platforms. This, it is said, in the light of the choice and presentation of the respondent’s name in the complainants’ colour scheme, can only be seen as a reference to the complainants’ businesses. The respondent points out that the complainants have shown no goodwill in the colour scheme, that the respondent’s colour scheme is derived from that of Google and that there are many other online marketplaces than Ebay and Gumtree.

6.3 The respondent’s explanation of the origin and presentation of its name are set out at paragraph 5.7 above. In support of that explanation the respondent provides a number of examples of usage of the phrase “eeh bah gum” (in various spellings) to show that it is recognised and used. These include an article from the BBC News website in 1990 noting that the phrase has been included in the Oxford English Dictionary, other online dictionary and similar references to it as being Yorkshire dialect and a book presenting the gospels in Yorkshire dialect available on Amazon the title of which is “Ee By Gum, Lord!” The complainants say that, in the light of the facts that the respondent was aware of the complainants’ businesses when it chose the name and that the respondent’s business competes with those of the complainants, this explanation is implausible. They say that there is no connection between the phrase “eeh bah gum” and the services provided by the respondent, the phrase is archaic, originated in Yorkshire and is used almost exclusively there, is not commonly used and will not be known to the majority of people outside Yorkshire or to young people. The complainants provide no evidence to back up any of these assertions and do not comment on the evidence of its usage provided by the respondent. The complainants also say that the implausibility of the alleged origin of the Disputed Domain is supported by the fact that the individual behind the respondent is based in Birmingham and has no connection with Yorkshire. It follows that there is a dispute as to the veracity of this claim which has to be resolved.

Similarity between the complainants’ marks and the Disputed Domain

6.4 The complainants assert similarity between the Disputed Domain and the brands in which they have rights in three distinct ways:

- (a) between EBUYGUMM and EBAY and GUMTREE in combination;
- (b) between EBUYGUMM and EBAY alone; and

(c) between EBUYGUMM and GUMTREE alone.

6.5 Taking these allegations in turn they are asserted on the following bases. The similarity between EBUYGUMM and the combined marks arises because the first element of EBUYGUMM is EBUY. This is very similar to EBAY and internet users will focus on it because it appears at the start of the Disputed Domain. The GUMM element is said to be highly similar to GUMTREE. The use being made of the Disputed Domain is for the purpose of calling to mind both the complainants' trade marks and the services for which they are used. This is said to be supported by an online comment in a news website for online marketplaces in which the user has commented:

"A brand new marketplace has launched in the UK, website name is Ebuygumm
<https://ebuygumm.co.uk/>

I love how the name is a spin on Ebay and Gumtree. Might be worth checking out ..."

It is unclear when this comment was made as there are two prints of it (which are very slightly different in content) dated "3 months ago" and "6 months ago" but in both cases without a print date on the exhibit.

6.6 The complainants say that this is a simple case of taking misspellings of their well-known marks and combining them. They point out that the DRS Experts Overview says that misspelled versions of names are normally found to be similar to their originals.

6.7 Asserting similarity between the Disputed Domain and EBAY alone, the complainants say that this is a case where there is similarity because the Disputed Domain takes the EBAY name and combines it with another well-known mark. They give as an example of similar facts the decision in DRS 19703 in which bayermonsanto was held to be similar to the mark Bayer. The circumstances of that case are explained in the quotation from the decision in that there had been public speculation about a merger between Bayer and Monsanto who trade in similar fields. The expert in that case was of the view that bayer was the dominating part of the domain name and appeared to qualify Monsanto. The complainants say that the same approach should be taken in this case. EBUY is highly similar to EBAY and is the dominating part of the Disputed Domain. It appears to qualify GUMM. EBAY and GUMTREE are in common ownership and trade in similar fields. These circumstances lead to the conclusion that EBAY is similar to EBUYGUMM in the same way that BAYER is similar to BAYERMONSANTO.

6.8 As to similarity between the Disputed Domain and the complainants' GUMTREE trade mark alone, they say that the GUMM element of EBUYGUMM "will jump out to consumers". They do not expressly explain why this should be so but some inkling of their reasoning may be gleaned from the comment that the GUMM element will immediately remind consumers of the complainants' GUMTREE mark because it is used in relation to online marketplace services.

