

WIPO Arbitration and Mediation Center
Case No.: DNL2020-0042
Date: 13 March 2021

1. The Parties

The Complainant is Telefónica UK Limited, United Kingdom, represented by Stobbs IP Limited, United Kingdom.

The Respondent is Creative Marketing Solutions, the Netherlands, represented internally.

2. The Domain Name and Registrar

The disputed domain name <giffgaff.nl> (the “Domain Name”) is registered with SIDN through TransIP Group.

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on September 24, 2020. On September 24, 2020, the Center transmitted by email to SIDN a request for registrar verification in connection with the Domain Name. On September 25, 2020, SIDN transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details. The Center verified that the Complaint satisfied the formal requirements of the Dispute Resolution Regulations for .nl Domain Names (the “Regulations”).

In accordance with the Regulations, articles 5.1 and 16.4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on October 6, 2020. In accordance with the Regulations, article 7.1, the due date for Response was October 26, 2020. The Center received an informal email communication from the Respondent on October 6, 2020. The Response was filed with the Center on October 26, 2020.

On November 3, 2021, the Complainant filed a further submission without being so invited, which the Panel determines to be inadmissible in the circumstances of this case, in accordance with article 11.2 of the Regulations.

On November 6, 2020, SIDN commenced the mediation process which was extended once by SIDN. On February 1, 2021, SIDN informed the parties that the dispute had not been solved in the mediation process.

The Center appointed Wolter Wefers Bettink as the panelist in this matter on February 27, 2021. The Panel finds that it was properly constituted. The Panelist has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required to ensure compliance with the Regulations, article 9.2.

4. Factual Background

The Complainant is a company active in the telecommunications business since 2009, selling *inter alia* SIM-only mobile services, handsets, and price-comparison services.

The Complainant owns a number of trade mark registrations for or including the element “giffgaff”, including but not limited to the following (hereinafter the “Trade Marks”):

- European Union word mark GIFFGAFF registered on December 1, 2009, under No. 008295743;
- United Kingdom word mark GIFFGAFF registered on August 14, 2009, under No. UK00002515287.

The Domain Name was registered on December 2, 2011, and resolves to a registrar hosting page.

5. Parties' Contentions

A. Complainant

According to the Complainant, the Domain Name is identical to the Trade Marks, as it comprises the Trade marks in their entirety without any modification and with a commonly used country code Top-Level Domain ("ccTLD"). Considering the reputation of the Trade Marks, the Complainant contends, consumers faced with the Domain Name will assume a connection with the Complainant.

The Complainant submits that the Respondent does not appear to have any legitimate interest in the Domain Name. The only reason for the Respondent to use the Trade Marks in relation to online services would, in the opinion of the Complainant, be to misleadingly divert consumers or to tarnish the Trade Marks. The Complainant also states that the Domain Name appears to have never been connected to a website holding any content (apart from a registrar hosting page), and that this would show that the Respondent has never had any legitimate interest in using the Domain Name. The Complainant also points out that the Domain Name is so similar to the Trade Marks, that consumers visiting the website [the Panel understands this to mean: a possible future website of the Respondent connected to the Domain Name] would automatically assume some form of connection with the Complainant, which could have a negative effect on the Complainant and/or divert trade away from them.

According to the Complainant, it is considerably likely that the Respondent would have come across other domain names already registered by the Complainant – such as <giffgaff.com> which has been registered since February 14, 2009, – and would have been made aware of the Complainant and their rights on this basis. According to the Complainant, the fact that the Domain Name has not been connected to a website with any content in the nine years since its creation in 2011, would point to the Respondent having no legitimate interest in the Domain Name, and only having registered the Domain Name with the intention to capitalize on the confusion created. Furthermore, the Complainant states, the Respondent appears to have acquired the Domain Name in order to sell it for a price exceeding the out-of-pocket expenses incurred in registering and renewing the Domain Name. In this connection, the Complainant refers to correspondence with the Respondent prior to submitting this Complaint, relating to the possible purchase of the Domain Name and the domain names <giffgaff.es> and <giffgaff.be> by the Complainant, which domain names are also registered in the name of the Respondent. The Complainant points out that, while the Respondent initially stated that it was willing to sell all three domain names for EUR 325,000, the Respondent, after a counter-offer of EUR 1,500 from the Complainant, lowered the price to EUR 15,000. The Complainant contends that the Respondent's initial Response, that the Domain Name was chosen because of the ancient Scottish meaning of the term "Giffgaff" as "mutual assistance" or "mutual giving", is unlikely as this meaning is not common knowledge and is not listed in the majority of standard online dictionaries. Instead, the Complainant submits, in view of the reputation of the Trade Marks it is very likely that the Respondent was aware of the Trade Marks and, in any case, that in conducting due diligence or research into the name "giffgaff" at the point of registration, the Respondent would have very likely come across the Complainant and the Trade Marks. Therefore, the Complainant puts forward, it is likely that the Respondent registered the Domain Name

with the intention of disrupting the business of the Complainant, and then selling it back for a disproportionately large fee.

