

## **ADMINISTRATIVE PANEL DECISION**

OANDA Corporation v. Privacy service provided by Withheld for Privacy ehf /  
Meir Barak, Whales  
Case No. D2022-1901

### **1. The Parties**

Complainant is OANDA Corporation, United States of America (“US”), represented by Donahue Fitzgerald, US.

Respondent is Privacy service provided by Withheld for Privacy ehf, Iceland / Meir Barak, Whales, US.

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

The disputed domain name <oandaifx.com> (the “Domain Name”) 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 26, 2022. On May 28, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On May 28, 2022, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Domain Name, which differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to Complainant on May 29, 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 May 29, 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 May 30, 2022. In accordance with the Rules, paragraph 5, the due date for Response was June 19, 2022. Respondent did not submit any response. Accordingly, the Center notified Respondent’s default on June 20, 2022. On June 21, 2022, the Center received an email communication from an apparent third party stating: “This email is directed to the wrong person. I have no connection with oandaifx.com or familiar with the name. (...)”

The Center appointed Christopher S. Gibson as the sole panelist in this matter on July 4, 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 a US-based corporation with its principal place of business in New York. Complainant's business model seeks to transform how the world interacts with monetary currencies – whether that be trading or utilizing currency data and information – by providing currency exchange and financial information services and products.

Complainant has continuously used its OANDA mark since 1996 as the basis for its name and as a source indicator of its commercial offering of services to the public. The mark is an invented word and has no other meaning aside from referencing Complainant and its services.

In 2004, Complainant was granted US registration no. 2874938 covering its OANDA mark. That registration has achieved incontestable status under US federal law. In addition, Complainant has registered its OANDA mark in other jurisdictions around the world including Australia, Canada, China, the European Union, Hong Kong, Singapore, Switzerland, Taiwan, and the UK.

Complainant also owns common law rights in its OANDA mark. Complainant has used its mark in commerce since 1996. Complainant provides its services all over the world and on nearly every continent, and does so in nearly every instance in connection with the OANDA mark. There have been millions of users of OANDA services. Complainant has spent millions of dollars to advertise and promote both itself and its services, in express connection with the mark. Unsolicited media coverage tying the OANDA mark to Complainant and its services is widespread.

In addition, Complainant was granted the following US trademarks for its “FX” trademarks:

- FXCOMMERCE, regis. no. 2563220 (April 23, 2002)
- FXCHEATSHEET, regis. no. 3038064 (January 3, 2006)
- FXCONVERTER, regis. no. 3062959 (February 28, 2006)
- FXNEWS, regis. no. 3067801 (March 14, 2006)
- FXDAILY, regis. no. 3179330 (December 5, 2006)
- FXDELIVERY, regis. no. 3200454 (January 23, 2007)

Complainant has also registered the FXTRADE mark in China, receiving registration no. 6118158 (March 14, 2010).

Since 1996, Complainant has also owned the <oanda.com> domain name and used it as the location of Complainant's official website.

The Domain Name was registered on November 25, 2021. The website linked to the Domain Name is currently inactive but previously purported to provide financial information and, in particular, information related to currencies while providing currency exchange trading services.

## 5. Parties' Contentions

### A. Complainant

#### (i) Identical or confusingly similar

Complainant states the Complaint concerns Respondent's unauthorized incorporation into the Domain Name of its registered OANDA trademark owned and used around the world by Complainant for decades. Complainant has submitted evidence to show it owns registered rights in its OANDA mark in the US and in other countries around the world. Complainant claims this ownership of a registered mark as to which the Domain Name is confusingly similar satisfies the Policy, paragraph 4(a)(i).

