

ADMINISTRATIVE PANEL DECISION

Open Society Institute v. Johnson Fred
Case No. D2023-2950

1. The Parties

Complainant is Open Society Institute, United States of America, represented by Morrison & Foerster, LLP, United States of America.

Respondent is Johnson Fred, United States Minor Outlying Islands, United States of America.

2. The Domain Name and Registrar

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

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on July 11, 2023. On July 12, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On July 12, 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 (Redacted for Privacy, Privacy service provided by Withheld for Privacy ehf) and contact information in the Complaint. The Center sent an email communication to Complainant on July 20, 2023 providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. Complainant filed an amended Complaint on July 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 Respondent of the Complaint, and the proceedings commenced on August 2, 2023. In accordance with the Rules, paragraph 5, the due date for Response was August 22, 2023. Respondent did not submit any response. Accordingly, the Center notified Respondent's default on August 25, 2023.

The Center appointed Frederick M. Abbott as the sole panelist in this matter on September 18, 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 is the owner of registrations on the Principal Register of the United States Patent and Trademark Office (USPTO) for the word trademark OPEN SOCIETY FOUNDATIONS, registration number 4,248,358, registration dated November 27, 2012, in international classes 9, 16, 36, 38 and 41, covering, *inter alia*, downloadable publications in the fields of democratic awareness and development, human and civil rights government and social policy; printed publications in the fields of democratic awareness and development, human and civil rights, and public health; philanthropic services concerning monetary donations, grants and scholarships; online electronic discussion groups and; for arranging and conducting educational conferences and seminars.

Complainant is a philanthropic organization concerned with building tolerant democratic societies, funding a range of programs around the world, involving public health, education and business development, and operating information platforms associated with its objectives. Complainant has since at least April 2010 operated a website at <opensocietiesfoundations.org>. The Panel takes administrative notice that Complainant is a well-known philanthropic organization operating under its OPEN SOCIETY FOUNDATIONS trademark.

According to the Registrar's verification, Respondent is registrant of the disputed domain name. According to a Whois report provided by Complainant, the disputed domain name was registered on June 30, 2023. There is no indication on the record of this proceeding that any party other than Respondent has owned or controlled the disputed domain name since its date of registration.

The disputed domain name is parked with the Registrar and resolves to a webpage listing "related searches" topics, including topics such as "scholarship programs", "foundations", and "project proposal". There is no evidence of use by Respondent of the disputed domain name other than in association with the parking page.

5. Parties' Contentions

A. Complainant

Complainant alleges that it owns rights in the trademark OPEN SOCIETY FOUNDATIONS and that the disputed domain name is identical to that trademark.

Complainant contends that Respondent lacks rights or legitimate interests in the disputed domain name because: (1) Respondent has not made use of the disputed domain name in connection with a *bona fide* offer of goods or services; (2) Complainant has not authorized Respondent to make use of its trademark in the disputed domain name or otherwise; (3) parking of the disputed domain name does not establish rights or legitimate interests; (4) Respondent has not been commonly known by the disputed domain name, and; (5) Respondent is not making legitimate noncommercial or fair use of the disputed domain name.

Complainant argues that Respondent registered and is using the disputed domain name in bad faith because: (1) Respondent was aware of Complainant's trademark when it registered the disputed domain name, has no connection to Complainant, and has no authorization or legitimate purpose to utilize the trademark; (2) Respondent has engaged in bad faith passive use of the disputed domain name because Complainant's trademark is well known, Respondent engaged a privacy service in registering the disputed domain name, and Respondent has no plausible good faith use for the disputed domain name;

(3) Respondent is disrupting Complainant's business by creating consumer confusion through use of a parking page associated with the disputed domain name, and; (4) Respondent provided the Registrar with false address information.

Complainant requests the Panel to direct the Registrar to transfer the disputed domain name to Complainant.

B. Respondent

Respondent did not reply to Complainant's contentions.

6. Discussion and Findings

The registration agreement between Respondent and the Registrar subjects Respondent to dispute settlement under the Policy. The Policy requires that domain name registrants submit to a mandatory administrative proceeding conducted by an approved dispute resolution service provider, one of which is the Center, regarding allegations of abusive domain name registration and use (Policy, paragraph 4(a)).

It is essential to Policy proceedings that fundamental due process requirements be met. Such requirements include that a respondent have notice of proceedings that may substantially affect its rights. The Policy and the Rules establish procedures intended to ensure that respondents are given adequate notice of proceedings commenced against them and a reasonable opportunity to respond (see, e.g., Rules, paragraph 2(a)).

The Center formally notified the Complaint to Respondent at the email and physical address provided in its record of registration. Courier delivery of the Written Notice to Respondent could not be completed because of inaccurate address information in the record of registration. There is no indication that email transmission to the principal registrant email address provided by Respondent encountered difficulty. The Center took those steps prescribed by the Policy and the Rules to provide notice to Respondent, and those steps are presumed to satisfy notice requirements.

Paragraph 4(a) of the Policy sets forth three elements that must be established by a complainant to merit a finding that a respondent has engaged in abusive domain name registration and use and to obtain relief. These elements are that:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which complainant has rights;
- (ii) 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.

Each of the aforesaid three elements must be proved by a complainant to warrant relief.

