

ADMINISTRATIVE PANEL DECISION

Oracle Corporation and Oracle International Corporation v. Privacy Service Provided by Withheld for Privacy ehf / Nonline Company and Sporto Live
Case No. D2022-1529

1. The Parties

The Complainants are Oracle Corporation and Oracle International Corporation, United States of America (“United States”), represented by Kilpatrick Townsend & Stockton LLP, United States (collectively referred to as “the Complainants”).

The Respondents are Privacy Service Provided by Withheld for Privacy ehf, Iceland / Nonline Company, British Virgin Islands, United Kingdom and Sporto Live, India.

2. The Domain Names and Registrars

The disputed domain names <e-oracle.com> and <e-oracle.net> are registered with NameCheap, Inc. and Instra Corporation Pty Ltd. (the “Registrars”), respectively.

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on April 28, 2022. On April 28, 2022, the Center transmitted by email to the Registrars a request for registrar verification in connection with the disputed domain names. On April 28, 2022, the Registrars transmitted by email to the Center their verification response disclosing registrant and contact information for the disputed domain names which differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to the Complainant on May 6, 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 11, 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 18, 2022. In accordance with the Rules, paragraph 5,

the due date for Response was June 7, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on June 9, 2022.

The Center appointed Zoltán Takács as the sole panelist in this matter on June 30, 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

The Complainants are Oracle Corporation (the First Complainant) and Oracle International Corporation (the Second Complainant).

The First Complainant is one of the world's foremost providers of network computing hardware, computing systems, computer software, services and solutions, and a leading developer of enterprise and Internet-based products and technologies, including integrated cloud applications, platform services and engineering systems.

The Second Complainant is a direct, wholly owned subsidiary of the First Complainant and the owner of the ORACLE marks. The First Complainant is a licensee in the United States of the ORACLE marks.

The First and the Second Complainant are collectively referenced herein as "Complainants" of "Oracle".

Oracle is one of the world's largest technology companies, with annual revenues of more than 40 billion, 430,000 customers in 175 countries, 41,000 developers and engineers, 5 million registered members of its customer and developer communities, 20,000 partners across the globe, 13,000 customer support and service specialists and 18,000 implementation consultants.

Oracle owns numerous trademark registrations for the ORACLE mark, including:

- the United States ("US") Trademark Registration No. 1200239 for the word mark ORACLE, registered since July 6, 1982 for goods of classes 9 and 16 of the Nice Agreement Concerning the International Classification of Goods and Services for the Purpose of the Registration of Marks (the "Nice Classification"),
- the US Trademark Registration No. 1555182 for the word mark ORACLE, registered since June 13, 1989 for services of classes 41 and 42 of the Nice Classification, and
- the European Union Trade Mark Registration ("EUTM") No. 002843019 for the word mark ORACLE, registered since June 16, 2004 for goods and services of classes 9, 16, 35, 36, 38, 41 and 42 of the Nice Classification.

Since December 2, 1998 the First Complainant owns the domain name <oracle.com>, which links to its principal corporate website.

The disputed domain name <e-oracle.com> was registered on May 31, 2021 and the disputed domain name <e-oracle.net> on April 2, 2022. The websites under both of the disputed domain names displayed the same content, identifying the Respondents as "an organic global knowledge network sustained by a portfolio of top tier Blockchain use-cases".

5. Procedural Issue – Consolidation of Multiple Complainants and Multiple Respondents

Paragraph 10(e) of the UDRP Rules grants a panel the power to consolidate multiple domain name disputes.

The Respondents' use of the ORACLE mark in the disputed domain names affects the Complainants' rights on substantially the same basis, who therefore have common interests in the disputed domain names.

The identical content layouts of the websites corresponding to the disputed domain names suggest that the Complainants are being targets of a common conduct based on abuse of the ORACLE trademark and business. In view of the Panel the Complainant has established that the disputed domain names are likely subject to common ownership, or at least common control, which justifies consolidation of the Complainants' claims against the Respondents. The Panel is also of convinced that consolidation would be procedurally efficient and that the principle of fairness to all parties would not be endangered.

These facts in view of the Panel warrant permitting consolidation in this proceeding as a procedurally equitable, efficient and fair action (see sections 4.11.1 and 4.11.2 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)").

6. Parties' Contentions

A. Complainants

The Complainants contend that the disputed domain names are confusingly similar to the ORACLE trademark, incorporating their famous trademark in its entirety, with only the addition of the abbreviation "e-", which is commonly understood as short for "electronic" or "online" version.

The Complainants allege that the Respondents have no rights or legitimate interests in respect of the disputed domain names and are unable to rely on any of the circumstances set out in paragraphs 4(c)(i), (ii) or (iii) of the Policy.

The Complainants claim that the Respondents have registered and are using the disputed domain names in bad faith for commercial gain, to benefit from the goodwill and notoriety associated with the ORACLE trademark and business.

The Complainants request that the disputed domain names <e-oracle.com> and <e-oracle.net> be transferred from the Respondents to the Complainants.

B. Respondents

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

7. Discussion and Findings

Paragraph 15(a) of the Rules requires that the Panel's decision be made "on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable".

It has been a consensus view in UDRP decisions that a respondent's default (*i.e.*, failure to submit a 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. See section 4.3 of the [WIPO Overview 3.0](#).

A complainant must evidence each of the three elements required by paragraph 4(a) of the Policy in order to succeed on the complaint, namely that;

(i) the disputed domain names are identical or confusingly similar to a trademark or service mark in which the complainant has rights;

- (ii) the respondent has no rights or legitimate interests in respect of the disputed domain names; and
- (iii) the disputed domain names have been registered and are being used in bad faith.

