

Decision for dispute CAC-UDRP-105211

Case number CAC-UDRP-105211

Time of filing 2023-02-17 09:51:52

Domain names turnitincn.com

Case administrator

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

Complainant

Organization Turnitin LLC

Complainant representative

Organization Stobbs IP

Respondent

Organization zhou qin yan (shang hai you ni qi ke wang luo ke ji you xian gong si)

Respondent representative

Organization Tianhe Law Firm

OTHER LEGAL PROCEEDINGS

The Respondent contends that it filed a lawsuit with the Chinese court for confirmation that the disputed domain name does not infringe the Complainant's trademark rights. To support its contention, it provides a screenshot of the website of the relevant Chinese court. The Panel notes from this screenshot that a case number is not given, and that neither claims nor substantive reasons are stated. It indicates that the amendment for rectifying deficiencies has not been filed. Therefore, the Panel cannot find any clue to see if this lawsuit is relevant to the disputed domain name.

IDENTIFICATION OF RIGHTS

The Complainant owns the USPTO trademark registration number 2812598 for the mark "TURNITIN" registered on February 10, 2004; and trademark registration number 3106628 for the mark "TURNITIN Logo [stylized arrow/sheet of paper] version 2" registered on June 20, 2006 in class 41; educational services, namely, providing online grading, statistical analysis, plagiarism detection, peer review, class assignment submission and retrieval, and class information services accessible through the Internet or

through an intranet.

FACTUAL BACKGROUND

The Complainant is an American company founded in 1998. It provides online plagiarism detection services and research integrity solutions for universities, corporations, and publishers globally and is currently licensed to over 15,000 academic institutions and has over 30 million student users. The Complainant also offers a plagiarism detection service for newspaper editors as well as book and magazine publishers called "iThenticate." The Complainant is the owner of the domain name <turnitin.com>, which was registered in 1999 and is actively used for the purposes of a global website promoting the TURNITIN brand online for over 20 years.

The disputed domain name was initially created on March 14, 2015, and it was acquired by the Respondent on December 3, 2019. The disputed domain name resolves to a website offering "thesis detection software," the website of which is comprised of the international version and the UK version.

PARTIES CONTENTIONS

Complainant

- i) The Complainant has rights in the marks "TURNITIN" and "TURNITIN Logo [stylized arrow/sheet of paper] version 2" as identified in the section 'Identification of Rights' above. The disputed domain name is confusingly similar to the Complainant's mark because the disputed domain name incorporates the Complainant's mark in its entirety with the addition of the letters "cn," commonly understood as a country suffix for China.
- ii) The Respondent has never been known as 'TURNITIN' at any point in time. The unauthorized use of the name "TURNITIN" at the disputed domain name by the Respondent could constitute trademark infringement of the Complainant's prior rights in the mark. Therefore, the Respondent failed to use the disputed domain name in connection with a bona fide offering of goods or services. The use of the disputed domain name by the Respondent does not constitute a legitimate non-commercial or fair use of the domain name.
- iii) The Respondent registered and uses the disputed domain name in bad faith. The Respondent's website purports to offer "TURNITIN" plagiarism detection software using the Complainant's "TURNITIN" word mark and the Logo mark "TURNITIN [stylized arrow/sheet of paper]" and attempts to commercially benefit by creating likelihood of confusion as to the Complainant's endorsement of the disputed domain name and the resolving website.

