

## **ADMINISTRATIVE PANEL DECISION**

Xpress Solutions, Inc. v. Mak Bheem

Case No. D2022-4687

### **1. The Parties**

The Complainant is Xpress Solutions, Inc., United States of America (“United States”), represented by Kirton & McConkie, United States.

The Respondent is Mak Bheem, Bangladesh.

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

The disputed domain name <xpressbillpay.ltd> is registered with Hosting Concepts B.V. d/b/a Registrar.eu (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on December 7, 2022. On December 7, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On December 8, 2023, 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 December 16, 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 amendment to the Complaint on December 19, 2022.

The Center verified that the Complaint together with the amendment to the 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 December 20, 2022. In accordance with the Rules, paragraph 5, the due date for Response was January 9, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on January 10, 2023.

The Center appointed Adam Taylor as the sole panelist in this matter on January 23, 2023. 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**

The Complainant has supplied payment services under the mark XPRESS BILL PAY since 2005.

In the last 12 months, the Complainant has processed more than 17 million payments totalling over USD 2.3 billion. Over 750 municipalities throughout the United States use the Complainant's services.

The first 100 search results for "xpress bill pay" on Google relate to the Complainant.

The Complainant owns United States trade mark No. 4,749,808 for XPRESS BILL PAY, listed on the Supplemental Register, filed on January 8, 2014, registered on June 2, 2015, in class 36.

The Complainant operates its own website at "xpressbillpay.com".

The disputed domain name was registered on August 10, 2021.

As of November 28, 2022, the disputed domain name resolved to a website headed "Xpress Bill Pay / Official Xpress Bill Pay Login Portal". The site, which purported to provide information about the Complainant and its services, included prominent use of the Complainant's logo as well as content copied from the Complainant's site and third party advertising.

#### **5. Parties' Contentions**

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

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

The XPRESS BILL PAY mark has become distinctive of the Complainant's services due to its long-term and extensive use by the Complainant.

The disputed domain name is identical to the Complainant's trade mark.

The Respondent lacks rights or legitimate interests in the disputed domain name, which was registered and is being used in bad faith.

The Complainant has no relationship with the Respondent and has not authorised the Respondent to use its trade mark.

The Respondent's site does not appear to offer any *bona fide* services.

The Respondent set out to create a likelihood of confusion by giving consumers the false impression that the Respondent's website is associated with the Complainant, including by use of the Complainant's logo and content, in order to obtain advertising revenue.

##### **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

As explained in section 1.2.2 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), complainants relying on trade mark registrations listed solely on the USPTO Supplemental Register are expected to show secondary meaning in order to establish trade mark rights under the Policy because, under United States law, a supplemental registration does not by itself provide evidence of distinctiveness to support trade mark rights.

Here, the Complainant has indeed established secondary meaning in the term XPRESS BILL PAY deriving from the Complainant's extensive and longstanding use of that mark.

Disregarding the Top-Level Domain ("TLD") suffix, which is excluded from the comparison, the disputed domain name is identical to the Complainant's trade mark. Accordingly, the Panel finds that the Complainant has 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 intentionally to attract, confuse and profit from Internet users seeking the Complainant's services. 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 are relevant in the circumstances of this case.

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

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 disputed domain name carries a high risk of implied affiliation as it is identical to the Complainant's trade mark - see section 2.5.1 of the [WIPO Overview 3.0](#). This risk of affiliation is enhanced yet further by use of the "ltd" TLD suffix, which denotes "limited" and conveys the strong impression that the disputed domain name reflects the name of a corporate entity connected with the mark.

Second, the disputed domain name has been used for a website that creates the impression that it is officially associated with the Complainant including by prominent use of the Complainant's mark/logo and the title "Official Xpress Bill Pay Login Portal", as well as the inclusion of material copied from the Complainant's website.

It appears that the Respondent's purpose is to profit by means of third-party advertising.

Furthermore, the Respondent has not come forward to deny the Complainant's assertions of bad faith. It is difficult to conceive of any legitimate reason underlying the Respondent's registration and use of the disputed domain name and the Respondent has offered no explanation.

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, <xpressbillpay.ltd>, be transferred to the Complainant.

*/Adam Taylor/*

**Adam Taylor**

Sole Panelist

Date: February 6, 2023