

ADMINISTRATIVE PANEL DECISION

The Common Application, Inc. v. Charles Lu
Case No. D2023-0087

1. The Parties

Complainant is The Common Application, Inc., United States of America (“United States”), represented by Venable, LLP, United States.

Respondent is Charles Lu, United States.

2. The Domain Name and Registrar

The disputed domain name <commonapp.online> (the “Domain Name”) is registered with Domain.com, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on January 7, 2023. On January 9, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On January 9, 2023, the Registrar transmitted by email to the Center its verification response confirming that Respondent is listed as the registrant and providing the contact details.

The Center verified that 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 January 17, 2023. In accordance with the Rules, paragraph 5, the due date for Response was February 6, 2023. The Response was filed with the Center on February 4, 2023.

The Center appointed Robert A. Badgley as the sole panelist in this matter on February 14, 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

Complainant identifies itself as a “well-known nonprofit organization.” According to Complainant:

“Since its inception over forty years ago, Common App has helped millions of students around the world with the college admissions process through its unified admissions form as well as its admissions resources and assistance.”

Complainant asserts that roughly one million students per year use its services to apply for college, research financial aid and scholarship opportunities, and find college counseling resources. In addition, Complainant states that it has more than a thousand institutions of higher learning in its membership.

Complainant holds various trademark registrations in several jurisdictions (including the European Union, India, United States) for the mark COMMON APP. For example, Complainant holds United States Reg. No. 3,305,082 for the word mark COMMON APP, registered on October 9, 2007 in connection with “downloadable electronic college admission forms,” with a May 1999 date of first use in commerce.

Complainant’s website is accessible via the domain name <commonapp.org>. In addition, Complainant maintains a robust social media presence. Complainant’s COMMON APP pages have more than 61,000 Facebook followers, 15,000 Instagram followers, 50,000 Twitter followers, and nearly 8,000 YouTube followers.

The Domain Name was registered on May 4, 2022. The Domain Name currently does not resolve to a website. As of October 11, 2022, however, the Domain Name resolved to a website purporting to offer college application services to consumers. Respondent’s website at the time bore numerous close similarities to Complainant’s website, often lifting text verbatim from Complainant’s site. For instance, one page of both sites states “Your future starts here” right above a link stating, “Start your application.” The organization of both sites was also strikingly similar.

Complainant asserts that Respondent is trying to pass itself off as being Complainant or being affiliated with Complainant.

Respondent does not deny any of the foregoing allegations.

5. Parties’ Contentions

A. Complainant

Complainant contends that it has established all three elements required under the Policy for a transfer of the Domain Name.

B. Respondent

Respondent did not reply to Complainant’s actual allegations. Rather, the substance of Respondent’s position is set forth below:

“Domain names follow the principle of first registrant first get. The other party has been running “commonapp.org” for more than 15 years, and it is a service based on the Internet. Therefore, the other party is familiar with the rules of domain name registration;

I obtained commonapp.online on May 4, 2022, that is, the Commonapp company itself was negligent in domain name registration, which led to me picking up this domain name. If they care or intend to protect their trademark, domain name exclusivity, why not spend a very cheap fee to achieve the purpose of protection? The fees they spend on lawyers are more than 1,000 times the cost of registering a domain

name. Obviously they do not abide by the World Intellectual Property Protection Convention for domain name registration.

Secondly, the other party claimed that we had infringed his trademark rights, and they initiated the same lawsuit in the United States. It is inappropriate for WIPO to start this arbitration case before the judgment of the US court or before the two parties settle. Because whether it constitutes infringement, there is no conclusion.

There are five levels of protection for trademarks: fanciful, arbitrary, suggestive, descriptive (including surnames), and generic. His trademark belongs to the level below suggestive and cannot restrict anyone or any company from using letters such as common/commonapp/common application. This The trademark is neither as Sony nor Disney, because common and application are words commonly used by human beings. In essence, a suggestive-level trademark cannot bind others to use the words in it.

