

ADMINISTRATIVE PANEL DECISION

Five9, Inc. v. Christopher Gillis, five9.io
Case No. DIO2022-0017

1. The Parties

The Complainant is Five9, Inc., United States of America (“United States”), represented The GigaLaw Firm, Douglas M. Isenberg, Attorney at Law, LLC, United States.

The Respondent is Christopher Gillis, five9.io, United States.

2. The Domain Name and Registrar

The disputed domain name <five9.io> is registered with Tucows Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on April 15, 2022. On April 19, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On April 19, 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 and contact information in the Complaint. The Center sent an email communication to the Complainant on April 20, 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 April 23, 2022.

The Center verified that the Complaint together with the amendment to the Complaint satisfied the formal requirements of the .IO Domain Name Dispute Resolution Policy (the “Policy”), the Rules for .IO Domain Name Dispute Resolution Policy (the “Rules”), and the WIPO Supplemental Rules for .IO 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 May 3, 2022. In accordance with the Rules, paragraph 5, the due date for Response was May 23, 2022. The Response was filed with the Center on May 3, 2022.

The Center appointed Evan D. Brown as the sole panelist in this matter on May 13, 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.

On June 9, 2022, the Panel issued a Panel Order that (1) requested the Respondent to provide any documents it may have that demonstrate its claimed noncommercial HAM radio-related uage of the disputed domain name, and (2) asked the Respondent to explain its choice of a domain name that exactly reproduces the Complainant's registered FIVE9 trademark. The Respondent provided information in response thereto later that day, on June 9, even though the Panel Order allowed such response through June 15. The Complainant was given until June 20, 2022 to comment on the Respondent's submission. The Complainant replied to Respondent's contentions on June 13, 2022.

4. Factual Background

The Complainant provides cloud-based software for contact centers. It owns the trademark FIVE9 which it has registered in the United States (Reg. No. 3119836, registered on July 25, 2006) and which it has used in commerce in the United States since at least as early as July 4, 2003.

According to the Whois records, the disputed domain name was registered on September 18, 2016. The Complainant has submitted evidence that the Respondent is not currently using the disputed domain name in connection with an active website. However, the Complainant's evidence shows that the Respondent has established MX records associated with the disputed domain name, which gives rise to the possibility that the Respondent may have used, or will use, the disputed domain name to send fraudulent email messages.

5. Parties' Contentions

A. Complainant

The Complainant contends that the disputed domain name is identical or confusingly similar to the Complainant's trademark; that the Respondent has no rights or legitimate interests in respect of the disputed domain name; and, that the disputed domain name was registered or is being used in bad faith.

In response to the Panel Order, the Complainant states the the Respondent failed to provide any relevant documents and as such the Respondent's statements are conclusory and unsupported by evidence.

B. Respondent

The Respondent asserts that the Complainant has not met the first Policy element because the disputed domain name is being used for personal reasons and not to profit from commercial activity that infringes the FIVE9 mark. Moreover, according to the Respondent (and supported by a link to a Wikipedia article), "five nine" has an agreed upon meaning among amateur radio enthusiasts indicating a perfectly readable and very strong signal. Further, the Respondent claims that the expression "five nines" is used in the context of technology contracts to designate a certain reliability of services.

As for the second element, the Respondent claims that the disputed domain name is being legitimately used for noncommercial purposes to resolve IP addresses for various amateur radio products. The Respondent does not deny the disputed domain name is being used without an active website, but asserts that it has no intent to mislead, divert customers, or tarnish the word marks of the Complainant.

Finally, as for the third element, the Respondent argues that there is no bad faith because the disputed domain name has not been listed for sale and there is no intention to sell, rent, or otherwise transfer the disputed domain name. Further, the Respondent claims that it is not engaged in commercial activity or competition with the Complainant, nor was the disputed domain registered to disrupt the Complainant's business. Instead, the Respondent claims that the disputed domain name is used to provide personal use DNS resolution services for the respondent's varied amateur radio interests.

In response to the Panel Order, the Respondent states that it does not keep documentation regarding past or prior DNS records that would show the personal use (presumably for HAM radio-related purposes) of the disputed domain name. And the Respondent also reiterates that the words “five” and “nine” are highly used phrases in both the HAM radio and software engineering communities. The Respondent asserts that since a domain name cannot begin with the number 5, it had to be spelled out, *i.e.*, “five9”.¹

6. Discussion and Findings

To succeed, the Complainant must demonstrate that all of the elements listed in paragraph 4(a) of the Policy have been satisfied, namely, 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 or is being used in bad faith.

