

ADMINISTRATIVE PANEL DECISION

Oracle Corporation, Oracle International Corporation v. Registration Private, Domains By Proxy, LLC / pradeep Kumar, Oracleappstechnical.com
Case No. D2022-3022

1. The Parties

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

The Respondent is Registration Private, Domains By Proxy, LLC, US / pradeep Kumar, Oracleappstechnical.com, India.

2. The Domain Name and Registrar

The disputed domain name <oracleappstechnical.com> is registered with GoDaddy.com, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on August 17, 2022. On August 17, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On August 18, 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 Complainants on August 18, 2022, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainants to submit an amendment to the Complaint. The Complainants filed an amended Complaint on August 23, 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 August 23, 2022. In accordance with the Rules, paragraph 5, the due date for Response was September 12, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on September 13, 2022.

The Center appointed Taras Kyslyy as the sole panelist in this matter on September 16, 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 a provider of network computing hardware, computing systems, computer software, services and solutions, and a 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 “the Complainant”.

The Complainant 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.

The Complainant owns numerous trademark registrations for the ORACLE mark, including, for instance the US trademark registration No. 1200239, registration date July 6, 1982.

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

The disputed domain name was registered on April 24, 2013, and resolves to a website, where the Respondent purports to offer online training on various Oracle applications, and claims to be both a specialized online training provider for Oracle applications and a Senior Oracle Apps Trainer.

5. Parties’ Contentions

A. Complainant

The disputed domain name is identical or confusingly similar to the Complainant’s trademark. The disputed domain name consists of and fully incorporates the Complainant’s trademark. The addition of the descriptive terms, “apps” and “technical” do not distinguish the disputed domain name, as the Complainant’s trademark is clearly identifiable and the primary and dominant element of the disputed domain name. Since the term ORACLE is a world-famous trademark that is closely associated with the Complainant, searchers will almost certainly be confused into believing that there is a connection of source, sponsorship, affiliation or endorsement between the Complainant and the Respondent by the Respondent’s use of the disputed domain name. Because the addition of a generic Top-Level Domain (“gTLD”) such as “.com” is irrelevant in an analysis of similarity, the disputed domain name is confusingly similar to the Complainant’s trademark.

The Respondent has no rights or legitimate interests in the disputed domain name. The disputed domain name is not a legitimate name or nickname of the Respondent; nor is it in any other way identified with or related to any rights or legitimate interest of the Respondent. The Respondent is neither using the disputed domain name in connection with a *bona fide* offering of goods or services, nor does its use constitute either legitimate noncommercial use or fair use of the disputed domain name. Rather, the Respondent has

registered the disputed domain name to trade on the goodwill established in the Complainant's well-known trademark and divert consumers seeking services offered by the Complainant to the Respondent's competing website so that the Respondent can profit. The Respondent has registered and is using the disputed domain name not for any legitimate noncommercial or fair use purpose, but rather to profit from the value of the Complainant's trademark, which does not constitute a legitimate, *bona fide* offering of goods or services. The Respondent fails to pass the Oki Data test, since (i) the Respondent is not actually offering educational goods or services that have been approved by the Complainant; (ii) the Respondent is offering services that directly compete with the Complainant's official training and certification programs; (iii) the Respondent fails to include any statement on its website that accurately or prominently discloses the Respondent's lack of any relationship with the Complainant. The disputed domain name should not be considered nominative fair use since it does not describe the commercial services, but suggests that it relates to technical information or support for the Complainant's applications and gives the impression that it is related to or endorsed by the Complainant – when it is not.

The disputed domain name was registered and is being used in bad faith. The Respondent has registered and is using the disputed domain name in bad faith for commercial gain and to benefit from the goodwill and notoriety associated with the Complainant's trademark. The disputed domain name begins with and completely incorporates the Complainant's exact trademark, and was registered decades after the Complainant secured worldwide universal recognition and trademark registrations for the Complainant's trademark. The Respondent has chosen to use the Complainant's trademarks without authorization and to impersonate the Complainant, or suggest an endorsement or connection to the Complainant, in order to attract users to its website. The Respondent's use of the Complainant's trademark to promote identical educational and training services is calculated to draw business away from the Complainant, its licensees, and certified trainers. The Respondent registered the disputed domain name primarily for the purpose of freeriding off of the Complainant's well-known trademark by attracting and diverting web users interested in the Complainant's products and services to the Respondent's website who mistakenly believe the disputed domain name is connected to, associated with, or endorsed or sponsored by the Complainant. After seeing the Complainant's trademark in the disputed domain name, consumers will initially be confused as to the site's association with or sponsorship by the Complainant.

B. Respondent

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

6. Discussion and Findings

A. Procedural Issue – Consolidation of Multiple Complainants

Section 4.11.1 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (["WIPO Overview 3.0"](#)) summarizes the consensus view of UDRP panels on the consolidation of multiple complainants, in part, as follows:

"In assessing whether a complaint filed by multiple complainants may be brought against a single respondent, panels look at whether (i) the complainants have a specific common grievance against the respondent, or the respondent has engaged in common conduct that has affected the complainants in a similar fashion, and (ii) it would be equitable and procedurally efficient to permit the consolidation."

