

ADMINISTRATIVE PANEL DECISION

AcademicMerit, LLC v. Kwan Hong Lee, multiplazas.com
Case No. D2022-3174

1. The Parties

The Complainant is AcademicMerit, LLC, United States of America (“United States”), represented by Bernstein Shur, United States.

The Respondent is Kwan Hong Lee, multiplazas.com, United States.

2. The Domain Name and Registrar

The disputed domain name <finetunelearning.com> (the 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 26, 2022. On August 29, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On August 29, 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.

On August 31, 2022, the Center sent a notification to the Complainant requesting the amendment of the mutual jurisdiction section of the Complaint. In response to this notification, the Complainant filed an amended Complaint on August 31, 2022.

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 1, 2022. In accordance with the Rules, paragraph 5, the due date for Response was September 21, 2022. The Respondent did not submit any formal response. Accordingly, the Center notified the Respondent’s default on September 23, 2022.

On September 22, 2022, the Respondent sent an email to the Center stating that the Disputed Domain Name was its own personal domain name, that it registered the Disputed Domain Name for its own purpose, and that it would sell the Disputed Domain Name to the Complainant. On the same date, the Complainant submitted a supplemental statement in response, requesting that the Panel not consider the Respondent's untimely response, and otherwise refuting all of the Respondent's assertions.¹

The Center appointed Lynda M. Braun as the sole panelist in this matter on September 29, 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 October 5, 2022, the Panel issued Administrative Panel Procedural Order No. 1 ("Panel Order No. 1") to the Parties, requesting that they clarify the payment for the Disputed Domain Name, and some information displayed on the website at the Disputed Domain Name. The Panel granted 2 days to submit a response, and the due date for the Decision was extended to October 18, 2022. The Complainant responded to the questions on October 6, 2022, but the Respondent did not submit any communication in response to Panel Order No. 1.

4. Factual Background

The Complainant, a limited liability company based in Maine, United States, is a developer of an award-winning suite of online professional-development, assessment, instruction, and learning solutions focused on literacy in grades 6-12 and used in relation to its hybrid artificial intelligence and human analysis and assessment services. The Complainant is the owner of the trademark FINETUNE, United States trademark Registration No. 4,236,148, registered on November 6, 2012, in international class 42 (hereinafter referred to as the "FINETUNE Mark").

The Respondent is a former employee and Chief Technology Officer of the Complainant. During its employment, the Respondent registered the domain name at the request of the Complainant, using the Complainant's company credit card. The Complainant directed the Respondent to register the domain name in the Complainant's name, but the Respondent apparently registered the domain name in its own personal name rather than the Complainant's corporate name and did so without the Complainant's knowledge or consent. The Complainant did not become aware that the Respondent had registered the Disputed Domain Name in its individual name until a recent company audit and due diligence revealed this fact. Despite the Complainant's demands to transfer the Disputed Domain Name, the Respondent refused to transfer the Disputed Domain Name to the Complainant without receiving compensation.

The Disputed Domain Name was registered on July 8, 2017. According to the Complaint, the Disputed Domain Name has always been used to direct consumers to Complainant's website. The Disputed Domain Name currently resolves to the website at "www.finetunelearning.com", where the home page states that the company is Boston-based.

The resolving website lists the Complainant's employees, and the Privacy Policy refers to the Complainant for necessary contacts.

5. Parties' Contentions

A. Complainant

¹ Paragraphs 10 and 12 of the Rules grant the Panel sole discretion to determine the admissibility of supplemental filings received from either Party. The Panel, in its sole discretion, has decided to consider the Respondent's untimely email response and the Complainant's supplemental filing in rendering its Decision.

The following are the Complainant's contentions:

- the Disputed Domain Name is confusingly similar to the Complainant's FINETUNE Mark;
- the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name;
- the Disputed Domain Name was registered and is being used in bad faith;
- the Respondent, as a former employee of the Complainant, registered the Disputed Domain Name in its own personal name, although the Complainant directed the Respondent to register the domain name in the Complainant's corporate name.
- the Respondent did not have a legitimate purpose to register the Disputed Domain Name in its own personal name; and
- the Complainant seeks the transfer of the Disputed Domain Name from the Respondent to the Complainant in accordance with paragraph 4(i) of the Policy.

B. Respondent

The Respondent did not submit a formal response, although the Respondent sent an informal email communication to the Center on September 22, 2022, as described under Section 3 above, indicating that it owns the Disputed Domain Name, and claimed that it rightfully registered the Disputed Domain Name in its own personal name, "before rebranding from Academic Merit to FineTune", and that the Respondent came up with it personally.

6. Discussion and Findings

In order for the Complainant to prevail and have the Disputed Domain Name transferred to the Complainant, the Complainant must prove the following (Policy, paragraph 4(a)):

- (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 has been registered and is being used in bad faith.

A. Identical or Confusingly Similar

Paragraph 4(a)(i) of the Policy requires a two-fold inquiry: a threshold investigation into whether a complainant has rights in a trademark, followed by an assessment of whether the domain name is identical or confusingly similar to that trademark. The Panel concludes that in the present case, the Disputed Domain Name is confusingly similar to the FINETUNE Mark.

