Decision for dispute CAC-UDRP-103257

Case number	CAC-UDRP-103257
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Domain names	UOPcourses.com

Case administrator

Organization	Iveta Špiclová (Czech Arbitration Court) (Case admin)

Complainant

Organization	The University of Phoenix, Inc

Complainant representative

Organization	RODENBAUGH LAW

Respondent

Name	Ping 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 names.

IDENTIFICATION OF RIGHTS

The Complainant bases its Complaint on several trademark registrations, namely:

Trademark: UNIVERSITY OF PHOENIX
Reg. No.: 1540927
DOFU: June 16, 1980
Reg. Date: May 23, 1989

Trademark: UOPX
Reg. No.: 3716563
DOFU: July 17, 2009
Reg. Date: November 24, 2009

Trademark: UNIVERSITY OF PHOENIX (logo)
Reg. No.: 2089210

DOFU: August 1, 1989
Reg. Date: August 19, 1997

Trademark: UNIVERSITY OF PHOENIX (logo)
Reg. No.: 3431022
DOFU: September 1995
Reg. Date: May 20, 2008

Trademark: UNIVERSITY OF PHOENIX (logo)
Reg. No.: 3988757
DOFU: July 9, 2010
Reg. Date: June 5, 2011.

FACTUAL BACKGROUND

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

PRELIMINARY ISSUE:

According to the Rules for Uniform Domain Name Dispute Resolution Policy, a complaint may relate to more than one domain name, provided that the domain names are registered by the same domain-name holder.

In this case, the Complaint relates to two domain names, <uopcourses.com> and <uopstore.com>, and although they seem to have different registrants, considering the information received from the registrars of these domain names, the disputed domain names resolve to essentially identical websites, including but not limited to the same format, color scheme, contact e-mail address on the home page (uoptutorialstore.com@hotmail.com), and even the same copyright notification at the bottom of each home page.

The Panel agrees that either the registrant of the disputed domain names is the same person and/or entity, or at the very least they both are under common control the same person and thus, the complaint is receivable as a single one for both disputes domain names.

FACTUAL BACKGROUND

The University of Phoenix, Inc. (“UOPX” or “Complainant,”) is a United States company 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 institutions of higher education.

The Complainant asserts to have continually used the UNIVERSITY OF PHOENIX, UOPX and UNIVERSITY OF PHOENIX logo trade marks since at least 1980.

The Complainant owns the above stated UNIVERSITY OF PHOENIX, UOPX trade mark registrations, all of which predate the registration of the disputed domain names.

The disputed domain name <uopcourses.com> has been registered on October 27, 2015, while <uopstore.com> has been registered on December 7, 2018 and the services provided by the Respondent under the disputed domain names are related to education as the services provided by the Complainant.

The disputed domain names both resolve to identical websites that include a list of Complainant’s courses on the right hand side menu, as per the assertion of the Complainant.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

The Complainant's contentions are the following:

The disputed domain names <uopcourses.com> and <uopstore.com> is confusingly similar to the Complainant's earlier trademarks UNIVERSITY OF PHOENIX and UOPX. The trademark UNIVERSITY OF PHOENIX is incorporated as an acronym and/or abbreviation for a Complainant's registered marks, while the UOPX are incorporated without the letter X.

The Complainant sustains that the omission of the letter 'X' within each of the disputed domain names is a minor change that will not be readily perceived by most Internet users. Moreover, the UOPX mark serves as an acronym for 'University of Phoenix' and is therefore pronounced by stating each letter separately, i.e. U-O-P-X; similarly the domain name plays off of the same acronym and is therefore also pronounced U-O-P, merely dropping the letter "X". Accordingly, the overall impression of the <uopcourses.com> and <uopstore.com> domain names and the UOPX mark are similar and enough to sustain a finding of confusing similarity.

Through long standing use by the Complainant, the UNIVERSITY OF PHOENIX and UOPX marks are famous both in the United States and throughout the world. The Complainant has invested copious amounts of time and money in growing UOPX and UNIVERSITY OF PHOENIX brand. As such, consumers around the world have come to associate UOPX with the UOPX and UNIVERSITY OF PHOENIX mark and brand.

The Complainant asserts that by the addition of the generic terms 'courses' and/or 'store' the disputed domain names are similar in overall commercial impression to Complainant's earlier trade marks.

Finally, the addition of the generic top-level domain ".com" does nothing to distinguish the disputed domain name from the Complainant's UOPX or UNIVERSITY OF PHOENIX marks.

Therefore, in the Complainant's view the <uopcourses.com> and <uopstore.com> domain names are confusingly similar to Complainant's UOPX and UNIVERSITY OF PHOENIX trade marks.

The Complainant further contends that the Respondent lacks rights or legitimate interests in the disputed domain names for a number of reasons.