6.9 The complainants say that the fame of both their marks increases the similarity between those marks and the Disputed Domain. Not only are they inherently distinctive but they have gained a very substantial reputation. They point to the well-established principle of trade mark law that marks with a highly distinctive character enjoy broader protection than those without. Consequently they say that when faced with the Disputed Domain the public will immediately call to mind the complainants' marks and see the similarity between them. In their reply they present evidence of what they suggest is an example of this: an advertisement from a business on the respondent's ebuygumm site which describes itself as the advertiser's "ebay shop". The respondent has not had an opportunity to comment on this evidence but, without investigation, it is hard to know what to make of this statement. It seems unlikely that the statement is a deliberate misrepresentation. Nor does it seem likely that an advertiser developing an online shop specifically for the respondent's website would describe it as an ebay shop by mistake. It could be no more than the result of the advertiser transposing his ebay shop on the complainants' ebay website on to the respondent's website and failing to update it properly to reflect its new location. In the absence of further information about the reason why this odd statement appears in this particular advertiser's entry on the respondent's website it does not seem to me that it would be appropriate to give it significant weight.

6.10 The respondent counters these three approaches as follows. It says that the comparison between the Disputed Domain and the complainants' marks in combination is impermissible. The complainants' brands are separately promoted and operated and there is no claim in law to a combination of marks which are not used in combination. The respondent says that the mosaicking of the two brands is equally impermissible when relying upon enhanced distinctiveness acquired by user: there can be no increased similarity as a result. It says that the correct comparison is first between EBAY and EBUYGUMM and then between GUMTREE and EBUYGUMM. In both cases, the respondent says that the comparison should be between the marks in the forms of the stylised logos which are actually used by the parties. It exhibits those logos to show the comparison. A copy of that exhibit is Annex 1 to this decision. It will be seen that the respondent's name is shown in that Annex in a form in which the letters of the GUMM element are all coloured blue. So compared the respondent says the complainants' marks are not similar at all to the Disputed Domain. There would be more similarity if the GUMM element of the Disputed Domain were in its original colours even though the order of colours is different from that used by EBAY.

6.11 As to the similarity between EBAY alone and EBUYGUMM, the respondent says that it is stretching the decision in DRS 19703 to say that it applies in this case. The compared parts of the marks in DRS 19703 were identical whereas they are not in this case. Further the totality of the Disputed Domain has a meaning to the reader so that the EBUY element cannot be seen as a qualifier of GUMM and the GUMM element cannot be linked to GUMTREE.

6.12 In answer to the alleged similarity between the Disputed Domain and GUMTREE, the respondent points to the following difficulties in the complainants' analysis. First it says that GUMM will not jump out to consumers. The respondent points to the tension between the argument advanced by the complainants in support of the allegation of similarity with EBAY and this assertion. It says that the EBUY element of the Disputed Domain cannot be ignored or dismissed and that it is just as prominent as a feature of the Disputed Domain because of its meaning. The respondent points out that the complainants have played up the prominence of EBUY in the comparison with EBAY and the prominence of GUMM in the comparison with GUMTREE. The thrust of the argument is that the complainants cannot have it both ways and that their conflicting positions are consequently flawed.

6.13 Finally the respondent says that the Disputed Domain is not a mis-spelling of the complainants marks but the use of a phrase which is a nod to the well-known Yorkshire phrase, not to either or both of the complainants' marks.

Abusive Registration

6.14 The complainants rely in support of the allegation that the Disputed Domain is an Abusive Registration on the definition in paragraph 1 of the DRS Policy and upon the specific factors listed in paragraphs 5.1.1.2, 5.1.1.3 and 5.1.2 which are set out above.

(i) The definition of Abusive Registration

6.15 The complainants rely upon the second limb of the definition arguing that the use of the Disputed Domain both takes unfair advantage of their Rights and is unfairly detrimental to those Rights.

6.16 In support of the allegation of taking unfair advantage the complainants say that the respondent registered the Disputed Domain without the complainants' authority when it must have been aware of their names, businesses and Rights. The Disputed Domain is used for precisely the same kind of services as those provided by the complainants under both of their marks and the respondent has copied the font and colour combination of the complainants' EBAY mark. Consequently, the respondent knew of the complainants' EBAY marketplace at the time of registration of the Disputed Domain.

