

ADMINISTRATIVE PANEL DECISION

GitHub, Inc v. Brodie Kyle Goold

Case No. DAU2022-0046

1. The Parties

The Complainant is is GitHub, Inc, United States of America, represented by Golja Haines & Friends, Australia.

The Respondent is Brodie Kyle Goold, Australia.

2. The Domain Name and Registrar

The disputed domain name <github.au> is registered with Cheaper Domains Pty Ltd (“the Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on December 23, 2022. On December 23, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On December 24, 2022, the Registrar 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 sent an email communication to the Complainant on December 27, 2022, requesting an amendment of the Mutual Jurisdiction Clause. The Complainant filed an amended Complaint on January 3, 2023.

The Center verified that the Complaint together with the amended Complaint satisfied the formal requirements of the .au Dispute Resolution Policy (the “Policy” or “.auDRP”), the Rules for .au Dispute Resolution Policy (the “Rules”), and the WIPO Supplemental Rules for .au Domain Name Dispute Resolution Policy (the “Supplemental Rules”).

In accordance with the Rules, paragraphs 2(a) and 4(a), the Center formally notified the Respondent of the Complaint, and the proceedings commenced on January 6, 2023. In accordance with the Rules, paragraph 5(a), the due date for Response was January 26, 2023. The Respondent did not submit any substantive response, however sent two informal communication emails on January 10, and 21, 2023.

The Center appointed Alistair Payne as the sole panelist in this matter on February 1, 2023. The Panel finds that it was properly constituted. The Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Center to ensure compliance with the Rules, paragraph 7.

4. Factual Background

The Complainant is an Internet hosting service for software development and version control using the term “Git”. It provides downloadable software to enable users to share and collaboratively develop software, computer codes and user generated content, and since its launch in Australia in 2008, it has more than one million Australian users. It operates in Australia through associated group entities Github Australia Pty Ltd and Github B.V. The online platform through which the Complainant operates its business is located at the domain name <github.com> which was registered on October 9, 2007. The Complainant owns Australian registered trade mark 1866628, filed on June 23, 2017, and registered on January 10, 2018, for the mark GITHUB.

The disputed domain name was registered on October 4, 2022, and does not resolve to an active website.

5. Parties’ Contentions

A. Complainant

The Complainant submits that it owns registered trade mark rights in Australia as set out above for its coined and highly distinctive GITHUB mark. It says that the disputed domain name wholly incorporates its mark and is therefore confusingly similar to it.

The Complainant notes that since its registration, the disputed domain name has not resolved to an active website but only generates a browser error message and has provided evidence from the Wayback Machine of the lack of use by the Respondent. As a result, says the Complainant, the Respondent has made no use, or demonstrable preparations to use, the disputed domain name or a name corresponding to the disputed domain name in connection with a *bona fide* offering of goods and services.

Further, says the Complainant, the Respondent is an individual and there is no evidence that she has been commonly known by the disputed domain name or has registered trade mark rights in the GITHUB mark. The Complainant submits that the Respondent does not appear to be making a legitimate noncommercial or fair use of the disputed domain name. It notes that when the disputed domain name was registered, the Complainant’s GITHUB trade mark was well known in the software development industry, in which the Complainant had been operating using the mark for over a decade. In fact, says the Complainant, it appears that the Respondent is domain name squatting as a review of the Respondent’s Australia Business Name listings show that the Respondent has registered other business names of third parties’ well-reputed marks, quite apart from GITHUB.

The Complainant submits that the Respondent will not be able to establish demonstrable preparations for legitimate, noncommercial, or fair use of the disputed domain name, without intent for commercial gain to misleadingly divert consumers or tarnish the trade mark at issue. There is no evidence that the Respondent has made a *bona fide* use or demonstrable preparations to use the disputed domain name or a name corresponding to it. Redirection to an error page, says the Complainant, does not amount to a *bona fide* use of the disputed domain name in connection with an offering of goods and services.

The Complainant says that it has not authorised, licensed, or permitted the Respondent to register or use the disputed domain name or to use the GITHUB trade mark. It notes that it has prior rights in the GITHUB trade mark which precede the Respondent’s registration of the disputed domain name by 14 years, and by five years having regard to the Australian trade mark registration, and that it was using its GITHUB trade mark on its website (which can be located at <github.com>) at the time that the Respondent registered the disputed domain name.

The Complainant notes that from March 24, 2022, domain names were able to be registered in the “.au” domain and existing domain name licence holders were given priority to register the “.au” direct equivalent of their domain names until September 20, 2022, after which time the domain names that had not been

allocated became available to the general public. The Complainant says that the Respondent registered the disputed domain name very quickly after the priority period ended which, it surmises, may indicate that the Respondent had been monitoring whether the disputed domain name was still available after the priority period and any searches to check the availability would have resulted in disclosure of the Complainant's domain name <github.com> and the Complainant's use of the trade mark GITHUB. The registration of the disputed domain name by the Respondent so quickly after the priority period, appears to be primarily for the purpose of either intentionally attempting to attract, for commercial gain, Internet users to the Respondent's website or otherwise for the purpose of selling or otherwise transferring the disputed domain name to the Complainant or its competitors for an amount likely in excess of the documented out-of-pocket costs for registration of the disputed domain name.

The Complainant submits that this amounts to typosquatting by use of a different Top-Level-Domain ("TLD") and that this results in a likelihood of confusion with the Complainant's domain name <github.com> which inevitably results in the diversion of Internet traffic from the Complainant's website to the Respondent's website.