The Complainant has demonstrated that each of these elements has been satisfied.

A. Identical or Confusingly Similar

A registered trademark provides a clear indication that the rights in the mark shown on the trademark certificate belong to its respective owner. *Sony Interactive Entertainment Europe Limited v. Host Master, 1337 Services LLC*, WIPO Case No. [DIO2020-0013](#). The Complainant has demonstrated its rights in the FIVE9 mark by providing evidence of its trademark registration. The disputed domain name incorporates the mark in its entirety. This is sufficient for showing identity or confusing similarity under the Policy. *Id.* The Complainant has established this first element under the policy.

B. Rights or Legitimate Interests

The Panel evaluates this element of the Policy by first looking to see whether the Complainant has made a *prima facie* showing that the Respondent lacks rights or legitimate interests in respect of the disputed domain name. If the Complainant makes that showing, the burden of production of demonstrating rights or legitimate interests shifts to the Respondent (with the burden of proof always remaining with the Complainant).

On this point, the Complainant asserts, among other things, that: (1) it has not authorized the Respondent to use the FIVE9 mark in any manner, (2) by failing to use the disputed domain name in connection with an active website, the Respondent has not used the disputed domain name in connection with a *bona fide* offering of goods and services, (3) the Respondent has not been known by the disputed domain name, and (4) the Respondent is not making a legitimate noncommercial or fair use of the disputed domain name.

The Panel finds that the Complainant has made the required *prima facie* showing. The Respondent has presented only conclusory and self-serving assertions to address this second element, without any evidence to show use that would support the existence of rights or legitimate interests in the disputed domain name in connection with its amateur radio activities. While Respondent argues that “five nine” is an expression frequently used in both the HAM radio and software engineering communities, and that it is used to provide personal use DNS resolution services for the respondent’s varied amateur radio interests, the Panel notes the lack of evidence to support the Respondent’s alleged use of the disputed domain name. The Panel notes that the disputed domain name is identical to the Complainant’s trademark, and the Respondent’s explanation that a domain name cannot begin with the number “5” rings hollow. Even if domain names consisting of the number “59” may have been already registered at certain extensions, that does not explain why the Respondent did not choose for the combination in letters “five nine” or “5 nine”, and instead chose

¹ The Panel notes that this assertion of the Respondent – that a domain name cannot begin with the number 5 – is not correct. For example, the domain name <59.io>, according to the relevant Whois records, was registered in 2013 and is still subject to an active registration.

an identical match to the Complainant's trademark.

The Respondent has not overcome the Complainant's *prima facie* showing. And nothing in the record otherwise tilts the balance in the Respondent's favor. Accordingly, the Panel finds that the Complainant has established this second element under the Policy.

C. Registered or Used in Bad Faith

The Policy requires that the Complainant show that the Respondent registered or used the disputed domain name in bad faith. The Panel incorporates its discussion above in the "Rights or Legitimate Interests" section. The Respondent has not provided evidence or argument to counter the Complainant's assertion that the establishment of MX records in connection with the disputed domain name indicates the disputed domain name may be employed for the sending of fraudulent email. The creation of such records is evidence of bad faith because it "give[s] rise to the strong possibility that Respondent intended or intends to use the disputed domain name to send emails as part of a fraudulent phishing scheme". *Altria Group, Inc. and Altria Group Distribution Company v. Emerson Terry*, WIPO Case No. [D2021-0045](#).² The presence of MX records undermines any argument by the Respondent that the primary use of the disputed domain name is for DNS resolution services. Instead, the Panel finds such use of a disputed domain name, comprised entirely of a well-known trademark such as FIVE9, to be an indicator of bad faith.

Accordingly, the Panel finds that the Complainant has established this third Policy element.

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 <five9.io> be transferred to the Complainant.

/Evan D. Brown/

Evan D. Brown

Sole Panelist

Date: June 20, 2022

² The Panel notes the similarities between the .IO Policy and the UDRP. As such, to count with criteria of interpretation for the analysis of the present case, the Panel will recur to previous UDRP decisions.