6.17 The complainants assert that the use of the Disputed Domain amounts to a misrepresentation which takes unfair advantage of the complainants' Rights because internet users will be drawn to an online marketplace under the name EBUYGUMM as a result of the link that name creates to the complainants' brands which users know to be a high quality source of the same services. The use of the same colour combination as the complainants' EBAY mark highlights the respondent's efforts to make that link. Consequently, the complainants say the Disputed Domain will unfairly benefit from an association in the minds of consumers with the reputation of the complainants' marks. They refer to the decision in DRS 19115 in which the

expert considered that the unconvincing nature of the respondent's explanation for its selection of the domain name in dispute in that case (guntree) taken with the lack of credibility of the respondent's general denials of its motives in that case led to an inference that the respondent's motivation for registering and using the domain name in dispute was to take unfair advantage of the complainant's rights by capturing traffic from the complainant by way of confusion or association. That was of course a decision on its particular facts which the complainants say are the same here.

6.18 The respondent says that the Disputed Domain is not the same as or similar to either of the complainants' marks. It points to its explanation for the choice of the Disputed Domain and says it did not need the complainants' permission to register. It says that visitors to its site will know it is operated by Ebuygumm Limited and, even if some visitors do make a link to either of the complainants' sites, mere calling to mind is insufficient to create a legal cause of action against the respondent. The complainant in reply accepts this last point but says that the consequences of the respondent's use of the Ebuygumm name go beyond mere calling to mind and extend to causing damage to the complainants' rights or taking advantage of them for the reasons set out in the complaint.

6.19 As to the decision in DRS 19115 the respondent says that the facts are different and that the respondent's motivation in the present case was not to create an association with the complainants.

6.20 The complainant asserts that the Disputed Domain is unfairly detrimental to the complainants' Rights since it serves to divert consumers away from the complainants' websites and therefore causes them damage. The complainants refer to the decision in DRS 00389 (scoobydoo.co.uk). The damage that ensues from the use of the Disputed Domain includes a loss of internet traffic with its resulting customers and sales opportunities and a loss of goodwill and reputation as providers of high quality, safe and trusted online marketplaces because of the inferior quality of the respondent's services.

6.21 The respondent answers these complaints by pointing out that the facts in DRS 00389 were very different, that case being one of a fan site which was found to be impersonating the complainant, and that any damage which results from its activities comes from competition and not from confusion. The respondent points to other competing websites which use the term ebuy such as ebuyer.com and ebuy-gb.co.uk which it says also compete with the complainants and have names more similar to that of the complainants' ebay sites.

(ii) DRS Policy paragraph 5.1.2

6.22 The complainant asserts that the Disputed Domain may cause initial interest confusion. There is a risk that search engines asked to search for the complainants' marks may produce the respondent's website high up in the search results. If this happens internet users may visit the respondent's website expecting to find a site

connected with the complainants having been deceived by the Disputed Domain name. The initial interest is compounded by the content of the respondent's website as an online marketplace using the same font and colours as the complainants' famous EBAY mark. This may therefore cause consumer confusion as to whether there is a connection between the parties. The complainants also say that users may be permanently put off from using the complainants' services as a result of believing that there is such a connection if they have an unsatisfactory experience with the respondent's website. Further, even if the initial interest confusion is dispelled, there is still damage to the complainants by redirection of users away from their websites. None of these assertions is supported by any evidence or examples.

6.23 The respondent accepts the principle that initial interest confusion may make the use of a domain abusive but does not accept that its use will cause such confusion. It counters the complainants' reliance upon the finding to this effect by the appeal panel in DRS 07991, (toshiba-laptop-battery.co.uk) by saying that the correct comparison with that case would be if the respondent had registered a domain such as ebayonlinemarketplace.co.uk or gumtreeclassifiedads.co.uk. Here the names are different and this kind of confusion will not occur.

(iii) DRS Policy paragraph 5.1.1.3

6.24 The complainants say that this objection arises because the respondent must have been aware of them and that registration of the Disputed Domain in relation to an identical service would cause conflict with the complainants' online activities. Relying on the same assertions it has made in support of other objections the complainants say that the respondent is using the Disputed Domain to attract users and benefit from the "pulling power" of the complainants' marks. Consequently the respondent is taking advantage of the complainants' marks for commercial gain and there is potential disruption to the complainants' business which includes loss of customers and traffic. The complainants rely on the reference to "other" online marketplaces in the respondents' website and say this is seeking to draw a link with them.

