Decision for dispute CAC-UDRP-106568

Case number	CAC-UDRP-106568
Time of filing	2024-05-30 08:52:58
Domain names	thepaysend.com

Case administrator

Name	Olga Slanařová (Case admin)

Complainant

Organization	PaySend Group Limited

Complainant representative

Organization	Motsnyi Consulting (dba Motsnyi Legal)

Respondent

Organization	Anonymouse Domains s.r.o

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, among other things, a registered owner of the following trademarks containing the word element "PAYSEND":

- PAYSEND (figurative), International Trademark, priority 11 September2015, registration date 13 October 2015, registration no. IR 1284999, registered for goods and services in classes 9 and 36;
- PAYSEND (word), International Trademark, priority 31 March2015, registration date 10 April2015, registration no. IR 1251936, registered for services in class 36;

besides other national and international trademarks consisting of or containing the "PAYSEND" denomination.

(Collectively referred to as "Complainant's trademarks").

The Complainant has also registered several domain names under generic Top-Level Domains ("gTLD") and country-code Top-Level Domains ("ccTLD") containing the term „PAYSEND" such as <PAYSEND.COM> and others.

Moreover, the word PAYSEND constitutes a significant part of the Complainant's company name.

FACTUAL BACKGROUND

The Complainant, PaySend Group Limited (“PaySend”), is a global FinTech company. Paysend was created with a vision to change the way people manage their everyday finances. Paysend was the first FinTech project to introduce international card-to-card transfers, allowing connections between 12 billion cards globally - Mastercard, Visa, China UnionPay and local card schemes.

Paysend currently serves over 7 (seven) million customers and operates in over 170 countries globally. It is one of the leaders in the area of online money transfers and received various awards including “PayTech 2018” – “Best Consumer Payments” and “FinovateSpring 2018”- Leading FinTech Product.

The Complainant has a strong social media presence, see Annex 3 for more information about Complainant’s social media accounts prior to the registration date of the disputed domain name.

The disputed domain name website (i.e. website available under the internet address containing the disputed domain name) contains merely (likely automatically generated) links to third party content (websites) and thus it has no genuine content.

The Complainant seeks transfer of the disputed domain name to the Complainant.

PARTIES CONTENTIONS

COMPLAINANT:

A) CONFUSING SIMILARITY

The Complainant states that:

- The disputed domain name contains the "PAYSEND " word element of the Complainant's trademarks in its entirety.
- In addition, the disputed domain name contains only a word element “THE”, which stands for definite article in the English language and has no distinctive character.
- Thus, according to the Complainant, the confusing similarity between the Complainant’s trademarks and the disputed domain name is clearly established.

B) NO RIGHTS OR LEGITIMATE INTERESTS

The Complainant states that:

- The Respondent has not been commonly known by the disputed domain name.
- The Complainant has not authorized, permitted or licensed the Respondent to use the Complainant’s trademarks in any manner. The Respondent has no connection or affiliation with the Complainant whatsoever. On this record, Respondent has not been commonly known by the disputed domain name.
- Furthermore, the disputed domain name website has not been used for any legitimate or fair purposes.

C) BAD FAITH REGISTRATION AND USE

The Complainant states that:

- Seniority of the Complainant's trademarks predates the disputed domain name's registration and such trademarks are well known in relevant business circles. The Respondent can be considered aware of the Complainant's trademarks when registering the disputed domain name due to the well-known character thereof.
- The disputed domain name (at the time of filing of the complaint) is not used for any bona fide offerings. More particularly, there are present circumstances indicating that, by using the domain name, the Respondent has registered the disputed domain name primarily for creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of his website.
- The disputed domain name represents a clear case of so-called “phishing” which means that the disputed domain name is intended to defraud the Complainant’s customers.

RESPONDENT:

The Respondent has not provided any response to the Complaint.

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

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

RIGHTS

The disputed domain name and the Complainant’s trademarks are not identical. Therefore, the key element investigated and considered by the Panel is whether the disputed domain name is confusingly similar to the Complainant’s trademarks.

The threshold test for confusing similarity under the UDRP involves a comparison between the trademark and the disputed domain name itself to determine the likelihood of Internet user confusion. In order to satisfy this test, the relevant trademark would generally need to be recognizable as such within the disputed domain name. The addition of common, dictionary, generic, or other descriptive terms is typically insufficient to prevent threshold Internet user confusion. Confusing similarity tests under the UDRP typically involve a straightforward visual and aural comparison of the trademark with the domain name in question.

Applying the principles described above, the Panel contends that incorporation of a dominant "PAYSEND" element of the Complainant’s trademarks (which standalone enjoys a high level of distinctiveness) into the disputed domain name constitutes a confusing similarity between the Complainant’s trademark and the disputed domain name.

The addition of a non-distinctive element – a definite article “THE” that has no meaning in English – cannot escape association in the eyes of internet consumers between the disputed domain name and the Complainant’s trademarks and thus the likelihood of confusion still exists. On the contrary, it may mislead the internet users that the disputed domain name is somehow related to the Complainant's business.

For the sake of completeness, the Panel asserts that the top-level suffix in the disputed domain name (i.e. the “.com”) must be disregarded under the identity and confusing similarity tests, as it is a necessary technical requirement of registration.

Therefore, the Panel has decided that there is identity in this case, it also concludes that the Complainant has satisfied paragraph 4(a)(i) of the Policy.

NO RIGHTS OR LEGITIMATE INTERESTS

The Complainant’s assertions that the Respondent is not commonly known by the disputed domain names and is not affiliated with nor authorized by the Complainant are sufficient to constitute a prima facie showing of absence of rights or legitimate interest in the disputed domain name on the part of the Respondent.

Given the facts above and in the absence of the Respondent's response, the Panel concludes that there is no indication that the disputed domain name was intended to be used in connection with a bona fide offering of goods or services as required by UDRP.

Consequently, the evidentiary burden shifts to the Respondent to show by concrete evidence that it does have rights or legitimate interests in that name. However, the Respondent failed to provide any information and evidence that it has relevant 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 Respondent has not used the disputed domain name in any manner, however, the Panel concludes (as it has been ruled in many similar cases, as for example Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case No. D2000-0003, <telstra.org>, Jupiters Limited v. Aaron Hall, WIPO Case No. D2000-0574, <jupiterscasino.com>, Ladbroke Group Plc v. Sonoma International LDC, WIPO Case No. D2002-0131, <ladbrokespoker.com>) that the apparent lack of so-called active use (e.g., to resolve to a website) of the domain name without any active attempt to sell or to contact the trademark holder (passive holding), does not as such prevent a finding of bad faith.

Examples of what may be cumulative circumstances found to be indicative of bad faith include cases in which (i) the Complainant has a well-known trademark and (ii) there is no genuine use (e.g. a mere "parking" website) of the disputed domain name by the Respondent (irrespective of whether the latter should also result in the generation of incidental revenue from advertising referrals).

Also, the use of the term PAYSEND in its entirety indicates that the disputed domain name might be intended for "phishing" purposes. Such practice consists of attracting customers to a web page that imitates the real page of the Complainant (i.e. website of a financial institution) with the intention to mislead such users and have them disclose confidential information.

All of the activities above are considered malicious activities.

It is well-founded that registration of the disputed domain name that is confusingly similar to the Complainant's trademarks which enjoys a strong reputation, plus other facts, such as above-described unfair use of the disputed domain name, are sufficient to establish bad faith under the 4(a)(iii) of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **thepaysend.com**: Transferred

PANELLISTS

Name	**Jiří Čermák**

DATE OF PANEL DECISION 2024-07-09

Publish the Decision