

ADMINISTRATIVE PANEL DECISION

Equifax Inc. v. Moe Khanm, Auto Finance Now
Case No. D2022-4433

1. The Parties

The Complainant is Equifax Inc., United States of America (“United States”), represented by The GigaLaw Firm, Douglas M. Isenberg, Attorney at Law, LLC, United States.

The Respondent is Moe Khanm, Auto Finance Now, Canada

2. The Domain Name and Registrar

The disputed domain name <equifaxfix.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 November 20, 2022. On November 20, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On November 21, 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 (Registration Private, Domains By Proxy, LLC) and contact information in the Complaint. The Center sent an email communication to the Complainant on November 22, 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 amendment to the Complaint on November 22, 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 the Respondent of the Complaint, and the proceedings commenced on November 23, 2022. In accordance with the Rules, paragraph 5, the due date for Response was December 13, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on December 16, 2022.

The Center appointed Dr. Clive N.A. Trotman as the sole panelist in this matter on December 24, 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 based company of long standing, engaged in information solutions and human resources business processes. The Complainant was incorporated in 1913 and its scale currently is such as to employ 11,000 people worldwide.

The Complainant is the holder of some 221 trademark registrations for or including EQUIFAX in at least 56 jurisdictions worldwide, the oldest of which was used and registered 47 years ago. The following trademarks are representative for the purposes of the present proceeding:

EQUIFAX, United States Patent and Trademark Office (“USPTO”), registered December 16, 1975, registration number 1027544, in class 36;

EQUIFAX, USPTO, registered August 3, 1976, registration number 1045574, in class 35;

EQUIFAX, USPTO, registered May 14, 1991, registration number 1644585, in classes 35, 36 and 42.

The Complainant has also been the registrant since February 21, 1995, of the domain name <equifax.com>, used as its primary website.

Nothing of significance is known about the Respondent except for the registrant contact details provided in order to register the disputed domain name on January 5, 2019. The WhoIs for the disputed domain name reflected a privacy service at the time of filing the Complaint. The disputed domain name does not resolve to an active website but to a parking page stating that it may be for sale.

5. Parties’ Contentions

A. Complainant

The Complainant’s extensive contentions may be summarised as follows.

The Complainant contends that the disputed domain name is identical or confusingly similar to a trademark in which the Complainant has rights. Disregarding the generic Top-Level Domain (“gTLD”) “.com”, the disputed domain name contains the entirety of the Complainant’s trademark. The Complainant’s trademark is recognisable in the disputed domain name and the additional word “fix” should not prevent a finding of confusing similarity.

The Complainant further contends that the Respondent has no rights or legitimate interests in respect of the disputed domain name. The Complainant says it has never authorised the Respondent to register or use the Complainant’s trademark. The disputed domain name is not in use in connection with a *bona fide* offering of goods or services, or in use at all, but is passively held. The statement on the parking page, that the disputed domain name may be for sale, is not a *bona fide* offering of goods or services. The Respondent has never been commonly known by the disputed domain name and has never acquired any trademark rights in it. Since the disputed domain name is not in active use, it cannot be in use for any legitimate noncommercial or fair purpose.

The Complainant says the disputed domain name was registered and is being used in bad faith. The Complainant says its trademark is famous and widely known, being protected in at least 56 jurisdictions worldwide, with the oldest registration dating back 47 years. The Complainant refers to previous decisions under the Policy and submits that because the disputed domain name is so obviously connected with the

Complainant, the Respondent's registration of the disputed domain name suggests opportunistic bad faith.

The Complainant contends that bad faith in connection with the disputed domain name being passively held is substantiated here for reasons that include: the distinctiveness, reputation, historical duration and geographical diversity of the Complainant's trademark; the Respondent's concealment of its identity under a privacy service; and that it is impossible to identify any good faith use to which the disputed domain name could be put. Furthermore, the disputed domain name is indicated as being available for possible sale.

The Complainant has cited a number of previous decisions under the Policy, many of which concern cases in which the Complainant has itself prevailed.

The Complainant requests the transfer of the disputed domain name.

B. Respondent

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

6. Discussion and Findings

Paragraph 4(a) of the Policy states that the Respondent is required to submit to a mandatory administrative proceeding in the event that the Complainant asserts to the applicable dispute-resolution provider, in compliance with the Rules, that:

"(i) your domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights; and

(ii) you have no rights or legitimate interests in respect of the domain name; and

(iii) your domain name has been registered and is being used in bad faith."