6.25 The respondent relies on its previous counters. There is an independent reason for the choice of the Disputed Domain. The reference to "other" online marketplaces is not directed simply at ebay but at all other marketplaces, of which there are many. Had ebuygumm wanted to compare itself directly to ebay, it would have done so explicitly.

(iv) DRS Policy paragraph 5.1.1.2

6.26 The Disputed Domain is said to be a blocking registration because it prevents the complainants from registering a domain which is similar to their primary brands. They point out that trade mark owners often register domains which are similar to their correct names with small changes which might represent mistyping by internet users and give examples of some such registrations that the complainants have for

domains which are similar to gumtree, such as gumtree, gumtee, gumtreee and gum-tree. The complainants say that registering a domain which is a misspelling of a registered trade mark is overwhelmingly indicative of a blocking registration. They also say that there are numerous cases of registrations of domains which combine the names of two companies which have recently or are about to merge. The present case is said to be an example of that in that the two brands are in common control.

6.27 The respondent accepts the principles identified by the complainants but says simply that this case does not fall within them. The Disputed Domain is not a slight misspelling of either of the complainants' brands. It says that if its name were EBAYGUMTREE, the principle of conjoining two marks might be said to apply but that is not the Disputed Domain.

7. Discussion and Findings

Rights

7.1 The first question in any DRS dispute is whether the complainant has "Rights" as defined by the DRS Policy. This is a threshold test and readily satisfied. In the present case there is no doubt that the complainants have rights in the names EBAY and GUMTREE. I do not consider that they have rights in the combination which extend beyond the rights in the individual marks. There is no suggestion that the two brands are used in combination and no evidence that the public is generally aware that they are in common ownership. The online comment quoted in paragraph 6.5 above seems to me to suggest that the commenter was not aware of the connection or he would have said something about it. Nor was he confused in any way. The nature of the comment indicates that the commenter thought that the allusion to the complainants' marks to which he was referring ("a spin") was entertaining rather than indicating any form of commercial relationship.

Rights in a name or mark which is identical or similar to the Disputed Domain

7.2 Clearly, the Disputed Domain is not identical to either of the complainants' trade marks. The next question is, therefore, whether the names in which the complainants have Rights are similar to the Disputed Domain. I propose to approach the comparison first objectively, having no regard to the dispute as to the origin of the form of the Disputed Domain. I will then consider whether the resolution of the latter dispute affects the objective conclusion.

7.3 For the reasons I have set out in paragraph 7.1, the respondent is correct in saying that the correct approach to comparison is with each of the complainants' marks individually and not with the two marks in combination. Unless the marks used together, comparing them in combination with the Disputed Domain is comparing them with something that the complainants do not use.

7.4 Before addressing the question of similarity directly, it is convenient to discuss the dispute between the parties as to the nature and renown of the Yorkshire phrase “eeh bah gum”. Resolution of that dispute has a bearing on the relative merits of the parties’ contentions as to how the Disputed Domain is likely to be perceived.

7.5 It may be that I am untypical but the phrase is certainly well-known to me and has been for decades. I cannot say without evidence whether young people would be aware of it but I can say that anyone who listens to Geoffrey Boycott commentating on cricket is likely to have heard it. As I have noted above, the complainants have produced no evidence to support their assertions as to the lack of knowledge of the public of the phrase and have not commented on the evidence produced by the respondent. I believe that eeh bah gum is quite likely to be recognised by a significant proportion of the public across the UK despite the fact that it originates in Yorkshire in the same way that well-known cockney rhyming slang (such as “apples and pears” for stairs and “butcher’s”, short for butcher’s hook, for look) is widely recognised if not widely used. It seems to me that my perception is supported by the examples of the use of the phrase which have been put in evidence by the respondent.

