

ADMINISTRATIVE PANEL DECISION

Xero Limited v. Steve Slisar, EzyLearn Pty Ltd - was Gateman Pty Ltd
Case No. D2023-3890

1. The Parties

The Complainant is Xero Limited, New Zealand, represented by CSC Digital Brand Services Group AB, Sweden.

The Respondent is Steve Slisar, EzyLearn Pty Ltd - was Gateman Pty Ltd, Australia.

2. The Domain Name and Registrar

The disputed domain name <xerocourse.com> is registered with Key-Systems GmbH (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on September 18, 2023. On September 18, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On September 19, 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 (REDACTED FOR PRIVACY) and contact information in the Complaint. The Center sent an email communication to the Complainant on September 19, 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 September 22, 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 September 28, 2023. In accordance with the Rules, paragraph 5, the due date for Response was October 18, 2023. The Response was filed with the Center on October 18, 2023.

The Center appointed Steven A. Maier as the sole panelist in this matter on October 31, 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 company located in New Zealand. It is a supplier of online accounting software including cloud-based services.

The Complainant is the owner of various registrations for the trademark XERO, including for example:

- New Zealand trademark registration number 758103 for the word mark XERO, registered on May 2, 2007; and
- Australia trademark registration number 1145998 for the word mark XERO, registered on November 10, 2006.

The Complainant provides evidence that it operates a principal website at “www.xero.com” and that it maintains a portfolio of over 100 domain names comprising or incorporating the term “xero”.

The Complainant also uses a circular logo featuring a stylized version of the word XERO (the “Complainant’s Logo”), which it asserts is a “protected mark” (although it provides no particulars of any relevant registration).

The disputed domain name was registered on January 19, 2010.

It is uncontested that the Respondent has used the disputed domain name for the purpose of a website, under the banner “National Bookkeeping”, offering online training courses in connection with the Complainant’s software products.

The Complainant exhibits a “letter of demand” to the Respondent dated July 18, 2023. The letter complains about the Respondent’s registration and use of the disputed domain name, and also of specific matters concerning the Respondent’s website, including objections that the website implies that users can gain official XERO certification via the website, which is not the case; that the website includes a graphic that has been copied from the Complainant’s website; and that the website includes a reproduction of the Complainant’s Logo. In the letter of demand, the Complainant requires the transfer of the disputed domain name.

The Respondent appears to have modified the relevant website in response to the letter of demand, as is also evidenced by email communications between the Parties. In particular, the Respondent appears to have removed the specific material to which the Complainant objected (although the website continued to include numerous references to the Complainant’s XERO trademark) and also to have included disclaimers on every page stating: “This website has NO association with Xero Limited the Accounting software company and the courses, training and bookkeeping services are NOT endorsed by Xero Limited - Xero is a registered trademark of Xero Limited - Training & support services at this website are provided by 123 Group Pty Ltd and National Bookkeeping clients and bookkeeping industry members.”

5. Parties’ Contentions

A. Complainant

The Complainant submits that it is an emerging global leader in its field, having been listed on the New Zealand stock exchange since 2007. It claims 3.7 million subscribers to its products in over 180 countries and submits that its XERO trademark has become widely recognized by consumers, industry peers and the broader global community.

The Complainant submits that the disputed domain name is identical or confusingly similar to its XERO trademark. It contends that the addition of the term “course” to that trademark does not exclude, and in fact increases, the likelihood of confusion.

The Complainant submits that the Respondent has no rights or legitimate interests in respect of the disputed domain name. It contends that the Complainant has the exclusive right to use the XERO trademark, that it has not authorized the Respondent to use that trademark, and that the Respondent is not commonly known by the disputed domain name. The Complainant submits that the Respondent's use of the disputed domain name for its website does not constitute a *bona fide* offering of goods or services, because it offers services that compete directly with the Complainant's own services and does not, in any event, meet the criteria for legitimate use of the Complainant's trademark as set out in *Okidata Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#). In particular, the Complainant states that the Respondent failed accurately and prominently to disclose its relationship with the Complainant until after receiving the Complainant's demand letter.

The Complainant submits that the disputed domain name has been registered and is being used in bad faith. It states that it is clear from the Respondent's use of the disputed domain name that it registered it with knowledge of, and reference to, the Complainant's trademark and products. It contends that the Respondent's website constitutes a “bait and switch” operation, whereby Internet users are attracted to the Respondent's website in the mistaken belief that it is operated by the Respondent, whereupon they are offered the Respondent's services. The Complainant further contends that the Respondent's inclusion of an (unapproved) disclaimer, after receiving the Complainant's letter of demand, demonstrates that the Respondent has acknowledged the likelihood of confusion.

The Complainant requests the transfer of the disputed domain name.

B. Respondent

In its email to the Center dated October 18, 2023, the Respondent denies having registered or used the disputed domain name in bad faith. It states that it has been creating training courses for the past 25 years, including those specifically related to the Complainant's products since 2013. It contends that it provides applicable training services, and uses the mark XERO on its website to identify the Complainant's products, and not in any manner to seek to confuse students that it is, or is authorized by, the Complainant. The Respondent states that it has dedicated significant time and effort to its website, and that it made changes to its website upon receiving the Complainant's letter of demand. It states that these changes were made because the website content was not acceptable to the Complainant, although (for example) the use of copyright material would normally be properly attributed. The Respondent contends that the transfer of the disputed domain name would not be an appropriate remedy in all the circumstances of the case.