The Complainants assert they are related corporate entities and have a common legal interest sufficient to justify consolidation. There is no reason to require each of them to submit an almost identical complaint against the Respondent with nearly identical facts, legal arguments and requested relief. Moreover, the Respondent will not suffer any prejudice, and consolidation will not affect the Respondent's rights in responding to the Complaint.

The Panel accepts these facts in favor of consolidation and grants the consolidation of the Complainants.

B. Identical or Confusingly Similar

According to section 1.11.1 of the [WIPO Overview 3.0](#), the applicable gTLD in a domain name (e.g., “.com”, “.club”, “.nyc”) is viewed as a standard registration requirement and as such is disregarded under the first element confusing similarity test. Thus, the Panel disregards gTLD “.com” for the purposes of the confusing similarity test.

According to section 1.7 of the [WIPO Overview 3.0](#), in cases where a domain name incorporates the entirety of a trademark, the domain name will normally be considered identical or confusingly similar to that mark for purposes of UDRP standing. The Panel finds that in the present case, the disputed domain name incorporates the entirety of the Complainant’s trademark.

According to section 1.8 of the [WIPO Overview 3.0](#), where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element. The Panel finds that in the present case the addition of terms “apps” and “technical” do not prevent a finding of confusing similarity to the Complainant’s ORACLE trademark.

Considering the above, the Panel finds the disputed domain name is confusingly similar to the Complainant’s trademark, therefore, the Complainant has established its case under paragraph 4(a)(i) of the Policy.

C. Rights or Legitimate Interests

The Complainant has established *prima facie* that the Respondent has no rights or legitimate interests in the disputed domain name.

Furthermore, the Respondent provided no evidence that it holds rights or legitimate interests in the disputed domain name.

The available evidence confirms that the Respondent is not commonly known by the disputed domain name, which could demonstrate its rights or legitimate interests (see, e.g., *World Natural Bodybuilding Federation, Inc. v. Daniel Jones, TheDotCafe*, WIPO Case No. [D2008-0642](#)).

The Complainant did not license or otherwise agree to use of its prior registered trademarks by the Respondent, thus no actual or contemplated *bona fide* or legitimate use of the disputed domain name could be reasonably claimed (see, e.g., *Sportswear Company S.P.A. v. Tang Hong*, WIPO Case No. [D2014-1875](#)).

According to section 2.8.1 of the [WIPO Overview 3.0](#) resellers, distributors using a domain name containing complainant’s trademark to undertake sales related to the complainant’s goods may be making a *bona fide* offering of goods and thus have a legitimate interest in such domain name. Outlined in *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#) (the “*Oki Data Test*”), the following cumulative requirements will be applied in the specific conditions of a UDRP case:

- (i) the respondent must actually be offering the goods at issue;
- (ii) the respondent must use the site to sell only the trademarked goods;
- (iii) the site must accurately and prominently disclose the registrant’s relationship with trademark holder; and
- (iv) the respondent must not try to “corner the market” in domain names reflecting trademark.

The Panel finds that the Respondent failed to satisfy at least the third and possibly the first above requirements, since it does not in any way disclose its lack of relationship with the Complainant. As to the offering of goods or services, this is somewhat more complicated, as “apps technical” does not seem to convey an obvious good or service. Either way, whether a service provider is authorized by the brand owner is not – contrary to the Complainant’s assertion – a fair use nor an Oki Data requirement.

The Panel does however agree with the Complainant that there is a risk that the Respondent’s use of the disputed domain name may mislead consumers into thinking that the website is operated by or affiliated with the Complainant. As such, the Respondent’s use of the disputed domain name cannot be considered *bona fide*.

Considering the above, the Panel finds the Complainant has established its case under paragraph 4(a)(ii) of the Policy.

D. Registered and Used in Bad Faith

The Respondent’s use of the disputed domain name to purport to offer services related to the Complainant’s products shows that at the time of the registration of the disputed domain name the Respondent clearly knew and targeted the Complainant’s prior registered and famous trademark, which confirms the bad faith (see, e.g., *The Gap, Inc. v. Deng Youqian*, WIPO Case No. [D2009-0113](#)).

According to section 3.1.4 of the [WIPO Overview 3.0](#), 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. The Panel is convinced that the Complainant’s trademark is well established through long and widespread use, and the Complainant has acquired a significant reputation and level of goodwill in its trademark both in the US and internationally. Thus, the Panel finds that the disputed domain name confusingly similar to the Complainant’s trademark was registered in bad faith.

According to paragraph 4(b)(iv) of the Policy, the following circumstances, in particular but without limitation, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith: 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. In this case, the disputed domain name is resolving to a website offering services related to the Complainant’s products and making false impression of being authorized by the Complainant to intentionally attract Internet users by creating likelihood of confusion with the Complainant’s trademark as to the source of the website and its products. The Panel finds the above confirms the disputed domain name was registered and used in bad faith.

Considering the above, the Panel finds the Complainant has established its case under paragraph 4(a)(iii) 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, <oracleappstechnical.com>, be transferred to the Complainant.

/Taras Kyslyy/

Taras Kyslyy

Sole Panelist

Date: September 30, 2022