

ADMINISTRATIVE PANEL DECISION

Chegg, Inc. v. Knoxweil Pty Ltd.

Case No. DAU2022-0010

1. The Parties

The Complainant is Chegg, Inc., United States of America (“United States”), represented by Corrs Chambers Westgarth, Australia.

The Respondent is Knoxweil Pty Ltd., Australia.

2. The Domain Name and Registrar

The domain name <chegg.com.au> (the “domain name”) is registered with Domain Directors Pty Ltd. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on May 24, 2022. On May 24, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the domain name. On May 25, 2022, the Registrar transmitted by email to the Center its verification response confirming that the Respondent is listed as the Registrant and providing the contact details.

The Center verified that the Complaint satisfied the formal requirements of the .au Dispute Resolution Policy (the “Policy” or “.auDRP”), the Rules for .au Dispute Resolution Policy (the “Rules”), and the WIPO Supplemental Rules for .au Domain Name Dispute Resolution Policy (the “Supplemental Rules”).

In accordance with the Rules, paragraphs 2(a) and 4(a), the Center formally notified the Respondent of the Complaint, and the proceedings commenced on May 27, 2022. In accordance with the Rules, paragraph 5(a), the due date for Response was June 16, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on June 22, 2022.

The Center appointed Alan L. Limbury as the sole panelist in this matter on June 27, 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

Founded in 2003 in the United States, the Complainant, Chegg, Inc., provides tutoring, textbook, study and related educational and entertainment services to university students globally through its website “www.chegg.com”. Its domain name <chegg.com> was registered on February 23, 2000. The Complainant has registered the CHEGG and CHEGG.COM trademarks in many countries, including in the United States, e.g. CHEGG, Reg. No. 3,191,844, registered on January 2, 2007, and in Australia, e.g. CHEGG, Reg. No. 1991954, registered on November 1, 2019 and CHEGG.COM, Reg. No. 1991955, registered on November 4, 2019.

The domain name was registered on October 2, 2017 and, at the time of the Complaint, resolved to a “domain parked” page. Previously, the domain name did not resolve to an active website.

5. Parties’ Contentions

A. Complainant

The Complainant submits that the domain name is identical or confusingly similar to the name and trade mark CHEGG in which the Complainant has had rights for over a decade prior to the registration of the domain name by the Respondent, which has no rights or legitimate interests in respect of the domain name, which was registered or is subsequently being used in bad faith.

As to legitimacy, as at the date of this Complaint, the Respondent was not using the domain name in connection with an active website. It currently resolves to a “domain parked” page and invites users to purchase the domain name from OnlyDomains. The Complainant has no awareness of the Respondent being known or commonly known by the domain name and has not licensed or otherwise authorised the Respondent’s registration of the domain name or any other domain name comprising the CHEGG mark or trade name. The mark CHEGG is not a descriptive word or generic name and has become exclusively associated with the Complainant and its goods and services. The Respondent has failed to make legitimate use of the domain name and has not demonstrated any attempt to make legitimate noncommercial use or fair use of the domain name without intent for commercial gain. Internet users would likely mistake the domain name as being owned by or affiliated with the Complainant, regardless of whether or not the domain name currently resolves to an active website: *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#).

As to bad faith, the registration of the domain name prevents the Complainant from reflecting its mark in the “com.au” namespace. The mere registration of a domain name that is identical or confusingly similar to the widely-known CHEGG mark and trade name by an unaffiliated entity can create a presumption of bad faith in itself. On the balance of probabilities, at the time of registering the domain name, the Respondent was actually (or, at the very least, constructively) aware of the Complainant and had the Complainant’s mark in mind: *Ebel International Limited v. Alan Brashear* WIPO Case No. [D2017-0001](#). This allegation is reinforced by the distinctive nature of the CHEGG mark, the Complainant’s reputation in its online learning platform and the absence of any legitimate noncommercial or fair use of the domain name. The Respondent’s registration suggests opportunistic bad faith and its passive holding of the domain name supports a finding of registration in bad faith: *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#). The totality of the circumstances indicates that the domain name was registered in bad faith and the implausibility of any good faith use to which the domain name may be put. See *Salvatore Ferragamo Italia S.P.A. v. Ashot Rostomian*, WIPO Case No. [D2000-1187](#), and see *ITT Industries, Inc. v. Katherine Kliszcz*, WIPO Case No. [D2000-1431](#). Finally, the Panel may take into account the Respondent’s anticipated failure to provide evidence of any actual or contemplated good faith use.

B. Respondent

As noted above, the Respondent did not submit any response.

6. Discussion and Findings

Paragraph 15(a) of the Rules instructs the Panel as to the principles it is to use in determining this dispute:

“A Panel shall decide a complaint on the basis of the statements and documents submitted in accordance with the Policy, these Rules, and any rules and principles of law that it deems applicable.”

Paragraph 4(a) of the auDRP requires the Complainant to prove each of the following three elements:

- (i) the domain name is identical or confusingly similar to a name (Note 1), trade mark or service mark in which the Complainant has rights; and
- (ii) the Respondent has no rights or legitimate interests in respect of the domain name (Note 2); and
- (iii) the domain name has been registered or subsequently used in bad faith.

