Decision for dispute CAC-UDRP-100858

Case number	CAC-UDRP-100858
Time of filing	2014-10-10 10:56:12
Domain names	SUREVEYMONKEY.COM, SURRVEYMONKEY.COM, SURVEYMONKET.COM, SURVYEMONKEY.COM, SUREVYMONKEY.COM

Case administrator

Name	Lada Válková (Case admin)

Complainant

Organization	SurveyMonkey Inc.

Complainant representative

Organization	Matkowsky Law PC

Respondent

Organization	Domain Admin, Private Registrations Aktien Gesellschaft

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other legal proceedings that relate to one or all the disputed domain names.

IDENTIFICATION OF RIGHTS

See below Panel's observations on the Complainant's rights.

FACTUAL BACKGROUND

FACTS AND CLAIMS ASSERTED BY THE COMPLAINANT AND NOT CONTESTED BY THE RESPONDENT:

"I. Protected Rights Relied on by the Complainant

Founded in 1999 at <surveymonkey.com>, Complainant is the world's leading provider of web-based survey solutions, trusted by millions of companies, organizations and individuals alike to gather the insights they need to make more informed decisions. With more than 43 million surveys completed and 2.2 million survey responses daily, Complainant has received numerous awards & recognitions, including from Silicon Valley Innovation Summit and PCMag, and has been featured in widespread media outlets, including TechCrunch, MSNBC, Bloomberg, and CNNMoney. Its customers include 100% of the Fortune 100, as well as other businesses, academic institutions, and organizations of all shapes and sizes. Literally millions of people use SurveyMonkey for everything from customer satisfaction and employee performance reviews, to course

evaluations and research of all types.

Complainant has extensive common law rights in the mark SURVEYMONKEY (the "Mark") since 2000, as is evidenced from the first use date in its issued federal U.S. Reg. No. 3945632 (Annex 3) (BN042, BN050), and owns multiple registrations for the Mark covering its services, including CTM Reg. No. 1044546. Id. (BN036). Indeed, the Mark constitutes a famous and well-known mark, as is corroborated by the Alexa Traffic Rank of <SurveyMonkey.com>. Over the past 3 months, based on a combination of average daily visitors and pageviews, the site is ranked within the top 500 sites worldwide, and within the top 250 sites in the United States. Annex 8 (BN144). As of August 27, 2003--well prior to the first creation date of any of the disputed domain names by any historical registrant--the <Surveymonkey.com> site was already one of the top 1000 sites across the Internet worldwide, according to Alexa Traffic Rank. Id. (BN165).

II. The Subject domain names are nearly identical or confusingly similar to Complainant's Well-Known Mark.

The subject domain names include either misspellings, such as an additional single letter (e.g., <sureveymonkey.com>, or other typographical errors that also do not negate confusing similarity, such as QWERTY keyboard slips (e.g., <surveymonket.com>), double letters (e.g., <surrveymonkey.com>, and swapped letters (e.g., <survyemonkey.com>, <surevymonkey.com>). E.g., Google, Inc. v. DktBot.org, FA 286993 (Nat. Arb. Forum Aug. 4, 2004) (mere addition of a single letter); Belkin Components v. Gallant, FA 97075 (Nat. Arb. Forum May 29, 2001) (slight misspelling); Wyndham IP Corp. v. LaPorte Holdings, Inc., FA 373545 (Nat. Arb. Forum Jan. 17, 2005) (letter swapping).

III. Respondent does not have any Rights or Legitimate Interest in the Subject Domain Names.

The Respondent does not pretend to have any right or legitimate interest in the disputed domain names. The Respondent has not been authorized, licensed or permitted to register and use them. Furthermore, it has not been commonly known by the disputed domain names and it is not making a legitimate non-commercial use thereof, in the meaning of Par. 4(c) of the Policy. There is also no legitimate interest in typosquatting.