First, the Complainant sustains that, the Respondent not only registered the disputed domain names years after Complainant's rights in the UOPX and UNIVERSITY OF PHOENIX marks arose, but is using the disputed domain names to direct Internet users to a website that sells University of Phoenix course specific discussion questions, papers, exams, and other materials, while directly referring to Complainant through the infringing websites, thereby directly profiting from Complainant's goodwill in the UOPX and UNIVERSITY OF PHOENIX marks.

Further, the Complainant asserts that the Respondent does not use, and has not used, the disputed domain names in connection with a bona fide offering of goods or services as the use of the disputed domain names is made to commercially benefit from Complainant's goodwill. The Complainant asserts that the Respondent uses the disputed domain names to direct Internet users to infringing websites, which sell University of Phoenix course-specific materials. The fact that Respondent repeatedly refers to Complainant by Complainant's UNIVERSITY OF PHOENIX mark within the website text, links to Complainant's own online e-campus portal (without any warning that users are leaving the infringing websites), and refers to itself as the "UOP tutorial store" leaves no question that Respondent is only attempting to profit from Complainant's goodwill.

The Complainant also asserts that the Respondent is not commonly known by the disputed domain names and that the Respondent does not use the disputed domain names for any legitimate or noncommercial fair use. The use of a domain

name to confuse or divert Internet traffic is not a legitimate use of a domain name.

Given the above facts, the Complainant considers that the Respondent has no rights or legitimate interests in respect of the disputed domain names.

Further, the Complainant contends that the Respondent has registered and used the disputed domain names in bad faith.

The Complainant asserts that the Respondent has registered and/or uses the disputed domain names in bad faith as the purpose of the registration was to confuse consumers as to the source of the website.

In the Complainant's view, the Respondent is clearly attempting to create a likelihood of confusion as to the source, sponsorship, affiliation and/or endorsement of the infringing websites by making use of Complainant's UNIVERSITY OF PHOENIX mark without authorization, and clearly using such mark to refer directly to Complainant, even including a link to Complainant's website.

The use of the UOP acronym (which is almost identical to Complainant's UOPX mark) in connection with the words 'courses' and/or 'store' within the disputed domain names themselves is enough to lead students to believe that the infringing websites are sponsored by Complainant.

Additionally, once a user arrives at the infringing websites they are presented with a homepage that boasts hundreds of links that directly correspond to University of Phoenix courses. The links, which correspond directly to University of Phoenix course numbers, direct users to various pages that sell course materials. For example, the link for 'ACC 291' directs users to a page where they can purchase a document titled "ACC 291 Week 5 Final Exam", where the detailed description contains sample test questions. This is all in addition to numerous references to Complainant and a link to Complainant's own website. This is clear evidence that Registrant is attempting to pose as and/or infer a connection or sponsorship with UOPX in an effort to cause consumer confusion.

Therefore, in the Complainant's view, Respondent's actions in connection with the disputed domain names amounts to bad faith use and registration.

The Complainant further asserts that the Respondent has registered the disputed domain names primarily for the purpose of disrupting Complainant's business. 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.

Moreover, the fact that Respondent has undertaken such actions only after Complainant's trademark rights arose is further evidence of a bad faith registration for the sole purpose of disrupting Complainant's business for Respondents own commercial gain.

Respondent was or should have been aware of UOPX rights in the UNIVERSITY OF PHOENIX and UOPX trade marks and registered the disputed domain names in bad faith.

Further, the Complainant argues that the disputed domain names were created decades after Complainant's trademark rights arose as Complainant registered the UNIVERSITY OF PHOENIX mark in 1989, and the UOPX mark in 2009. Accordingly, Complainant's rights predate Respondent's registration of the disputed domain names by at least 35 years. Respondent's use of the UNIVERSITY OF PHOENIX mark and confusingly similar UOP mark suggests, rather, that Respondent was acutely aware of Complainant's rights and undertook such action deliberately.

Thus, on these bases, the Complainant sustains that it is clear that Respondent knowingly registered and has used the disputed domain names to not only confuse customers as to the source of the infringing websites, but also to disrupt Complainant's business, evidencing Respondent's bad faith use and registration of the disputed domain names.

The Complainant has, to the satisfaction of the Panel, shown the disputed domain names are 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

The Complainant has, to the satisfaction of the Panel, shown the Respondent to have 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, to the satisfaction of the Panel, 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.

PRINCIPAL REASONS FOR THE DECISION

I. Confusing Similarity

The Panel agrees that the disputed domain names <uopcourses.com> and <uopstore.com> incorporates the Complainant's earlier UNIVERSITY OF PHOENIX trade mark as an acronym and/or abbreviation, as well as the UOPX trade mark, without the letter 'X, that the omission of the letter 'X' and the addition of the generic terms 'courses' and/or 'store' is not sufficient to escape the finding that the domain names are confusingly similar to the earlier trademarks UNIVERSITY OF PHOENIX and UOPX.

