

## **ADMINISTRATIVE PANEL DECISION**

Oracle America, Inc. v. Nikunj Suthar

Case No. D2023-2695

### **1. The Parties**

The Complainant is Oracle America, Inc., United States of America, represented by Kilpatrick Townsend & Stockton LLP, United States of America.

The Respondent is Nikunj Suthar, India.

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

The disputed domain name <sibyllsoftware.com> (the “Disputed 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 June 22, 2023. On June 23, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On June 23, 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 (REGISTRATION PRIVATE / DOMAINS BY PROXY, LLC) and contact information in the Complaint. The Center sent an email communication to the Complainant on June 26, 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 June 29, 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 June 30, 2023. In accordance with the Rules, paragraph 5, the due date for Response was July 20, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on July 25, 2023.

The Center appointed Nick J. Gardner as the sole panelist in this matter on August 1, 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 is a subsidiary of Oracle Corporation which is a leading international provider of information technology related products and services. In 2005, the Complainant announced its acquisition of Siebel Systems, Inc. (Siebel Systems), a software company founded in 1993. Siebel Systems was a leading provider of Customer Relationship Management (“CRM”) software. Since 2005 the Complainant has sold CRM systems under the brand name SIEBEL. The Complainant’s SIEBEL branded CRM systems are very successful on an international basis and have for example won a number of awards as being the leading CRM software in the CRM marketplace. These systems are very well known in the information technology and software fields.

The Complainant owns a number of registered trademarks for the term “Siebel” – see for example Indian trademark no 1294071 registered on July 2, 2004. These trademarks are referred to as the “SIEBEL trademark” in this decision.

The Disputed Domain Name was registered on July 2, 2016. It resolves to a website (the “Respondent’s Website”) which purports to offer various information technology related services under “Sibyll Software” (see further below). On November 11, 2016, the Respondent filed a trademark application in India for a device trademark including the words “Sibyll Software - The raven eye in technology”. In 2020 the Complainant learnt of this application and filed an opposition to the application. The opposition was upheld in 2022. Correspondence subsequently took place between the Complainant (through its legal advisers in India) and the Respondent with the Complainant objecting to the Respondent’s continued use of the term “sibyll” in the Disputed Domain Name and in the Respondent’s business. The Respondent indicated it was reluctant to rebrand because of the associated costs which it said it could not afford.

#### **5. Parties’ Contentions**

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

The Complainant says that the Disputed Domain Name is confusingly similar to the SIEBEL trademark. It says that if the dictionary word “software” is ignored, the dominant part of the Disputed Domain Name is the term “sibyll” which it says is similar to the mark SIEBEL each being a six letter word commencing with “si” and ending with “l” with a “b” in the middle. It also says “sibyl” and “siebel” are pronounced almost identically. It further says that a significant proportion of actual or potential customers regularly misspell the term “Siebel” typically as either Sibel or Sybil and provides examples of where this has occurred.

The Complainant says the Respondent has no legitimate interest in the term “siebel” nor in the term “sibyll” or “sibyllsoftware”.

The Complainant says the Respondent’s website is a sham. It produces detailed evidence showing that the Respondent’s website is based on a *pro forma* template which can be purchased online for under USD 100. It shows examples of other websites in this regard which contain identical content to the Respondent’s Website. It also points out that large parts of the Respondent’s Website are incomplete or make no sense and some information it contains (such as the address shown in the “Contacts” section) are fictitious and derive from the template in question. The Complainant says that the likely true purpose of the Respondent’s Website is to collect customer details from enquiries made via the Respondent’s Website, and then the Respondent contacts such potential customers to attempt to sell them some form of information technology services. The Complainant has placed in evidence copies of social media pages produced by the Respondent which appear to indicate his business is the provision of web development services. The Complainant says potential customers are attracted to the Respondent’s Website because of the confusion

between the Disputed Domain Name and the SIEBEL trademark. The Complainant says that given the Respondent is involved in the provision of some form of information technology services, he will have been familiar with the SIEBEL trademark and the Disputed Domain Name was deliberately chosen because of its confusing similarity to the SIEBEL trademark. The Complainant says this is indicative of registration and use in bad faith.

## **B. Respondent**

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

## **6. Discussion and Findings**

### **Preliminary Matters**

The Panel notes that no communication has been received from the Respondent. However, given the Complaint and Written Notice were sent to the relevant addresses disclosed by the Registrar, then the Panel considers that this satisfies the requirement in paragraph 2(a) of the UDRP Rules to "employ reasonably available means calculated to achieve actual notice". Accordingly, the Panel considers it is able to proceed to determine this Complaint and to draw inferences from the Respondent's failure to file any Response. While the Respondent's failure to file a Response does not automatically result in a decision in favor of the Complainant, the Panel may draw appropriate inferences from the Respondent's default (see, e.g., *Verner Panton Design v. Fontana di Luce Corp*, WIPO Case No. [D2012-1909](#)).

