

## **ADMINISTRATIVE PANEL DECISION**

Xerox Corporation v. Shubham Sethi  
Case No. D2022-1631

### **1. The Parties**

The Complainant is Xerox Corporation, United States of America (“United States”), represented by Fidus Law Chambers, India.

The Respondent is Shubham Sethi, India.

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

The disputed domain name <xeroxbaba.com> (“Domain Name”) 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 May 5, 2022. On May 5, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On May 5, 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 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 7, 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 9, 2022. In accordance with the Rules, paragraph 5, the due date for Response was May 29, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on May 30, 2022.

The Center appointed Nicholas Smith as the sole panelist in this matter on June 12, 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 Complainant is a United States company, dating from 1906 and trading under the Xerox name for over 70 years, that specializes in document solutions including offering a wide variety of printers and other multi-function devices. The Complainant established a subsidiary in India (the location of the Respondent) in 1983. It has held the domain name <xerox.com> since 1986 and maintains an active website at that domain name.

The Complainant is the owner of trade marks in various jurisdictions consisting of the word “xerox” (the XEROX Mark”) including an Indian registration for the XEROX Mark (Registration No. 155627, registered on September 22, 1952) for goods in class 1.

The Domain Name was registered on October 11, 2020, and does not resolve to an active website, rather the Domain Name resolves to a website simply indicating that the website is “coming soon”.

#### **5. Parties’ Contentions**

##### **A. Complainant**

The Complainant makes the following contentions:

- (i) that the Domain Name is identical or confusingly similar to the Complainant’s XEROX Mark;
- (ii) that the Respondent has no rights nor any legitimate interests in respect of the Domain Name; and
- (iii) that the Domain Name has been registered and is being used in bad faith.

The Complainant is the owner of the XEROX Mark, having registered the XEROX Mark in various jurisdictions including India, the location of the Respondent. The Domain Name is confusingly similar to the XEROX Mark, wholly incorporating the XEROX Mark and adding the arbitrary term “baba”.

There are no rights or legitimate interests held by the Respondent in respect of the Domain Name. The Complainant has not granted any license or authorization for the Respondent to use the XEROX Mark nor is the Respondent commonly known by the Domain Name. The Respondent does not use the Domain Name for a *bona fide* purpose or legitimate noncommercial purpose. Indeed the Domain Name does not resolve to an operational webpage.

The Respondent has registered and uses the Domain Name in bad faith. There is no plausible circumstance under which the Respondent could legitimately use the Domain Name, which combines the XEROX Mark and the arbitrary term “baba”, other than in bad faith. Given the reputation of the coined XEROX Mark, the Respondent must have been aware of the Complainant’s mark at the time of registration. In such circumstances, the Respondent’s passive holding of the Domain Name amounts to use of the Domain Name in bad faith.

##### **B. Respondent**

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

## 6. Discussion and Findings

### A. Identical or Confusingly Similar

To prove this element the Complainant must have trade or service mark rights and the Domain Name must be identical or confusingly similar to the Complainant's trade or service mark.

The Complainant is the owner of the XEROX Mark, having a registration for the XEROX Mark as a trade mark in various jurisdictions, including India.

The Domain Name incorporates the XEROX Mark in its entirety with the addition of the word "baba" (a honorific commonly used in South Asia). Other UDRP panels have repeatedly held that where the relevant trade mark is recognizable within the disputed domain name, the addition of other terms does not prevent a finding of confusing similarity under the first element; see section 1.8 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)").

The Panel finds that the Domain Name is confusingly similar to the Complainant's XEROX Mark. Consequently, the requirement of paragraph 4(a)(i) of the Policy is satisfied.

### B. Rights or Legitimate Interests

To succeed on this element, a complainant may make out a *prima facie* case that the respondent lacks rights or legitimate interests in the disputed domain name. If such a *prima facie* case is made out, the respondent then has the burden of demonstrating rights or legitimate interests in the domain name.

Paragraph 4(c) of the Policy enumerates several ways in which a respondent may demonstrate rights or legitimate interests in a disputed domain name:

"Any of the following circumstances, in particular but without limitation, if found by the Panel to be proved based on its evaluation of all evidence presented, shall demonstrate your rights or legitimate interests to the domain name for purposes of paragraph 4(a)(ii):

(i) before any notice to you of the dispute, your use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a *bona fide* offering of goods or services; or

(ii) you (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trade mark or service mark rights; or

(iii) you are making legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trade mark or service mark at issue."

The Respondent is not affiliated with the Complainant in any way. It has not been authorized by the Complainant to register or use the Domain Name or to seek the registration of any domain name incorporating the XEROX Mark or a mark similar to the XEROX Mark. There is no evidence that the Respondent is commonly known by the Domain Name or any similar name.

There is no evidence that the Respondent has used or made demonstrable preparations to use the Domain Name in connection with a *bona fide* offering of goods or services or for a legitimate noncommercial use. In fact, there is no evidence of any demonstrable preparations to use the Domain Name at all beyond the creation of a "coming soon" page.

The Panel finds that the Complainant has established a *prima facie* case that the Respondent lacks rights or legitimate interests in the Domain Name. The Respondent has chosen not to respond to the Complaint and thus has failed to provide any evidence of rights or legitimate interests in the Domain Name. The Panel finds that the Respondent has no rights or legitimate interests in respect of the Domain Name under paragraph

4(a)(ii) of the Policy.

### **C. Registered and Used in Bad Faith**

For the purposes of paragraph 4(a)(iii) 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 the Domain Name in bad faith:

- (i) circumstances indicating that the Respondent has registered or has 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 trade mark or service mark or to a competitor of the Complainant, for valuable consideration in excess of its documented out-of-pocket costs directly related to the Domain Name; or
- (ii) the Respondent has registered the Domain Name in order to prevent the owner of the trade mark or service mark from reflecting the mark in a corresponding domain name, provided that the Respondent has engaged in a pattern of such conduct; or
- (iii) the Respondent has registered the Domain Name primarily for the purpose of disrupting the business of a competitor; or
- (iv) by using the Domain Name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its 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 the Respondent's website or location or of a product or service on the Respondent's website or location.

The Domain Name was registered over 60 years after the XEROX Mark was registered in India and the Complainant has a significant global reputation in its XEROX Mark. The Panel finds, on the balance of probabilities, that the Respondent would have been aware of the Complainant and its reputation in the XEROX Mark at the time the Respondent registered the Domain Name. There is no obvious reason, nor has the Respondent offered an explanation, for the Respondent to register a domain name incorporating the coined XEROX Mark and the word "baba" unless there was an intention to create a likelihood of confusion between the Domain Name and the XEROX Mark from which the Respondent would likely benefit.

Considering the nature of the Domain Name (containing a coined mark and a descriptive term) and the failure by the Respondent to participate in this proceeding or otherwise provide any explanation of its conduct in registering a domain name that combines the well-known XEROX Mark and the word "baba", the Panel finds that the passive holding of the Domain Name does not prevent a finding of use in bad faith. Moreover, the Panel is prepared to infer, based on the conduct of the Respondent, that the Domain Name is most likely being held pending use as website or email address that, without the license of the Complainant, will make reference to the Complainant in an illicit manner for the Respondent's commercial gain.

Accordingly, the Panel finds that the Respondent has registered and is using the Domain Name in bad faith 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 Domain Name, <xerobaba.com> be transferred to the Complainant.

*/Nicholas Smith/*

**Nicholas Smith**

Sole Panelist

Date: June 23, 2022