Taken together, the Complainant submits, these facts show that the Domain Name has been registered and is being used in bad faith.

B. Respondent

According to the Respondent “Giffgaff” or “Giff-gaff” is a general expression that has been used for more than a century, *inter alia* in The Urban Dictionary, The Dictionary of the Scots Language, the books “Divided Skates” by Evelyn Raymond, “A Knight of the Nets” by Amelia E. Barr, “The President” by Alfred Henry, “St. Ronans Well” by Walter Scott, as well as the poem “To a Nightingale” by R.F. Langley. The Respondent submits that it was aware of this meaning when registering the Domain Name in 2011. Furthermore, the Respondent contends that the Trade Marks and the Complainant are unknown in the Netherlands, where the Respondent resides, and products or services sold under the Trade Marks cannot be bought in the Netherlands.

The Respondent puts forward that it owns seventeen domain names which have been bought with the intention of creating businesses, none of which are currently being used. The Respondent disputes the Complainant’s submission that it has registered the Domain Name for use in relation to online services to misleadingly divert consumers or to tarnish the Trade Marks. The Respondent further states that it has never sold any of its domain names and that it did not proactively contact the Complainant about the sale of the Domain Name, but that the Complainant made the contact and asked the Respondent to state a price. The Respondent, on the basis of the above, disputes that it has registered or is using the Domain Name in bad faith.

6. Discussion and Findings

At the outset, the Panel notes that the Complainant has initiated this case almost nine years after the Domain Name was registered. This may raise the question – which is not addressed in the Complaint – why the Complainant waited to initiate proceedings and, in particular, whether filing the Complaint after so many years have lapsed since the Domain Name was registered, has any effect on the Complainant’s standing under the Regulations or the validity of the Complaint. This is not the case. The Regulations do not have a statute of limitations or any other mechanism which would require a complainant to file a complaint within a certain period of time after the domain name in question has been registered. Whether the timing of filing of the Complaint has an effect on the merits of this case will be discussed under section C below.

A. Identical or Confusingly Similar

The Complainant has shown that it has registered rights in the Trade Marks. The Domain Name is confusingly similar to the Trade Marks as it incorporates the mark GIFFGAFF, of which the Trade Marks consist, in its entirety (see also [WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition](#) (“WIPO Overview 3.0”), [section 1.7](#)).¹ The ccTLD “.nl” is typically disregarded under the confusing similarity test, since it is a technical registration requirement (see [WIPO Overview 3.0, section 1.11](#)).

Therefore, the Panel finds that the Domain Name is confusingly similar to the Trade Marks in which the Complainant has rights.

B. Rights or Legitimate Interests

Under article 3.1 of the Regulations, the Complainant has to make out a *prima facie* case that the Respondent does not have rights to or legitimate interests in the Domain Name, upon which the burden of production on this element shifts to the Respondent to come forward with relevant evidence demonstrating rights to or legitimate interests in the Domain Name ([WIPO Overview 3.0, section 2.1](#)). In this connection, the Complainant states that the Domain Name appears to have never been connected to a website holding any content and that the similarity of the Domain Name and the Trade Marks is such that consumers visiting a website of the Respondent connected to the Domain Name would automatically assume some form of connection with the Complainant, which does not exist. The Panel *inter alia* derives from this statement that the Complainant did not authorize the Respondent to incorporate the Trade Marks in the Domain Name.

The Respondent has put forward that “Giffgaff” is a dictionary word which is used in a number of books, of which the Respondent has submitted examples. This has been confirmed by a brief Internet search conducted by the Panel. The word “Giffgaff” or “Giff-gaff” originated in Scotland, as evidenced by the Etymological diary of the Scottish Language (1818) which gives as its meaning “mutual giving”. The Merriam-Webster online dictionary gives as meaning of “Giffgaff” “mutual assistance” and “fair exchange” and an example of its use in the proverb “giffgaff makes good fellowship”. “Giffgaff” or “Giff-gaff” is found in, “A General Dictionary of Provincialisms” (1840), “Seven Sermons before Edward VI” by Edward Arber (1869) and, the examples provided by the Respondent, in “Divided Skates” by Evelyn Raymond (1900), “A Knight of the Nets” by Amelia E. Barr (1896), “The President” by Alfred Henry (1904), “St. Ronans Well” by Walter Scott (1824) and the poem “To a Nightingale” by R.F. Langley (2011).

