

ADMINISTRATIVE PANEL DECISION

Zoom Video Communications, Inc. v. JH Kang
Case No. DCO2023-0071

1. The Parties

The Complainant is Zoom Video Communications, Inc., United States of America (“United States”), represented by Chestek Legal, United States.

The Respondent is JH Kang, Republic of Korea.

2. The Domain Name and Registrar

The disputed domain name <zoomgov.co> is registered with Spaceship, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on August 7, 2023. On August 8, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On August 22, 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 Purposes, Privacy service provided by Withheld for Privacy ehf) and contact information in the Complaint. The Center sent an email communication to the Complainant on August 22, 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 August 23, 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 August 29, 2023. In accordance with the Rules, paragraph 5, the due date for Response was September 18, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on September 25, 2023.

The Center appointed Miguel B. O'Farrell as the sole panelist in this matter on October 2, 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, Zoom Video Communications, Inc., renders teleconferencing services under the trademark ZOOM which it adopted in 2012.

The Complainant owns several trademark registrations for ZOOM in several jurisdictions, including the following:

- International Trademark Registration No. 1365698, registered on August 4, 2017, in class 38;
- Chinese Trademark Registration No. 40417467, registered on May 14, 2020, in class 38.

Also, the Complainant uses the domain name <zoomgov.com> for its government customers (the "ZOOM Government website").

The disputed domain name was registered on July 1, 2020, and resolves to a website that provides pay-per-click links related to the Complainant or services similar to those offered by the Complainant, such as "Zoom", "Teleconference Service", and "Best Online Conference Call Service".

5. Parties' Contentions

A. Complainant

The Complainant adopted its famous trademark ZOOM for its teleconference service in 2012 and its first trademark registration was granted in 2017. Therefore, the Complainant's common law trademark rights predate the the registration of the disputed domain name on July 1, 2020 by many years and the Complainant's registered trademark rights predate the disputed domain name by at least two years.

The Complainant claims that the disputed domain name is confusingly similar to the trademark ZOOM in which the Complainant has rights and that the Respondent has no rights or legitimate interests in the disputed domain name, which was registered and is being used in bad faith.

More specifically, there is no evidence that the Respondent uses or has prepared to use the disputed domain name in connection with a *bona fide* offering of goods or services. In fact, as per the content of the website to which the disputed domain name resolves, the services being offered are similar to those offered by the Complainant.

By using the disputed domain name, the Respondent intentionally attempts to attract for commercial gain, Internet users to the Respondent's website by creating a likelihood of confusion with the Complainant's mark ZOOM as to source, sponsorship, affiliation, or endorsement of the Respondent's website.

Considering the content of the website, it may be assumed that using a proxy or privacy service, the Respondent has incurred in bad faith with the registration of the disputed domain name with the Complainant's famous worldwide registered trademark ZOOM.

The disputed domain name is being used to likely mislead visitors into cyber attacks under the guise of being the official ZOOM Government website.

Finally, the Complainant requests the Panel to issue a decision ordering the transfer of the disputed domain name to the Complainant.

B. Respondent

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

6. Discussion and Findings

According to paragraph 4(a) of the Policy, for this Complaint to succeed in relation to the disputed domain name, the Complainant must prove each of the following, namely that:

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

A. Identical or Confusingly Similar

As set forth in section 1.7 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), the standing test for confusing similarity involves a reasoned but relatively straightforward comparison between the trademark and the disputed domain name to determine whether the disputed domain name is confusingly similar to the trademark. The test involves a side-by-side comparison of the disputed domain name and the textual components of the relevant trademark to assess whether the mark is recognizable within the disputed domain name.

The Panel considers that the disputed domain name is confusingly similar to the Complainant's ZOOM trademark. The disputed domain name incorporates the Complainant's trademark ZOOM with the addition of the term "gov" which does not prevent a finding of confusing similarity. Section 1.8 of the [WIPO Overview 3.0](#) provides that when the relevant trademark is recognizable within the disputed domain name - as it occurs in this case - the addition of other terms would not prevent a finding of confusing similarity under the first element.

