

ADMINISTRATIVE PANEL DECISION

Booker Autism Foundation of Learning, Inc. v. Steve Slobodzian
Case No. D2023-1210

1. The Parties

The Complainant is Booker Autism Foundation of Learning, Inc., United States of America ("United States"), represented by Dinsmore & Shohl LLP, United States.

The Respondent is Steve Slobodzian, Canada.

2. The Domain Name and Registrar

The disputed domain name <bafol.org> is registered with NameCheap, Inc. (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on March 19, 2023. On March 20, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On the same day, 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 ("Withheld for Privacy ehf") and contact information in the Complaint. The Center sent an email communication to the Complainant on March 22, 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 amendment to the Complaint on March 27, 2023.

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 the Respondent of the Complaint, and the proceedings commenced on March 29, 2023. In accordance with the Rules, paragraph 5, the due date for Response was April 18, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on April 25, 2023.

The Center appointed Andrew D. S. Lothian as the sole panelist in this matter on May 9, 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 is a Kentucky, United States corporation with a principal place of business in Louisville, Kentucky, United States. According to the Complaint, the Complainant has used the name “BAFOL”, being an acronym of its formal entity name, since at least 2012 and has been referred to as such by the community since that time. The Complainant uses the arts, education, and research to improve the lives of individuals with Autism Spectrum Disorder, and specializes in providing free wellness programs for individuals with the condition.

The Complainant is the owner of United States Trademark Application with Serial No. 97092617 for the word and design mark BAFOL BOOKER AUTISM FOUNDATION OF LEARNING, in which the largest element is the initials BAFOL, which appears in large white block letters outlined in grey, other than the letter “A”, which is in a spectrum of colors from blue to red, while the word “Autism” overlays the “A” and is in a black script typeface. Said mark was filed on October 26, 2021, and was published for opposition on April 4, 2023. The mark contains a disclaimer of the words “AUTISM FOUNDATION OF LEARNING” apart from the mark as shown.

The disputed domain name was created on August 21, 2020. Little is known regarding the Respondent, other than that it appears to be a private individual with an address in Ontario, Canada. The website associated with the disputed domain name reproduces the Complainant's BAFOL mark along with the Complainant's copyrighted images, and requests donations to the Complainant's organization. Although still largely representing the Complainant's operations, the said website content has been amended to include an endorsement of a plumbing business based in Louisville, Kentucky.

The Complainant was the owner of the disputed domain name until about April 2017 and used it in connection with its official website, which displayed the Complainant's BAFOL mark prominently at the top of each page. The Complainant later transitioned to a new domain name.

5. Parties' Contentions

A. Complainant

In summary, the Complainant contends as follows:

Identical or confusingly similar

The disputed domain name is comprised of the dominant and distinctive element of the Complainant's mark. Confusing similarity may be found where at least a dominant feature of the relevant mark is recognizable in the domain name concerned. The Complainant has established strong common law trademark rights in the BAFOL mark due to continuous use for over a decade, and the disputed domain name incorporates the entirety of this mark.

The addition of the “.org” to the end of the disputed domain name does not affect the disputed domain name for the purpose of determining whether it is identical or confusingly similar to said mark. It is also well accepted that where content on the disputed domain name trades off the Complainant's reputation, a finding of confusing similarity is further supported. The disputed domain name is being used to trade off the Complainant's reputation for the purpose of luring users to submit monetary donations through the website or otherwise to engage with the website operator posing as the Complainant, placing the public at risk.

Rights or legitimate interests

The Respondent is not commonly known by the disputed domain name, nor is there any indication that it has registered the disputed domain name as a trademark. The Respondent is not using the disputed domain name in connection with a *bona fide* offering of goods or services. The Complainant has never assigned or transferred any rights in its BAFOL trademark to the Respondent. The Complainant has no relationship with the Respondent, and has not granted the Respondent permission to use or register its BAFOL trademark as a domain name. Said mark is an arbitrary term which has no meaning outside its use by the Complainant as a source of certain services. The Respondent has not altered the majority of the content on the website hosted at the disputed domain name, which was created by the Complainant to advertise its services prior to the Respondent's registration thereof, and contains the Complainant's business address and contact information.

The Complainant's use and ownership of the BAFOL mark predates the registration of the disputed domain name. The Respondent's failure to respond to this Complaint is evidence that it has no rights or legitimate interests in the disputed domain name. The Respondent is using the disputed domain name to profit from and trade off the Complainant's goodwill by misleadingly and fraudulently diverting its potential donors and community members to a website formerly owned by the Complainant, which still hosts identical content to that created by the Complainant, for purposes of committing fraud and perpetrating cybercrime and phishing activities.