Complainant states that it has also demonstrated ownership of common law rights in its OANDA mark substantially preceding Respondent's registration of the Domain Name by decades. Complainant asserts such rights arise when a complainant's use of a mark results in secondary meaning, *i.e.*, the mark having become a distinctive identifier associated with Complainant or its goods or services. Secondary meaning can be established by a variety of factors, including advertising expenditures, consumer linking of the mark to the source, unsolicited media coverage of the product, sales success, and length and exclusivity of mark usage. Complainant maintains that the record in this case demonstrates it has cultivated sufficient secondary meaning in its OANDA mark as a unique source identifier of its products and services and of Complainant itself, so that Complainant has proven common law rights.

Complainant states that the relevant inquiry under Policy paragraph 4(a)(i) concerns whether the Domain Name is confusingly similar to the OANDA mark. Complainant contends that incorporating a complainant's registered trademark into a disputed domain name is sufficient without anything more to establish that the domain name is confusingly similar to that trademark. On this basis, Complainant submits that the Domain Name is confusingly similar to the OANDA mark for purposes of the Policy, paragraph 4(a)(i).

Furthermore, Complainant observes that the Domain Name includes the generic suffix "ifx" appended to Complainant's world-famous OANDA mark. The confusingly similar inquiry thus depends on the relative distinctiveness of the mark and the non-mark elements in the Domain Name, and whether the non-mark element (*i.e.*, "ifx") detracts from or contradicts the mark's function as an origin indicator. Complainant submits that where the incorporated trademark enjoys a high degree of inherent distinctiveness reinforced by longstanding international recognition so as to amount to a famous mark (which Complainant states is the case for its OANDA mark), and where the non-mark element in the domain name is generic and does nothing to dispel the connection in the public's mind between the trademark and Complainant, the Policy, paragraph 4(a)(i) is satisfied.

Further, Complainant states that in addition to the trademark registrations for its OANDA mark, it also has, as noted above, registrations covering the following trademarks: FXDELIVERY, FXCOMMERCE, FXCONVERTER, FXCHEATSHEET, FXNEWS, and FXDAILY. Complainant has also registered its FXTRADE trademark in China. The acronym "ifx" in the Domain Name can be parsed into two different subsets, "i" and "fx." "Fx" is commonly known to be the abbreviation for the word "foreign exchange." Further, coupling "i" with "fx" commonly represents an abbreviation for "international foreign exchange." Complainant is widely known to offer international foreign exchange services, and the above registrations for the "FX" marks, both nationally and internationally, serve as proof of this. Ultimately, the acronym "ifx" in the Domain Name reinforces the connection in the public's mind between Complainant, its OANDA mark, and the FX marks. All of the foregoing explains why the descriptive "ifx" is included in the Domain Name. The Domain Name is therefore confusingly similar to Complainant's OANDA mark, and Complainant has satisfied the Policy, paragraph 4(a)(i).

#### (ii) Rights or legitimate interests

Complainant states that it has never authorized Respondent to use the OANDA mark in the Domain Name or otherwise. Complainant is the exclusive owner of all rights in the mark in jurisdictions around the world.

Complainant has not given Respondent permission to advertise or distribute any of its OANDA-based services, whether in connection with the mark or otherwise. Complainant has not authorized Respondent to assert that Respondent is Complainant or that Complainant has any relationship with Respondent. Complainant is not affiliated with, and has never endorsed or sponsored, Respondent or any business associated with Respondent's website. Instead, Complainant asserts that Respondent has attempted to usurp the goodwill in Complainant's OANDA mark and deceptively impersonate Complainant via the website linked to the Domain Name in a blatant attempt to confuse and deceive Internet users into doing business with Respondent instead of Complainant. Accordingly, Respondent has no basis to argue it has any right or legitimate interest in the Domain Name.