The Respondent uses the disputed domain names that have no primary dictionary meanings to host commercial websites that provide competing web portal links and general advertisement links to a variety of businesses and products, none of which is a bona fide offering of goods or services under the Policy. Respondent offers highly related services that are likely to cause confusion. Regardless of whether the Respondent consciously included links highly related or competitive with Complainants' services and marks or whether an algorithm over which the Respondent had limited or no control generated is irrelevant because the advertisements undoubtedly take advantage of the Complainant's trademark. E.g, Dr. Martens International Trading GmbH, Dr. Maertens Marketing GmbH v. Private Whois Service, Case No. D2011-1753 (WIPO Dec. 2, 2011) (citing Boris Johnson v. Belize Domain Whois Service Lt, WIPO Case No. D2010-1954).

As of September 4, 2014, all of the disputed domain names were being used to divert users looking for Complainant's site to the disputed domain names hosting pay-per-click advertisements, including highly related advertisements directly competitive with Complainant's business. Annex 5. On or about September 4, Complainant had sent a notice letter to the Respondent and its hosting providers, through counsel, requesting of Respondent to voluntarily transfer the disputed domain names, and of the hosting providers to enforce their respective terms of service prohibiting such intellectual property violations. Annex 6. Respondent ignored the notice letter, although Respondent's hosting providers blocked the domain names from their systems pursuant to their respective terms of service. Because Respondent still controls the name servers (NS records), Respondent can simply move the domain to a provider that will facilitate the competitive pay-per-click ads and affiliate survey schemes that were being displayed previously to maximize Respondent's revenue. Regardless of whether the domain names are moved to a parking company that enables Respondent to continue with its pay-per-click revenue model exploiting typographical errors to mislead users, or keeps the name servers pointing to a blank page, neither of these uses constitutes a bona fide offering of goods or services under the paragraph 4(c)(i) of the Policy, or a legitimate non-commercial or fair use under paragraph 4(c)(iii) of the Policy. E.g., Air Austral v. WWW Enterprise, Inc., Case No. D2004-0765 (WIPO October 29, 2004) (finding that where domains were initially being used for pay-per-click revenue model, and then served a blank page after respondent failed to respond to a cease and desist notice, neither use to be a bona fide offering or a legitimate non-commercial or fair use). In addition, Respondent has a reputation for attracting Internet users to phishing

websites and deceiving them into divulging private information. Given that at least some of the websites hosted at the disputed domain names had "surveys" for users to enter personal information, there is a significant risk here that Respondent can gain at any moment from illegitimate uses of users' sensitive information. E.g., Apple Computer, Inc. v. PrivacyProtect.org / Private Registrations Aktien Gesellschaft, WIPO Case No. D2012-0879.

IV. The Disputed Domain Names have been Registered and are Being used in Bad Faith.

As of August 27, 2003--well prior to the first creation date of any of the disputed domain names by any historical registrant--the <Surveymonkey.com> site was already one of the top 1000 sites across the Internet worldwide, according to Alexa Traffic Rank. Annex 8 (BN164). Typosquatting and misspelling of well-known trademarks for pay-per-click revenue or affiliate marketing schemes is evidence of bad faith registration and use. E.g., Zone Labs, Inc. v. Zuccarini, FA 190613 (Nat. Arb. Forum Oct. 15, 2003). Typosquatting is generally regarded as "per se" evidence of bad faith registration and use. E.g., Paragon Gifts, Inc. v. Domain.Contact, WIPO Case No. D2004-0107; ESPN, Inc. v. XC2, WIPO Case No. D2005-0444; Edmunds.com, Inc. v. Digi Real Estate Foundation, WIPO Case No. D2006-1043. Moreover, the Respondent has chosen not to vindicate its conduct and provide an explanation of its choice of the domain names after the Complainant sent to a notice letter prior to initiating this proceeding, which is further indicative of bad faith. E.g., Orange Brand Services Limited v. Ancient Holdings, LLC, Wendy Webbe, Case No. D2014-0397 (WIPO May 26, 2014). Respondent disrupts Complainant's business by intentionally attracting users for commercial gain by creating a likelihood of confusion with the Complainant. E.g., Pocket Kings Limited v. Al Cabug, Case No. D2010-1821 (WIPO Dec. 17, 2010). In fact, some of the disputed domains specifically include references to Complainant's website. Annex 5. Although now inactive, "this circumstance does not prevent a finding of bad faith use." E.g., Galderma S.A. v. PrivacyProtect.org, CAC Case No. 100666. Some of the domains were also listed for sale, which is additional evidence of bad faith. Annex 5.

