

## **ADMINISTRATIVE PANEL DECISION**

F5, Inc., f/k/a F5 Networks, Inc. v. Kevin Morse  
Case No. D2024-3297

### **1. The Parties**

Complainant is F5, Inc., f/k/a F5 Networks, Inc., United States of America (“United States”), represented by Azora Law, United States.

Respondent is Kevin Morse, United States.

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

The disputed domain name <f5networksolutions.com> (hereinafter “Disputed Domain Name”) 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 August 12, 2024. On August 13, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On August 13, 2024, 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 (F5 Network Solutions, LLC, DomainsByProxy) and contact information in the Complaint. The Center sent an email communication to Complainant on August 14, 2024 providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. Complainant filed an amendment to the Complaint on August 14, 2024.

The Center verified that the Complaint together with the amendment to the 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 Respondent of the Complaint, and the proceedings commenced on August 15, 2024. In accordance with the Rules, paragraph 5, the due date for Response was September 4, 2024. A third party submitted a Response on September 4, 2024. On September 9, 2024, the Center notified the Parties that it would proceed to panel appointment.

The Center appointed Lawrence K. Nodine as the sole panelist in this matter on September 13, 2024. 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.

### **Preliminary Procedural Question**

On September 4, 2024, the due date for Respondent to submit a response, the Center received an email from "[...]"@f5networksolutions.com" that included a point-by-point response to the Complaint. However, the sender's email address was not the same as the email address that the Registrar had identified as the contact for Registrant. Accordingly, the Center asked the sender to provide information to confirm that the response was intended to be from Respondent. The Center did not receive the requested confirmation.

The Panel will nonetheless treat the received email as a response from Respondent. The email address is a combination of "kevin", the first name of Respondent, plus the Disputed Domain Name and it includes substantive responses to the Complaint transmitted by the email sent to the contact identified by the Registrar.

The Panel is satisfied that the September 4 email is in fact from Respondent and will accordingly treat the September 4 email as Respondent's answer to the Complaint.

### **4. Factual Background**

Complainant owns several United States Trademark Registrations F5 (the "F5 Mark"), including:

- United States Reg. No. 2427084; (registered on February 6, 2001)<sup>1</sup>
- United States Reg. No. 3718219; (registered on December 1, 2009)<sup>2</sup>

Complainant also owns United States Trademark Registrations for F5 NETWORKS (hereinafter the "F5 NETWORKS Mark"), including:

- United States Reg. No. 2399278; (registered on October 31, 2000)<sup>3</sup>

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<sup>1</sup> The registration describes the covered goods and services as follows: "computer hardware and software for enhancing the performance of a plurality of servers connected together by a network; and "computer consulting services."

<sup>2</sup> This registration describes the covered goods and services as follows:

"Providing an online forum for transmission and posting of messages among computer users concerning enhancing, optimizing, monitoring and managing computer network traffic; providing on-line electronic bulletin boards for transmission of messages among computer users concerning code development contests and information related to application delivery network management solutions and related matters"; and "Training services in the fields of operation of computers and networks, network system design, network operation, computer network maintenance, network testing, network protocols, network management, network engineering, computer use and operation, software design and development, operation of microprocessors and information technology; entertainment services, namely, organizing contests and sweepstakes regarding network management systems, and organizing community sporting and cultural events; providing on-line publications in the nature of magazines, newsletters, journals, books and brochures in the fields of network management solutions and related computer network goods and services; providing an on-line academic library of documents which may be shared by users; computerized on-line training and education services, namely, providing classes, seminars, tutorial sessions, conferences and workshops in the field of computers networks, computer network hardware and software and optimization thereof; educational services, namely, providing interactive tutorial sessions and courses in the nature of how-to guides, tips and techniques, expert guidance and advice, all relating to the purchase, use, care, maintenance, support, upgrading, updating and configuring of computer network related goods".

<sup>3</sup> This registration describes the covered goods and services as follows:

"computer hardware and software for enhancing the performance of a plurality of servers connected together by a network"; and "computer consulting services".

- United States Reg. No. 3763191 (registered on March 23, 2010)<sup>4</sup>

The Panel will hereinafter sometimes refer to Complainant's two trademarks collectively as the Marks. Complainant's trademark registrations describe goods and services relating to computer hardware and software useful for building or managing computer networks, providing a forum for communicating about computer networks; training relating to management of computer networks.