Respondent

- i) The term "turn it in" is a simple English word collocation, with fixed meaning, belongs to the general vocabulary, not significant. The Respondent's offered goods at the disputed domain name's resolving website are not similar to the goods or services of the Complainant's trademark rights.
- ii) The disputed domain name (registered 14 March 2015) predates the Complainant's trademark Reg. No. 23476007 in China (registered 28 March 2018). The services "educational services" in Class 41 are different from the "thesis detection software and its relevant services" which are offered at the disputed domain name's resolving website. The Respondent did not use the Complainant's mark but used the Chinese trademark Reg. No. 7590532 for the mark "Turnitin in combination of a device [stylized arrow/sheet of paper]," which is different from the Complainant's mark. On the basis of obtaining the legitimate authorization from the trademark holder for trademark Reg. No. 7590532 for "TURNITIN", the Respondent uses the authorized trademark in the disputed domain name in good faith. The disputed domain name enjoys a certain degree of consumer recognition as shown in the Baidu search results by a keyword "English thesis heavy detection software," which displays the disputed domain name in the forefront.
- iii) The registration and use of disputed domain name are not in bad faith. The Respondent acquired the disputed domain name not for sale, lease or any other form of transfer to the Complainant or its competitors for commercial gain. The Respondent acquired the disputed domain name for the common use of the phrase "turn it in" and not to prevent the Complainant from using the disputed domain name on the Internet to reflect its trademark. The Respondent has no intention of undermining the normal business of competitors. The Respondent provides software commodities at the disputed domain name's resolving website, which is not identical or similar to the Complainant's main business. The Respondent did not intentionally cause confusion with the Complainant's mark for its goods or services by linking the source, sponsor or associate to attract Internet users to access the disputed domain name. The software products provided by the Respondent are not identical or similar to those of the Complainant. The Complainant already has a certain reputation in China, and Chinese Internet users will not associate a relationship between the disputed domain name and the Complainant.

RIGHTS

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

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 name (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 name has been registered and is being used in bad faith (within the meaning of paragraph 4(a)(iii) of the Policy).

PROCEDURAL FACTORS

1. Language of the Proceedings

The Panel notes that the Registration Agreement is written in Chinese, thereby making the language of the proceedings in Chinese. The Panel has discretion to determine the appropriate language of the proceedings on appointment. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Ed. (hereinafter referred to as "WIPO Overview 3.0"). In accordance with the Rules of UDRP, paragraphs 11(a), 10(b) and 10(c), the Complainant requests that the proceedings be conducted in English and that the Complaint should be accepted in the language filed (which is English) for the reasons: (i) the disputed domain name is in English; and (ii) allowing the proceeding to be in Chinese may result in delay, and considerable and unnecessary expense of translating documents. The Respondent contends that Chinese should be used as the language of the proceedings (i) because the language of the Registration Agreement is in Chinese; and (ii) the Respondent must respond within 20 days of receiving the Complaint, and if the administrative proceeding uses English as the language of procedure, the respondent will be disadvantaged. Given the contentions of the Complainant and the Respondent above, the Panel accepts the Complaint filed in English and the Response filed in Chinese. The Panel will render its decision in English.

2. Other Legal Proceedings

The Respondent contends that it filed a lawsuit with the Chinese court for confirmation that the disputed domain name does not infringe the Complainant's trademark rights. Therefore, the Panel should extend the period of administrative procedures, give the Respondent more time to respond to the Complaint, or suspend or terminate the administrative proceedings until the conclusion of the lawsuit at the Chinese court. Paragraph 18(a) of the UDRP Rules gives the panel discretion to suspend, terminate, or continue a UDRP proceeding where the disputed domain name is also the subject of other pending legal proceedings. The Panel notes that panels are reluctant to suspend a UDRP case due to concurrent court proceedings, most notably because of the potential for indeterminate delay (See Section 4.14.1, WIPO Overview 3.0). The Panel also observes that panels generally issue a UDRP decision on the merits even in an overlapping court-UDRP proceeding scenario where, notwithstanding the fact that a UDRP decision would not be binding on the court, the relative expediency of the UDRP versus courts is seen as a benefit to the parties. As previously noted, the Respondent provides a screenshot of the relevant Chinese court's website. The Panel notes from this screenshot that a case number is not given, and that neither claims nor substantive reasons are stated. It indicates that the amendment for correcting or supplementing deficiencies has not been filed. Therefore, the Panel cannot find any clue to see if this lawsuit is relevant to the disputed domain name. Even if the lawsuit with the Chinese court is for confirmation that the disputed domain name does not infringe the Complainant's trademark rights, the Panel is of the view that a UDRP decision would not be binding on the court and that the use of the disputed domain name which does not infringe the Complainant's trademark rights does not necessarily preclude a finding of bad faith in relation to this disputed domain name. Therefore, the Panel finds no reason to suspend or discontinue the proceedings, and finds it is proper to render the decision under the Policy.

