

Decision for dispute CAC-UDRP-104506

Case number	CAC-UDRP-104506
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Time of filing	2022-05-26 09:26:26
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Domain names	edubirdies.net
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Case administrator

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

Organization	RADIOPLUS EXPERTS LTD
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Respondent

Name	Nathan Lukayo
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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 has adduced evidence that the Panel accepts that there are trademarks for EDUBIRDIE that have been registered in various jurisdictions around the world by Plan B Services LLC and of which the Complainant is the licensee pursuant to the Trademark License Agreement between Plan B Services LLC and the Complainant which is dated January 14, 2022 and which is current and in evidence. Those trademarks are all for EDUBIRDIE and are:

1. International trademark 1401021, registered on August 31, 2017;
2. Australian trademark 1925707, registered on August 31, 2017 and enjoying a priority since April 24, 2017;
3. US Registration Number 5699892, registered on March 19, 2019 and enjoying a priority since August 31, 2017;
4. Canadian trademark TMA1019056, registered on April 10, 2019 and enjoying a priority since September 13, 2017,

("the EDUBIRDIE trademarks.")

FACTUAL BACKGROUND

The Complainant is a company domiciled in Cyprus that provides educational services such as a writing platform and related services.

The domain name under which the Complainant provides its services, namely <edubirdie.com>, was registered by its predecessor in title, Plan B Services LLC, on August 10, 2015. Pursuant to a Domain Name & Website Purchase Agreement of January 14, 2022 between Plan B Services LLC and the Complainant, the Complainant became the owner of the

<edubirdie.com> domain name, several related domain names, "all associated trademark rights..." and " ...attendant goodwill". That purchase agreement is in evidence.

The Complainant also became the Licensee of the EDUBIRDIE trademarks under which it also provides its services by means of the Trademark License Agreement between Plan B Services LLC and the Complainant which is dated January 14, 2022 and which is current and in evidence.

The Respondent registered the disputed domain name on December 14, 2020.

The Complainant has become aware that the Respondent has wrongly copied the EDUBIRDIE trademarks by registering and using the disputed domain name, <edubirdies.net>, and that it has since been passing itself off as the Complainant and offering similar services to those offered by the Complainant and that it is doing so for money. The Complainant has concluded that the conduct of the Respondent in that regard is misleading to the public and damaging to the Complainant and its brand and business. Hence it has brought this proceeding to have the disputed domain name transferred to itself.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

PARTIES' CONTENTIONS:

COMPLAINANT:

The disputed domain name is confusingly similar to the EDUBIRDIE trademarks in which the Complainant has the rights of a licensee and which are set out with more particularity above. The Complainant's domain name <edubirdie.com> was registered long before the disputed domain name <edubirdies.net> was registered. The difference between the domain names is minimal and the domain names are confusingly similar to the EDUBIRDIE mark. That is because the Respondent has merely added the letter "s" to the Complainant's trademark; the disputed domain name, based on the word "edubirdies", is thus a pluralised form of the word "edubirdie". Moreover, it has been registered in the ".net" gTLD instead of ".com" to give it an air of legitimacy.

The Respondent should be considered as having no rights and legitimate interests in respect of the disputed domain name. Specifically, neither the Complainant as licensee nor the registered owner of the EDUBIRDIE marks gave the Respondent a license or permission to use the mark in a domain name. Moreover, the Respondent's conduct has been deceptive, thus negating any possibility of it having a right or legitimate interest in the disputed domain name.

The disputed domain name was registered and is being used in bad faith. The Respondent uses the disputed domain name for its commercial benefit, as it sells writing services through its website.

The Respondent's web page at www.edubirdies.net is offering services that are indistinguishable from those supplied by the Complainant at the www.edubirdie.com website. Respondent does not identify itself as the provider of the services. Nothing on the website says that the services are not being supplied by or on behalf of the Complainant so as to give the false impression that they are provided by the Complainant.

RESPONDENT:

The Respondent did not file a Response in this proceeding.