7.6 I therefore reject the complainants’ contention that the phrase eeh bah gum would not generally be known to or recognised by the public outside Yorkshire. In my view a significant proportion of the public will make the connection between the Disputed Domain and that phrase when they see the Disputed Domain. Some may also see a “spin” on either or both of the complainants’ marks. Some will see both forms of allusion, some may only see one and some none. Some may see an allusion to one of the complainants’ marks and not the other. For the reasons I explain below, it seems to me to be unlikely that anyone will see an allusion to either or both of the complainants’ marks as indicating any form of link or connection with them. The likelihood that the phrase will be recognised by people outside Yorkshire means that little or no significance should be attached to the fact that the individual behind the respondent is from Birmingham. If he is a typical member of the public he is likely both to be aware of the phrase and believe that others across the UK will recognise it. Indeed, the fact that the phrase has its origins in Yorkshire might be said to provide a good reason for adapting it as the name of an online marketplace. Yorkshire people are widely considered to be careful with money. Being careful with money might be seen as a good impression for an online marketplace to give.

7.7 With those conclusions in mind, I turn to the alleged similarity between the complainants’ marks and the Disputed Domain. Taking first the similarity with EBAY. The comparison is between EBUYGUMM and EBAY. There are it seems to me two difficulties in the complainants’ way in concluding that there is similarity between these two marks. The first is that the “common” element is not EBAY but EBAY against EBUY. If one compares those two marks, it is immediately obvious that they leave, at least on an English speaker, different impressions when applied to online marketplaces. One is a place (or bay) for e-commerce. The other is the act of buying by e-commerce. As the respondent has pointed out, the well-known electronics site

ebuyer.com has a name which is more similar to ebay than the Disputed Domain. If the public were going to connect the Disputed Domain with ebay, they would be more likely to connect ebuyer with ebay but this does not happen. I note in passing that the complainants refer to ebuyer.com and ebay-gb.co.uk in their reply as “unlawful and potentially infringing websites”. I know that ebuyer.com is a long-established and successful online retailer of computer supplies and electronics. It is not as described by the complainants. That fact that they are driven to seek to remove it from consideration by so characterising it fortifies my view that the complainants are casting their net too widely in their assertion of similarity.

7.8 The second difficulty facing the complainant is the well-established principle of trade mark law that consumers perceive marks as a whole and do not proceed to analyse their individual elements. That difficulty is compounded in the present case because the Disputed Domain brings to mind the phrase eeh bah gum which those who recognise it will probably not look beyond. If they do, then it seems to me that they are more likely to think first of e-buying than ebay, particularly bearing in mind that the name is used in relation to an online marketplace. The complainants’ approach, suggesting that this fact is more likely to bring ebay to mind takes no account of the descriptive connotation of the term ebuy. Indeed, the complainants’ submissions ignore this aspect of the dispute even though it is expressly raised by the respondent.

7.9 Although a DRS dispute is not a trade mark claim, it seems to me that in the circumstances of the present case, where one mark is said to bring another to mind, it is appropriate in considering the similarity between the two to adopt the standard method of comparison now used in trade mark law and look at the visual, oral and conceptual comparisons. Taking that approach, one sees that there is a slight visual and oral similarity but that, looking at the marks as a whole there is no conceptual similarity; and even looking at the EBUY element in isolation the conceptual similarity arises from their common reference to e-commerce. I therefore conclude that there is a low degree of similarity between EBAY and EBUYGUMM rather than no similarity at all as the respondent contends or a high degree of similarity as the complainants’ contend.

7.10 Turning to the alleged similarity between the Disputed Domain and GUMTREE, it seems to me that the difficulties facing the complainant are even more formidable than those in relation to similarity with the EBAY mark. First, one has to take the GUMM element out of context. As noted above, this is not how consumers perceive trade marks. They look at them as a whole. I do not agree with the complainants that the GUMM element will jump out at the reader. On the contrary, it seems to me that it is likely to form a cohesive whole with the totality of the mark as part of a quirky mis-spelling the phrase eeh bah gum.

7.11 Indeed, it seems to me that the vast majority of the public is unlikely without some thought even to see a similarity between GUMM as part of EBUYGUMM and GUMTREE. Like the Disputed Domain GUMTREE is a mark that is perceived by the public as a whole and not dissected into its constituent parts. It follows in my view

that GUMM as part of EBUYGUMM will probably not generate a connection with or recognition of the GUM element of GUMTREE in the public perception. If it does, it seems to me that it is likely to do so only in the way it did to the online commenter noted in paragraph 6.5 above: as a clever “spin” on the two online commerce marks EBAY and GUMTREE. As the two marks are separately promoted and used, that “spin” points away from rather towards any form of link or connection. It will be seen simply as a clever play on words.