6. Discussion and Findings

In order to succeed in the Complaint, the Complainant is required to show that all three of the elements set out under paragraph 4(a) of the Policy are present. Those elements are that:

- (i) the disputed domain name is identical 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; and
- (iii) the disputed domain name has been registered and is being used in bad faith.

A. Identical or Confusingly Similar

The Complainant has established that it is the owner of trademark registrations in respect of the mark XERO.

The disputed domain name incorporates that trademark in full, together with the additional term “course”, which does not prevent the Complainant’s trademark from being recognizable within the disputed domain name. The Panel therefore finds that the disputed domain name is confusingly similar to a trademark in which the Complainant has rights.

B. Rights or Legitimate Interests

The Respondent has apparently used the disputed domain name for the purpose of a website offering online courses relating to the Complainant’s software products. The question therefore arises of whether the Respondent can demonstrate: “... 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” (paragraph 4(c)(i) of the Policy).

In certain limited circumstances, panels under the UDRP have recognized that resellers, distributors, or service providers using a domain name containing the complainant’s trademark to undertake sales or repairs related to the complainant’s goods or services may be making a *bona fide* offering of goods and services and thus have a legitimate interest in such domain name (see, e.g., section 2.8 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”). Those circumstances will not apply where the disputed domain name represents, in itself, an impersonation of the relevant complainant, but may be of application in cases falling short of impersonation, where the disputed domain name might otherwise be found to be taking unfair advantage of the complainant’s trademark.

The criteria set out in section 2.8 of [WIPO Overview 3.0](#) (which are based upon the Decision in the *Oki Data Americas* case cited by the Complainant) are as follows:

- (i) the respondent must actually be offering the goods or services at issue;
- (ii) the respondent must use the site to sell only the trademarked goods or services;
- (iii) the site must accurately and prominently disclose the registrant’s relationship with the trademark holder; and
- (iv) the respondent must not try to “corner the market” in domain names that reflect the trademark.

In this case, it appears to be undisputed that the Respondent did not include any relevant disclaimer on its website prior to receiving the Complainant’s demand letter. In those circumstances, the original version of the website did not accurately and prominently disclose the Respondent’s relationship (or lack thereof) with the Complainant, and the third criterion set out above was not therefore satisfied. While the Respondent subsequently included an adequate disclaimer, this was not done “before any notice... of the dispute” and cannot therefore meet the requirements of paragraph 4(c)(ii) of the Policy.

Further, setting aside the application of the *Oki Data Americas* case, the Panel notes that the disputed domain name features prominently a banner and logo for “National Bookkeeping”. This would seem to correspond to the domain name used for the email address from which the Response was filed, namely <natbooks.com.au>, from which the Respondent appears to offer identical services to those offered on the disputed domain name. Accordingly, the question arises as to the Respondent’s use of the disputed domain name as a referral service for its own-branded competing services. The Panel comments that, in such later scenario, the use of the Complainant’s trademark to advertise the Respondent’s services would not represent a *bona fide* offering under the Policy. For the reasons stated above, however, this additional observation is not determinative of the Panel’s finding under this element.

The Panel finds therefore that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

C. Registered and Used in Bad Faith

It is undisputed that the Respondent registered the disputed domain name in the knowledge of the Complainant's XERO mark and products, and with the intention of making reference to those products for training purposes.

The Panel accepts the Respondent's submission that it did not intend to act in a manner which was intended to cause confusion to Internet users or to divert such users seeking the Complainant's products or services to its own website. Nevertheless, the disputed domain name incorporates the Complainant's trademark in full, together with the term "course", which (while arguably falling short of impersonation) is liable to imply to Internet users that there may be a commercial affiliation between the Complainant and the Respondent.

Furthermore, at least before the Respondent received the Complainant's letter of demand, its website not only featured the Complainant's XERO trademark and the Complainant's Logo, but also included material copied from the Complainant's website, and may incorrectly have implied that it could provide XERO certification.

In the view of the Panel, the consequence of the above matters is that, whether or not the Respondent expressly so intended, it has used the disputed domain name in a manner which took unfair commercial advantage of the Complainant's trademark rights, which must lead to the conclusion that the disputed domain name was both registered and is being used in bad faith.

The Panel notes that the Respondent removed the objectionable material from its website and included a disclaimer in response to the Complainant's letter of demand. However, the Panel finds that the Respondent's use of the disputed domain name prior to those changes is corroborating evidence of the use of the Complainant's mark by the Respondent in an attempt to attract Internet users based on the Complainant's mark and reputation. The Panel finds further that, given the prominent advertising of the "National Bookkeeping" logo on the forefront of the website to which the disputed domain name resolves, and moreover the inclusion of the Respondent's own bookkeeping services on the site, the Respondent appears to be using the Complainant's trademark to divert Internet users expecting to find courses related to the Complainant's products to the Respondent's bookkeeping services.

The Panel therefore finds that the disputed domain name has been registered and is being used in bad faith.

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, <xerocourse.com>, be transferred to the Complainant.

/Steven A. Maier/

Steven A. Maier

Sole Panelist

Date: November 9, 2023