Registered and used in bad faith

There is clear evidence of bad faith on the Respondent's part. The fact that the Respondent registered, without authorization, a domain name that fully incorporates the Complainant's trademark creates, by itself, a presumption of bad faith. The Respondent uses the Complainant's content without authorization to trick Internet users into believing that the website still belongs to the Complainant. The Respondent intentionally diverts the Complainant's potential donors for the Respondent's fraudulent commercial gain, using a PayPal link previously active on the website. Visitors to the Complainant's former website who wish to donate to the organization are highly likely to believe that the donation link is associated with the Complainant, resulting in the collection of fraudulent donations by the Respondent, tarnishing the reputation of the Complainant, diminishing the willingness of community members and businesses to donate in the future, and presenting a serious risk of cybercrimes to Internet users.

The Respondent has inserted language into the homepage of the website endorsing a business named "Dr Pipes Plumbing", with that insertion being the only update to the website content. This indicates that the Respondent has the capability to remove the Complainant's content from the disputed domain name but has chosen to maintain it and otherwise use the platform to induce Internet users to engage with a potentially fraudulent business. The Respondent has also used a privacy service to conceal its identity, and this redaction supports an inference of bad faith. Given that the Respondent took control of the disputed domain name while the Complainant's website was still associated with it, it is impossible to argue that the Respondent was unaware of the Complainant's prior use and rights in its BAFOL trademark. The Respondent has failed to reply to multiple cease and desist letters sent by the Complainant prior to the filing of this Complaint, which is also indicative of bad faith.

B. Respondent

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

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:

- (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 and is being used in bad faith.

A. Identical or Confusingly Similar

The first element analysis under the Policy is usually conducted by way of a two-part process. In the first step, the Panel ascertains whether the Complainant possesses UDRP-relevant rights in a trademark, whether registered or unregistered. In the second step, the domain name concerned is compared with any such trademark, typically on a straightforward side-by-side basis, in which the Top-Level Domain ("TLD") of said domain name (in the disputed domain name, ".org") is usually disregarded as being merely of technical significance. Confusing similarity may be found if the trademark is recognizable in the disputed domain name, whether or not accompanied by other terms. Identity may be found if the trademark is identical to the disputed domain name (with the exception of the TLD), having disregarded any special characters, punctuation or spaces.

In the present case, the Complainant first puts forward its application for a registered trademark, described in the factual background section above. This application has not yet proceeded to grant, and as such, cannot constitute "a trademark or service mark in which the Complainant has rights" for the purposes of the Policy. The Complainant supplements its application for a trademark by way of a claim to common law rights in the mark BAFOL, which it asserts that it has been using since at least 2012.

Section 1.3 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)") provides examples of what needs to be evidenced by a complainant in order to successfully assert unregistered trademark rights in cases under the Policy, namely (i) the duration and nature of use of the mark, (ii) the amount of sales under the mark, (iii) the nature and extent of advertising using the mark, (iv) the degree of actual public (e.g., consumer, industry, media) recognition, and (v) consumer surveys. In the present case, the Complainant provides no evidence along these lines to support its claim, other than undated screenshots of the website associated with the disputed domain name when it was said to be under the Complainant's direct control. Section 1.3 of the [WIPO Overview 3.0](#) goes on to note that specific evidence supporting assertions of acquired distinctiveness should be included in the complaint; conclusory allegations of unregistered or common law rights, even if undisputed in the particular UDRP case, would not normally suffice to show secondary meaning.

This Complaint might have failed at this point for want of evidence supporting the Complainant's assertion that it possesses relevant unregistered trademark rights. Nevertheless, the Complainant does assert that it commenced use of the "BAFOL" acronym in 2012, and was using the disputed domain name (together with the associated website) from its original date of registration until around 2017. This is a relatively straightforward matter for the Panel to check from publicly available sources, namely historic Whois records concerning the disputed domain name, and archived screenshots of the corresponding website (see section 4.8 of the [WIPO Overview 3.0](#) with regard to the Panel conducting limited factual research into matters of public record, such as consulting relevant publicly available websites). These sources can sometimes be incomplete but any historic entries that are present may support the Complainant's contentions on this topic.

In terms of historic Whois entries for the disputed domain name, the Panel can see that the disputed domain name appears to have been registered to one of the Complainant's office bearers, as listed on its website, from at least August 10, 2014. These records continue until early 2017. In terms of the Internet Archive entries, the Panel can see that the Complainant's website, in which it solicits donations and refers to itself as "BAFOL", has been online since at least November 13, 2014. In these circumstances, evidence is available regarding the duration and use of the mark that suggests that the Complainant has been known, and soliciting donations for its foundation, as "BAFOL" for almost a decade. Furthermore, as the Complainant indicates, it cannot be overlooked that the Respondent itself has chosen to publish a copy of the

Complainant's website, with only minor modifications to add a third party advertisement, since it registered the disputed domain name in 2020. This does not appear to the Panel to be accidental or coincidental, particularly as the Respondent has made deliberate changes to the website content without deleting that which refers to the Complainant. This suggests that the Respondent is targeting the Complainant's mark in a manner which supports the contention that such mark is indeed a source identifier. Section 1.3 of the [WIPO Overview 3.0](#) notes "The fact that a respondent is shown to have been targeting the complainant's mark (e.g., based on the manner in which the related website is used) may support the complainant's assertion that its mark has achieved significance as a source identifier". In all of these circumstances, the Panel finds that the Complainant possesses UDRP-relevant unregistered trademark rights in the mark BAFO.