7.12 Taking the conventional approach of visual, oral and conceptual comparison, it seems to me that there is a very slight degree of visual and oral similarity between EBUYGUMM and GUMTREE because of the common three letters “GUM” but no conceptual similarity. I therefore reject the contention that there is no similarity at all but equally reject the proposition advanced by the complainants that there is a high degree of similarity.

7.13 Having concluded that there is objectively only slight visual and oral similarity between the Disputed Domain and either of the complainants’ brands, is that conclusion altered either by the claimed enhanced reputation of the complainants’ trade marks or by the way in which the Disputed Domain was derived or generated by the respondent? As to the impact of the claimed enhanced reputation, it seems to me that this does not affect the evaluation in the present case. Although highly distinctive marks are given a broader penumbra of protection, the kind of similarity which I have identified is purely verbal. It exists only because there is a short sequence of letters which is similar to one of the complainants’ marks or corresponds to part of one of those marks in a longer composite mark. That sequence has first to be visually extracted from the Disputed Domain for the similarity to become apparent. In such a case the reason for the enhanced penumbra of protection, which is that the eye sees or the ear hears what it is expecting and not what is there, is not present. Turning to the origin and derivation of the Disputed Domain, I explain below why that cannot be rejected as implausible. On the contrary, it seems likely to me that it is essentially accurate. It follows that the way in which the Disputed Domain was derived does not affect the conclusion I have reached as to the low level of similarity between the Disputed Domain and the complainants’ trade marks.

Abusive Registration

7.14 It is sensible to begin consideration of the claim that the Disputed Domain is an Abusive Registration with the allegation by the complainants that the respondent must have chosen the Disputed Domain to make a link with the complainants’ marks. The complainants have two limbs to their argument. The first is the similarity in the original rainbow colouring and the alleged reference to the complainants when the respondent’s website discusses “other” online marketplace websites. The second is the alleged implausibility of the respondent’s explanation of the origin of the Disputed Domain. The complainants suggest the fact that the Disputed Domain is “an amalgamation of the complainants’ rights” is relevant to whether it is Abusive. It is important to keep in mind that the second limb of the

argument requires a finding that they respondent is to be disbelieved when it says that the name was chosen with reference to the phrase eeh bah gum. That is a very serious allegation and requires cogent evidence to support it: see Expert Overview paragraph 2.1 where it is pointed out that although the standard of proof is on the balance of probabilities, the more serious an allegation the more cogent the evidence required to support it before that standard has been met.

7.15 It is therefore necessary to consider the plausibility of the respondent's claim that the Disputed Domain ebuygumm was chosen as a play on words with the Yorkshire phrase eeh bah gum. The difficulty with saying that this claim is implausible is that one only has to look at the two to see that the proposition is entirely plausible. Indeed, as I have pointed out above, for significant numbers of people, that will be the first thing that comes to mind, contrary to the complainants' contention. It therefore seems to me that it is impossible to say that the respondent's claim as to the origin of the Disputed Domain is implausible. Even if one were to take the view that the use of rainbow colouring for the GUMM element as originally chosen must have been done with an eye to the rainbow colouring of ebay, it is impossible to ignore the fact that both the colouring and the typeface also have a strong similarity to Google's presentation. One might take the view that the respondent was being cheeky but it is difficult to conclude that it was deliberately trying to cause confusion or even association. Had the respondent used rainbow colouring for the EBUY element of its name, the complainants' argument might have more substance, but it did not.

