

## **ADMINISTRATIVE PANEL DECISION**

### **Equifax Inc. and Equifax Workforce Solutions LLC v. Domain Administrator Case No. D2023-3022**

#### **1. The Parties**

Complainant is Equifax Inc., United States of America (“United States”), and Equifax Workforce Solutions LLC, United States, represented by The GigaLaw Firm, Douglas M. Isenberg, Attorney at Law, LLC, United States.

Respondent is Domain Administrator, United States of America, represented by Lewis & Lin, LLC, United States.

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

The disputed domain name <worknumber.com> (the “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 July 14, 2023. On July 14, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On July 17, 2023, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Domain Name which differed from the named Respondent (Registration Private / Domains By Proxy, LLC) and contact information in the Complaint. The Center sent an email to Complainant on July 19, 2023 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 July 20, 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 Respondent of the Complaint, and the proceedings commenced on July 20, 2023. In accordance with the Rules, paragraph 5, the due date for Response was August 9, 2023. The Response was filed with the Center on August 9, 2023. While the Respondent had requested a three-member Panel, as the requisite fees were not received, the Center proceeded to appoint a single-member panel. The Parties requested a suspension of the proceedings on

August 14, 2023. On August 15, 2023, the Center sent the Notification of Suspension. On August 24, 2023, Complainant requested for the proceedings to be reinstated. The proceedings were reinstated as of August 24, 2023. On August 24, and September 6, 2023, Complainant submitted unsolicited supplemental filings. On August 25, September 5 and 6, 2023, Respondent submitted unsolicited supplemental filings. In its discretion, the Panel opted to consider both Parties' supplemental filings.

The Center appointed Robert A. Badgley as the sole panelist in this matter on September 11, 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.

On September 27, 2023, the Panel issued Procedural Order No. 1 seeking clarification from the Parties on certain points raised in their submissions. The Parties filed timely responses to Procedural Order No. 1 on October 6, 2023.

#### **4. Factual Background**

The Parties have raised numerous issues, but the Panel will address only those issues necessary to a disposition of this dispute under the UDRP. The Panel notes that the Parties have made competing arguments concerning the veracity of certain evidence – namely a particular screenshot of the relevant links appearing on the relevant website; ultimately, nothing turns on whether one party's version of events is correct given that they both agree that a separate screenshot represents links that appeared on the relevant website.

According to the Complaint, Complainant "is a leading global provider of information solutions and human resource business process outsourcing services for businesses, governments and consumers." Complainant's Workforce Solutions business unit provides "verification services" (described to include income verification, employment and educational history, and so forth) and "employment services" (described to include support for payroll and human resource management processes, employee screening, immigration case management, and so forth). The Workforce Solutions unit provides such services under the trademark THE WORK NUMBER.

Complainant holds registered trademarks in several jurisdictions (including United States, European Union, Canada, United Kingdom) for the mark THE WORK NUMBER. In the United States, Complainant holds Reg. No. 2,077,613, registered on July 8, 1997. Complainant also has owned the domain name <theworknumber.com> since November 1, 1996, and Complainant uses that domain name to host a website promoting its "employment and salary verification services."

The Domain Name was first registered on April 26, 1998. Respondent acquired the Domain Name from its prior owner on July 7, 2022. After this acquisition by Respondent, the Domain Name resolved to a parking page which featured pay-per-click ("PPC") hyperlinks, such as "Employment Verification Service", "Employer of Record Service", and "Income Data Validation".

As evidenced by the Respondent, after the Complaint in this proceeding was filed, the Domain Name resolved to a parking page featuring hyperlinks "Dedicated Server New York", "Dedicated Server North America", "Dedicated Server Europe", "Dedicated Server Asia".

According to Respondent, it acquired the Domain Name without knowledge of Complainant's mark and "because it contains the dictionary words 'work' and 'number' – not to target Complainant's trademark. Respondent asserts further that it acquired the Domain Name in 2022 under the assumption – based on court decisions from the United States Court of Appeals for the 9th Circuit – that the Domain Name was a form of "property" and that Respondent would be acquiring all prior "property rights" in the Domain Name that had been enjoyed by the prior owner, *i.e.*, going back to 1998.