Let us give an example to illustrate this case. I accidentally bought a cage in a market where I was wandering. There were various animals or gods in the cage. They had a fight, and an elephant came to tell the arbitration tribunal that the ants had violated the trademark of the elephant. But instead of suing the ants, the elephant sued the person who held the cage, saying that you should give me the cage. Does this comply with minimum intellectual property protection rules? Those who bought land in the Great West of the United States in the 18th century, because people who walked on the land fought on the land, would they have to deprive the ownership of the land to those who lost the fight?"

6. Discussion and Findings

Paragraph 4(a) of the Policy lists the three elements which Complainant must satisfy with respect to the Domain Name:

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

A. Identical or Confusingly Similar

The Panel concludes that Complainant has rights in the trademark COMMON APP through registration and use demonstrated in the record. The Panel also concludes that the Domain Name is identical to that mark. The generic Top-Level Domain ".online" is disregarded for purposes of assessing identity or confusing similarity under the first element.

Complainant has established Policy paragraph 4(a)(i).

B. Rights or Legitimate Interests

Pursuant to paragraph 4(c) of the Policy, Respondent may establish its rights or legitimate interests in the Domain Name, among other circumstances, by showing any of the following elements:

- (i) before any notice to you [Respondent] of the dispute, your 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) you [Respondent] (as an individual, business, or other organization) have been commonly known by the Domain Name, even if you have acquired no trademark or service mark rights; or

- (iii) you [Respondent] are making a legitimate noncommercial or fair use of the Domain Name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

The Panel concludes that Respondent lacks rights or legitimate interests in respect of the Domain Name. None of the “safe harbors” listed above has been invoked by Respondent, and none appears even remotely plausible based on the record here. It is undisputed that Complainant has not authorized Respondent to use COMMON APP in a domain name or otherwise.

It is also undisputed, and otherwise evident from the comparison of the Parties’ respective websites in October 2022, that Respondent registered the Domain Name with knowledge of Complainant’s COMMON APP trademark, and with the intent to set up a website to impersonate Complainant and mislead consumers looking for Complainant’s services. Such conduct is obviously illegitimate.

Complainant has established Policy paragraph 4(a)(ii).

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy provides that the following circumstances, “in particular but without limitation,” are evidence of the registration and use of the Domain Name in “bad faith”:

- (i) circumstances indicating that Respondent has registered or has acquired the Domain Name primarily for the purpose of selling, renting, or otherwise transferring the Domain Name registration to Complainant who is the owner of the trademark or service mark or to a competitor of that Complainant, for valuable consideration in excess of its documented out of pocket costs directly related to the Domain Name; or
- (ii) that Respondent has registered the Domain Name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that Respondent has engaged in a pattern of such conduct; or
- (iii) that Respondent has registered the Domain Name primarily for the purpose of disrupting the business of a competitor; or
- (iv) that by using the Domain Name, Respondent has intentionally attempted to attract, for commercial gain, Internet users to Respondent’s website or other online location, by creating a likelihood of confusion with Complainant’s mark as to the source, sponsorship, affiliation, or endorsement of Respondent’s website or location or of a product or service on Respondent’s website or location.

The Panel concludes that Respondent has registered and used the Domain Name in bad faith within the meaning of the above-quoted Policy paragraph 4(b)(iv). As discussed above, it is obvious from the content of the Parties’ respective websites that Respondent had Complainant’s COMMON APP trademark in mind when registering the Domain Name. It is plausibly alleged and supported with screenshot evidence, and undisputed by Respondent, that Respondent has sought to impersonate Complainant to deceive consumers into believing that Respondent’s website is somehow affiliated with or sponsored by Complainant.

Complainant has established Policy paragraph 4(a)(iii).

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 Domain Name <commonapp.online> be transferred to Complainant.

/Robert A. Badgley/

Robert A. Badgley

Sole Panelist

Date: February 27, 2023