The ".co" generic Top-Level Domain ("gTLD") is viewed as a standard registration requirement and is generally disregarded under the first element confusing similarity test, as set forth in section 1.11.1 of the [WIPO Overview 3.0](#).

Accordingly, the Panel finds that the disputed domain name is confusingly similar to the trademark ZOOM in which the Complainant has rights and that the requirements of paragraph 4(a)(i) of the Policy are fulfilled.

B. Rights or Legitimate Interests

Pursuant to paragraph 4(c) of the Policy, a respondent may establish rights to or legitimate interests in a domain name by demonstrating any of the following non-exclusive defenses:

- (i) before any notice to [the respondent] of the dispute, [the respondent's] 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 it 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.

Although the Policy addresses ways in which a respondent may demonstrate rights or legitimate interests in a disputed domain name, it is well established, as it is put in section 2.1 of the [WIPO Overview 3.0](#), that a complainant is required to make out a *prima facie* case that the respondent lacks rights or legitimate interests in the domain name. Once such *prima facie* case is made, the burden of production shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the disputed domain name. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element.

There is no evidence in the present case that the Respondent has been commonly known by the disputed domain name, enabling it to establish rights or legitimate interests therein.

Furthermore, there is no evidence in the file to prove any of the circumstances mentioned in paragraph 4(c) of the Policy, nor any other circumstances to suggest that the Respondent has rights or legitimate interests in the disputed domain name.

Likewise, and as further discussed under section 6.C of this decision, it seems that the Respondent is not making any legitimate noncommercial or fair use of the disputed domain name.

As established in section 2.5 of the [WIPO Overview 3.0](#): “Fundamentally, a respondent’s use of a domain name will not be considered ‘fair’ if it falsely suggests affiliation with the trademark owner; the correlation between a domain name and the complainant’s mark is often central to this inquiry.” Here, the Complainant uses the domain name <zoomgov.com> for its government customers. Therefore, the nature of the disputed domain name, which incorporates the Complainant’s ZOOM trademark with the term “gov”, carries a risk of implied affiliation.

The Panel finds that the Complainant has made out a *prima facie* case, a case calling for an answer from the Respondent. The Respondent has not responded and the Panel is unable to conceive of any basis upon which the Respondent could sensibly be said to have any rights or legitimate interests in respect of the disputed domain name (*Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#)).

The Panel finds that the Respondent has no rights or legitimate interests in respect of the disputed domain name and that the requirements of paragraph 4(a)(ii) of the Policy have been fulfilled.

C. Registered and Used in Bad Faith

The Panel is satisfied that the Respondent must have been aware of the Complainant’s trade name and trademark ZOOM mentioned in section 4. above (Factual Background) and the Complainant’s domain name <zoomgov.com> when it registered the disputed domain name on July 1, 2020. By that time, the Complainant had already registered the trademark ZOOM and had been using it intensely for a long time.

By registering the disputed domain name which includes the Complainant’s trademark ZOOM in its entirety together with the term “gov”, the Respondent was targeting the Complainant and its business. The addition of the term “gov” only contributes to confuse Internet users and lead them into thinking that the relevant website belongs to or is endorsed by the Complainant with the intention to capitalize on the fame of the Complainant’s trademark for its own benefit.

The fact that there is a clear absence of rights or legitimate interests coupled with no credible explanation for the Respondent’s choice of the disputed domain name, the nature of the disputed domain name, and the use of the disputed domain name to resolve to a website providing pay-per-click links related to the Complainant or services similar to those offered by the Complainant, are indicative of bad faith (as stated in section 3.2.1 of the [WIPO Overview 3.0](#)). The Panel finds that the Respondent registered and is using the disputed domain name in bad faith.

For the above reasons, the Panel finds that the requirements of paragraph 4(a)(iii) of the Policy have 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 <zoomgov.co> be transferred to the Complainant.

/Miguel B. O'Farrell/

Miguel B. O'Farrell

Sole Panelist

Date: October 16, 2023