3. Unsolicited Additional Submission

The Panel notes that the Complainant submitted an unsolicited additional submission on April 12, 2023. Paragraph 10 of the UDRP Rules enjoins the panel to conduct the proceeding "with due expedition." Therefore, UDRP panels are typically reluctant to countenance delay through additional rounds of pleading and normally accept supplemental filings only to consider material new evidence or provide a fair opportunity to respond to arguments that could not reasonably have been anticipated. The Panel finds it unnecessary and inappropriate to take into consideration the Complainant's Additional Submission to conduct the proceeding "with due expedition."

The Panel is satisfied that all other 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

Paragraph 15(a) of the Rules for the UDRP ('the Policy') instructs this Panel to "decide a complaint on the basis of the statements and documents submitted in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable."

Paragraph 4(a) of the Policy requires that Complainant must prove each of the following three elements to obtain an order that a domain name should be cancelled or transferred:

- (1) the domain name registered by respondent is identical or confusingly similar to a trademark or service mark in which complainant has rights; and
- (2) respondent has no rights or legitimate interests in respect of the domain name; and
- (3) the domain name has been registered and is being used in bad faith.

Rights

The Complainant claims rights in the marks "TURNITIN" and "TURNITIN Logo [stylized arrow/sheet of paper] version 2" as identified in the section 'Identification of Rights' above. The Panel notes that the USPTO trademark registrations are sufficient to establish rights in the marks. As such, the Panel finds that the Complainant has established its rights in the mark "TURNITIN" and "TURNITIN Logo [stylized arrow/sheet of paper] version 2." The Complainant contends that the disputed domain name is confusingly similar to the Complainant's mark because the disputed domain name incorporates the Complainant's mark in its entirety with the addition of the letters "cn," commonly understood as a country suffix for China.

The Respondent contends that the term "turn it in" is a simple English word collocation, with fixed meaning, belongs to the general vocabulary, not significant. In addition, the respondent's offered goods at the disputed domain name's resolving website are not similar to the goods or services of the Complainant's trademark rights.

However, the Panel finds that the Complainant's mark is not generic or descriptive in connection of the goods or services covered by the Complainant's marks. Furthermore, the goods and/or services for which the mark is registered or used in commerce, are not considered relevant to the test of Policy paragraph 4(a)(i). In addition, the addition of a generic or descriptive phrase and gTLD generally fails to sufficiently distinguish a disputed domain name from a mark per Policy paragraph 4(a)(i). See *Microsoft Corporation v. Thong Tran Thanh*, FA 1653187 (Forum Jan. 21, 2016) (determining that confusing similarity exists where [a disputed domain name] contains complainant's entire mark and differs only by the addition of a generic or descriptive phrase and top-level domain, the differences between the domain name and its contained trademark are insufficient to differentiate one from the other for the purposes of the Policy). Therefore, the Panel finds the disputed domain name is confusingly similar to the Complainant's mark per Policy paragraph 4(a)(i).

No rights or legitimate interests

The Complainant must first make a prima facie case that the Respondent lacks rights and legitimate interests in the disputed domain name under Policy paragraph 4(a)(ii), then the burden shifts to the Respondent to show it does have rights or legitimate interests. See *Croatia Airlines d. d. v. Modern Empire Internet Ltd.*, WIPO Case No. D2003-0455 (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 Respondent carries the burden of demonstrating rights or legitimate interests in the domain name. If the Respondent fails to do so, the Complainant is deemed to have satisfied paragraph 4(a) (ii) of the UDRP). See also *Advanced International Marketing Corporation v. AA-1 Corp*, FA 780200 (FORUM Nov. 2, 2011) (finding that a complainant must offer some evidence to make its prima facie case and satisfy Policy paragraph 4(a)(ii).