Moreover, the extension ".com" is not to be taken into consideration when examining the similarity between the Complainant's trademarks and the disputed domain names (WIPO Case No. D2005-0016, Accor v. Noldc Inc.). The mere adjunction of a gTLD such as ".com" is irrelevant as it is well established that the generic Top Level Domain is insufficient to avoid a finding of confusing similarity (WIPO Case No. 2013-0820, L'Oréal v Tina Smith, WIPO Case No. D2008-0820 Titoni AG v Runxin Wang and WIPO Case No. D2009-0877, Alstom v. Itete Peru S.A.).

Therefore, the Panel is satisfied that the first condition under the Policy is met.

II. Lack of Respondent's rights or legitimate interests

The complainant is required to make out a prima facie case that the respondent lacks rights or legitimate interests. Once such prima facie case is made, the burden of proof shifts to the respondent to come forward with appropriate allegations or evidence demonstrating rights or legitimate interests in the domain name. If the respondent fails to come forward with such appropriate allegations or evidence, a complainant is generally deemed to have satisfied paragraph 4(a)(ii) of the Policy.

Based on the available evidence, the Respondent is not a licensee of, nor has any kind of relationship with, the Complainant, which has several earlier UNIVERSITY OF PHOENIX and UOPX trademark registrations. Also, the Respondent is not commonly known by the disputed domain names. The Complainant has never authorised the Respondent to make use of its trademarks, nor of a confusingly similar trade mark in the disputed domain names.

Also, the Respondent has registered the disputed domain names much later after the registration Complainant's UOPX and UNIVERSITY OF PHOENIX trade marks. Based on the evidences provided by the Complainant, the Respondent directs Internet users to websites that sell University of Phoenix course specific discussion questions, papers, exams, and other materials, while directly referring to Complainant through the infringing websites, thereby directly profiting from Complainant's goodwill in the UOPX and UNIVERSITY OF PHOENIX marks.

The Panel notes that the Respondent had an opportunity to comment on the Complaint's allegations by filing a Response, which the Respondent failed to do.

Thus, the Panel is satisfied that the Complainant has at least established a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain names. Accordingly, the Panel takes the view that also the second requirement under the Policy is met.

III. Bad Faith

Based on the filed evidences, the Complainant is a United States company that has pioneered higher education for the working learner. The Complainant offers quality academic programs, qualified faculty, and a comprehensive student experience that comprise a respected institutions of higher education. Through long standing use by the Complainant, the UNIVERSITY OF PHOENIX and UOPX marks are famous both in the United States and throughout the world. The Complainant has invested copious amounts of time and money in growing UOPX and UNIVERSITY OF PHOENIX brand. As such, consumers around the world have come to associate UOPX with the UOPX and UNIVERSITY OF PHOENIX mark and brand.

The Complainant has continually used the UNIVERSITY OF PHOENIX, UOPX and UNIVERSITY OF PHOENIX logo trade marks since at least 1980.

Therefore, the Panel concludes that at the time of registration of the disputed domain names, the Respondent was well aware of the Complainant's UNIVERSITY OF PHOENIX and UOPX trade marks and has intentionally registered the domain names <uopcourses.com> and <uopstore.com> in order to benefit from the reputation of the Complainant's previous trade marks.

In the present case, the following factors should be considered:

(i) the Complainant's UNIVERSITY OF PHOENIX and UOPX trade marks, which are earlier rights, are highly distinctive;

(ii) the Respondent failed to submit any response and has not provided any evidence of actual or contemplated good faith use of the disputed domain names;

(iii) the Respondent registered the disputed domain names containing an abbreviation and/or an acronym of a highly distinctive trade mark;

(iv) the Respondent has no business relationship with the Complainant, nor was ever authorised to use domain names similar to the Complainant's trade marks;

(v) the disputed domain names seem to be used in relation to websites that are presenting a homepage that boasts hundreds of links that directly correspond to University of Phoenix courses. The Respondent is thus, attempting to create a likelihood of confusion as to the source, sponsorship, affiliation and/or endorsement of the infringing websites by making use of Complainant's UNIVERSITY OF PHOENIX mark without authorization, and using such mark to refer directly to Complainant.

In light of the foregoing, the Panel concludes that the Respondent has registered and has been using the disputed domain names in bad faith. Thus, also the third and last condition under the Policy is satisfied.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **UOPCOURSES.COM**: Transferred
2. **UOPSTORE.COM**: Transferred

PANELLISTS

Name	**Delia-Mihaela Belciu**

DATE OF PANEL DECISION 2020-12-11

Publish the Decision