The Complainant says that the disputed domain name is likely to confuse consumers as to whether the Complainant is the source of, has sponsored or endorsed, or is affiliated with, the Respondent's website. This is because, in particular, the disputed domain name is for all intents and purposes confusingly similar to the Complainant's GITHUB trade mark. Due to the disputed domain name not being active, the Complainant says that it is not aware of the goods or services offered by the Respondent. While there has been no evidence of actual "use" of the disputed domain name by the Respondent, the Complainant submits that the passive holding of a domain name may in certain circumstances be held to constitute a "use" of a domain name particularly whereas in the present instance, it would prevent the Complainant from registering its trade mark in a corresponding domain name. The Complainant submits the Respondent's passive holding of the domain name in this case satisfies the requirement of paragraph 4(a)(iii) that the domain name "is being used in bad faith" by the Respondent.

The Complainant also submits that the disputed domain name is so obviously connected with the trade mark of the Complainant that the very use by someone with no connection with the Complainant suggests opportunistic bad faith.

B. Respondent

The Respondent did not submit any substantive response, however sent two informal communication emails on January 10, and 21, 2023. In its informal communications, the Respondent states that it had no intention of "domain squatting", it would be "happy to cede ownership of the domain over to" the Complainant, and lastly that it will not be filing a response.

6. Discussion and Findings

A. Identical or Confusingly Similar

The Complainant has demonstrated that it owns the Australian trade mark registration mentioned under Section 4 above, for the mark GITHUB. The disputed domain name (not including the TLD element) wholly incorporates the Complainant's GITHUB mark and is identical to it. Accordingly, the Panel finds that the Complaint succeeds under the first element of the Policy.

B. Rights or Legitimate Interests

Since its registration on October 4, 2022, based on the evidence submitted by the Complainant, the disputed domain name has not resolved to an active website but only generates a browser error message which the Complainant says is not consistent with the Respondent having used the disputed domain name in connection with a *bona fide* offering of goods or services.

The Respondent seems to be an individual and the Complainant has submitted that there is no evidence that the Respondent has been commonly known by the disputed domain name or has registered trade mark rights in the GITHUB mark. The Complainant has also submitted that the Respondent does not appear to be making a legitimate noncommercial or fair use of the disputed domain name. It has noted that at the time of registration of the disputed domain name the Complainant's GITHUB trade mark was well known in the software development industry and that the Complainant had been operating in the industry using the mark for over a decade. The Complainant has also noted that the Respondent's Australia Business Name listings include other business names that incorporate third parties' well-reputed marks (quite apart from GITHUB itself) which it has suggested are consistent with an intention of domain name squatting. The Complainant has also submitted that the Respondent in this case cannot establish demonstrable preparations for legitimate, noncommercial, or fair use of the disputed domain name and it has asserted that redirection to an error page does not amount to a *bona fide* use of the disputed domain name in connection with an offering of goods and services.

The Panel finds that the Complainant has made out a *prima facie* case that the Respondent has no rights or legitimate interests in the disputed domain name. The Respondent has failed to rebut the Complainant's case and for this reason and also as set out under section C below the Panel finds that the Complaint also succeeds under this element of the Policy.

C. Registered or Subsequently Used in Bad Faith

The disputed domain name was registered long after the Complainant registered its Australian trade mark and even longer after the Complainant appears to have commenced the use of its GITHUB mark. The GITHUB mark is a coined and highly distinctive term that has been used by the Complainant at its main website at <github.com> and which has garnered a very considerable number of users and a significant degree of goodwill in Australia. The Respondent has also registered an Australian Business Name registration for "Github", all of which suggests that the Respondent was well aware of the Complainant and of its GITHUB mark when it registered the disputed domain name.

The disputed domain name has not been used by the Respondent to divert to an active website and it has therefore been held passively which may amount to use in bad faith in certain circumstances. Factors that previous panels have considered relevant in applying the passive holding doctrine under the UDRP as noted at section 3.3 of [WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition](#) (which is confirmed as being the same test under the auDRP in the auDA Overview of Panel Views On Selected auDRP Questions First Edition) include: (i) the degree of distinctiveness or reputation of the complainant's mark, (ii) the failure of the respondent to submit a response or to provide any evidence of actual or contemplated good-faith use, (iii) the respondent's concealing its identity or use of false contact details (noted to be in breach of its registration agreement), and (iv) the implausibility of any good faith use to which the domain name may be put.

In this case, the GITHUB mark is highly distinctive and appears to be well reputed in the software industry in Australia based upon the substantial number of users noted by the Complainant. The Respondent indicated to the Center that it would not file a response and while the Respondent has not attempted to conceal its identity, it appears to the Panel that in the circumstances as described, it is entirely implausible that the Respondent would potentially put the disputed domain name to good faith use. In this regard the Respondent's registration of "Github" as an Australian Business Name without the Complainant's consent and its registration of third parties' marks as business names, together with the Complainant's evidence of the timing of the registration of the disputed domain name very quickly after the priority period for registration in the ".au" domain space ended, strongly suggests that the Respondent was looking for opportunities to opportunistically take advantage and register well-reputed marks. This is entirely inconsistent with any intent to use the disputed domain name in good faith. Moreover, upon notice of the Complaint, the Respondent has expressed its willingness to surrender the disputed domain name, reinforcing the notion that the Respondent lacks good faith motive for the registration and passive holding of the disputed domain name. As a result, the Panel finds that the disputed domain name has been passively held by the Respondent in bad faith.

Accordingly, the Panel finds that the disputed domain name was registered and has been used in bad faith and that the Complaint also succeeds under this element of the Policy.

7. Decision

For all the foregoing reasons, in accordance with Paragraphs 4(j) of the Policy and 15 of the Rules, the Panel orders that the domain name, <github.au>, be transferred to the Complainant.

/Alistair Payne/

Alistair Payne

Sole Panelist

Date: February 7, 2023