Note 1

“For the purposes of this policy, auDA has determined that a ‘name ... in which the complainant has rights’ refers to:

- (a) the complainant’s company, business or other legal or trading name, as registered with the relevant Australian government authority; or
- (b) the complainant’s personal name.”

Note 2

“For the purposes of this policy, auDA has determined that “rights or legitimate interests in respect of the domain name’ are not established merely by a registrar’s determination that the respondent satisfied the relevant eligibility criteria for the domain name at the time of registration.”

A. Identical or Confusingly Similar

The Complainant has shown that it has rights in the CHEGG and CHEGG.COM trademarks through registrations in many countries.

The Panel finds the domain name to be identical to the Complainant’s CHEGG trademark, since the “.com.au” suffix may be disregarded.

The Complainant has established this element.

B. Rights or Legitimate Interests

Paragraph 4c of the auDRP provides:

“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, is to be taken to 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 subject matter of the dispute, your *bona fide* use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with an offering of goods or services (not being the offering of domain names that you have acquired for the purpose of selling, renting or otherwise transferring); or

(ii) you (as an individual, business, or other organisation) 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 name, trademark or service mark at issue.”

Under the auDA Overview of Panel Views on Selected auDRP Questions First Edition (“auDA auDRP Overview 1.0”), section 2.1:

“A complainant is required to make out a *prima facie* case that the respondent lacks rights or legitimate interests. The complainant will usually make out a *prima facie* case by establishing that none of the paragraph 4(c) circumstances are present. Once such a *prima facie* case is made, the burden of production shifts to the respondent, requiring it to provide evidence or plausible assertions demonstrating rights or legitimate interests in the domain name. If the respondent fails to provide such evidence or assertions, a complainant is generally deemed to have satisfied paragraph 4(a)(ii) of the Policy [...] If the respondent does provide some evidence or plausible assertions of rights or legitimate interests in the domain name, the panel then weighs all the evidence – with the burden of proof always remaining on the complainant.”

As noted above, the domain name was registered on October 2, 2017, since when it has remained inactive. It presently resolves to a “domain parked” page which invites the user to purchase the domain name from OnlyDomains.

The Panel accepts that the Complainant’s CHEGG mark is distinctive. Its Australian trademarks were filed and registered after the registration of the domain name, so the Panel is not satisfied that the Respondent was aware of those registered marks at that time. Nor is it likely that the Respondent, based in Australia, was then aware of the Complainant’s United States prior registered marks. However, the Complainant has shown that it has operated its website at “www.chegg.com” since April, 2006 and has operated social media accounts under the CHEGG mark with many thousands of followers, namely Facebook since April 2008; Instagram since May 2012; Twitter since December 2008; LinkedIn since October 2013 and YouTube since September 2009. The nature and scope of these activities satisfy the Panel that, by the time the Respondent registered the domain name, the Complainant had established common law rights in the distinctive CHEGG mark and that the Respondent had that mark and the Complainant’s “www.chegg.com” website in mind when registering the domain name.

These circumstances, together with the Complainant’s assertions and the fact that the domain name has not been actively used, are together sufficient to constitute a *prima facie* case of absence of rights or legitimate interests in respect of the domain name on the part of the Respondent.

In the absence of any response, the Panel finds that the Respondent has no rights or legitimate interests in respect of the domain name.

The Complainant has established this element.

C. Registered or Subsequently Used in Bad Faith

Paragraph 4(a) of the auDRP provides that, for the purposes of paragraph 4(a)(iii), 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 a domain name in bad faith:

(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 another person 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 a name, trademark or service mark from reflecting that name or mark in a corresponding domain name; or
- (iii) you have registered the domain name primarily for the purpose of disrupting the business or activities of another person; or
- (iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to a website or other online location, by creating a likelihood of confusion with the complainant's name or mark as to the source, sponsorship, affiliation, or endorsement of that website or location or of a product or service on that website or location; or
- (v) if any of your representations or warranties as to eligibility or third-party rights given on application or renewal are, or subsequently become, false or misleading in any manner.

Leaving aside the question whether the Respondent registered the domain name in bad faith, the Panel finds that, in the circumstances of this Complaint, the passive holding of the domain name by the Respondent amounts to use in bad faith, for the following reasons:

- (i) the Complainant's CHEGG mark is distinctive and, as the Panel has found, the Respondent was aware of it when the Respondent registered the domain name;
- (ii) the Respondent has provided no evidence of any actual or contemplated good faith use of the domain name in the several years since its registration;
- (iii) the Complainant has shown that the Respondent has engaged in a pattern of behaviour by registering the domain name <homeworkmarket.com.au> which, as in the present case, does not resolve to an active website. The United States entity "HomeworkMarket" is a homework help service provider for students and operates the website at "www.homeworkmarket.us";
- (iv) as in *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#), it is not possible to conceive of any plausible actual or contemplated active use of the domain name by the Respondent that would not be illegitimate, such as by passing off, infringement of consumer protection legislation, or infringement of the Complainant's rights under trademark law.

Accordingly, the Panel concludes that the Respondent's passive holding of the domain name satisfies the requirement of paragraph 4(a)(iii) that, subsequent to its registration, the domain name has been used in bad faith by the Respondent.

The Complainant has established this element.

7. Decision

For all the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the domain name <chegg.com.au> be transferred to the Complainant.

/Alan L. Limbury/

Alan L. Limbury

Sole Panelist

Date: July 7, 2022