Decision for dispute CAC-UDRP-101935

Case number	CAC-UDRP-101935
Time of filing	2021-01-26 09:05:38
Domain names	ukofficeoffice.com, usofficeoffice.com, officeofficecomoffiice.com

Case administrator

Organization	Denisa Bilík (CAC) (Case admin)

Complainant

Organization	Microsoft Corporation

Complainant representative

Organization	Convey srl

Respondent

Organization	Aayun Khan

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other legal proceedings that are pending or decided and that relate to the Disputed Domain Names.

IDENTIFICATION OF RIGHTS

The Complainant states, and provides evidence to support, that it is the owner of certain trademark registrations that consist of or contain the mark OFFICE, including Int'l Reg. No. 1,175,022 (registered August 20, 2013) (the "OFFICE Trademark").

FACTUAL BACKGROUND

The Complainant states that it is "the world's biggest personal-computer software company"; that it "is amongst the leading players in the world hi-tech, with about 120 subsidiaries and 160.000 employees worldwide"; that it "is considered one of the Big Five companies in the U.S. information technology industry, along with Google, Apple, Amazon and Facebook"; and that in 2020 its "revenues were almost USD 143.000 million and its ranked number 21 in the 2020 Fortune 500 rankings of the largest United States corporations by total revenue."

The Complainant further states that it is the owner of multiple registrations for the OFFICE Trademark, which "is distinctive and well known all around the world and has been used for a software produced in several versions targeted towards different end-users and computing environments"; and that it "has been extensively using the 'OFFICE' denomination on all internet environments including and not limited to the company's official websites www.office.com...,

https://www.microsoft.com... and its official accounts on the major social networks such as LinkedIn, Instagram, Facebook, Twitter and blog."

The Disputed Domain Names were created on June 17, 2020 (<usofficeoffice.com>); July 4, 2020 (<ukofficeoffice.com>); and January 11, 2020 (<officeofficecomoffiice.com>). The Disputed Domain Names <usofficeoffice.com> and <officeofficecomoffiice.com> are being used in connection with websites that purport to provide information about "Microsoft Office," including downloading and activating software. The Disputed Domain Name <ukofficeoffice.com> is being used in connection with a website that states it "is for sale!"

The Complainant contends, in relevant part, as follows:

Paragraph 4(a)(i): The Complainant states that each of the Disputed Domain Names incorporates the OFFICE Trademark in its entirety; and that the addition of a "generic word" to the Disputed Domain Names is "insufficient in itself to negate confusing similarity between a trademark and a domain name."

Paragraph 4(a)(ii): Complainant states that Respondent has no rights or legitimate interests in respect of the Disputed Domain Names because, inter alia, "Respondent is not licensee, authorized agent of the Complainant or in any other way authorized to use Complainant's trademarks"; "Respondent is not commonly known by the Domain Names as individuals, business or other organization and their family names do not correspond to OFFICE or the Domain Names"; and "Respondent has not provided the Complainant with any evidence of the use of, or demonstrable preparations to use, the Domain Names in connection with a bona fide offering of goods or services before any notice of the dispute."

Paragraph 4(a)(iii): Complainant states that the Disputed Domain Names were registered and re being used in bad faith because, inter alia, "in light of the registration and intensive use of the trademark OFFICE since many years, the advertising and sales of the Complainant's products worldwide, the Respondents could not have possibly ignored the existence of the Complainant's trademark, confusingly similar to the Disputed Domain Names"; "actual knowledge of OFFICE trademark by Respondent at the time of the registration of the Domain Names is demonstrated by the facts that the Respondent provides guidelines and support services regarding OFFICE products and services and that the Respondent reproduces the Complainant's trademarks in the websites corresponding to the disputed Domain Names"; "the Domain Names resolve to websites where the OFFICE trademarks are misappropriated without the authorization, approval, or license of the Complainant providing information to download the Complainant's software programs and prima facie support services to internet users"; and "Respondent is disrupting the Complainant's the business and the reputation offering a false service of assistance to the Complainant's products, in light of the inactive email indicated on the websites corresponding to the Domain Name the internet users would never receive assistance."

PARTIES CONTENTIONS

No administratively compliant response has been filed.

RIGHTS

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 UDRP).

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 UDRP).

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 UDRP).

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

Identical or Confusingly Similar: Paragraph 4(a)(i):

Based upon the trademark registrations cited by Complainant, it is apparent that Complainant has rights in and to the BNP PARIBAS Trademark.

