

ADMINISTRATIVE PANEL DECISION

F5, Inc., f/k/a F5 Networks, Inc. v. Xiufeng Guo - xTom LLC
Case No. DIO2022-0006

1. The Parties

Complainant is F5, Inc., f/k/a F5 Networks, Inc., United States of America (“United States”) (hereinafter, “Complainant”), represented by Azora Law, United States.

Respondents are Xiufeng Guo - xTom LLC, United States (hereinafter, “Respondent”).

2. The Domain Name and Registrar

The disputed domain name <nginx.io> is registered with Sav.com, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on February 15, 2022. On February 17, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On February 17, 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 February 21, 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 February 21, 2022. The Center received an email communication from Respondent on February 21, 2022.

The Center verified that the Complaint together with the amendment to the Complaint (hereinafter, “the Complaint”) satisfied the formal requirements of the .IO Domain Name Dispute Resolution Policy (the “Policy”), the Rules for .IO Domain Name Dispute Resolution Policy (the “Rules”), and the WIPO Supplemental Rules for .IO 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 February 23, 2022. In accordance with the Rules, paragraph 5, the due date for Response was March 15, 2022. Respondent did not submit any formal response (but sent an email noted below). Accordingly, the Center notified the commencement of Panel appointment process on March 16, 2022.

The Center appointed M. Scott Donahey as the sole panelist in this matter on March 21, 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 the owner of several trademark registrations in the United States since 2012 as well as various countries around the world consisting of or including its NGINX trademark. Complaint, Annex 3. Under its trademark, Complainant offers the following goods and services: computer and software goods and services, application management goods and services, computer networking and technology goods and services, and goods and services related to servers, networks, systems, and computers.

The disputed domain name was registered on December 30, 2019.

Respondent is using Complainant's trademark on its website and is using its website to offer computer-related information and apparently services. Complaint, Annex 4. It is highly likely according to Complainant that consumers will be confused into believing that Complainant is associated with or endorses Respondent and its goods and services.

Respondent is not authorized by Complainant to use its trademarks in any way.

5. Parties' Contentions

A. Complainant

Complainant asserts that the disputed domain name is identical to and/or confusingly similar to its registered trademarks. Complainant contends that Respondent has no rights or legitimate interests in respect of the disputed domain name. Complainant asserts that consumers will be confused into mistakenly believing that Complainant has authorized or endorsed Respondent's services when no such authorization or endorsement has been granted. Complainant argues that the disputed domain name has been registered and is being used in bad faith. Complainant states that while Respondent is apparently making use of open-source software, Respondent has no rights to do so in a way that is likely to cause confusion with Complainant's marks.

B. Respondent

Respondent sent an email to say: "nginx.io is a open source project based on the famous web server software Nginx. We didn't receive any notification from any 3rd party, can you please contact us first before submitting WIPO?".

6. Discussion and Findings

A panel shall decide a complaint 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."

Paragraph 4(a) of the Policy directs that the complainant must prove each of the following:

(i) that the domain name registered by the respondent is identical or confusingly similar to a trademark or service mark in which the complainant has rights; and,

(ii) that the respondent has no rights or legitimate interests in respect of the domain name; and,

(iii) that the domain name has been registered or is being used in bad faith.

A. Identical or Confusingly Similar

The disputed domain name is self-evidently identical to Complainant's NGINX trademark.

B. Rights or Legitimate Interests

While the overall burden of proof in UDRP proceedings is on the complainant, UDRP panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the almost 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 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. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 2.1.

In the present case Complainant alleges that Respondent has no rights or legitimate interests in respect of the disputed domain name and Respondent has failed to assert any such rights (leaving Complainant's *prima facie* case un rebutted), merely claiming reference to an open-source project. At the same time, Respondent acknowledges that this is based on "the famous web server software Nginx", *i.e.*, Complainant's mark. While Respondent may be able to make use of open source software, whether that of Complainant or otherwise, it may not do so by using a domain name identical to the referenced trademark. See *e.g.*, [WIPO Overview 3.0](#) section 2.5.1. Accordingly, the Panel finds that Respondent has no rights or legitimate interests in respect of the disputed domain name.

C. Registered or Used in Bad Faith

Respondent is using the disputed domain name to resolve to a website at which products and services similar to those provided by Complainant under its registered trademarks without permission form or attribution to Complainant, again merely claiming in its communication to the Center reference to an open-source project, while also acknowledging the repute of Complainant's mark. Again without taking a view on whether Respondent may make use of such software, it may not do so by using a domain name identical to the relevant trademark which gives the false impression of being sponsored or endorsed by (or indeed that of) Complainant. Accordingly, the Panel finds that Respondent has registered and is using the disputed domain name in bad faith.

6. 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, <nginx.io>, be transferred to Complainant.

/M Scott Donahey/

M. Scott Donahey

Sole Panelist

Date: May 19, 2022