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

DISCUSSION AND FINDINGS

This is a mandatory administrative proceeding pursuant to Paragraph 4 of the Uniform Domain Name Dispute Resolution Policy (the “Policy” or “UDRP”) of the Internet Corporation for Assigned Names and Numbers (“ICANN”), the Rules for Uniform Domain Name Dispute Resolution Policy (the “Rules”), and the CAC Supplemental Rules.

A. Administrative compliance

By notification dated May 26, 2022 and in accordance with paragraph 4 (b) of the Rules, the CAC notified the Complainant that the Complaint was administratively deficient in that the Complaint did not sufficiently identify the Respondent. The notification invited the Complainant to have regard to the Registrar’s verification available in the online case file in the form of a non-standard communication regarding the appropriate identification of the domain name holder. On May 30, 2022, the Complainant filed an Amended Complaint and the CAC determined also on May 30, 2022 that the Complaint should be admitted to proceed further in the Administrative Proceeding.

The Panel has reviewed all of the above matters and makes a finding that within the meaning of paragraph 4(b) of the Rules, the administrative deficiencies have been corrected and that this matter has proceeded properly to the Panel in accordance with the Policy and the Rules.

B. Substantive matters

Paragraph 15 of the Rules provides that the Panel is to decide the complaint on the basis of the statements and documents submitted and in accordance with the Policy, the Rules and any rules and principles of law that it deems applicable.

In that regard, the Panel also notes that the onus is on the complainant to make out its case and past UDRP panels have consistently said that a complainant must show that all three elements of the Policy have been made out before any order can be made to transfer a domain name.

The Panel therefore turns to discuss the various issues that arise for decision on the facts as they are known.

For the complainant to succeed it must prove, within the meaning of paragraph 4(a) of the Policy, that:

- (i) The domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights; and
- (ii) The respondent has no rights or legitimate interests in respect of the domain name; and

(iii) The domain name has been registered and is being used in bad faith.

The Panel will therefore deal with each of these requirements in turn.

A. Identical or Confusingly Similar

The Complainant has adduced evidence that the Panel accepts that there are trademarks for EDUBIRDIE that have been registered in various jurisdictions around the world and that they are:

1. International trademark 1401021, registered on August 31, 2017;
2. Australian trademark 1925707, registered on August 31, 2017 and enjoying a priority since April 24, 2017;
3. US Registration Number 5699892, registered on March 19, 2019 and enjoying a priority since August 31, 2017;
4. Canadian trademark TMA1019056, registered on April 10, 2019 and enjoying a priority since September 13, 2017.

The aforesaid trademarks have already been defined as “the EDUBIRDIE trademarks.”

The Panel has inspected the relevant record for each of those trademark registrations and has found that the company named Plan B Services LLC of Wilmington, Delaware USA is the registered owner of each of the trademarks and that the respective trademarks were registered on the abovementioned dates.

It will be seen therefore that each of the trademarks was registered before the disputed domain name was registered, which was on December 14, 2020.

It will also be seen, for later purposes, that when the disputed domain name was registered, the Complainant was not their registered owner, but that Plan B Services LLC was and is still their owner. However, the UDRP does not require that the Complainant must establish its ownership of a trademark before the domain name was registered or at all. The UDRP requires that the Complainant must show that there is “a trademark or service mark in which the complainant has rights;...”. Thus, the Complainant must show that it has, not ownership, but “rights” in the trademark in question. The Complainant has established that element because it has proved that it is a licensee of each of the trademarks from Plan B Services LLC. This is established to the satisfaction of the Panel by the Trademark License Agreement dated and commencing to operate on January 14, 2022. The Panel has inspected this document which is in evidence and finds that it shows that Plan B Services LLC, the registered owner of the specific trademarks listed above, confers on the Complainant an exclusive right and license to use the trademarks, the right to protect them from infringement and numerous other rights. Thus, the Complainant clearly has rights in the EDUBIRDIE trademark.