A. Identical or Confusingly Similar

Under paragraph 4(a)(i) of the Policy, there are two requirements which the Complainant must establish, first that it has rights in a trademark or service mark, and second that the disputed domain name is identical or confusingly similar to the trademark or service mark.

It has been a consensus view among UDRP panels that if the complainant owns a trademark, then it generally satisfies the threshold requirement of having trademark rights.

The Complainants produced proper evidence of having registered rights in the ORACLE trademark and for the purpose of this proceeding the Panel establishes that the Complainants have satisfied the requirement of having trademark rights for the purpose of the Policy.

Having determined the presence of the Complainants' trademark rights, the Panel next considered whether the disputed domain names are identical or confusingly similar to the trademark.

According to sections 1.7 and 1.8 of the [WIPO Overview 3.0](#), the standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the complainant's trademark and the disputed domain name. This test typically involves a side-by-side comparison of the disputed domain name and the textual components of the relevant trademark to assess whether the mark is recognizable within the disputed domain name. Where the relevant trademark is recognizable within the disputed domain name, the addition of other terms would not prevent a finding of confusing similarity under the first element.

According to section 1.11.1 of the [WIPO Overview 3.0](#), the applicable generic Top-Level Domain ("gTLD") in a domain name (in this case ".com" and ".net") is viewed as a standard registration requirement and as such is generally disregarded under the first element confusingly similar test.

The disputed domain names contain the ORACLE trademark in its entirety. The Respondents' addition of the abbreviation "e-", which is commonly used to describe "electronic version" in e.g. business, commerce, finance etc. (e-business, e-commerce, e-finance) in view of the Panel does not prevent the finding of confusing similarity between the disputed domain names and the Complainants' ORACLE trademark.

The applicable gTLD suffixes in the disputed domain names, ".com" and ".net" should in relation to this administrative proceeding be disregarded.

Based on the above the Panel finds that the disputed domain names <e-oracle.com> and <e-oracle.net> are confusingly similar to the Complainants' ORACLE trademark and that the requirement of paragraph 4(a)(i) of the Policy is satisfied.

B. Rights or Legitimate Interests

Under paragraph 4(c) of the Policy, a respondent may demonstrate its rights or legitimate interests in a domain name by showing any of the following circumstances, in particular but without limitation:

- (i) its use of, or demonstrable preparation to use the domain name or a name corresponding to the domain name in connection with a *bona fide* offering of goods and services;
- (ii) it has been commonly known by the domain name;
- (iii) it is making a legitimate noncommercial or fair use of the domain name, without intent for commercial

gain to misleadingly divert customers or to tarnish the trademark or service mark at issue.

In the present case, the Complainants have submitted sufficient and uncontested evidence that they hold well-established rights in the ORACLE trademark.

The Complainants have never authorized the Respondents to use the ORACLE trademark in any way, and their prior rights long precede the date of registration of the disputed domain names.

According to section 2.1 of the [WIPO Overview 3.0](#), while the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the often impossible task of “proving a negative”, requiring information that is often primarily within the knowledge or control of the respondent.

As such, 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 the relevant evidence demonstrating rights or legitimate interests in the domain name. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element.

The Respondent defaulted and failed to respond, and by doing so failed to offer the Panel any type of evidence set forth in paragraph 4(c) of the Policy, or otherwise counter the Complainants’ *prima facie* case.

The Respondents’ use of the disputed domain names and the corresponding websites containing the Complainants’ famous ORACLE mark is in view of the Panel intended to confuse consumers into mistakenly believing that the Respondents’ websites are owned by, or somehow affiliated with or approved by Oracle. According to section 2.5.1 of the [WIPO Overview 3.0](#), “even where a domain name consists of a trademark plus an additional term, such composition cannot constitute fair use if it effectively impersonates or suggests sponsorship or endorsement by the trademark owner”.

The Panel finds that the Respondent has no rights or legitimate interests in the disputed domain names in accordance with paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy lists a number of factors which, if found by the panel to be present, shall be evidence of registration and use of a domain name in bad faith. This non-exclusive list includes:

- “(i) circumstances indicating that you have registered or you have 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 your documented out-of-pocket costs directly related to the domain name; or
- (ii) you have 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 you have engaged in a pattern of such conduct; or
- (iii) you have registered the domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your website or other online location, by creating a likelihood of confusion with the complainant’s mark as to the source, sponsorship, affiliation, or endorsement of your website or location or of a product or service on your website or location.”

The ORACLE trademark is widely recognized around the world, not just by the computing industry professionals but members of the general public as well. The Forbes Magazine ranks the ORACLE trademark within top 20 brands of the world.

The disputed domain names fully incorporate and the corresponding websites extensively use the famous ORACLE trademark, without any authorization or approval.

Prior UDRP panels have consistently found that the mere registration of a domain name that is identical or confusingly similar to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith (see section 3.1.4 of the [WIPO Overview 3.0](#)).

The Panel finds that by using the famous ORACLE trademark in the disputed domain names and on the corresponding websites without authorization or approval, the Respondents have attempted to attract, for commercial gain, Internet users to their websites, by creating a likelihood of confusion with the Complainants' mark as to the source, sponsorship, affiliation or endorsement within the meaning of paragraph 4(b)(iv) of the Policy.

Therefore, the Panel finds that paragraph 4(a)(iii) of the Policy is satisfied.

8. 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 names <e-oracle.com> and <e-oracle.net> be transferred to Complainants.

/Zoltán Takács/

Zoltán Takács

Sole Panelist

Date: July 14, 2022