Apart from identifying these registrations (with copies attached as an annex), Complainant does not describe its business in the Complaint, except indirectly when it alleges that Respondent offers the same services as Complainant.

Complainant does not identify its own domain name, or allege or offer evidence that it is well known or otherwise propose any way to quantify or assess the scope of its reputation, currently or in 2017.

Respondent registered the Disputed Domain Name on April 19, 2017. On the associated webpage (hereinafter "Disputed Webpage"), Respondent promotes its IT management services. Complainant alleges that Respondent in fact offers the services described on the Disputed Webpage.

## **5. Parties' Contentions**

### **A. Complainant**

Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the Disputed Domain Name.

Notably, Complainant alleges that Respondent uses the F5 Marks throughout the Disputed Website to promote Respondent's goods and services relating to computer software and hardware, application management, computer networking and technology, hosting and cloud computing; and network security services. Complainant alleges that Respondent's goods and services are identical to its goods and services and that this use has caused and is likely to continue causing confusion or the mistaken belief that Respondent is associated with Complainant.

Complainant offers evidence of actual confusion, namely a misdirected DHL message that, although addressed to Respondent, was mistakenly delivered to Complainant in June 2024.

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<sup>4</sup> This registration describes the covered goods and services as follows:

"Providing an online forum for transmission and posting of messages among computer users concerning enhancing, optimizing, monitoring and managing computer network traffic; providing on-line electronic bulletin boards for transmission of messages among computer users concerning code development contests and information related to application delivery network management solutions and related matters"; and

"Training services in the fields of operation of computers and networks, network system design, network operation, computer network maintenance, network testing, network protocols, network management, network engineering, computer use and operation, software design and development, operation of microprocessors and information technology; entertainment services, namely, organizing contests and sweepstakes regarding network management systems, and organizing community sporting and cultural events; providing on-line publications in the nature of magazines, newsletters, journals, books and brochures in the fields of network management solutions and related computer network goods and services; providing an on-line academic library of documents which may be shared by users; computerized on-line training and education services, namely, providing classes, seminars, tutorial sessions, conferences and workshops in the field of computers networks, computer network hardware and software and optimization thereof; educational services, namely, providing interactive tutorial sessions and courses in the nature of how-to guides, tips and techniques, expert guidance and advice, all relating to the purchase, use, care, maintenance, support, upgrading, updating and configuring of computer network related goods".

Complainant alleges that Respondent intentionally attempts to attract, for commercial gain, Internet users to Respondent's website or other on-line location by creating a likelihood of confusion with Complainant's Marks.

## **B. Respondent**

In his response, Respondent asserts that "I am a small business doing business in a 100 sq mile radius", presumably from Yucaipa, California, which Complainant alleges is Respondent's address. Respondent asserts that "nothing I have is similar to Complainant. A web search doesn't even bring up my company at all and all likely combinations result in the Complainant's web address. so there is NO generated traffic as a result".

Respondent contends that the Disputed Domain Name is neither identical nor confusingly similar to Complainant's Marks because the Disputed Domain Name, unlike the Marks, capitalizes "F5" and includes the singular form of "Network" rather than the plural "networks". Respondent says there are no similarities of color and text.

Respondent denies any intention to trade of Complainant's Mark and asserts he included F5 in his business name and the Disputed Domain Name as a "play off the F5 key on a keyboard", a function key on a standard keyboard that causes the computer to refresh or reload the current webpage.

## **6. Discussion and Findings**

### **A. Identical or Confusingly Similar**

It is well accepted that the first element functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between Complainant's trademark and the Disputed Domain Name. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, ("[WIPO Overview 3.0](#)"), section 1.7.

Complainant has shown rights in respect of a trademarks or service marks for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The entirety of the F5 Mark is reproduced within the Disputed Domain Name. Accordingly, the Disputed Domain Name is confusingly similar to the F5 Mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

The Panel finds the F5 NETWORKS Mark is recognizable within the Disputed Domain Name. The plural versus singular distinction does not prevent likelihood of confusion and the color and capitalization distinctions are not displayed in the Disputed Domain Name. Accordingly, the Disputed Domain Name is confusingly similar to Complainant's F5 NETWORKS Mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

The Panel finds the first element of the Policy has been established.

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

In the next section the Panel finds the third element of the Policy has not been established. Accordingly, there is no need to address the second element of the Policy, but the Panel observes that the second and third elements overlap.

