

## **ADMINISTRATIVE PANEL DECISION**

Xero Limited v. Boris Nandi, Imprint Media Group Pty Ltd  
Case No. D2023-3889

### **1. The Parties**

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

The Respondent is Boris Nandi, Imprint Media Group Pty Ltd, Australia.

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

The disputed domain name <thexeroacademy.com> 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 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 (Registration Private / Domains By Proxy, LLC) and contact information in the Complaint. The Center sent an email communication to the Complainant on September 21, 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 26, 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 Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on October 20, 2023.

The Center appointed Andrea Jaeger-Lenz 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, based in New Zealand, is listed on the New Zealand Stock Exchange and the Australian Securities Exchange and engages in the development and distribution of online accounting software, including a software branded XERO, across New Zealand, Australia, and the United Kingdom.

The Complainant is the owner of trademark registrations worldwide consisting of or including the designation XERO, *inter alia* the following:

- International trademark registration No. 1202118 XERO (word) designating Australia, China, the European Union (“EU”) and the United States of America (“US”), filed and registered on January 14, 2014, for services in Classes 35 and 42;
- EU trademark registration No. 005867361 XERO (word), filed on April 30, 2007, and registered on March 12, 2008, for goods and services in Classes 9, 36, and 38;
- US trademark registration No. 6098229 XERO (word), filed on July 6, 2017, and registered July 14, 2020, for goods and services in Classes 9, 16, 21, and 35.
- US trademark registration No. 6098229 XERO (word), filed on July 6, 2017, and registered on July 14, 2020, for services in Classes 36 and 42.
- Australian trademark registration No. 1145998 XERO (word), filed on November 10, 2006, and registered on November 10, 2006, for goods and services in Classes 9, 16, 35, 36, 41, and 42.

In addition, the Complainant owns a portfolio of over 100 domain names including the designation XERO, including the domain name <xero.com>, which resolves to the Complainant’s official website.

The disputed domain name was registered on November 25, 2020. It is currently inactive resolving to an error page without content. Previously, it had been redirected to a website offering training courses on the Complainant’s XERO software.

#### **5. Parties’ Contentions**

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

The Complainant holds that the disputed domain name is confusingly similar to the XERO trademarks, in which it claims rights according to Annex 1 to the Complaint. The disputed domain name fully reproduces the Complainant’s trademark XERO. The presence of the generic, descriptive term “the” before the Complainant’s trademark and the term “academy” after the trademark, according to the Complainant, merely emphasizes the word “xero” as the only distinctive element, as the Complainant itself has provided a series of learning and certification courses at its primary website. The generic Top-Level Domain (“gTLD”) “.com” – being a necessary part of a domain name – must be disregarded in the comparison. In addition, the Complainant puts forth that the Respondent is using the disputed domain name in a way to contribute to the confusion created through the disputed domain name, as he purports to be “the XERO Academy” and is using a similar blue colour scheme and look and feel as the Complainant’s website, circumstances that may be taken into consideration for confusing similarity under WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, ([“WIPO Overview 3.0”](#)), section 1.15.

The Complainant argues that it owns exclusive rights in the XERO trademark. In contrast, the Respondent's name as divulged by the Registrar information does not resemble the disputed domain name in any way, nor did the prior Registrant information as "Registration Private/Domains by Proxy, LLC". Thus, there is no evidence that the Respondent was ever commonly known by the disputed domain name. The fact that the Respondent has, upon filing the disputed domain name, used a privacy WHOIS service has also been found by past UDRP panels as a lack of legitimate interest. The Complainant has not authorized or otherwise permitted the Respondent to offer XERO certification courses. Despite this, the Respondent has, prior to the initiation of the present UDRP proceeding, used the disputed domain name to redirect to a website imitating the look and feel of the Complainant's website and thereby clearly trying to pass itself off as the Complainant to offer competing services, which the Complainant provides evidence for in Annexes 3 and 5 to the Complaint. This, according to the Complainant, cannot be regarded as a *bona fide* offering of goods or services. In this vein, the Complainant refers to the "Oki Data test" devised to ascertain which conditions have to be met for an alleged service provider under the incumbent trademark. In the present case, so the Complainant, the Respondent has failed to accurately and prominently disclose the relationship with the Complainant, but instead falsely claimed to be "The Xero Academy Pty Ltd" and "The Xero Academy Global Ltd." as featured in the imprint of the website under the disputed domain name. Lastly, the trademark rights of the Complainant significantly predate the registration of the disputed domain name.

