

ADMINISTRATIVE PANEL DECISION

Thoughtworks, Inc. v. Withheld for Privacy ehf / Edvard Northon
Case No. D2022-0831

1. The Parties

Complainant is Thoughtworks, Inc., United States of America (“United States” or “U.S”), represented by Culhane Meadows PLLC, United States.

Respondent is Withheld for Privacy ehf, Iceland / Edvard Northon, United States.

2. The Domain Name and Registrar

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

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on March 9, 2022. On March 10, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On March 10, 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 Complainant on March 15, 2022, providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. Complainant filed an amendment to the Complaint on March 17, 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 Respondent of the Complaint, and the proceedings commenced on March 24, 2022. In accordance with the Rules, paragraph 5, the due date for Response was April 13, 2022. Respondent sent an email to the Center on March 16, 2022, but did not submit any formal response. On April 14, 2022, the Center informed the Parties of the Commencement of Panel Appointment Process.

The Center appointed Phillip V. Marano as the sole panelist in this matter on May 5, 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

Complainant is Thoughtworks, Inc., a global technology consulting company based in Chicago, Illinois that provides software design and delivery as well as consulting services, and was founded in 1993. Complainant owns valid and subsisting registrations for the THOUGHTWORKS trademark in numerous jurisdictions around the world, including the trademark for THOUGHTWORKS U.S. Reg. No. 1,866,548 and U.S. Reg. No. 2,361,539, with a first use date and earliest priority dating back to June 1, 1993.

Respondent registered the disputed domain name <thoughtworks.sbs> on February 17, 2022. At the time this Complaint was filed, the disputed domain name resolved to a website that is identical to Complainant's own website.

5. Parties' Contentions

A. Complainant

Complainant asserts ownership of the THOUGHTWORKS trademark and has adduced evidence of trademark registrations in numerous jurisdictions around the world including in the United States, India, and Chile. Such trademark registrations include for example, U.S. Reg. 1866548 (registered on December 6, 1994, for business consulting services). The disputed domain name is confusingly similar to Complainant's THOUGHTWORKS trademark, according to Complainant, because it is composed of the verbal element "thoughtworks", which entirely incorporates Complainant's THOUGHTWORKS trademark.

Complainant further asserts that Respondent lacks any rights or legitimate interests in the disputed domain name based on the lack of evidence that Respondent is commonly known by the disputed domain name, the lack of evidence that Respondent has made use of, or demonstrable preparations to use the disputed domain name in connection with a *bona fide* offering of goods or services, and the fact that the disputed domain name has been used to impersonate Complainant and create a website that is identical to Complainant's own website. It is more likely than not, according to Complainant, that Respondent registered the disputed domain name to impersonate Complainant and send improper emails to third parties.

Complainant argues that Respondent has registered and used the disputed domain name in bad faith based on the inherently distinctive nature of Complainant's THOUGHTWORKS trademark, and Respondent's use of the disputed domain name to target and impersonate Complainant by creating a website that is identical to Complainant's own website.

B. Respondent

Respondent sent an email communication to the Center on March 16, 2022, stating: "Hello. What happened? Why are you complaining about me?" but did not reply to the Complainant's contentions.

6. Discussion and Findings

To succeed in its Complaint, Complainant must establish in accordance with paragraph 4(a) of the Policy:

- i. The disputed domain name is identical or confusingly similar to a trademark in which Complainant has rights;
- ii. Respondent has no rights or legitimate interests in respect of the disputed domain name; and

- iii. The disputed domain name has been registered and is being used in bad faith.

Although Respondent did not reply to Complainant's contentions, the burden remains with Complainant to establish by a balance of probabilities, or a preponderance of the evidence, all three elements of paragraph 4(a) of the Policy. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 4.3 ("[...] a respondent's default (i.e., failure to submit a formal response) would not by itself mean that the complainant is deemed to have prevailed; a respondent's default is not necessarily an admission that the complainant's claims are true [...] UDRP panels have been prepared to draw certain inferences in light of the particular facts and circumstances of the case, e.g. where a particular conclusion is *prima facie* obvious, where an explanation by the respondent is called for but is not forthcoming, or where no other plausible conclusion is apparent."); see also *The Vanguard Group, Inc. v. Lorna Kang*, WIPO Case No. [D2002-1064](#) ("The Respondent's default does not automatically result in a decision in favor of the complainant. The Complainant must still prove each of the three elements required by Policy paragraph 4(a)"). Indeed, Panels typically treat a respondent's submission of a so-called "informal response" (merely making unsupported conclusory statements and/or failing to specifically address the case merits as they relate to the three UDRP elements, e.g., simply asserting that the case "has no merit" and demanding that it be dismissed) in a similar manner as a respondent default. See [WIPO Overview 3.0](#), Section 4.3.

A. Identical or Confusingly Similar

Ownership of a nationally or regionally registered trademark serves as *prima facie* evidence that Complainant has trademark rights for the purposes of standing to file this Complaint. [WIPO Overview 3.0](#), section 1.2.1. Complainant submitted evidence that the THOUGHTWORKS trademark has been registered in numerous countries around the world, including the United States, India, and Chile, with the first use date and earliest priority in the United States dating back to June 1, 1993. Thus, the Panel finds that Complainant's rights in the THOUGHTWORKS trademark have been established pursuant to the first element of the Policy.