It is uncontroverted that the Complainant has established rights in the FINETUNE Mark based on its years of use as well as its registered trademark for the FINETUNE Mark in the United States. The consensus view is that "registration of a mark is *prima facie* evidence of validity, which creates a rebuttable presumption that the mark is inherently distinctive". See *CWI, Inc. v. Domain Administrator c/o Dynadot*, WIPO Case No. [D2015-1734](#). The Respondent has not rebutted this presumption, and therefore the Panel finds that the Complainant has rights in the FINETUNE Mark. Moreover, the registration of a mark satisfies the threshold requirement of having trademark rights for purposes of standing to file a UDRP case. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.2.1. Thus, the Panel finds that the Complainant satisfied the threshold requirement of having rights in the

FINETUNE Mark.

The Disputed Domain Name consists of the FINETUNE Mark in its entirety followed by the term “learning”, and then followed by the generic Top-Level Domain (“gTLD”) “.com”. It is well established that a domain name that wholly incorporates a trademark is deemed confusingly similar to that trademark for purposes of the Policy despite the addition of other terms. As stated in section 1.8 of [WIPO Overview 3.0](#), “where the relevant trademark is recognizable within the disputed domain name, the addition of other terms [...] would not prevent a finding of confusing similarity under the first element”. For example, numerous UDRP decisions have reiterated that the addition of terms to a trademark does not prevent a finding of confusing similarity. See *Allianz Global Investors of America, L.P. and Pacific Investment Management Company (PIMCO) v. Bingo-Bongo*, WIPO Case No. [D2011-0795](#); and *Hoffmann-La Roche Inc. v. Wei-Chun Hsia*, WIPO Case No. [D2008-0923](#).

Further, the addition of a gTLD such as “.com” in a domain name is technically required. Thus, it is well established that, as here, such element may typically be disregarded when assessing whether a domain name is identical or confusingly similar to a trademark. See *Proactiva Medio Ambiente, S.A. v. Proactiva*, WIPO Case No. [D2012-0182](#) and [WIPO Overview 3.0](#), section 1.11.

Accordingly, the Panel finds that the first element of paragraph 4(a) of the Policy has been met by the Complainant.

B. Rights or Legitimate Interests

Under the Policy, a complainant has to make out a *prima facie* case that the respondent lacks rights or legitimate interests in the disputed domain name. Once such a *prima facie* case is made, the respondent carries the burden of production of evidence that demonstrates rights or legitimate interests in the disputed domain name. If the respondent fails to do so, the complainant may be deemed to have satisfied paragraph 4(a)(ii) of the Policy. See [WIPO Overview 3.0](#), section 2.1.

There is no evidence in the record suggesting that the Respondent has rights or legitimate interests in the Disputed Domain Name. The Complainant has not authorized, licensed, or otherwise permitted the Respondent to use, let alone register, the Complainant’s FINETUNE Mark for its own purposes. There is also no evidence that the Respondent is commonly known by the Disputed Domain Name or by any similar name.

The Respondent claims the Disputed Domain Name was rightfully registered in its own personal name, “before rebranding from Academic Merit to FineTune”, and that the Respondent came up with it personally. However, the Panel notes that the Complainant’s FINETUNE Mark was registered in 2012, that the Disputed Domain Name was registered in 2017, that the Respondent is a former employee and Chief Technology Officer of the Complainant, and that the Disputed Domain Name has been used as the Complainant’s website.

In sum, the Panel finds that the Complainant has established an un rebutted *prima facie* case that the Respondent lacks rights or legitimate interests in the Disputed Domain Name.

Accordingly, the Panel finds that the second element of paragraph 4(a) of the Policy has been met by the Complainant.

C. Registered and Used in Bad Faith

The Panel finds that based on the record, the Complainant has demonstrated the existence of the Respondent’s bad faith pursuant to paragraph 4(b) of the Policy.

First, the Respondent was clearly aware of the Complainant's trademark rights at the time it was directed to register the Disputed Domain Name on behalf of the Complainant for its use as Complainant's website. Nonetheless, the Respondent registered the Disputed Domain Name in its own personal name and did not disclose that fact to the Complainant. There is nothing in the record before the Panel that arguably shows that the Respondent was given permission to proceed in this manner or that the Respondent had a legitimate personal interest in such registration. In view of the circumstances of the case, the Panel considers on the balance of probabilities that the Respondent was charged with registering the Disputed Domain Name for the benefit of the Complainant and not for the personal benefit of the Respondent.

Second, despite the Complainant's demands, the Respondent has refused to transfer the Disputed Domain Name to the Complainant, instead requiring that the Complainant pay significant compensation to the Respondent in exchange for transfer of the Disputed Domain Name. Such demand for compensation by the Respondent, when the Respondent knew that the Disputed Domain Name rightfully belongs to the Complainant, further evidences bad faith. See *Blue On Highland LLC v. Matthew Sullivan*, WIPO Case No. [D2021-3168](#) ("Respondent acted opportunistically and in bad faith when he registered the disputed domain name in his personal name, assumed control of the disputed name and later refused to take steps to transfer the disputed domain name to Complainant when asked to do so.")

Accordingly, the Panel finds that the third element of paragraph 4(a) of the Policy has been met by the Complainant.

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 <finetunelearning.com> be transferred to the Complainant.

/Lynda M. Braun/

Lynda M. Braun

Sole Panelist

Date: October 11, 2022