It is true, of course, that the Complainant did not acquire its rights until 13 months after the domain name was registered. But the UDRP makes it clear that a complainant must show, not that it had trademark rights by the time the domain name was registered, but that it “has” them, i.e., now, meaning that it has them when it files the Complaint. It filed the Complaint in the present case on May 30, 2022 and by that time it had rights in the trademarks and thus satisfied the requirements of the Policy.

Moreover, it should also be recalled, as noted above by the Panel, that the Complainant has other trademark rights and in its capacity as an owner. That is because the domain name under which the Complainant provides its services, namely <edubirdie.com>, was registered by its predecessor in title, Plan B Services LLC, on August 10, 2015 and pursuant to the Domain Name & Website Purchase Agreement of January 14, 2022 between Plan B Services LLC and the Complainant, the Complainant became the owner of the <edubirdie.com> domain name, several related domain names, “all associated trademark rights...” and “...attendant goodwill”. That purchase agreement is in evidence. Thus, the Complainant has trademark rights in the

EDUBIRDIE marks as it owns the trademark rights that are associated with the <edubirdie.com> domain name, which must include the EDUBIRDIE trademarks themselves.

The Complainant thus became the Licensee of the EDUBIRDIE trademarks under which it provides its services by means of the Trademark License Agreement between Plan B Services LLC and the Complainant dated January 14, 2022 and also acquired trademark rights when it acquired the <edubirdie.com> domain name.

The Complainant has satisfied the requirements of the Policy to give it standing by reference to the registered trademarks. The Panel also holds that on the evidence it also has common law trademark rights in EDUBIRDIE.

The Panel next finds that the disputed domain name <edubirdies.net> is confusingly similar to the EDUBIRDIE trademark for the following reasons.

First, the domain name includes the entirety of the EDUBIRDIE trademark and includes only a single additional letter, namely “s” which turns the singular into a plural. Even with that minor addition, it is obvious that the domain name has been inspired by and is an attempt to copy the trademark. Accordingly, the domain name would inculcate in the mind of any internet user who saw it that it was in fact the mark itself but that it was being used on this occasion in a plural sense and hence that it was being used for a legitimate commercial purpose.

Secondly, the domain name is registered with a “. net” suffix. Here, also, the internet user would simply assume that this was the official EDUBIRDIE trademark in an authorised domain name, and that it was registered in several gTLDs, as are many domain names.

Thirdly, taken as a whole, the disputed domain name would convey to the objective bystander that it related to the activities of the Complainant, giving rise to inevitable confusion.

Here, it is often said that confusing similarity will exist, as in the present case, despite the fact that small spelling alterations have been made. That is true, but it is also true that the confusing similarity will exist because the spelling alteration in fact enhances and draws attention to the domain name as a reflection the trademark itself.

It is also now well established that the addition of a generic top level domain, such as “.net” in the present case, cannot negate confusing similarity that is otherwise present, as it is in this case.

As the Complainant rightly submits, the views just expressed are consistent with decisions by prior UDRP panels.

Accordingly, the Panel finds that the domain name is confusingly similar to the EDUBIRDIE trademarks in which the Complainant has rights and it has thus proved the first of the three elements that it must establish.

B. Rights or Legitimate Interests

Under paragraph 4(a)(ii) of the Policy, the Complainant has the burden of establishing that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

But by virtue of paragraph 4(c) of the Policy, it is open to a respondent to establish its rights or legitimate interests in a domain name, among other circumstances, by showing any of the following elements:

- (i) before any notice to you [respondent] of the dispute, your use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services; or
- (ii) you [respondent] (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or

(iii) you [respondent] are making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

Thus, if a respondent proves any of these elements or indeed anything else that shows that it has a right or legitimate interest in the domain name, the complainant will have failed to discharge its onus and the complaint will fail.

It is also well-established that a complainant is required to make out a prima facie case that the respondent lacks rights or legitimate interests and that when such a prima facie case is made, the respondent carries the burden of demonstrating rights or legitimate interests in the domain name. If the respondent cannot do so, a complainant is deemed to have satisfied paragraph 4(a)(ii) of the UDRP.