Turning briefly to the comparison exercise, it may be seen that the Second-Level Domain of the disputed domain name is an alphanumerically exact match for the Complainant's BAFO mark. In these circumstances, the Panel finds that the disputed domain name is confusingly similar to a trademark in which the Complainant has rights and therefore that the Complainant has carried its burden in respect of paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy lists several ways in which the Respondent may demonstrate rights or legitimate interests in the disputed domain name:

"Any of the following circumstances, in particular but without limitation, if found by the Panel to be proved based on its evaluation of all evidence presented, shall demonstrate your rights or legitimate interests to the domain name for purposes of paragraph 4(a)(ii):

- (i) before any notice to you 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 (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 are making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to mislead consumers or to tarnish the trademark or service mark at issue."

The consensus of previous decisions under the Policy is that a complainant may establish this element by making out a *prima facie* case, not rebutted by the respondent, that the respondent has no rights or legitimate interests in a domain name. In the present case, the Panel finds that the Complainant has established the requisite *prima facie* case based on its submissions and the related evidence that the disputed domain name was operated for many years on behalf of the Complainant, that the Respondent has effectively maintained or reproduced a copy of the Complainant's website in connection with the disputed domain name, merely adding an advertisement, and that the Respondent is thereby impersonating the Complainant and misleading the public.

In the above circumstances, the burden of production shifts to the Respondent to bring forward evidence of any rights or legitimate interests which it might claim in the disputed domain name. As noted above, the Respondent has chosen not to engage with the administrative proceeding. The Panel has found nothing in the facts and circumstances of the case, which suggest that any aspects of paragraph 4(c) of the Policy might have been engaged on the Respondent's behalf. The Panel has also been unable to identify any legitimate reason why the Respondent might be using the website associated with the disputed domain name as it is currently doing, or to conceive of any potential rights or legitimate interests, which the Respondent might have claimed had it chosen to participate in this case.

In all of these circumstances, the Panel finds that the Respondent has failed to rebut the Complainant's *prima facie* case that the Respondent has no rights or legitimate interests in the disputed domain name, and therefore that the Complainant has carried its burden in terms of paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy provides four, non-exclusive, circumstances that, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith:

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

In the present case, the evidence shows that the Complainant was the original user of the disputed domain name for many years, and that the Respondent registered the disputed domain name some three years ago. The Respondent has retained the content from the Complainant's original website and has made no alterations other than to insert a specific endorsement of a plumbing business. It is clear that the Respondent seeks to benefit by impersonating the Complainant with intent for commercial gain.

The Panel accepts the Complainant's contention that the Respondent could not have been unaware of the Complainant or its rights at the point of registration of the disputed domain name, given the fact that it has reproduced the exact content of the website previously published by the Complainant and has merely added an advertisement to this. The evidence suggests that the disputed domain name was newly registered by the Respondent after the Complainant moved on to a new domain name. In these circumstances, the cloning or maintenance of the Complainant's content, with modification to include a third party advertisement, seems more probably than not to have been a purposeful and bad faith act on the Respondent's part rather than mere coincidence.

The Respondent has not engaged with the administrative proceeding, nor, it would appear, has it ever engaged with the Complainant's attempts to contact it regarding its registration and use of the disputed domain name. In the Panel's opinion, the Complainant's submissions and evidence on this topic raise a case for the Respondent to answer, albeit that no such answer is forthcoming. In the absence of any suitable explanation, the Panel has been unable to identify any possible good faith reason whereby the Respondent has registered and used the disputed domain name in the manner described and evidenced in the Complaint. The circumstances suggest that by registering and using the disputed domain name, the Respondent purposefully intended to benefit commercially from a false association with the Complainant's BAFO mark.

The Panel therefore finds that by using the disputed domain name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of such website.

Accordingly, the Panel finds that the disputed domain name has been registered and is being used in bad faith, and therefore that the Complainant has carried its burden in terms of 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 <bafol.org> be transferred to the Complainant.

/Andrew D. S. Lothian/

Andrew D. S. Lothian

Sole Panelist

Date: May 16, 2023