It is undisputed that Respondent has been a respondent in at least five prior UDRP cases, in each of which Respondent was found to have registered and used the subject domain names in bad faith. The domain names included <allieduniversaljobs.com>, <biolemiux.com>, <tysonsfoodscareer.com>, <primestreamtv.com>, and <wwwcbsandyou.com>. Respondent notes that in those cases it did not file a response to the complaint and that “[i]t is not uncommon for domain name investors to buy and sell portfolios of domain names, and to acquire within them some problematic domain names, but the fact that some domain names may have been found to be problematic does not mean that every domain name acquired by Respondent is automatically a part of a bad faith scheme to profit off of trademarks”.

## 5. Parties’ Contentions

### A. Complainant

Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the Domain Name. With respect to Respondent’s argument that Respondent’s alleged rights in the Domain Name go back to 1998 (when the first owner registered it), Complainant argues that, regardless of case law in the 9th Circuit, the UDRP jurisprudence (as reflected in the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition [[“WIPO Overview 3.0”](#)], section 3.9) holds that “the transfer of a domain name from a third party to the respondent is not a renewal and the date on which the current registrant acquire the domain name is the date a panel will consider in assessing bad faith.” Accordingly, Complainant argues, whatever the prior owner did vis-à-vis the Domain Name is irrelevant to this proceeding; only what Respondent has done is germane to this proceeding.

### B. Respondent

Those assertions and arguments raised by Respondent which are considered potentially relevant to the Panel have been reflected above in the “Factual Background” section.

(The Panel notes that the Respondent as a corporation sits in the First Circuit whereas the Registrar sits in the Ninth Circuit; the Complainant has agreed to submit to the courts at the jurisdiction of the Registrar.)

### C. Response to Procedural Order No. 1

In their respective responses to the Panel’s Procedural Order No. 1, the Parties addressed, among other things, the issue of a respondent changing the PPC links after a UDRP complaint was filed. Respondent’s argument is best captured in the following paragraph:

“The pay per click (PPC) links with competitive ads that temporarily-appeared on Respondent’s website at <WorkNumber.com> corresponded with the descriptive meaning of the words and phrase “work number,” and did not refer to Complainant or any trademark holder. “Work number” is a common phrase for a type of number that can have a connotation separate and apart from Complainant’s trademark, which is “The Work Number” and appears together in usage with Complainant’s EQUIFAX® house mark, rather than as “work number” on its own. The temporarily-appearing PPC ads did not reference Complainant or its The Work Number trademark. Once it was brought to Respondent’s attention that the Complainant alleged trademark rights to the common phrase “work number,” it took steps to cure any claim of targeting by removing the PPC links to any perceived trademark-competitive ads by employing negative keywords.”

Complainant argued as follows (with boldface emphasis omitted):

“[I]t appears as if the Panel is seeking comments on the issue of whether Respondent’s decision to stop using the Disputed Domain Name in connection with PPC ads related to Complainant’s THE WORK NUMBER Trademark after the Complaint was filed can somehow create retroactive good faith. Complainant is aware of no such doctrine or any decisions under the Policy on this point.”

“On the contrary, the plain language of the Policy makes clear, in paragraph 4(b)(iii), that bad faith use of a

disputed domain name requires an analysis of how the domain name “*is being used*” (emphasis added) – not how the domain name may be used at a later date. Allowing a respondent to evade a finding of bad faith use by changing how it uses a domain name at a later date would simply allow every cybersquatter to avoid liability, completely undermining the Policy.”