However, the Respondent (who, the Panel notes in another context invokes his residence in the Netherlands as a basis for lack of knowledge) has not explained why it chose to include this particular word, which on the whole appears to have been rarely used outside Scotland and, with one exception, only in 19th and early 20th century literature. In addition, the Respondent registered the Domain Name two years after the oldest of the Trade Marks and, although the Respondent has pointed out that the Complainant does not sell its services under the Trade Marks in the Netherlands, it has not denied the Complainant’s assertion that it was very likely aware of the Trade Marks. Furthermore, the statement of the Respondent that it bought the Domain Name (like the other ones it owns) with the intention of creating a business does not appear credible. The Respondent does not specify what type of business the Domain Name would be used for, nor is that readily apparent from the meaning of “Giffgaff” as “mutual assistance” and “fair exchange”. In addition, the Respondent has held the Domain Name for nine years, apparently without ever using it for a website or any other business.

In assessing whether the Respondent has a legitimate interest in the Domain Name, it should also be taken into account that (i) since the Domain Name incorporates the Trade Marks in their entirety, it carries a high risk of implied affiliation ([WIPO Overview 3.0, section 2.5.1](#)); and (ii) the Respondent has not provided evidence, nor is there any indication in the record of this case, that the Respondent is commonly known by the Domain Name (article 3.1(b) of the Regulations). Furthermore, in view of the fact that the Domain Name does not resolve to a website of the Respondent, there is no evidence that the Respondent is making a legitimate noncommercial or fair use of the Domain Name.

The Panel concludes that on balance, taking into account all of the above, the Complainant has demonstrated that the Respondent has no rights to or legitimate interests in the Domain Name.

C. Registered or Used in Bad Faith

In accordance with article 3.2 of the Regulations, the Complainant has to show that the Domain Name was registered or is being used in bad faith.

The Complainant has initiated this case nine years after the Respondent's registration of the Domain Name. As noted, this may raise the question what, if any, effect this has on the question of bad faith registration and/or use of the Domain Name. In this context, the Panel finds it relevant whether the Respondent at the time of registration of the Domain Name was or should have been aware of the Trade Marks, and whether it is clear that the aim of the registration was to take advantage of the confusing similarity between the Domain Name and the Trade Marks. In this respect, based on the information and the unrefuted evidence provided by the Complainant, the Panel notes that (i) the Complainant has been using the Trade Marks since 2009, two years before the Respondent's registration of the Domain Name; (ii) the Domain Name incorporates the Trade Marks in their entirety; (iii) "Giffgaff" is a rarely used word which does not appear to be a word of which the Respondent was likely to spontaneously or accidentally think, while the Respondent has not explained why it chose to include this particular word in the Domain Name; (iv) indeed, a simple search on the Internet at the time of registration would have alerted the Respondent to the Trade Marks and the Complainant.

On the basis of these circumstances the Panel concludes that at the time of registration of the Domain Name, the Respondent was or should have been aware of the Trade Marks and that the Respondent registered the Domain Name in bad faith.

For completeness' sake, the following circumstances – in combination with the above – point at bad faith use of the Domain Name: (i) the Respondent has also registered the domain names <giffgaff.be> and <giffgaff.es>, indicating that the Respondent thereby has tried to prevent the Complainant from using the Trade Marks in domain names under the ccTLDs of the Netherlands, Belgium, and Spain; (ii) the Respondent has offered these three domain names for sale for, initially, a price of EUR 325,000 and, at a later stage, for EUR 15,000, both amounts likely (far) in excess of the out-of-pocket expenses for registering and maintaining the domain names, indicating that the Domain Name has been registered or acquired primarily for the purpose of selling, renting or transferring it to the Complainant or to the Complainant's competitors; (iii) the Domain Name appears not to have been used over the years and such a passive holding of the Domain Name in this case constitutes bad faith, taking into consideration the overall context of the Respondent's behavior (see *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. D2000-0003 and *Novartis AG v. YXP Li*, WIPO Case No. DNL2020-0037).

7. Decision

For all the foregoing reasons, in accordance with articles 1 and 14 of the Regulations, the Panel orders that the domain name <giffgaff.nl> be transferred to the Complainant.

Wolter Wefers Bettink
Panelist

¹In view of the fact that the Regulations are to an extent based on the Uniform Domain Name Dispute Resolution Policy ("UDRP"), it is well established that both cases decided under the Regulations and cases decided under the UDRP, and therefore WIPO Overview 3.0, are relevant to this proceeding (see, e.g., *Aktiebolaget Electrolux v. Beuk Horeca B.V.*, WIPO Case No. DNL2008-0050).