In the absence of any right or legitimate interest and lacking any contrary evidence by the Respondent, the Respondent's registration of disputed domain names confusingly similar to the Complainant's well-known trademark suggests opportunistic bad faith (MasterCard International Incorporated v. North Tustin Dental Associates, WIPO Case No. D2007-1412 and Mastercard International Incorporated v. Total Card Inc., WIPO Case No. D2007-1411). To the extent that surveys gathering personal information were being hosted on at least some of the disputed domain names, these actions constitute bad faith registration and use pursuant to the Policy. E.g., Halifax Plc. v. Sontaja Sanduci, WIPO Case No. D2004-0237 and MasterCard International Incorporated v. Capital Conservator Group LLC, WIPO Case No. D2009-1051. Furthermore, under the circumstances of this case where a proxy service (Domain Admin, Private Registrations Aktien Gesellschaft) is masked behind yet another proxy service (Contact@PrivacyProtect.org)--a 'Russian Doll' scenario--an inference of bad faith is properly drawn. E.g., WSFS Financial Corporation v. Private Registrations Aktien Gesellschaft ("Further, there appears to be no legitimate justification for such 'Russian doll' registrations. Indeed, panels have concluded that a Russian doll registration is evidence of bad faith."). Not only can bad faith be inferred from the Russian Doll scenario, but this particular Respondent has been adjudicated by other panelists as a notorious "serial cybersquatter." E.g., Apple Computer, Inc. v. PrivacyProtect.org / Private Registrations Aktien Gesellschaft, WIPO Case No. D2012-0879.

For all of the foregoing reasons, the Respondent's registration of the domain name confusingly similar to the Complainant's trademark was done in bad faith."

PARTIES CONTENTIONS

No response has been filed.

RIGHTS

The Complainant, helped by the Respondent's silence, has shown the disputed domain names are identical or confusingly similar to a mark in which it has rights (within the meaning of paragraph 4(a)(i) of the Policy).

NO RIGHTS OR LEGITIMATE INTERESTS

The Complainant has, to the satisfaction of the Panel, shown the Respondent has no rights or legitimate interests in respect of the disputed domain names (within the meaning of paragraph 4(a)(ii) of the Policy).

BAD FAITH

The Complainant has shown the disputed domain names have been registered and are being used in bad faith (within the meaning of paragraph 4(a)(iii) of the Policy).

PROCEDURAL FACTORS

The Panel is satisfied that all procedural requirements under UDRP were met and there is no other reason why it would be inappropriate to provide a decision.

However it should be noted that the present proceedings began in October 2014 when the Complainant filed a complaint against “Privacy Protection Service INC d/b/a PrivacyProtect.org” over 16 domain names (7 + 7 + 1 + 1) registered respectively with four different registrars. Subsequent communications from registrars showed that four of the disputed names were available and one was set to expire soon. Verifications also established that some of the names were registered by different domain name holders. The Complainant was notified on October 17 that its complaint presented administrative deficiencies and was requested to correct them, in accordance with Paragraph 4 (b) of the Rules.

Within the course of following weeks, the Complainant had been demanding additional verifications claiming that one of the registrars acted contrary to its obligation under Registrar Accreditation Agreement. Therefore, the deadline to submit an amended complaint was extended to allow new verifications. The Complainant then decided on November 11 to split its initial complaint into four. The present one only deals with the five names that follow:

(1) SUREVEYMONKEY.COM (registered on June 20, 2005)
(2) SURRVEYMONKEY.COM (registered on April 15, 2006)
(3) SURVEYMONKET.COM (registered on July 11, 2006)
(4) SURVYEMONKEY.COM (registered on July 11, 2005)
(5) SUREVYMONKEY.COM (registered on July 11, 2005)

Accordingly, an amended complaint was filed on November 15. Since October 2014, the Respondent has never replied to any of the communications it received or to the complaint.