The Complainant contends that the Respondent has never been known as 'TURNITIN' at any point in time. The unauthorized use of the name "TURNITIN" at the disputed domain name by the Respondent could constitute trade mark infringement of the Complainant's prior rights in the mark. The Respondent has made use of a mark which is identical and/or highly similar in respect of goods that are identical and/or highly similar to those covered by the Complainant's marks. Therefore, consumers would likely believe that the goods or services offered by the Respondent under the sign TURNITIN as part of the infringing disputed domain name's website would be authorized, or somehow associated with the Complainant. The disputed domain resolves to a website, which makes use of the Complainant's brand assets including the word mark "TURNITIN" and the TURNITIN logo. Therefore, the Respondent failed to use the disputed domain name in connection with a bona fide offering of goods or services. For the same reasons, the use of the disputed domain name by the Respondent does not constitute a legitimate non-commercial or fair use of the domain name.

The Panel notes that the disputed domain name's resolving website prominently displays the Complainant's mark "TURNITIN" and "TURNITIN Logo [stylized arrow/sheet of paper] version 2," and offers competing goods and services i.e., "thesis detection software" and relevant services, which are competing with the Complainant's "online plagiarism detection services." The Panel finds that the use of the disputed domain name to pass the Respondent off as the Complainant does not constitute bona fide offering of goods or services, nor any legitimate non-commercial or fair use. The Panel further notes that nothing in the records suggests the Respondent is commonly known by the disputed domain name.

Given the considerations above, the Panel finds that Complainant has made out a prima facie case. As the onus thus shifts to the

Respondent, the Panel must now see if the Respondent has rebutted the prima face case and shown that it has a right or legitimate interest in the disputed domain name. The registration date of the disputed domain (registered 14 March 2015) predates the Complainant's trademark Reg. No. 23476007 in China (registered 28 March 2018). The services "educational services" in Class 41 are different from the "thesis detection software and its relevant services" which are offered at the disputed domain name's resolving website. The Respondent did not use the Complainant's mark but used the Chinese trademark Reg. No. 7590532 for the mark "Turnitin in combination of a device [stylized arrow/sheet of paper]," which is different from the Complainant's mark. On the basis of obtaining the legitimate authorization from the trademark holder for trademark Reg. No. 7590532 for "TURNITIN", the Respondent uses the authorized trademark in the disputed domain name in good faith. The disputed domain name enjoys a certain degree of consumer recognition as shown in the Baidu search results by a keyword "English thesis heavy detection software," which displays the disputed domain name in the forefront. To support its arguments, the Respondent provides a grant of trademark license for trademark Reg. No. 7590532, and a screenshot of the Baidu search results.

The Panel notes that the grant of trademark license does not contain the licensed period. Furthermore, this document lacks the date of execution. Therefore, the Panel does not accept this document confirming the Respondent's license for the Chinese trademark Reg. No. 7590532. In addition, the Panel cannot rule out the possibility that the Baidu search results by a keyword "English thesis heavy detection software" retrieving the disputed domain name in the forefront is reverse evidence of confusion caused by passing off the disputed domain name's resolving website as the Complainant's. Furthermore, in the light of the reputation and goodwill of the Complainant's USPTO trademark registration number 2812598 for the mark "TURNITIN" (registered on February 10, 2004) and trademark registration number 3106628 for the mark "TURNITIN Logo [stylized arrow/sheet of paper] version 2" (registered on June 20, 2006) covering educational services including the plagiarism detection services, the Panel cannot preclude the possibility that the Chinese trademark Reg. No. 7590532 for the "TURNITIN Logo [stylized arrow/sheet of paper]" mark was registered in bad faith imitating the Complainant's marks which have been extensively used for offering online plagiarism detection services and other related services since 1998. As the Panel finds that the Respondent has failed to rebut the prima facie case against it, it concludes that the Respondent has no rights or legitimate interests in the disputed domain name.