A. Identical or Confusingly Similar

Complainant has provided evidence of rights in the trademark OPEN SOCIETY FOUNDATIONS, including by registration at the USPTO and through use in commerce. See Factual Background, *supra*. Respondent has not challenged Complainant's assertion of rights. The Panel determines that Complainant owns rights in the trademark OPEN SOCIETY FOUNDATIONS.

The disputed domain name directly and fully incorporates Complainant's trademark. Direct and full incorporation of Complainant's trademark in the disputed domain name is sufficient to establish identity within the meaning of the Policy. Addition of the generic top-level domain ("gTLD") "fund" to Complainant's

trademark does not prevent a finding of identity between the disputed domain name and Complainant's trademark. The disputed domain name is identical to Complainant's OPEN SOCIETY FOUNDATIONS trademark within the meaning of the Policy.

The Panel determines that Complainant has established rights in the trademark OPEN SOCIETY FOUNDATIONS trademark, and that the disputed domain name is identical to that trademark.

B. Rights or Legitimate Interests

Complainant's allegations to support Respondent's lack of rights or legitimate interests in the disputed domain name are outlined above in section 5.A, and the Panel finds that Complainant has made a *prima facie* showing that Respondent lacks rights or legitimate interests in the disputed domain name.

Respondent has not replied to the Complaint, and has not attempted to rebut Complainant's *prima facie* showing of lack of rights or legitimate interests.

The disputed domain name is parked by Respondent with a parking page maintained by the Registrar. Such parking page includes "related searches" terms that appear to facilitate searches of identified subject matter by clicking through on provided links. A disclaimer on the parking page indicates that these "sponsored listings" are serviced automatically by a third party, and that the owner of the disputed domain name does not maintain any relationship with the "advertisers". At least a substantial part of the listed subject matter is directly or indirectly related to types of activities pursued by Complainant.

Respondent's use of the Registrar parking page associated with the disputed domain name does not establish rights or legitimate interests in favor of Respondent. Assuming for the sake of argument that Respondent receives some compensation from activities associated with the parking page, Complainant has not authorized Respondent to use its trademark in connection with that activity that includes links to subject matter directly or indirectly related to activities carried out by Complainant. This is neither a *bona fide* offering of goods or services nor a fair use of Complainant's trademark.

If Respondent is not receiving compensation based on the parking page, its use of the disputed domain name nevertheless does not establish rights or legitimate interest because in practical effect Respondent is not using or preparing to use the disputed domain name for *bona fide* purpose.

There is no indication that Respondent was commonly known by the disputed domain name or Complainant's trademark.

Respondent's use of the disputed domain name does not otherwise manifest rights or legitimate interests.

The Panel determines that Complainant has established that Respondent lacks rights or legitimate interests in the disputed domain name.

C. Registered and Used in Bad Faith

In order to prevail under the Policy, Complainant must demonstrate that the disputed domain names "ha[ve] been registered and is being used in bad faith" (Policy, paragraph 4(a)(iii)). Paragraph 4(b) of the Policy states that "for the purposes of paragraph 4(a)(iii), the following circumstances, in particular but without limitation, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith". These include that, "(iii) [the respondent has] registered the domain name primarily for the purpose of disrupting the business of a competitor; or (iv) by using the domain name, [the respondent has] intentionally attempted to attract, for commercial gain, Internet users to [the respondent's] web site or other online location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of [the respondent's] web site or location or of a product or service on [the respondent's] web site or location".

Respondent registered and is using the disputed domain name more than a decade following Complainant's registration of its OPEN SOCIETY FOUNDATIONS trademark. Complainant's trademark is well known in connection with its philanthropic organization operating under that trademark. A routine Google or other search of Complainant's trademark predominantly returns results identifying Complainant. Respondent knew or should have known of Complainant's trademark when it registered and used the disputed domain name, which is identical to that trademark.

Respondent is using the disputed domain name in association with a Registrar parking page that includes search links relating directly or indirectly to the types of activities engaged in by Complainant. It is not clear whether such use provides compensation to Respondent. If it does, such use constitutes registration and use intentionally attempting for commercial gain to attract Internet users to Respondent's website or online location by creating a likelihood of confusion with respect to Complainant acting as source, sponsor, affiliate or endorser of Respondent's website.

If Respondent is not benefiting commercially from the parking page, it is nevertheless diverting potential visitors to Complainant's website to Respondent's website in a manner that is likely to cause confusion and interfere with Complainant's activities.

Respondent registered the disputed domain name with a transparently inaccurate physical address identifying a city and ZIP Code that do not exist.

Respondent has not provided a response to the Complaint and has not attempted to provide some justifiable basis for registering and using the disputed domain name incorporating Complainant's trademark, which Complainant did not authorize Respondent to do. The Panel will not speculate regarding what some justifiable basis might be. Complainant has argued there is no plausible legitimate use by Respondent of Complainant's trademark in the disputed domain name.

Risks associated with abuse of domain names incorporating well-known trademarks, such as use in email addresses confusingly similar to those of the trademark owner, and exploiting Internet users through those email addresses is substantial. Respondent has registered Complainant's well-known trademark in the disputed domain name with no apparent legitimate purpose. This creates an ongoing substantial risk for Complainant.

The Panel determines that Respondent registered and is using the disputed domain name in bad faith within the meaning of paragraph 4(b) of the Policy.

The Panel will direct the Registrar to transfer the disputed domain name to 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 <opensocietyfoundations.fund> be transferred to the Complainant.

/Frederick M. Abbott/

Frederick M. Abbott

Sole Panelist

Date: October 2, 2023