Complainant contends that Respondent knew or should have known of Complainant's exclusive OANDA trademark rights when Respondent registered the Domain Name. This dispute concerns Complainant's world-famous mark, used by Complainant around the world for decades (and prior to Respondent's registration of the Domain Name), and supported by worldwide trademark registrations owned by Complainant. The mark has no meaning except as Complainant's name and as a source indicator of Complainant's services. Against these facts, the website accessible through the Domain Name is devoted entirely to tricking Internet visitors into believing falsely that Respondent is supposedly Complainant, or affiliated with Complainant, and that Complainant has sponsored or endorsed Respondent's site. On this record, any story Respondent may spin to describe an alleged unawareness of Complainant's OANDA mark rights when Respondent registered the Domain Name would simply not be believable.

Further, Complainant asserts that Respondent cannot establish any right or legitimate interest in the Domain Name under the Policy, paragraphs 4(c)(i) or (iii) because Respondent has never used the Domain Name in connection with a *bona fide* offering of goods or services. Instead, Respondent registered and has been using the Domain Name: (a) to capture the attention of Internet users looking for information about Complainant and/or services offered by Complainant and who otherwise would likely be directed to Complainant's official website at its very similar <oanda.com> domain name; and (b) to fool users into believing incorrectly that Complainant is responsible for or supports Respondent's site. Complainant contends the use of a disputed domain name for an illegal or nefarious purpose – such as the trademark counterfeiting/infringement, unfair competition, and fraud occasioned by Respondent's publication of its website – is not a *bona fide* offering of goods or services under Policy, paragraph 4(c)(i). Moreover, such use does not constitute a legitimate noncommercial or fair use and cannot under the circumstances confer on Respondent any rights or legitimate interests in the Domain Name.

Here, Respondent registered and was using the Domain Name for the singular bad faith purpose of trying to attract Internet users to Respondent's site by creating a likelihood of confusion between the Domain Name and the OANDA mark, for commercial gain. This constitutes bad faith under the Policy and means Respondent cannot establish any right or legitimate interest in the Domain Name by trying to prove that its use of the Domain Name for the website has been *bona fide*.

Finally, Respondent has never been commonly known by the Domain Name. No evidence suggests Respondent has ever been called by any name incorporating the OANDA mark or been commonly known by the mark or the Domain Name. This is demonstrated by the fact that Respondent's registration information for the Domain Name does not mention the mark.

(iii) Registered and used in bad faith

Complainant contends that Respondent registered and is using the Domain Name in bad faith. Complainant claims that here, the facts demonstrate it is not possible to conceive of any plausible actual or contemplated active use of the Domain Name by Respondent that would be legitimate.

Complainant contends a finding of bad faith may be made where a respondent knew or should have known of the registration and use of a trademark prior to registering the Domain Name. In other words, registration of a well-known trademark as a domain name is a clear indication of bad faith in itself, even without considering other elements. Complainant states this is the case with Respondent's registration of the

Domain Name decades after Complainant began obtaining its registered and common law rights in its world-famous OANDA mark and started using its <oanda.com> domain name as the portal to its official website. That conclusion is inescapable given: (a) Complainant's longstanding registered rights in its OANDA mark; (b) the Domain Name implies an obvious affiliation with Complainant since the OANDA mark has no meaning other than as Complainant's name and as a source indicator to Complainant and its services, and the mark is the dominant component in the Domain Name; and (c) Respondent's website is entirely about Complainant and its services. Put simply, there is no basis upon which Respondent can prove that Respondent registered the Domain Name in good faith and without knowledge of Complainant's exclusive mark rights.

Complainant further submits that Respondent has used the Domain Name in bad faith with the intention to attract, for commercial gain, users to Respondent's website. Complainant contends a registrant's use of a domain name in which the registrant has no right or legitimate interest to pursue an illegal activity constitutes bad faith registration and use under the Policy. Respondent's bad faith under Policy, paragraph 4(b)(iv), is established because Respondent has intentionally attempted to attract, for commercial gain, Internet users to Respondent's site by: (a) first creating a likelihood of confusion with Complainant's OANDA mark as to the source, sponsorship, affiliation, or endorsement of either Respondent or its website; and then (b) constructing the website to fool visitors into believing that Respondent is purportedly Complainant and that Respondent supposedly offers Complainant's services, so as to trick those users into doing business with Respondent instead of Complainant. Complainant submits that where Respondent at the time of registering the Domain Name had knowledge of Complainant's rights in the OANDA mark incorporated into the Domain Name, this opens the door for the Panel to find that the Domain Name was registered with an intention to take unfair advantage of confusion between that mark and the Domain Name in order to draw Internet users to Respondent's website – which in turn constitutes bad faith registration and use of the Domain Name under the Policy.