7.16 It does not seem to me that one can conclude that the respondent's claims can be disbelieved. One may well take the view that the respondent, having come up with the Disputed Domain may also have had an eye to the possible play on words with the complainants' marks but that does not make the respondent's claims untrue. It follows that the allegations that the Disputed Domain is abusive have to be approached on the basis that the respondent did indeed choose the domain as a word play on the Yorkshire phrase eeh bah gum. On that basis, the fact that the Disputed Domain can be taken to include elements from both the complainants' brands is not relevant to whether it is an Abusive Registration under the DRS Policy. Such a factor could only be relevant if it were established that the amalgamation arose from an intention to take both names. Once it is concluded that the origin of the Disputed Domain is the phrase eeh bah gum, then the play on words which results from the presence of elements which can be taken to include elements from both the complainants' brands is simply the result of taking that starting point and following the derivation explained by the respondent.

7.17 The complainants argue that the Disputed Domain is abusive on two basic grounds. First, it takes advantage of their reputation by attracting custom through the misrepresentation it creates of an association with the complainants. Second, in doing so it harms them by taking custom away from them and by damaging their reputation as a supplier of high quality services in the event that customers have poor experiences with the respondent's website. As to the latter it seems to me that this is pure speculation. There is no evidence that the services offered by the

respondent are of a poor standard and this aspect of the allegation therefore seems to me to be without substance. In the light of my conclusions as to the nature and origin of the Disputed Domain, it seems to me to be unlikely that any significant number of members of the public who see the respondent's website will make the kind of connection with the complainants that they assert. This is particularly so because of the low level of similarity between the Disputed Domain and either of the complainants' trade marks. Anyone who sees the similarity cannot also fail to see the very substantial differences between them. That leads in my view to the conclusion that it is improbable in the extreme that the public will make the kind of connection the complainants assert. I am reinforced in that view by the fact that the complainants have found no-one who appears to have made such a connection. I have no doubt that they have looked carefully for such evidence. The single online comment that they have found appears to have been made at the foot of an article about something else (probably the complainants' ebay website) and must have required considerable research to find. I therefore reject the complainants' arguments based solely upon the definition of an Abusive Registration in the DRS Policy.

7.18 Under paragraph 5.1.2 of the DRS Policy the complainants rely upon initial interest confusion caused by presentation of the respondent's website on the Disputed Domain high up in search engine results in response to a search for one of the complainants' trade marks. They say that such confusion will be compounded by the nature of the respondent's website as an online marketplace. I disagree. I do not consider it in the least likely that searches for EBAY or GUMTREE will return results for EBUYGUMM. The complainants have not produced any such results, presumably because they do not exist. As the respondent points out, the names are different. If there were an element which corresponded directly to one of the complainants' marks, one might take a different view. This claim too therefore fails. For completeness I mention that the possibility of a poor experience with the respondent's website is also prayed in aid by the complainants under this heading. For the reasons set out above I reject that suggestion.

7.19 The same analysis disposes of the complaint under paragraph 5.1.1.3 of the DRS Policy. There is no plausible basis for suggesting that the respondent is attracting in consumers by their perception of a linkage with the complainants' marks. I also reject the complainants' suggestion that the reference to "other" online marketplaces on the respondent's website will be taken as a reference only to the complainants' websites. There is no reason at all why consumers should read it this way. There are many other online marketplaces including giants such as Amazon and Alibaba. The comment is equally apt to refer to them. In addition, the complainants' argument depends upon the proposition that consumers realise that there is no connection between the respondent's website and those of the complainants and that those of the complainants are being disparaged in comparison. That of course is the complete opposite of the reaction to the Disputed Domain that the complainants rely upon to justify the present complaint. I have consequently found the complainants' position in relation to this argument impossible to understand.

7.20 Finally the complainants rely upon the Disputed Domain being a blocking registration contrary to paragraph 5.1.1.2 of the DRS Policy. I suspect that this argument is presented last because the complainants recognised that it was something of a makeweight. It is hard to see how it could succeed if the previous arguments failed. A blocking registration is one which prevents the complainant from acquiring a domain it might wish to have for its own use. That is why slight misspellings of brands are considered to be blocking registrations because they are the kind of thing that may be entered by an internet user in error when looking for the brand. That is simply not this case. The Disputed Domain contains at most a faint allusion to the complainants' trade marks. It is not the sort of thing that an internet user looking for either trade mark would enter in error. I therefore reject this allegation too.

7.21 In the result all the complainants' allegations fail and the complaint is dismissed.

8. Decision

8.1 I direct that no action be taken on this complaint.

Signed

Dated 19 August 2019

ANNEX 1



Gumtree