### **Substantive Matters**

To succeed, in accordance with paragraph 4(a) of the Policy, the Complainant must satisfy the Panel that:

- (i) the Disputed Domain Name is identical with or confusingly similar to a trademark or service mark in which the Complainant has rights;
- (ii) the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name;
- (iii) the Disputed Domain Name has been registered and is being used in bad faith.

### **A. Identical or Confusingly Similar**

The Complainant has rights in the SEIBEL trademark. The Panel finds the Disputed Domain Name is confusingly similar to this trademark. Previous UDRP panels have consistently held that domain names are identical or confusingly similar to a trademark for purposes of the Policy "when the domain name includes the trademark, or a confusingly similar approximation, regardless of the other terms in the domain name" (*Wal-Mart Stores, Inc. v. Richard MacLeod d/b/a For Sale*, WIPO Case No. [D2000-0662](#)). In the present case the Panel considers that "sibyll" is a confusingly similar approximation to SIEBEL. That is particular so given the Complainant's evidence that customers can misspell SIEBEL as "sibel" or "sybel". It is also the case that the terms "siebel" and "sibyll" are phonetically almost identical. Phonetic equivalence or confusing similarity phonetically suffices for establishing the first element under the Policy – See *Zumiez Inc. v. Richard Jones* WIPO Case No. [D2007-0024](#) and the cases therein cited.

It is also established that 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 (see [WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition](#), section 1.8. Therefore, the addition of a descriptive term (such as here "software") to a disputed domain name has little, if any, effect on a determination of confusing similarity between the domain name and the mark (*Quixtar Investments, Inc. v. Dennis Hoffman*, WIPO Case No. [D2000-0253](#)); furthermore, mere addition of a generic or descriptive term does not prevent a finding of

confusing similarity under the first element (*PRL USA Holdings, Inc. v. Spiral Matrix*, WIPO Case No. [D2006-0189](#)).

It is also well established that the generic Top-Level Domain, in this case “.com”, does not affect the Disputed Domain Name for the purpose of determining whether it is identical or confusingly similar. See, for example, *Rollerblade, Inc. v. Chris McCrady*, WIPO Case No. [D2000-0429](#).

Accordingly the Panel finds that the Disputed Domain Name is confusingly similar to the Complainant's trademark and hence the first condition of paragraph 4(a) of the Policy has been fulfilled.

## **B. Rights or Legitimate Interests**

Paragraph 4(c) of the Policy provides a list of circumstances any of which is sufficient to demonstrate that a respondent has rights or legitimate interests in a domain name:

- (i) before any notice to the respondent of the dispute, 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) the respondent has been commonly known by the domain name, even if the respondent has acquired no trademark or service mark rights; or
- (iii) the respondent is 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.

The evidential record in this case indicates that the Respondent may conduct whatever his business may be, via a company called SIBYLL SOFTWARE (OPC) PRIVATE LIMITED. Whilst the Respondent has not filed a Response it would seem to the Panel likely that had he done so, he would potentially have argued that Paragraph 4 (i) and/or (ii) of the Policy apply ((iii) cannot apply as it relates to noncommercial situations). The difficulty with that argument, were it to be made, is that the Panel does not consider that a respondent who deliberately adopts a name which corresponds to, or is similar to, that of a complainant (particularly a well-known one), with a view to taking advantage of that complainant's fame and reputation, can then take advantage of an “own name” provision to justify its actions. The right to use one's own name is not unlimited and cannot be used to circumvent well known prior rights in a similar name – see for example *Peter Frampton vs. Frampton Enterprises, Inc.*, WIPO Case No. [D2002-0141](#):

“While the Panel recognizes that any individual has a right to use his (her) name in connection with a business, that right is not unfettered; instead, it is circumscribed by the prior trademark rights of others who use that name in connection with specific goods and services, as is certainly the case here.

A party alleging, under paragraph 4(c)(ii), as the Respondent purports to do here, that it is commonly known by a particular name, sufficient to show legitimate rights and interest in a domain name that contains that particular personal name (*e.g.*, a surname), must provide adequate extrinsic proof that a corresponding group of consumers, *e.g.*, Internet users, who are likely to access that party's web site, associates that domain name with that party rather than with the trademark owner, *i.e.*, that domain name possesses requisite secondary meaning, or at least that party has used or is using that name sufficiently broadly such a panel can infer that such meaning exists.”