The Complainant has made the relevant assertions as required by the Policy. The dispute is properly within the scope of the Policy and the Panel has jurisdiction to decide the dispute.

A. Identical or Confusingly Similar

The Panel has perused the copies of trademark registration documentation produced by the Complainant and is satisfied that the Complainant has the requisite rights under the Policy in the trademark EQUIFAX.

The disputed domain name is <equifaxfix.com>, of which the gTLD ".com" may be disregarded in the determination of confusing similarity. The body of the disputed domain name then reads "equifax", being identical to the Complainant's trademark, followed by the word "fix". In a side-by-side comparison, the disputed domain name clearly portrays the Complainant's trademark and is found to be confusingly similar to the trademark; the additional word "fix" is found not to prevent a finding of confusing similarity in this instance. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), sections 1.7 and 1.8.

The Panel finds for the Complainant under paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

The Complainant states a *prima facie* case to the effect that it has never authorised the Respondent to register or to use the Complainant's trademark, and that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

Under paragraph 4(c) of the Policy the Respondent may contest the Complainant's *prima facie* case under paragraph 4(a)(ii) of the Policy and may seek to establish rights or legitimate interests in a disputed domain name by demonstrating, without limitation:

“(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 trademark or service mark rights; or

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

Since the disputed domain name is passively held there is no evidence it is in active use or in preparation for use in connection with a *bona fide* purpose, or for any legitimate noncommercial or fair purpose. There is no evidence the Respondent has ever been commonly known by the disputed domain name.

The Respondent has not responded and has not asserted rights or legitimate interests in the disputed domain name with reference to paragraphs 4(c)(i), (ii) or (iii) of the Policy or otherwise.

The Panel finds that the Respondent does not have rights or legitimate interests in the disputed domain name and finds for the Complainant under paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

The Complainant must prove under paragraph 4(a)(iii) of the Policy that the disputed domain name has been registered and is being used in bad faith. Paragraph 4(b) of the Policy lists four alternative circumstances that shall be evidence of the registration and use of a domain name in bad faith by a respondent:

“(i) circumstances indicating that you have registered or you have 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 trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of your documented out-of-pocket costs directly related to the domain name; or

(ii) you have registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that you have engaged in a pattern of such conduct; or

(iii) you have registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your web site or other on-line 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.”

The provisions of paragraph 4(b) of the Policy are without limitation and bad faith may be found alternatively by the Panel.

Examination of the website to which the disputed domain name has resolved reveals a parking page headed “Go Daddy / equifaxfix.com / may be for sale”, followed by purchase advice and telephone numbers. No evidence has been produced to the effect that the disputed domain name has been used for any active purpose. Thus, the disputed domain name is passively held.

On the totality of the evidence, the disputed domain name is confusingly similar to the distinctive, non-dictionary trademark that has been held by the Complainant for 47 years and that is widely known internationally. The Complainant's trademark is by any reasonable standard famous to the point that the Respondent may be assumed to have been aware of it or at least ought to have made itself aware of it. The Respondent has not attempted to establish any rights in the disputed domain name, having not participated in the proceeding and seemingly having provided false contact information in light of the courier's inability to deliver the Center's written communication to the physical contact details disclosed by the Registrar for the Respondent. The statement on the parking page that the disputed domain name "may be for sale" can reasonably be interpreted as an invitation to potential buyers, that attempts to avoid having made an overt offer to sell in the terms of paragraph 4(b)(i) of the Policy. Since the disputed domain name sits passively without apparently earning revenue, the inescapable conclusion on balance is that it was registered speculatively by the Respondent with the intention of an unspecified future commercial gain, the only apparent direction of which, to date, has been the parking page notice that it "may be for sale".

It is not essential to determine the Respondent's precise future intentions for the disputed domain name, which may not yet have been formulated. The instances of bad faith exemplified in paragraph 4(b) of the Policy are without limitation. The Panel finds ample evidence upon which to conclude on the balance of probabilities that the disputed domain name was registered speculatively in bad faith for ultimate commercial gain and is in use in bad faith by being passively held with what is effectively an invitation to negotiate over its potential sale.

On the evidence and on the balance of probabilities, the Panel finds registration and use of the disputed domain name in bad faith by the Respondent in the terms of 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 <equifaxfix.com> be transferred to the Complainant.

/Dr. Clive N.A. Trotman/

Dr. Clive N.A. Trotman

Sole Panelist

Date: January 7, 2023