Decision for dispute CAC-UDRP-103272

Case number	CAC-UDRP-103272
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Domain names	uopstudy.com

Case administrator

Name	Olga Slanařová (Case admin)

Complainant

Organization	The University of Phoenix, Inc.

Complainant representative

Organization	RODENBAUGH LAW

Respondent

Name	Changfeng Lee

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other legal proceedings which are pending or decided and which relate to the disputed domain name

IDENTIFICATION OF RIGHTS

The Complainant is the owner of various trademark registrations, such as:

• The U.S. word trademark No 1540927 UNIVERSITY OF PHOENIX, registered on May 23, 1989 in class 41;

• The U.S. word trademark No 3716563 UOPX, registered on November 24, 2009 in class 41;

• The U.S. figurative trademark No 2089210 UNIVERSITY OF PHOENIX (logo), registered on August 19, 1997 in class 41;

• The U.S. figurative trademark No 3431022 UNIVERSITY OF PHOENIX (logo), registered on May 20, 2008 in class 41;

• The U.S. figurative trademark No 3988757 UNIVERSITY OF PHOENIX (logo), registered on June 5, 2011 in class 41.

The disputed domain name <uopstudy.com> was created on January 22, 2019.

FACTUAL BACKGROUND

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

The Complainant is an American University that has pioneered higher education for the working learner.
UOPX offers quality academic programs, qualified faculty, and a comprehensive student experience that comprise a respected institution of higher education.

UOPX has continually used the UNIVERSITY OF PHOENIX trademark in commerce since at least 1980. Since that time, UOPX has also extensively used in commerce the UOPX and UNIVERSITY OF PHOENIX logo marks.

The disputed domain name <uopstudy.com> was registered on January 22, 2019 under a privacy service.
According to the UDRP Rules, the Registrar disclosed the name of the registrant.

The Disputed Domains name resolves to a website that prominently displays a purported list of Complainant's courses on the left hand side menu.

When a user clicks on a link for an available course, they are presented with a purported listing of various discussions, homework, entire course materials, as well as the corresponding price for such materials. Id.

Users can also purchase purported final exams and assignments for various courses, e.g. for the course ACC 300, ACC 349, ACC421, and many more.

None of this material is verified to be true or accurate, nor otherwise authorized by Complainant.

To the contrary, such online unverified materials are strongly discouraged to be used by students, as their accuracy is neither verified nor otherwise guaranteed.

The domain name <uopstudy.com> gives access to a webpage offering "online materials":
- "Click the Course you need. All Tutorials will be downloaded immediately after the Payment and can also be downloaded by clicking on "My Downloads".

- « We offer tutorials for UOP courses. We provide customized tutoring for online courses. Once you have our tutorials working for you, life will get easier. Find the courses you are interested. Once you click a course you will be redirected to a web page where you can have instant download access! ».

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

PARTIES' CONTENTIONS:

COMPLAINANT:

On the confusing similarity.

The Complainant contends that he has prior, valid trademark rights In the UOPX and UNIVERSITY OF PHOENIX trademarks.

Complainant's trademark rights date back to at least as early as 1980 when the UNIVERSITY OF PHOENIX mark was first used in commerce and 2009 when the UOPX mark was first used in commerce, whereas, the disputed domain name was not even registered until January 21, 2019, almost four decades after Complainant first used the UNIVERSITY OF PHOENIX mark in commerce and approximately ten years after Complainant registered and used the UOPX mark.

The disputed domain is confusingly similar to complainant's UOPX and UNIVERSITY OF PHOENIX mark.

He adds that the burden to establish confusing similarity is low. Research in Motion Limited v. One Star Global LLC, Case No. D2009-0227 (WIPO Apr, 9, 2009). A showing of confusing similarity only requires a "simple comparison of the mark relied upon with the domain name in issue."

Here, a simple comparison of the <uopstudy.com> domain name and Complainant's UOPX and/or UNIVERSITY OF PHOENIX marks demonstrates that the disputed domains are confusingly similar.

He relies on prior cases Sharman License Holdings, Limited v. Mario Dolzer, Case No. D2004-0935 (WIPO Jan. 31, 2006); and e.g., Apollo Education Group, Inc. v. Vikash Ranaram, Case No. 101665 (CAC Oct. 15, 2017) (finding <uophelp.com> confusingly similar to UOPX); Apollo Education Group, Inc. v. Milen Radumilo, Case No. 101664 (CAC Oct. 27, 2017) (finding <uofploanforgiveness.com> confusingly similar to UOPX). Here, the addition of the generic term 'study' does nothing to create a new mark or avoid a finding of confusing similarity.

He submits that second, setting aside addition of the generic term 'study', the disputed domain name is similar in overall commercial impression to Complainant's UOPX mark.

Both UOP and UOPX are commonly used acronyms for UNIVERSITY OF PHOENIX, as illustrated by Respondent's use of UOP in connection with purported course materials for his students.