As to whether the Disputed Domain Names are identical or confusingly similar to the OFFICE Trademark, the relevant comparison to be made is with the second-level portion of the Disputed Domain Names only (i.e., "usofficeoffice", "ukofficeoffice", and "officeofficecomoffiice") because "[t]he applicable Top Level Domain ('TLD') in a domain name (e.g., '.com', '.club', '.nyc') is viewed as a standard registration requirement and as such is disregarded under the first element confusing similarity test." WIPO Overview of WIPO Overview 3.0, section 1.11.1.

Here, each of the Disputed Domain Names contains the OFFICE Trademark in its entirety. As set forth in section 1.7 of WIPO Overview 3.0, "in cases where a domain name incorporates the entirety of a trademark, or where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar to that mark for purposes of UDRP standing." Further, section 1.8 of WIPO Overview 3.0 states: "Where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element."

Accordingly, the Panel finds that Complainant has proven the first element of the UDRP.

Rights or Legitimate Interests: Paragraph 4(a)(ii)

Complainant states that Respondent has no rights or legitimate interests in respect of the Disputed Domain Names because, inter alia, "Respondent is not licensee, authorized agent of the Complainant or in any other way authorized to use Complainant's trademarks"; "Respondent is not commonly known by the Disputed Domain Names as individuals, business or other organization and their family names do not correspond to OFFICE or the Domain Names"; and "Respondent has not provided the Complainant with any evidence of the use of, or demonstrable preparations to use, the Disputed Domain Names in connection with a bona fide offering of goods or services before any notice of the dispute."

WIPO Overview 3.0, section 2.1, states: "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 production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element."

The Panel finds that Complainant has established its prima facie case and without any evidence from Respondent to the contrary, the Panel is satisfied that the Complainant has satisfied the second element of the UDRP.

Registered and Used in Bad Faith: Paragraph 4(a)(iii)

Whether a domain name is registered and used in bad faith for purposes of the UDRP may be determined by evaluating four (non-exhaustive) factors set forth in paragraph 4(b) of the UDRP: (i) circumstances indicating that the registrant has registered or the registrant 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 registrant's documented out-of-pocket costs

directly related to the domain name; or (ii) the registrant 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 registrant has engaged in a pattern of such conduct; or (iii) the registrant has registered the domain name primarily for the purpose of disrupting the business of a competitor; or (iv) by using the domain name, the registrant has intentionally attempted to attract, for commercial gain, Internet users to the registrant's website or other online location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of the registrant's website or location or of a product or service on the registrant's website or location.

As set forth in section 3.1.4 of WIPO Overview 3.0: "Panels have consistently found that the mere registration of a domain name that is identical or confusingly similar (particularly domain names comprising typos or incorporating the mark plus a descriptive term) to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith." Here, given the length of use of the OFFICE Trademark by Complainant and the size and scope of Complainant's business associated with the OFFICE Trademark, the Panel finds that the OFFICE Trademark is, for purposes of the Policy, famous or widely known.

As further set forth in section 3.1.4 of WIPO Overview 3.0, "seeking to cause confusion (including by technical means beyond the domain name itself) for the respondent's commercial benefit, even if unsuccessful" is evidence of bad faith. Content on websites associated with two of the Disputed Domain Names purporting to offer services related to the OFFICE Trademark is evidence of Respondent's attempt to cause confusion.

As set forth in section 3.1.1 of WIPO Overview 3.0, "the respondent's likely knowledge of the complainant's rights", "a pattern of abusive registrations by the respondent", and "failure of a respondent to present a credible evidence-backed rationale for registering the domain name" – all of which are applicable here – are evidence of bad faith under paragraph 4(b)(i) of the Policy.

Further, given the three Disputed Domain Names in this proceeding, the Panel finds that Respondent has engaged in a "pattern of such conduct," further establishing bad faith under paragraph 4(b)(ii) of the Policy.

Accordingly, the Panel finds that the Complainant has proven the third element of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **UKOFFICEOFFICE.COM**: Transferred
2. **USOFFICEOFFICE.COM**: Transferred
3. **OFFICEOFFICECOMOFFIICE.COM**: Transferred

PANELLISTS

Name	**Douglas M. Isenberg**

DATE OF PANEL DECISION 2021-03-03

Publish the Decision