The Panel agrees with that approach in the circumstances of the present case. For reasons discussed below in relation to bad faith it seems to the Panel more likely than not that the Respondent adopted the term “sibyll” as part of the Disputed Domain Name and for use in his business because of its confusing similarity to the SIEBEL trademark. In those circumstances the Respondent cannot avail himself of the provisions of (i) or (ii) above. Furthermore, it should be noted that what paragraph 4 (c)(i) of the Policy requires Respondent to demonstrate that he has used the Disputed Domain Name in connection with a *bona fide*

offering of goods or services, whereas paragraph 4(c)(ii) of the Policy requires that the Respondent demonstrates that he is commonly known as the Disputed Domain Name. No evidence at all to this effect has been produced by the Respondent.

The Complainant has not authorised, licensed, or permitted the Respondent to register or use the Disputed Domain Name or to use SIEBEL trademark. The Complainant has prior rights in the SIEBEL trademark, which precede the Respondent's acquisition of the Disputed Domain Name. The Complainant has therefore established a *prima facie* case that the Respondent does not have any rights or legitimate interests in the Disputed Domain Name, and thereby the burden of production shifts to the Respondent to produce evidence demonstrating rights or legitimate interests in respect of the Disputed Domain Name (see, for example, *Do The Hustle, LLC v. Tropic Web*, WIPO Case No. [D2000-0624](#); *Croatia Airlines d.d. v. Modern Empire Internet Ltd.*, WIPO Case No. [D2003-0455](#)).

The Panel finds that the Respondent has failed to produce any evidence to establish his rights or legitimate interests in the Disputed Domain Name. Nothing in the record, including the email communications sent from the Respondent to the Complainant before the commencement of these proceedings, shows that the Respondent may have rights or legitimate interests over the Disputed Domain Name. For the reasons discussed above the Panel in any event concludes that none of paragraphs 4(c)(i) to (iii) of the Policy apply in the present circumstances. Accordingly the Panel finds the Respondent has no rights or any legitimate interests in the Disputed Domain Name and the second condition of paragraph 4(a) of the Policy has been fulfilled.

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

Under paragraph 4(b) of the Policy a non-exhaustive list of factors evidencing registration and use in bad faith comprises:

- (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 web site or location or of a product or service on your web site or location.

In the present circumstances the Panel is not sure that the Respondent's exact motivation falls squarely within any of the above sub-paragraphs, but that list is in any event non-exhaustive. In assessing this issue, the Panel accepts that it is more likely than not that the Respondent knew of the SIEBEL trademark when he registered the Disputed Domain Name, given that he is involved in the provision of information technology services and the SIEBEL trademark is well known in that field of activity. This is further confirmed with the composition of the Disputed Domain Name itself, since the term "software" likely increases the likelihood of confusion given that term relates to the nature of the Complainant's business carried out using the SIEBEL trademark.

Moreover, the Respondent's Website is quite obviously incomplete and amateurish – for example it contains numerous sections comprising what printers refer to as “Lorem Ipsum” text *i.e.*, dummy text. The Panel thinks that anyone other than a casual visitor would on scrutiny realise this was unlikely to be a website operated by or with the consent of the Complainant. The Panel is accordingly doubtful at how effective this website would be at attracting any customers who would actually provide details that the Respondent could then use to attempt to sell his services (whatever they are). On balance it seems to the Panel that the Respondent's Website (and the Respondent's other usage of the term “sibyll” in his business) are intended to provide to actual or potential customers the *imprimatur* of a connection with the Complainant – in other words the Respondent is adopting the persona of “sibyll software” (which includes his use of the Disputed Domain Name and the Respondent's website), and that persona suggests to potential customers the Respondent seeks to do business with that his business is in some way authorised by or connected to the Complainant. The Panel considers that the registration and use of the Disputed Domain Name as part of a business methodology that falsely suggests a connection with the Complainant (and thereby trading off the Complainant's fame and reputation) amounts to registration and use in bad faith. The Panel also notes that the Respondent has not filed a Response and hence has not availed himself of the opportunity to present any case of good faith that he might have. The Panel infers that none exists.

Accordingly, the Panel finds that the Disputed Domain Name has been registered and is being used in bad faith and the third condition of paragraph 4(a) of the Policy has been fulfilled.

## **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, <sibyllsoftware.com>, be transferred to the Complainant.

*/Nick J. Gardner/*

**Nick J. Gardner**

Sole Panelist

Date: August 15, 2023