Moreover, the UOP portion of the disputed domain name is phonetically and visually similar to his UOPX mark, merely dropping the letter 'x'. Previous panels have held that omitting one letter from a mark within the disputed domain name may sustain a finding of confusing similarity because they are visually and/or phonetically similar to the asserted mark.

The omission of the letter 'x' within the disputed domain is a minor change that will not be readily perceived by most Internet users. Accordingly, the overall impression of the <uopstudy.com> disputed domain name and the UOPX mark are highly confusingly similar.

Therefore, the Complainant submits that he has established the first element of the Policy under paragraph 4(a).

On the absence of rights or legitimate interest.

The Complainant asserts that the second element of a UDRP claim only requires that the Complainant makes a prima facie showing that Respondent lacks a right or legitimate interest in the disputed domain name.

Respondent not only registered the disputed domain name years after Complainant's rights in the UOPX and UNIVERSITY OF PHOENIX marks arose, but is using the disputed domain name to direct Internet users to a website that sells University of Phoenix course specific discussion questions, homework assignments, exams, and other materials, while directly stating that they sell materials for "UOP courses", thereby directly profiting from his goodwill in the UOPX and UNIVERSITY OF PHOENIX marks.

The Complainant submits that in considering whether a Respondent has a right or legitimate interest in a disputed domain name under Paragraph 4(c) the panel may consider: (i) whether the Respondent is using the disputed domain name in connection with a bona fide offering of goods or services; (ii) whether the Respondent is commonly known by the disputed domain name; and (iii) whether the Respondent is making a legitimate noncommercial use or fair use of the disputed domain.

The Respondent is only using the disputed domain name to sell purported University of Phoenix course materials in order to profit from Complainant's goodwill and to confuse consumers as to the source and/or sponsorship of the Infringing Website.

Therefore, the Respondent does not use, and has not used, the disputed domain name in connection with a bona fide offering of goods or services

The Respondent is not commonly known by the disputed domain name.

On bad faith registration and use

The Respondent has registered and/or used a disputed domain name in bad faith where the purpose of the registration is to confuse consumers as to the source of the website.

Paragraph 4(b)(iv), to contend that the Panel may make a finding that the registrant has registered and used the disputed domain name in bad faith where "by using the disputed domain name, [the registrant has] intentionally attempted to attract, for commercial gain, Internet users to [its] web site or other on-line location, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of [registrant's] web site or location or of a product or service on [registrant's] web site or location."

Respondent is clearly attempting to create a likelihood of confusion as to the source, sponsorship, affiliation and/or endorsement of the Infringing Website by making use of the UOP acronym, which is almost identical to Complainant's UOPX mark, in connection with the words 'study'. Such use is enough to lead students to believe that the Infringing Website is sponsored by Complainant.

The Complainant contends that the Respondent registered the disputed domain name primarily for the purpose of disrupting Complainant's business

He asserts that the use of an identical or confusingly similar domain to promote third party products, services and websites that compete with those of Complainant can only be construed as an effort to disrupt Complainant's business.

He adds that the Respondent was or should have been aware of UOPX rights in the UNIVERSITY OF PHOENIX and UOPX marks and registered the disputed domain name in bad faith

He asserts that even if Respondent did not have actual knowledge of UOPX's trademark rights, Respondent had a duty to ensure that the registration of the disputed domain would not infringe a third party's rights.

If the Respondent had performed a simple Google search for any of the terms "University of Phoenix", "UOPX" and/or "UOP" it would have been presented with numerous search results relating to Complainant and the existence of Complainant's rights.

The Complainant submits that it is clear that Respondent knowingly registered and has used the disputed domain name to not only confuse customers as to the source of the Infringing website, but also to disrupt Complainant's business, evidencing Respondent's bad faith use and registration of the disputed domain name.

RIGHTS

Pursuant to paragraph 4(a)(i) of the Policy, the Complainant is required to prove that it has rights in a trademark or service mark, and that the disputed domain names are identical or confusingly similar to the Complainant's mark.

The Panel finds that the Complainant has established rights in the UOPX and UNIVERSITY OF PHOENIX trademarks, by virtue of its trademark registrations, details of which are set out above.

The disputed domain name <uopstudy.com> incorporates the first four letters of the UOPX trademark.

UOP is a current abbreviation of the UOPX trademark.
The addition of the generic term “study”, which refers to the education services designated by the UOPX trademarks and offered by the Complainant, does not exclude any likelihood of confusion.

The Complainant has, to the satisfaction of the Panel, shown the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights (within the meaning of paragraph 4(a)(i)of the Policy).