The only remaining question under the first element of the Policy is whether the disputed domain name is identical or confusingly similar to Complainant's THOUGHTWORKS trademark. In this Complaint, the disputed domain name is identical to Complainant's THOUGHTWORKS trademark because, disregarding the ".sbs" generic Top-Level Domain ("gTLD"), the trademark is contained in its entirety within the disputed domain name. [WIPO Overview 3.0](#), section 1.7. ("This test typically involves a side-by-side comparison of the domain name and the textual components of the relevant trademark to assess whether the mark is recognizable within the disputed domain name ... [I]n cases where a domain name incorporates the entirety of a trademark, or where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar..."). In regards to gTLDs, such as ".sbs" in the disputed domain names, they are generally viewed as a standard registration requirement and are disregarded under the first element. [WIPO Overview 3.0](#), section 1.11.

In view of Complainant's registration for the THOUGHTWORKS trademark, and Respondent's incorporation of that identical trademark in its entirety in the disputed domain name, the Panel concludes that Complainant has established the first element of the Policy.

B. Rights or Legitimate Interests

Complainant must make out a *prima facie* case that Respondent lacks rights or legitimate interests in the disputed domain name, shifting the burden of production on this element to Respondent to come forward with evidence demonstrating such rights or legitimate interests. Where, as in this Complaint, Respondent fails to come forward with any relevant evidence, Complainant is deemed to have satisfied the second element of the Policy. WIPO Overview, section 2.1.

It is evident that Respondent, identified by the Registrar for the disputed domain name as “Edvard Northon”, is not commonly known by the disputed domain name or Complainant’s THOUGHTWORKS trademark.

UDRP panels have categorically held that use of a domain name for illegal activity – including the impersonation of the complainant and other types of fraud – can never confer rights or legitimate interests on a respondent. Circumstantial evidence can support a credible claim made by complainant asserting respondent is engaged in such illegal activity, including that respondent has masked its identity to avoid being contactable, or that respondent’s website has been suspended by its hosting provider. [WIPO Overview 3.0](#), section 2.13. See *e.g. Graybar Services Inc. v. Graybar Elec, Grayberinc Lawrence*, WIPO Case No. [D2009-1017](#) (“Respondent has used the domain name to pretend that it is the Complainant and in particular to create false emails pretending that they are genuine emails coming from the Complainant and one of its senior executives”). See also *The Commissioners for HM Revenue and Customs v. Name Redacted*, WIPO Case No. [D2017-0501](#) (“In addition, the disputed domain names ... have had their web hosting suspended as a result of fraudulent activities. This is evidence of bad faith registration and use of the disputed domain names.”). In this Complaint, Complainant has proffered strong evidence to establish that Respondent registered and used the disputed domain name in a clear attempt to impersonate Complainant. Specifically, Respondent set up a website under the disputed domain name that appears to be identical to Complainant’s own website. Respondent’s fraudulent website misappropriates Complainant’s stylized logo, the overall look and feel of Complainant’s website, and copywritten literary and pictorial content from Complainant’s website. To this end, the second and third elements of the Policy may be assessed together where clear *indicia* of bad faith suggests that there cannot be any Respondent rights or legitimate interests. [WIPO Overview 3.0](#), section 2.15.

In view of the absence of any evidence supporting any rights or legitimate interests in the disputed domain name, and Complainant’s clear cut evidence that the disputed domain name has been used to impersonate Complainant by creating a website that is identical to Complainant’s, the Panel concludes that Complainant has established the second element of the Policy.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy proscribes the following non-exhaustive circumstances as evidence of bad faith registration and use of the disputed domain name:

- i. Circumstances indicating that Respondent has registered or Respondent has acquired the disputed domain name primarily for the purpose of selling, renting, or otherwise transferring the disputed domain name registration to Complainant who is the owner of the trademark to a competitor of that Complainant, for valuable consideration in excess of Respondent’s documented out of pocket costs directly related to the disputed domain name; or
- ii. Respondent has registered the disputed domain name in order to prevent the owner of the trademark from reflecting the mark in a corresponding domain name, provided that Respondent has engaged in a pattern of such conduct; or
- iii. Respondent has registered the disputed domain name primarily for the purpose of disrupting the business of a competitor; or
- iv. By using the disputed domain name, Respondent has intentionally attempted to attract, for commercial gain, Internet users to Respondent’s website or other online location, by creating a likelihood of confusion with Complainant’s mark as to the source, sponsorship, affiliation, or endorsement of Respondent’s website or location or of a product or service on Respondent’s website or location.

UDRP panels have categorically held that registration and use of a domain name for illegal activity – including impersonation, passing off, and other types of fraud – is manifestly considered evidence of bad faith within paragraph 4(b)(iv) of the Policy. [WIPO Overview 3.0](#), section 3.1.4. *Graybar Services Inc. v. Graybar Elec, Grayberinc Lawrence*, WIPO Case No. [D2009-1017](#). Again, Complainant has produced clear

cut evidence establishing that Respondent registered the disputed domain name to purposefully target Complainant's THOUGHTWORKS trademark in the disputed domain name in bad faith and in furtherance of Respondent's illegal scheme to impersonate Complainant. Under these circumstances, the Panel is inclined to agree with Complainant, that Respondent more likely than not registered and used the disputed domain names in bad faith as part of an attempt to defraud Complainant, Complainant's customers, or Internet users generally.

In view of Respondent's intentional targeting of Complainant's THOUGHTWORKS trademark and attempted impersonation of Complainant as part of an apparent fraudulent scheme, the Panel concludes that Complainant has established the third element 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 <thoughtworks.sbs> be transferred to Complainant.

/Phillip V. Marano/
Phillip V. Marano
Sole Panelist
Date: May 19, 2022