Finally, on registration in bad faith, the Complainant claims that it as well as its XERO trademark are known internationally including in Australia, where the Respondent is allegedly based. The Complainant marketed its services since 2008, i.e. well before the disputed domain name was registered. The Complainant, considering the composition of the disputed domain name and the design of the website to which it redirected, finds it evident that the Respondent was familiar with the Complainant and specifically targeted the Complainant when registering the disputed domain name. In addition, the Respondent had made use of a privacy service to hide its true identity. On use in bad faith, the Complainant contends that the website that was available under the disputed domain name resembles the Complainant's own main website under <xero.com> (Annex 5 to the Complaint) imitating its look and feel by using the same colour scheme and the header "The XERO Academy". In thus impersonating the Complainant or alleging affiliation, the Respondent is making use of the disputed domain name for commercial gain, namely to attract consumers to its website offering competing services, at the same time disrupting the Complainant's business. Finally, the Respondent ignored an attempt of the Complainant to resolve the dispute outside of this proceeding and chose not to respond to the Complainant's cease-and-desist letter (Annex 8 to the Complaint).

## **B. Respondent**

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

## **6. Discussion and Findings**

Under paragraph 4(a) of the UDRP, the Complainant must cumulatively establish and prove 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 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**

On the first element, pursuant to paragraph 4(a)(i) of the UDRP, the Complainant must demonstrate that the disputed domain name is (i) identical or confusingly similar to a trademark or service mark, (ii) in which the Complainant has rights.

On the basis of the evidence presented, it is established that the Complainant owns several trademarks for the term XERO.

It is well-accepted that in cases where a domain name incorporates the entirety of a trademark, or where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar to that mark [WIPO Overview 3.0](#), section 1.7. Where the 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 ([WIPO Overview 3.0](#), section 1.8; and *LEGO Juris A/S v. DBA David Inc/ DomainsByProxy.com*, WIPO Case No. [D2011-1290](#)).

Furthermore, it is generally maintained that the addition of a gTLD is a standard registration requirement. Therefore, the gTLD “.com” may be disregarded when assessing the confusing similarity between the disputed domain name and the Complainant’s trademarks ([WIPO Overview 3.0](#), section 1.11.1).

Against this backdrop, the Panel finds that the disputed domain name is confusingly similar to the Complainant’s trademarks. It fully reproduces the XERO trademarks. The addition of the words “the” and “academy” does not prevent a finding of confusing similarity between the disputed domain name and the Complainant’s trademarks (see also *Allianz SE v. Domain Admin, Privacy Protect, LLC (PrivacyProtect.org) / Fernando Flores*, WIPO Case No. [D2021-1956](#)). The Panel agrees with the Complainant that the fact that the Respondent is using the disputed domain name in a way to contribute to the confusion created through the disputed domain name, by purporting on the website to be “the XERO Academy” and using a similar blue colour scheme and look and feel as the Complainant’s website, may be taken into consideration to confirm confusing similarity whereby it appears *prima facie* that the respondent seeks to target a trademark through the disputed domain name ([WIPO Overview 3.0](#), section 1.15).

For the above reasons, the Panel finds that the disputed domain name is confusingly similar to the Complainant’s trademarks and hence the first condition of paragraph 4(a) of the UDRP has been fulfilled.

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

On the second element, pursuant to paragraph 4(c) of the UDRP, evidence of the Respondent’s rights or legitimate interests in the disputed domain name for the purposes of paragraph 4(a)(ii) may be established, in particular, by any of the following circumstances:

(i) prior to becoming aware of the dispute, the Respondent has used the disputed domain name or a name corresponding to the disputed domain name in connection with a *bona fide* offering or goods or services, or made serious preparations to do so;

(ii) the Respondent is known by the disputed domain name in question, even without having acquired trademark or service mark rights; or

(iii) the Respondent is making a legitimate noncommercial or fair use of the disputed domain name without intent to divert consumers for profit by creating confusion or to tarnish the trademark or service mark at issue.

Where the Complainant establishes *prima facie* that the Respondent has no rights or legitimate interests in the disputed domain name, the burden of production on this element is on the Respondent and it is up to the Respondent to provide relevant evidence demonstrating rights or legitimate interests in the disputed domain name. If the Respondent does not provide such relevant evidence, the Complainant is deemed to have satisfied the second element ([WIPO Overview 3.0](#), section 2.1).