Complainant contends the only plausible analysis of the evidence in this case establishes that Respondent was aware of Complainant's OANDA mark rights when Respondent registered the Domain Name. Complainant had owned its mark rights for decades prior to the date on which Respondent registered the Domain Name. The mark is an invented word with no meaning other than as Complainant's name and a source indicator for its services. The dominant component of the Domain Name is Complainant's OANDA mark. The content of Respondent's website is devoted exclusively to Complainant and its services. Respondent has impermissibly traded off the OANDA mark's fame by using it, without Complainant's authorization, to confuse Internet users into visiting Respondent's commercial website where Respondent has tried to fool those same users, based on Respondent's attempt to steal Complainant's identity, into believing that Complainant has endorsed or sponsored Respondent's actions in relation to the Domain Name and Respondent's site. This is quintessential bad faith registration and use under the Policy.

Finally, Complainant contends that a finding of bad faith registration and use is necessary where a disputed domain name is so obviously connected with a well-known product such that its very use by someone with no connection to the product suggests opportunistic bad faith. Complainant submits that this circumstance exists here and requires a finding that Respondent registered and is using the Domain Name in bad faith.

## **B. Respondent**

Respondent did not reply to Complainant's contentions.

## **6. Discussion and Findings**

In order to succeed on its Complaint, Complainant must demonstrate that the three elements set forth in paragraph 4(a) of the Policy have been satisfied. These elements are that:

- (i) the Domain Name registered by Respondent is identical or confusingly similar to a trademark or service mark in which Complainant has rights;

- (ii) Respondent has no rights or legitimate interests in respect of the Domain Name; and
- (iii) Respondent has registered and is using the Domain Name in bad faith.

#### **A. Identical or Confusingly Similar**

Complainant has demonstrated that it has well-established rights in its OANDA trademarks through registration and widespread use. Complainant has also demonstrated rights in its FX marks through registration and use. The Domain Name incorporates the OANDA mark in its entirety, while adding the three-letter acronym, “ifx”, which is not only as an abbreviation for “international foreign exchange”, but may also be seen as an allusion to Complainant’s FX marks. With the OANDA mark remaining the dominant feature in the Domain Name, this combination in the Domain Name creates confusing similarity with Complainant’s OANDA and FX marks. See section 1.7 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”), which states that “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 to that mark for purposes of UDRP standing.”

Accordingly, the Panel finds that the Domain Name is confusingly similar to a trademark in which Complainant has rights in accordance with paragraph 4(a)(i) of the Policy.

#### **B. Rights or Legitimate Interests**

Regarding the second element of the Policy, section 2.1 of the [WIPO Overview 3.0](#) states, “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 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.”

Here, the Panel determines that Complainant has made out a *prima facie* case, while Respondent has failed to respond to the Complaint. The Panel finds that Complainant has not authorized Respondent to use Complainant’s well-established OANDA trademark; that Respondent is not commonly known by the Domain Name; that Respondent has not used the Domain Name for a legitimate noncommercial or fair use, nor used it in connection with a *bona fide* offering of goods or services. Instead, the Domain Name has been used to connect to a website that purports to offer financial services information and related services (e.g., currency exchange) that relate directly to Complainant’s business. Moreover, the impact of the Domain Name and its use for Respondent’s previous website (*i.e.*, the Domain Name is currently inactive) provided an overall impression such that Respondent might be said to be impersonating Complainant and purporting to be one of Complainant’s websites. In *OANDA Corporation v. Wenshan Lin, WhoisGuard, Inc. / Guobing Li, and Tao Liqiang (涛力强)*, WIPO Case No. [D2020-2551](#), concerning the domain names <oanda-hk.com>, <oanda.me>, and <oandartw.com>, the panel found on a similar factual record as follows:

“The disputed domain names resolve to websites that display the Complainant’s OANDA trademark and logo and purport to offer the same type of services as the Complainant. However, the Complainant submits that it has not given the Respondent permission, authorization, consent or license to use its OANDA trademark. Therefore, the Panel does not find the Respondent’s use to be a *bona fide* offering of goods or services within the meaning of paragraph 4(c)(i) of the Policy.”

The Panel observes that Respondent has made no attempt to rebut any of Complainant’s allegations in the Complaint.

Accordingly, the Panel finds that Complainant has made a *prima facie* showing of Respondent’s lack of rights or legitimate interests in respect of the Domain Name, which has not been rebutted by Respondent. The Panel therefore finds that Complainant has established the second element of the Policy in accordance with paragraph 4(a)(ii).

### C. Registered and Used in Bad Faith

The third element of paragraph 4(a) of the Policy requires that Complainant demonstrate that Respondent registered and is using the Domain Name in bad faith. [WIPO Overview 3.0](#), section 3.1, states that “bad faith under the UDRP is broadly understood to occur where a respondent takes unfair advantage of or otherwise abuses a complainant’s mark.”

Here, the Panel determines that the Domain Name was registered and has been used in bad faith. With respect to registration, the evidence submitted by Complainant demonstrates that Respondent improperly targeted Complainant and its distinctive OANDA trademark when registering the Domain Name. Complainant has made clear that the OANDA mark is a fanciful mark with no meaning other than as Complainant’s name and as a source indicator for Complainant and its services. Respondent used Complainant’s trademark in full, while combining it with an abbreviation “ifx”, which refers not only to Complainant’s currency exchange business, but also creates an allusion to Complainant’s FX marks. The Panel finds that the Domain Name is so obviously connected with Complainant’s well-established and distinctive OANDA mark that its use by Respondent suggests opportunistic bad faith. Moreover, in the face of these allegations made by Complainant, Respondent has provided no response at all to attempt to justify why Respondent chose to register the Domain Name corresponding to Complainant’s OANDA mark.

This point is further confirmed by Respondent’s use of the Domain Name. Complainant has submitted evidence to indicate that the Domain Name was being used by Respondent for a website that purports to offer financial information and, in particular, information related to monetary currencies, while providing supposed currency exchange trading services, which would be in direct competition with Complainant’s business offerings. As noted above, the overall impression is that Respondent might be said to be impersonating Complainant and purporting to be one of Complainant’s websites. [WIPO Overview 3.0](#), section 3.1.4, provides in relevant part that “use of a domain name for per se illegitimate activity such as the sale of counterfeit goods or phishing can never confer rights or legitimate interests on a respondent, such behavior is manifestly considered evidence of bad faith.” Moreover, as stated in *Autodesk, Inc. v. Oring, Ltd.*, WIPO Case No. [D2020-1610](#), where the panel found that the respondent was impersonating the complainant and effectively had a mirror website under its control, “[t]he only conceivable aim of [the respondent’s] actions was to attract consumers to its website by deceiving them into thinking it was a website operated by the Complainant. These actions are clearly in bad faith.”

In conclusion, the Panel determines that, for all of the above reasons, the Domain Name was registered and is being used in bad faith. Accordingly, Complainant has satisfied 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 Domain Name, <oandaifx.com>, be transferred to Complainant.

*/Christopher S. Gibson/*

**Christopher S. Gibson**

Sole Panelist

Date: July 30, 2022