Decision for dispute CAC-UDRP-106830

Case number	**CAC-UDRP-106830**
Time of filing	**2024-09-04 09:24:26**
Domain names	**paysend.business**

Case administrator

Name	**Olga Slanařová (Case admin)**

Complainant

Organization	**PaySend Group Limited**

Complainant representative

Organization	**Motsnyi IP Group (dba Motsnyi Legal)**

Respondent

Name	**Ishara Lakshan**

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 inter alia the following trade marks incorporating the “Paysend” word element:

- International TM registration ("IR") No.**1284999** for “PAYSEND” (word + device), registered on 13 October 2015, in inter alia in the following jurisdictions: the United States, the UK, Turkey, Spain, Poland, Portugal, Germany, Benelux, Switzerland, Sweden, France, Italy, Ukraine, Kazakhstan, Mexico, New Zealand, Zambia, Zimbabwe, the African Intellectual Property Organization, Singapore in class 09 and class 36;
- IR No.**1251936** “PAYSEND” (word), registered on 10 April 2015, and subsequently designated in the following jurisdictions: the United States, Armenia, Belarus, Bosnia and Herzegovina, Benelux, Ireland, Hungary, Switzerland, China, Colombia, Spain, Sweden, the UK, Greece, France, India, Italy, Mexico, New Zealand, Poland, Singapore, Turkey, Kazakhstan, Ukraine, Mexico, New Zealand, the African Intellectual Property Organization in class 36+
- IR No. **1539382** “PAYSEND Money for the future” (word + device), registered 30 May 2020, and subsequently designated in the following the United States, the UK, Turkey, Ukraine, Australia, Austria, Brazil, Benelux, Belarus, Canada, Spain, Indonesia, Iceland, Switzerland, Republic of Korea, New Zealand, Japan, the African Intellectual Property Organization (OA), in class 9 and class 36;
- R No. **1735950** "PAYSEND Libre" (word), registered 23 February 2023, and protected inter alia in the EU, Switzerland, Australia, the Philippines and Turkey in class 9 and class 36;
- The Complainant also owns and operates various domain names (both gTLDS and ccTLDS) incorporating its “Paysend” trademark, including its main domain <paysend.com>.

FACTUAL BACKGROUND

The Complainant, PaySend Group Limited, is a global FinTech company and a leader in international card-to-card transfers. Since its founding in 2017 it has launched a number of products, including “Paysend Global Transfers”, “Paysend Global Account”, “Paysend Connect”, “**Paysend Business**” and “Paysend Libre”. It 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 disputed domain name was registered on 13 August 2024. The disputed domain is “Paysend” mark plus the <.business> gTLD. On the date of the complaint the disputed domain name does not resolve to an active website.

PARTIES CONTENTIONS

The Complainant contends that the requirements of the Policy have been met and that the disputed domain name should be transferred to it.
No administratively compliant Response has been filed.

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 CAC received a reply to a written notice sent to the physical address of the respondent stating: “I have lived at the address below for the last 15 years and can confirm that nobody by the name of Ishara Lakshan has lived here in that me and I do not know anyone of that name.”

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 Complainant has registered marks and so Rights under the Policy in the distinctive term Paysend. It is inherently distinctive and more than the sum of its parts. See also previous CAC decisions, **CAC Case No. 104089** (<paysend.money>) and **CAC Case No.105334** (<paysend.website>). The Complaint claims that its “Paysend” trademark is well-known in the field of online payments and money transfers and was so prior to the registration date of the disputed domain name. The disputed domain name uses the distinctive name and mark in its entirety. It is therefore identical. This is often found to be impersonation. While the suffix is usually irrelevant to similarity, as are the addition of generic terms, such as business, in this case the selection of the <.business> gTLD compounds the similarity as the Complainant offers a product called Paysend Business. It was carefully selected and this is relevant to the third limb of the Policy.

While the words "pay" and "send" are ordinary words, their combination is distinctive to the Complainant. There is no use by the Respondent for fair or legitimate use and while passive holding is not per se bad faith, it is highly fact dependant. The criteria set

forth in sec. 3.3 of WIPO Overview 3.0 and in the "Telstra" decision, Telstra Corporation Limited v. Nuclear Marshmallows", WIPO Case No. D2000-0003, need to be considered. In particular: (i) the Complainant's mark needs to have a strong reputation or be highly distinctive and (ii) the (im)plausibility of any good faith use to which the disputed domain name should be considered. Here we do not know if the MX records were configured but where there is no use, often the purpose is email use and phishing. 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.

As to bad faith, as noted in relation to the first factor, careful thought has gone into the selection of the elements of the disputed domain name so that it is identical to the well-known product offered by the Complainant. The Respondent has not come forward with any innocent or indeed any explanation as to the selection of the disputed domain name. Therefore, given the facts and the totality of circumstances of this case the Panel finds that the Telstra criteria is met and registration and use of the disputed domain name clearly indicates intent to take an unfair advantage (taking into account the composition of the disputed domain name, timing of registration of the disputed domain name and reputation of the Complainant's mark).

The Panel finds that the Complainant has discharged its burden.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **paysend.business**: Transferred

PANELLISTS

Name	**Victoria McEvedy**

DATE OF PANEL DECISION 2024-10-14

Publish the Decision