The Panel finds that the Complainant has established such *prima facie* case. According to the evidence produced by the Complainant, the Respondent neither under the privacy service used upon registration or nor under its actual clear name, is not commonly known by the disputed domain name. The Complainant

has not authorized or otherwise permitted the Respondent to use its trademarks within the disputed domain name.

The Panel also holds that the Respondent has no actual intention to use the disputed domain name for a legitimate noncommercial or fair use. Currently, the disputed domain name merely resolves to an error page. Before, as the Complainant has demonstrated on record, the disputed domain name resolved to a website offering certification courses in relation to the Complainant's XERO branded accounting software. While the Respondent could have tried to refute these contentions by putting forth argumentation along the lines of the criteria in *Okidata Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#), to be a legitimate reseller or service provider for the Complainant's products, he chose not to do so and remained silent. Also, the website to which the disputed domain name resolved did not accurately and prominently disclose the Respondent's relationship with the Complainant. Thus, the Respondent's activities do not amount to legitimate or fair use. Rather, given the composition of the disputed domain name, which featured the XERO trademark between the prefix "the" and the descriptive term "academy", it is clear that the Respondent sought to create a direct inference of association with the Complainant, compounded by the impersonating nature of the content found at the disputed domain name, ultimately for the Respondent's illegitimate commercial gain. For the same reasons, the Panel is also unable to find any evidence that the Respondent was or intends to use the disputed domain name in connection with a *bona fide* offering of goods or services.

For the above reasons, the Panel concludes that the Complainant has provided sufficient evidence to hold that the Respondent has no rights or legitimate interests in respect of the disputed domain name. Accordingly, the Complainant has satisfied paragraph 4(a)(ii) of the Policy.

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

On the third element, pursuant to paragraph 4(a)(iii) of the UDRP, the Complainant must demonstrate that the disputed domain name has been registered and is being used in bad faith.

As to registration in bad faith, the Panel notes that the disputed domain name was registered a significant number of years after the Complainant's trademarks, and accepts that it was chosen by reference to them. The Panel holds the XERO trademark to be sufficiently distinctive to assume that it is inconceivable that the disputed domain name with its specific composition could have been chosen and registered without actual knowledge of the Complainant's trademark. Furthermore, given the use of the disputed domain name to allegedly offer the Complainant's courses under the same color scheme as used by the Complainant, the Panel therefore deems it inconceivable that the Respondent has registered the disputed domain name completely unaware of the Complainant's trademarks. As a result, and in the absence of evidence from the Respondent that the similarity of the disputed domain name to the trademarks is coincidental or permitted, the Panel must conclude that the Respondent knew of the Complainant's rights when he registered the disputed domain name.

As to use in bad faith, according to paragraph 4(b) of the Policy, the following circumstance shall be evidence of the registration and use in bad faith: (iv) by using the domain name, to intentionally attempt to attract, for commercial gain, Internet users to the respondent's website or other online location, by creating a likelihood of confusion the complainant's mark as to the source, sponsorship, affiliation, or endorsement of his website or location of a products or service on his website or location. Given the evidence produced by the Complainant by screenshots of the website to which the disputed domain name resolved, the website falsely purported to be operated by "The XERO" Academy", offering certification courses for XERO software and imitating the look and feel of the Complainant's official website to support the confusion created by the disputed domain name. Thus, the Respondent attempted to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the Complainant's trademark ([WIPO Overview 3.0](#), sections 3.1.4 and 3.5), which constitutes use in bad faith.

Additional circumstances in support of this finding include (i) the failure of the Respondent to submit a response neither to the letter of the Complainant, nor to the Complaint in this proceeding; (ii) the Respondent's concealing its identity, and – in the absence of plausible reasons put forth by the Respondent –

(iii) the implausibility of any good faith use to which the misleading disputed domain name may be put ([WIPO Overview 3.0](#), section 3.3).

For these reasons, the Panel concludes that the Respondent has registered and is using the disputed domain name in bad faith. Accordingly, the Complainant has satisfied paragraph 4(a)(iii) of the Policy.

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

*/Andrea Jaeger-Lenz/*

**Andrea Jaeger-Lenz**

Sole Panelist

Date: November 13, 2023