The parties agree that Respondent started using the Disputed Domain Name before he received notice of this dispute. The Disputed Domain Name was registered on April 19, 2017, and Complainant alleges that Respondent is now and has been offering essentially the same goods and services relating to management

of computer networks as those offered by Complainant. Respondent does not deny offering these services, He avers “I am a small business doing business in a 100 sq mile radius” from his office in Yucaipa, California.

Plainly, Respondent has been using the Disputed Domain Name in connection with a real, non-pretextual business delivering real services to real clients. The question is whether this use is “bona fide” within the meaning of Policy paragraph 4(c)(i). This question, in turn, depends on “whether the Respondent knew of Complainant and its trademark rights, and whether it selected the Disputed Domain Name in order to take advantage of the goodwill in Complainant’s trademark and/or to confuse or divert Complainant’s customers”. *Breazy Inc. v. Domains By Proxy, LLC*, WIPO Case No. [D2021-1486](#).

These questions obviously overlap the question of bad faith considered in the next section.

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

Complainant has not carried its burden to prove by a preponderance of evidence that Respondent registered the Disputed Domain Name in bad faith.

The Complaint does not allege that Respondent was aware of Complainant’s rights when he registered the Disputed Domain Name in 2017. Nor does Complainant allege any facts or offer any evidence to support a finding by inference that Respondent was aware of Complainant or its rights when he registered the Disputed Domain Name in 2017. Surprisingly, Complainant offers no information about Complainant other than to reference its trademark registrations. There are no allegations or evidence about the current scope or quantity of Complainant’s services, and nothing about extent of Complainant’s reputation in 2017 when Respondent registered the Disputed Domain Name. Complainant does not even identify its own domain name or website.

Although Complainant has not alleged or argued that Respondent should be charged with constructive knowledge of Complainant’s trademark rights, the Panel has considered this contention nonetheless. “Application of this concept [constructive knowledge] may depend in part on the complainant’s reputation and the strength or distinctiveness of its mark, or facts that corroborate an awareness of the complainant’s mark.” [WIPO Overview 3.0](#), section 3.2.2. Complainant offers none of the ancillary evidence that might support reliance on constructive knowledge.

If there is evidence that Complainant was so well known in 2017 that Respondent was probably aware of Complainant’s trademark rights, it was incumbent upon Complainant to make the required allegations and offer the historical evidence to support them. Complainant did neither, and therefore failed to give thereby Respondent notice and an opportunity to respond to the relevant allegations and evidence. Such evidence may have been available to Complainant, but it was not presented. The Panel emphasizes that the issue here is not whether Complainant is well known today, but instead whether Complainant was well known in 2017.

First, and most important, the key question—what was the extent of Complainant’s reputation in 2017—is not easily or reliably determined, and, in any event, Complainant has not provided any evidence of its own historical records in that regard. Complainant is represented by counsel who is expected to understand and foresee the need to offer evidence to substantiate prima facie allegations.

Consequently, there is no evidence to support an inference that Respondent was aware of Complainant’s rights and targeting Complainant when he registered the Disputed Domain Name in 2017. On the contrary, Respondent says that he included “F5” in the Disputed Domain Name as a play on the “F5” function key on the keyboard, which function key operates to refresh or reload the current web page. The Panel finds that this explanation is plausible. Because there is no record evidence quantifying Complainant’s reputation in 2017, the Panel has no basis to reject Respondent’s explanation or to find that the balance of probabilities favors Complainant.

Respondent also contends that the Disputed Website does not mimic Complainant's website. Because Complainant offered no evidence about its own website, or any comparison of the parties' respective websites, the Panel accepts Respondent's contention as unrebutted.

Complainant says that "Respondent intentionally attempts to attract, for commercial gain, Internet users to Respondent's website or other on-line location by creating a likelihood of confusion with the Complainant's F5 Marks", but this is merely a boilerplate recitation of Policy paragraph 4(b)(iv).

The Panel finds the third element of the Policy has not been established.

Complainant's case can be summarized with the following excerpt from the Complaint: "Complainant asserts Respondent's use of the F5 Marks is currently likely to cause consumer confusion in the marketplace and will continue to do so in the future. Respondent offers identical goods and services as well as goods and services related to and within the natural zone of expansion of the services provided by Complainant under a confusingly similar mark."

These are essentially allegations of a trademark case, and the Policy is not suited to adjudicate such claims, if any.

## **7. Decision**

For the foregoing reasons, the Complaint is denied.

*/Lawrence K. Nodine/*

**Lawrence K. Nodine**

Sole Panelist

Date: September 27, 2024