

ADMINISTRATIVE PANEL DECISION

Federal Express Corporation v. Viet Tomtom, Viet Technology and Media Services

Case No. D2023-0466

1. The Parties

The Complainant is Federal Express Corporation, United States of America, represented by BMVN International LLC, Viet Nam.

The Respondent is Viet Tomtom, Viet Technology and Media Services, United Kingdom.

2. The Domain Name and Registrar

The disputed domain name <fedexvietnam.net> is registered with NameSilo, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on February 1, 2023. On February 1, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On February 1, 2023, 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 (PrivacyGuardian.org) and contact information in the Complaint. The Center sent an email communication to the Complainant on February 2, 2023 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 February 3, 2023.

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 February 8, 2023. In accordance with the Rules, paragraph 5, the due date for Response was February 28, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on March 1, 2023.

The Center appointed Nayiri Boghossian as the sole panelist in this matter on March 8, 2023. 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 Complainant was founded in 1971 and is a transportation and logistics services company. The Complainant owns many trademark registrations for FEDEX such as International trademark registration No. 1081148 registered on August 29, 1985.

The disputed domain name was registered on August 1, 2018, and resolves to a website which provides logistics and transportation services.

5. Parties' Contentions

A. Complainant

The Complainant contends that the disputed domain name is confusingly similar to a service mark in which the Complainant has rights. The disputed domain name fully incorporates the Complainant's trademark, which is well-known. The geographical term "vietnam" heightens the confusion as it suggests that the disputed domain name is affiliated with the Complainant's services in Viet Nam. The element ".net" does not prevent confusion. The services provided through the disputed domain name are identical to those offered by the Complainant.

The Complainant contends that the Respondent has no rights or legitimate interests in the disputed domain name. The disputed domain name was registered long after the registration of the Complainant's trademark. The Complainant's trademark has been used extensively for over 50 years and has acquired worldwide recognition and is not a dictionary word. The Respondent is not affiliated with the Complainant nor authorized or licensed to use its trademark. There is no evidence that the Respondent is commonly known by the disputed domain name. The webpage does not state that there is no relationship between the Complainant and the Respondent. The Respondent is attempting to create a false connection with the Complainant in order to redirect consumers to its website for commercial gain. Such use cannot constitute *bona fide* offering of goods or services.

The Complainant contends that the disputed domain name was registered and is being used in bad faith. Incorporating the Complainant's well-known trademark indicates bad faith registration. The Respondent must have been aware of the Complainant's trademark which was registered long before the registration of the disputed domain name. The disputed domain name was registered for commercial gain by misleading consumers into using the Respondent's services. Consumers will be initially confused by the disputed domain name. The Respondent did not reply to the cease-and-desist letter sent by the Complainant. The use of privacy services is further indication of bad faith under the circumstances. The Respondent's continued ownership of the disputed domain name poses a threat that infringing activities will continue to occur, which demonstrates bad faith.

B. Respondent

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

6. Discussion and Findings

A. Identical or Confusingly Similar

The Complainant owns trademark registrations for FEDEX. The Panel is satisfied that the Complainant has established its ownership of the trademark FEDEX.

It is established by prior UDRP panels that when a domain name incorporates a complainant's registered trademark, such incorporation is sufficient to establish identity or confusing similarity for the purposes of the Policy even if other words are added as part of the disputed domain name. *E.g., Oki Data Americas, Inc v. ASD, Inc.*, WIPO Case No. [D2001-0903](#) ("*Oki Data*"). The disputed domain name incorporates the Complainant's trademark FEDEX in its entirety. The word "vietnam" does not prevent the fact that the disputed domain name is confusingly similar to the Complainant's trademark.

The generic Top-Level Domain ".net" should generally be ignored when assessing confusing similarity as established by prior UDRP decisions.

Consequently, the Panel finds that the disputed domain name is confusingly similar to the trademark of the Complainant and that the Complainant has satisfied paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

Under paragraph 4(a)(ii) of the Policy, a complainant must make at least a *prima facie* showing that a respondent does not have any rights or legitimate interests in the disputed domain name. Once such showing is made, the burden of production shifts to the respondent. In the instant case, the Complainant asserts that the Respondent is not affiliated with nor authorized by the Complainant to use its trademark. The Respondent should prove that it has rights or legitimate interests.

The Panel finds it necessary to assess whether there is a *bona fide* offering of goods or services as the disputed domain name resolves to a website through which transportation and logistics services are being advertised. In other words, the disputed domain name is being used to sell competing products. Prior Panels have held that a respondent is not using a domain name for a *bona fide* offering of goods or services if it uses the domain name for competing products. The use of the Complainant's trademark which has a reputation for offering the type of products being offered by the Respondent is not fair as the Respondent's website does not include a disclaimer that it is not connected with the Complainant, and it gives the impression of being the Complainant's website or affiliated to it. See *CareSource v. Domain Administrator*, See *PrivacyGuardian.org/FAG*, WIPO Case No. [D2018-2411](#).

Furthermore, the absence of a response by the Respondent allows the Panel to draw inferences, and under the circumstances, the absence of response leaves the Complainant's *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name un rebutted.

Accordingly, the Complainant has satisfied paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

The Respondent must have known of the Complainant's business and trademark as the Complainant's trademark was registered more than 30 years before the creation of the disputed domain name. The disputed domain name resolves to a website, which offers products similar to those offered by the Complainant. As such, the disputed domain name has been registered in order to attract Internet users to the Respondent's website by creating a likelihood of confusion with the Complainant's trademark as to the source, sponsorship, affiliation or endorsement. It has been found by prior UDRP panels that such use of a domain name constitutes bad faith, see *Gilead Sciences, Inc. v. Adewale Tokosi*, WIPO Case No. [D2021-0961](#).

Such conduct falls squarely within the meaning of paragraph 4(b)(iv) of the Policy, and accordingly, the Panel finds that the Complainant has satisfied 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 <fedexvietnam.net> be transferred to the Complainant.

/Nayiri Boghossian/

Nayiri Boghossian

Sole Panelist

Date: March 22, 2023