The Panel, after considering all of the evidence in the Complaint, finds that the Complainant has made out a prima facie case that the Respondent has no rights or legitimate interests in the disputed domain name.

That prima facie case is made out from the following considerations.

(a) The Complainant has clearly established its rights in the EDUBIRDIE trademarks as licensee and as owner of the <edubirdie.com> domain name and that the Respondent has no such rights and no rights at all in the mark.

(b) Moreover, the owner of the registered trademarks has given its consent to bringing this proceeding and to the disputed domain name being transferred to the Complainant.

(c) The evidence of the Complainant is that the Respondent is not related in any way to the Complainant's business, is not affiliated with the Complainant or authorized by it in any way to use the EDUBIRDIE trademark and does not carry out any activity for, nor has any business with, the Complainant.

(d) The evidence shows that the Respondent is not commonly known by the domain name under paragraph 4(c)(ii) of the Policy.

(e) The essence of this proceeding is that the Respondent has engaged in typosquatting, which means that it has deliberately altered the spelling of the trademark by adding the letter "s" when the trademark is used as the basis of the domain name, clearly with the intention to deceive and trick internet users into thinking that the domain name is an official domain name of the Complainant and that it will lead to an official website of the Complainant, neither of which is true. There is no other rational explanation for what the Respondent has done. Clearly, such conduct cannot give rise to a right or legitimate interest in the domain name as it is dishonest. So likewise, it can be said that registering the disputed domain name in the ".net" gTLD is deceptive, as it was clearly done to give the false impression that the domain name was another official domain name of the Complainant in addition to its registration in the ".com" gTLD.

(f) The disputed domain name points to a website purporting to promote the services that the Respondent offers to provide. Those services are described in the evidence of a webpage that is exhibited to the Complaint and to which the disputed domain name resolves, as "Essay Writing". The Complainant's evidence also shows that its website promotes services as "Essay Writing" and the Complainant was providing that service since at least December 2015. The disputed domain name was not even registered until December 14, 2020. Thus, the Respondent has clearly copied the Complainant in the services that it provides and it has done this by trading on the Complainant's trademark. Moreover, the Respondent's webpage goes on to say: "Professional academic writing experts ready to write for you original papers." Apart from the grammar, it is clear that the Respondent is trying to offer the same services as the Complainant is offering under its trademark and the Respondent is doing so for money. The Respondent goes on to display on its webpage a button and the invitation to "Calculate your essay price" and another button for "Order" meaning that the Respondent wants internet users to order an essay and to pay for it. It is now well established that such conduct cannot give rise to a right or legitimate interest in the domain name and the Panel so holds in the present proceeding. The reason why that is so is a valid one, namely that the Respondent is using the Complainant's trademark to attract business and earn money under the guise of the Complainant's name and trademark.

None of this conduct is bona fide or legitimate and none of it comes within any of the criteria for a right or legitimate interest in a domain name that are set out in paragraph 4(c) (i) – (iii) of the Policy. Now is there any evidence to show that the Respondent could in any other way show a right or legitimate interest in the domain name.

These facts give rise to the prima facie case made out by the Complainant.

As the Complainant rightly submits, it has been held by previous UDRP panels that such conduct as the Respondent has exhibited must lead to the rejection of any suggestion that it would constitute a right or legitimate interest by the Respondent in the disputed domain name.

The Respondent has not filed a Response or made any other answer to the claims of the Complainant and is in default. Accordingly, the prima facie case has not been rebutted and the Complainant has made out the second of the three elements that it must establish.

C. Registered and Used in Bad Faith

The Complainant must prove on the balance of probabilities both that the disputed domain name was registered in bad faith and that it is being used in bad faith.

Paragraph 4(b) of the Policy sets out four circumstances, any one of which is evidence of the registration and use of a domain name in bad faith, although other circumstances may also be relied on, as the four circumstances are not exclusive. The four specified circumstances are:

(i) circumstances indicating that the respondent has registered or 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 respondent's documented out-of-pocket costs directly related to the domain name; or

(ii) the respondent 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 respondent has engaged in a pattern of such conduct; or

(iii) the respondent has registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, the respondent has intentionally attempted to attract, for commercial gain, Internet users to the respondent's website or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of the respondent's website or location or of a product or service on the site or location.

