

## **ADMINISTRATIVE PANEL DECISION**

ACT, Inc. v. Privacy Service Provided by Withheld for Privacy ehf / Jack Mi  
Case No. D2022-1642

### **1. The Parties**

The Complainant is ACT, Inc., United States of America (“United States”), represented by Davis Graham & Stubbs LLP, United States.

The Respondent is Privacy Service Provided by Withheld for Privacy ehf, Iceland / Jack Mi, Canada.

### **2. The Domain Name and Registrar**

The disputed domain name <actpanda.com> is registered with NameCheap, Inc. (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on May 5, 2022. On May 6, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On May 6, 2022, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain name, which differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to the Complainant on May 9, 2022, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed an amended Complaint on May 13, 2022.

The Center verified that the Complaint together with the amended Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the “Policy” or “UDRP”), the Rules for Uniform Domain Name Dispute Resolution Policy (the “Rules”), and the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the “Supplemental Rules”).

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on May 20, 2022. In accordance with the Rules, paragraph 5, the due date for Response was June 9, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on June 10, 2022.

The Center appointed Adam Taylor as the sole panelist in this matter on June 20, 2022. The Panel finds that it was properly constituted. The Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Center to ensure compliance with the Rules, paragraph 7.

#### **4. Factual Background**

For some 60 years, the Complainant has supplied tests / assessments to assist with “college and career readiness” under the mark “ACT”.

The Complainant owns a number of trade mark registrations for ACT, including United States registration No. 2,888,069, filed on April 27, 1999, registered on September 28, 2004, in classes 9, 16, 41 and 42.

The Complainant operates a website at “www.act.org”.

The disputed domain name was registered on March 31, 2022.

As of April 20, 2022, the disputed domain name resolved to a website that was branded with an “ACTPanda” logo and purported to offer a range of “ACT” practice tests for download under the headings “ACT Practice Tests Online” and “ACT Real Past Papers Download”.

#### **5. Parties’ Contentions**

##### **A. Complainant**

The following is a summary of the Complainant’s contentions.

The Complainant owns common law rights in the term “ACT”, in addition to its registered trade marks.

The disputed domain name is confusingly similar to the Complainant’s trade mark, which it incorporates.

The Respondent lacks rights or legitimate interests in the disputed domain name.

The Complainant has not authorised the Respondent to register the disputed domain name, or to use its trade marks or copyrights, or to resell its products.

The Respondent has not used the disputed domain name in connection with a *bona fide* offering of goods or services. On the contrary, the Respondent is trying to deceive users into thinking that the disputed domain name and related products and services are affiliated with the Complainant.

The disputed domain name was registered and is being used in bad faith.

The Respondent is attempting to profit from the goodwill and fame of the Complainant’s marks by creating a likelihood of confusion on the part of users searching for the Complainant’s goods and services. The Respondent’s website provides no disclaimer or other indication that it is not a provider of the Complainant’s products or services.

The disputed domain name has been used in a manner that infringes the Complainant’s trade mark. The Respondent has also infringed the Complainant’s copyright by providing copies of the Complainant’s own tests for download.

The Respondent has engaged in a pattern of such activity.

## B. Respondent

The Respondent did not reply to the Complainant's contentions.

## 6. Discussion and Findings

Under the Policy, the Complainant is required to prove on the balance of probabilities that:

- the disputed domain name is identical or confusingly similar to a trade mark in which the Complainant has rights;
- the Respondent has no rights or legitimate interests in respect of the disputed domain name; and
- the disputed domain name has been registered and is being used in bad faith.

### A. Identical or Confusingly Similar

The Complainant has established registered rights in the mark ACT, as well as unregistered trade mark rights deriving from the Complainant's extensive and longstanding use of that mark.

Section 1.8 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)") makes clear that, where the relevant trade mark is recognisable within the disputed domain name, the addition of other terms, whether descriptive or otherwise, would not prevent a finding of confusing similarity under the first element.

Here, the disputed domain name consists of the Complainant's trade mark, which remains readily recognisable within the disputed domain name, plus the additional term "panda", which does not prevent a finding of confusing similarity as explained above.

For the above reasons, the Panel concludes that the disputed domain name is confusingly similar to the Complainant's trade mark and that the Complainant has therefore established the first element of paragraph 4(a) of the Policy.

### B. Rights or Legitimate Interests

As explained in section 2.1 of [WIPO Overview 3.0](#), the consensus view is that, where a complainant makes out a *prima facie* case that the respondent lacks rights or legitimate interests, the burden of production shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name. If not, the complainant is deemed to have satisfied the second element.

Here, the Complainant has not licensed or otherwise authorised the Respondent to use its trade mark.

Paragraph 4(c) of the Policy gives examples of circumstances which, if proved, suffice to demonstrate that a respondent possesses rights or legitimate interests.

As to paragraph 4(c)(i) of the Policy, for reasons explained in section 6C below the Panel considers that the Respondent has used the disputed domain name to intentionally attempt to attract, confuse and profit from Internet users seeking the Complainant's goods and/or services, including by use of the Complainant's copyrighted materials. Such use of the disputed domain name could not be said to be *bona fide*.

Nor is there any evidence that paragraphs 4(c)(ii) or (iii) of the Policy apply in the circumstances of this case.

The Panel finds that the Complainant has established a *prima facie* case of lack of rights or legitimate interests and there is no rebuttal by the Respondent.

For the above reasons, the Panel concludes that the Complainant has established the second element of paragraph 4(a) of the Policy.

### C. Registered and Used in Bad Faith

For the following reasons, the Panel considers that the Respondent has intentionally attempted to attract Internet users to its website for commercial gain by creating a likelihood of confusion with the Complainant's trade mark in accordance with paragraph 4(b)(iv) of the Policy.

First, the Respondent has selected a domain name which comprises the Complainant's distinctive mark plus a descriptive term.

Second, the Respondent has used the disputed domain name for a website that creates the impression that it is officially associated with the Complainant including by prominent display of the Complainant's mark, as well as by the unauthorised use of what the Respondent describes as "real past papers", namely the Complainant's own copyrighted materials.

The Complainant also asserts that the Respondent is connected with the respondent in *ACT, Inc. v. 马程遥 (Max Will)*, WIPO Case No. [D2021-3128](#), who was held to have registered and used the domain name <crackact.com> in bad faith. That respondent operated a similar website, which directed users to the same download source as the website at the disputed domain name.

The Panel notes that the Respondent has not come forward to deny this or any of the Complainant's other allegations of bad faith.

For the above reasons, the Panel considers that the Complainant has established the third element of paragraph 4(a) of the Policy.

### 7. Decision

For the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the disputed domain name, <actpanda.com>, be transferred to the Complainant.

*/Adam Taylor/*

**Adam Taylor**

Sole Panelist

Date: July 4, 2022