Bad faith

The Complainant contends that the Respondent registered and uses the disputed domain name in bad faith. The Respondent's website purports to offer "TURNITIN" plagiarism detection software using the Complainant's "TURNITIN" word mark and the Logo mark "TURNITIN Logo [stylized arrow/sheet of paper]" and attempts to commercially benefit by creating likelihood of confusion as to the Complainant's endorsement of the disputed domain name and the resolving website.

The Respondent claims that the registration and use of disputed domain name are not in bad faith. The Respondent acquired the disputed domain name not for sale, lease or any other form of transfer to the Complainant or its competitors for commercial gain. The Respondent acquired the disputed domain name for the common use of the phrase "turn it in" and not to prevent the Complainant from using the disputed domain name on the Internet to reflect its trademark. The Respondent has no intention of undermining the normal business of competitors. The Respondent provides software commodities at the disputed domain name's resolving website, which is not identical or similar to the Complainant's main business. The Respondent did not intentionally cause confusion with the Complainant's mark for its goods or services by linking the source, sponsor or associate to attract Internet users to access the disputed domain name. The software products provided by the Respondent are not identical or similar to those of the Complainant. The Complainant already has a certain reputation in China, and Chinese Internet users will not associate relationship between the disputed domain name and the Complainant.

The Panel observes that use of a disputed domain name to pass off as a complainant and offer competing or counterfeited goods may be evidence of bad faith per Policy paragraph 4(b)(iii) and (iv). See *Ripple Labs Inc. v. Jessie McKoy / Ripple Reserve Fund*, FA 1790949 (Forum July 9, 2018) (finding bad faith per Policy Paragraph 4(b)(iii) and (iv) where the respondent used the disputed domain name to resolve to a website upon which the respondent passes off as the complainant and offers online cryptocurrency services in direct competition with the complainant's business), see also *Guess? IP Holder L.P. and Guess?, Inc. v. LI FANGLIN*, FA 1610067 (Forum Apr. 25, 2015) (finding respondent registered and used the domain name in bad faith per Policy Paragraph 4(b)(iii) because the respondent used the resolving website to sell the complainant's products, using images copied directly from the complainant's website), see also *Bittrex, Inc. v. Wuxi Yilian LLC*, FA 1760517 (Forum Dec. 27, 2017) (finding bad faith per Policy Paragraph 4(b)(iv) where "Respondent registered and uses the <bittrex.com> domain name in bad faith by directing Internet users to a website that mimics Complainant's own website in order to confuse users into believing that Respondent is Complainant, or is otherwise affiliated or associated with Complainant.").

The Panel recalls that the Complainant provides screenshots of the disputed domain name's resolving website which prominently displays the "TURNITIN" word mark and [stylized arrow/sheet of paper] logo mark which are considered identical or confusingly similar to the Complainant's "TURNITIN" word mark and [stylized arrow/sheet of paper] logo mark. Furthermore, the Panel notes that the plagiarism detection software which are offered at the disputed domain name's resolving website is competing with the Complainant's online plagiarism detection services. The disputed domain name resolving website is comprised of the international version and the UK version, and thus the Respondent targets Internet users outside China as well as within China unlike the Respondent's arguments. Therefore, the Panel concludes that the Respondent registered and uses the disputed domain name in bad faith per Policy paragraph 4(b)(iii) and (iv).

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **turnitincn.com**: Transferred

PANELLISTS

Name	Mr. Ho-Hyun Nahm Esq.
------	-----------------------

DATE OF PANEL DECISION 2023-04-13

Publish the Decision