NO RIGHTS OR LEGITIMATE INTERESTS

Pursuant to paragraph 4(c) of the Policy, the Respondent may establish rights or legitimate interests in the disputed domain name by demonstrating any of the following:

(i) before any notice to it of the dispute, the Respondent’s use of, or demonstrable preparations to use, the disputed domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services; or

(ii) the Respondent has been commonly known by the disputed domain name, even if it has acquired no trademark or service mark rights; or

(iii) the Respondent is making a legitimate noncommercial or fair use of the disputed domain name, without intent for commercial gain, to misleadingly divert consumers, or to tarnish the trademark or service mark at issue.

While the overall burden of proof in UDRP proceedings is on the Complainant, panels have recognized that proving a Respondent lacks rights or legitimate interests in a domain name may result in the often impossible task of 'proving a negative', requiring information that is often primarily within the knowledge or control of the Respondent.

As such, where a Complainant makes out a prima facie case that the Respondent lacks rights or legitimate interests, the burden of proof shifts to the Respondent. If the Respondent fails to come forward with such relevant evidence, the Complainant is deemed to have satisfied the second element.

The Respondent is not known under the disputed domain name and has not been licensed or authorized to use the UOPX and UNIVERSITY OF PHOENIX trademarks or to register the disputed domain name <uopstudy.com>.
It does not make a fair or noncommercial use of the disputed domain name.

In the circumstances of this case, the Panel finds that the Complainant has established a prima facie case of the Respondent’s lack of rights or legitimate interests in relation to the disputed domain name, which the Respondent has not rebutted. The conditions of paragraph (4)(a)(ii) of the Policy have therefore been satisfied.

BAD FAITH

Paragraph 4(b) of the Policy sets out examples of circumstances that will be considered by a Panel to be evidence of bad faith registration and use of a domain name. It provides that: “For the purposes of paragraph 4(a)(iii), the following circumstances, in particular but without limitation, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith:

(i) circumstances indicating that the Respondent has registered or the Respondent has acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of the Respondent’s documented out-of-pocket costs directly related to the domain name; or

(ii) the Respondent has registered the domain name in order to prevent the owner of the trademark or service mark from

reflecting the mark in a corresponding domain name, provided that the Respondent has engaged in a pattern of such conduct; or

(iii) the Respondent has registered the domain name primarily for the purpose of disrupting the business of a competitor; or (iv) by using the domain name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to your website or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of the Respondent's website or location or of a product or service on the Respondent's website or location."

The UOPX and UNIVERSITY OF PHOENIX trademarks predate the disputed domain name.

There is no doubt that the Respondent was well aware of the UOPX trademark when it registered the disputed domain name.

The Respondent was planning to target internet users studying at the University of Phoenix.

Therefore it registered a domain name incorporating the common abbreviation UOP of the Complainant's UOPX trademark.

The Panel finds that the Complainant has made a prima facie case that the Respondent registered the disputed domain name in bad faith.

With regard to bad faith use, the disputed domain name was used to resolve to a website offering "online materials" in relation with the Complainant:
"About Us - We offer tutorials for UOP courses. We provide customized tutoring for online courses. Once you have our tutorials working for you, life will get easier. Find the courses you are interested. Once you click a course you will be redirected to a web page where you can have instant download access!"

Offering these tutorials using the domain name <uopsutdy.com> lets internet users believe that there is a relation between the Respondent and the UOP University, i.e., the Complainant, which is not the case.

The Panel is of the opinion that this use satisfies the requirement of paragraph (4)(b)(iv) of the policy "by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your web site or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of your web site or location or of a product or service on your web site or location".

The Complainant has, to the satisfaction of the Panel, shown the disputed domain name has been registered and is 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.

PRINCIPAL REASONS FOR THE DECISION

The UOPX and UNIVERSITY OF PHOENIX trademarks are protected in the United States and are well-known in the field of higher education. They predate the registration of the disputed domain name.

UOP is a current abbreviation of the UOPX trademark. The addition of the generic term "study", which refers to the education services designated by the UOPX trademarks and offered by the Complainant, does not exclude any likelihood of confusion.

The Respondent is not known under the disputed domain name and has not been licensed or authorized to use the UOPX and UNIVERSITY OF PHOENIX trademarks or to register the disputed domain name <uopstudy.com>.

It does not make a fair or noncommercial use of the disputed domain name.

Given the notoriety of the Complainant's in the field of higher education and the fact that the disputed domain name was used to resolve to a website offering "online materials" in relation with the Complainant, the Panel finds that the Respondent was well aware of the Complainant's rights in the well-known UOPX and UNIVERSITY OF PHOENIX trademarks when it registered the disputed domain name. It constitutes bad faith registration.

The Panel is of the opinion that this use satisfies the requirement of paragraph (4)(b)(iv) of the policy "by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your web site or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of your web site or location or of a product or service on your web site or location".

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **UOPSTUDY.COM**: Transferred

PANELLISTS

Name	**Marie-Emmanuelle Haas, Avocat**

DATE OF PANEL DECISION 2020-11-02

Publish the Decision