PRINCIPAL REASONS FOR THE DECISION

PRELIMINARY OBSERVATIONS

The Complainant’s mark SURVEYMONKEY has been registered in the European Union in 2010 (Community Trade Mark 1044546) and in the USA in 2011 (Service Mark 3945632). The disputed domain names were registered before these dates. The Panel accepts the Complainant’s claim that it has common law rights in the mark SURVEYMONKEY since 2000, as certified by U.S. Reg. No. 3945632 which mentions a first use in commerce on May 21, 2000. As noted by other Panels in the infancy of the UDRP, the ICANN Policy and Rules do not require that the Complainant’s mark be registered with a government authority or agency for such right to exist [WIPO Arbitration and Mediation Center, Case No. D2000-0310, <choyongpil.net>]. But after reviewing the evidence the Complainant brought, this Panel disagrees that the Complainant would have, as it alleges, “extensive common law rights” and/or that its sign would be “a famous and well-known mark”:
- though the Complainant states that its web-based survey service has seen “more than 43 million surveys completed and 2.2 million survey responses daily”, it does not detail when and where its service was provided or to how many different consumers its trademark has been displayed
- though it states that “based on a combination of average daily visitors and pageviews, [its] site is ranked within the top 500 sites worldwide, and within the top 250 sites in the United States”, that was, per the Complainant, “[o]ver the past three months” only and not since the mark has been used.
The Complainant did not submit materials that establish whether its name has been continuously used between its first use and the registration of the disputed domain names, and where. Thus, the Panel cannot conclude from the materials submitted by the Complainant that its SURVEYMONKEY name had kept the status of common law mark, or in which territories it would have attained this status, before the registration of the disputed domain names. In particular, though the Complainant alleges that “[a]s of August 27, 2003--well prior to the first creation date of any of the disputed domain names

by any historical registrant--the <Surveymonkey.com> site was already one of the top 1000 sites across the Internet worldwide, according to Alexa Traffic Rank," the evidence it submits is unconvincing. This evidence consists of just one screenshot of search engine results "before Dec. 31, 2004" without any explanation of the methodology used to generate these results or of what "before Dec. 31, 2004" means (is it a few days, weeks, months, years, before that date?). In this screenshot, the first result, arguably the most relevant, is dated "Feb. 1, 2001" and points to a different website named "Zoomerang" (prima facie different than the Complainant's). The panel also notes that the traffic to a given domain does not mean this name --and the corresponding trademark-- is visible to the users (think, for example, of analytics or ads services, which provide content to third websites through a domain name which is widely accessed to but remains invisible to internet users).

PRINCIPAL REASONS FOR THE DECISION

1. The Panel finds that the Complainant's mark is easily recognizable as such within the disputed domain names and that these names are obviously confusingly similar to the Complainant's mark.

2. "In those circumstances [when it is in default] when the Respondent has no obvious connection with the disputed Domain Names, the prima facie showing by the Complainant that the Respondent has no right or legitimate interest is sufficient to shift the burden of proof to the Respondent to demonstrate that such a right or legitimate interest exists" [as pointed out by Panelist in WIPO Arbitration and Mediation Center case No. D2002-0856, <potsdam.com>, <potsdam.net>, <potsdam.org> & <potsdam.info>, citing WIPO Case No. D2002-0273, <sachsen-anhalt> and WIPO Case No. D2002-0521, <volvovehicles.com>].
In the absence of any response from the Respondent, or any other information indicating the contrary, the Panel finds that the Respondent has no rights or legitimate interests in respect of the disputed domain names.

3. According to paragraph 4 (b)(iv) of the Policy, there is evidence of bad faith when the Respondent by using the domain name intentionally attempted to attract, for commercial gain, Internet users to his website by creating a likelihood of confusion with Complainant's mark. The Complainant provided clear evidence that the Respondent acted in bad faith when it registered (with the aim of using them an illegal manner) and then used the disputed domain names.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

AND THE DISPUTED DOMAIN NAME(S) IS (ARE) TO BE

1. **SUREVEYMONKEY.COM**: Transferred
2. **SURRVEYMONKEY.COM**: Transferred
3. **SURVEYMONKET.COM**: Transferred
4. **SURVYEMONKEY.COM**: Transferred
5. **SUREVYMONKEY.COM**: Transferred

PANELLISTS

Name	**Prof. Cédric Manara**

DATE OF PANEL DECISION 2014-12-25

Publish the Decision