There is no need to repeat all of the details set out already, but in general the conduct of the Respondent up to and including the time when it registered the domain name clearly amount to bad faith registration and all of its conduct since the registration clearly amount to bad faith use.

That is so for the following reasons.

First, the Respondent must have been aware of the existence of the Complainant and its reputation when it registered the disputed domain name, because the Respondent chose the name of the domain name itself and then made a small addition to it by means of adding the letter "s" and then registered it in the ".net" gTLD. The Panel finds that it is highly likely that the

Respondent chose the trademark, made this addition and registered the domain name in the “.net” gTLD to invoke the existence and activities of the Complainant and to give the false impression that the Respondent was the Complainant, that the domain name was owned and used by the Complainant and that it was only a pluralised version of the Complainant’s trademark and its <edubirdie.com> domain name.

Secondly, by that means the Respondent, in registering the domain name deceptively and without any authority to do so, must be taken to have created a likelihood of confusion, with the intention of attracting current and potential customers of the Complainant looking for its services and doing so in this misleading manner. It even went as far as offering a means of calculation of the cost of the essays it offered to write and a means of ordering and paying for them. Accordingly, that conduct brings the case squarely within the provisions of paragraph 4(b) (iii) because the respondent must have registered the domain name primarily for the purpose of disrupting the business of a competitor, as the more business the Respondent gained by its subterfuge, the more business the Complainant lost.

Thirdly, the same conduct brings the case squarely within the provisions of paragraph 4(b) (iv) of the Policy because the Respondent must have intentionally attempted to attract, for commercial gain, Internet users to its website by creating confusion with the Complainant’s EDUBIRDIE marks as to whether or not the Complainant was the source of the essay -writing services offered on the Respondent’s webpage.

Fourthly, the Panel agrees with all of the other grounds of bad faith registration and use advanced by the Complainant. They are that there is no conceivable ground for concluding that the Respondent was acting in good faith, that the Respondent was clearly taking advantage of the Complainant’s trademark by registering the domain name in the “.net “ gTLD and that the Respondent was clearly targeting the Complainant.

Fifthly, in addition and having regard to the totality of the evidence, the Panel finds that, in view of Respondent’s registration of the disputed domain name using the EDUBIRDIE mark and slightly amending it and in view of the conduct that Respondent has engaged in when using the domain name, Respondent registered and used it in bad faith within the generally accepted meaning of that expression.

As the Complainant rightly submits, such conduct of the Respondent has been held by previous UDRP panels to constitute bad faith registration and use.

For the record, it should be stated that the foregoing acts of the Respondent, which amount to bad faith registration and use of the disputed domain name were all committed after the EDUBIRDIE trademarks were registered and whilst they were registered, as they still are. Those acts of bad faith were clearly directed at the EDUBIRDIE trademarks. The Complainant is now the licensee of those trademarks and the Trademark License Agreement between the Complainant and Plan B Services LLC referred to above specifically provides that the Complainant may bring legal proceedings to protect the EDUBIRDIE trademark against infringement and that it has full power to prosecute proceedings in its name which it has done in this proceeding. The Complainant is also the owner of the <edubirdie.com> domain name and " all associated trademark rights". Moreover, the Letter of Approval of May 3, 2022 from Plan B Services LLC gives permission to the Complainant to bring this proceeding and to have the disputed domain name transferred to the Complainant. Clearly, when all of those considerations are put together, the right to take action to rectify infringement of the EDUBIRDIE trademarks must have inured to the Complainant. The Complainant is therefore entitled to the relief it seeks.

Accordingly, the Complainant has shown the third of the three elements that it must establish.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **EDUBIRDIES.NET**: Transferred
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PANELLISTS

Name **The Hon. Neil Brown, QC**

DATE OF PANEL DECISION 2022-06-23

Publish the Decision