“Numerous decisions under the Policy make clear that a respondent’s actions after a complaint has been filed are, at best, irrelevant to both paragraph 4(a)(ii) (rights or legitimate interests) and paragraph 4(a)(iii) (bad faith) – and, if anything, may emphasize that a respondent lacks rights or legitimate interests and has engaged in bad faith. See, e.g., *HemnetSverige AB v. Domain Admin, Private Registrations Aktien / <PrivacyProtect.org>*, WIPO Case No. [D2012-1787](#) (finding no rights or legitimate interests and finding bad faith where respondent “continued to use the disputed domain name but changed the sponsored links available on its website”); *B&H Foto & Electronics Corp. v. Avi Lang*, WIPO Case No. [D2016-0525](#) (“such change in use is merely pretextual and telling of the Respondent’s lack of rights or legitimate interest in the Disputed Domain Name” and “such change is only pretextual and telling of the Respondent’s initial intent to benefit from the Complainant’s goodwill in its trademark,” constituting bad faith); [additional citations omitted].”

## 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 THE WORK NUMBER through registration and use demonstrated in the record. The Panel also concludes that the Domain Name is confusingly similar to that mark. The omission of the word “the” does not prevent the mark from being easily recognizable within the Domain Name.

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.

First, the Panel must address the argument by Respondent that, according to case law in the Ninth Circuit of

the United States Court of Appeals, a domain name is a form of “property” and hence the “property rights” of a prior domain name owner (presumably including any goodwill associated with the domain name that was built up by the prior owner) are fully transferred to the new owner of the domain name. Whether Respondent accurately describes the law in the Ninth Circuit, and whether that jurisdiction’s law is reflective of a majority view on the issue (neither of which question the Panel needs to address), Respondent is simply incorrect in arguing that the perceived law of the Ninth Circuit prevails over the well-established rule in UDRP cases that, as Complainant points out, “the transfer of a domain name from a third party to the respondent is not a renewal and the date on which the current registrant acquire the domain name is the date a panel will consider in assessing bad faith.” [WIPO Overview 3.0](#), section 3.9.<sup>1</sup>

Having set aside the “property” issue, the Panel notes Respondent’s claim that it was unaware of Complainant’s THE WORK NUMBER when registering the Domain Name, and that it registered the Domain Name because it contained two common words. The Panel also notes Respondent’s argument that, under the UDRP, a respondent may legitimately use a domain name comprised of one or more common words, even if those words also reflect a trademark, as long as the associated website concerns those common words and does not target a trademark.

On the first point – Respondent’s denial of knowledge of Complainant’s mark – the Panel is not able to accept Respondent’s claim. First, although Respondent correctly notes that Complainant had not provided much evidence of the mark’s renown, Complainant’s registered mark had been in existence for 25 years when Respondent purchased the Domain Name.

Second, the use to which the Domain Name was put (before the website content changed after the Complaint in this proceeding was filed), *i.e.*, a parking page featuring hyperlinks closely associated with the services offered by Complainant under its THE WORK NUMBER mark (“Employment Verification Service”, “Employer of Record Service”, and “Income Data Validation”) raises doubt as to whether Respondent was not aware of Complainant’s mark.

Third, the fact that Respondent has been found to have engaged in cybersquatting in at least five other cases undermines the credibility of Respondent’s claim that it was unaware of Complainant’s mark.

Fourth, Respondent’s credibility is undermined by the fact that it is internally somewhat inconsistent in its

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<sup>1</sup> This common sense approach applied by UDRP panelists is reflected in a recent Fourth Circuit case involving a similar domain name transfer issue, in which the Court stated:

“Next, SSN contends that there can be no ACPA cybersquatting liability here because, according to SSN, cybersquatting cannot occur where the domain name has previously been registered. Specifically, SSN contends that, because an unaffiliated Texas company initially registered the PRU.COM domain name, SSN’s re-registration of the PRU.COM domain name in 2017 is not a qualifying “registration” within the meaning of the ACPA. In support of this claim, SSN cites *GoPets Ltd. v. Hise*, 657 F.3d 1024 (9th Cir. 2011), a Ninth Circuit case holding that a re-registration of an existing domain name is not a “registration” under the ACPA. The *GoPets* decision is not helpful to SSN. There, an individual (Hise) registered a specific website in his own name and then re-registered the website in the name of a company owned by him and his brother. See *id.* at 1027–28. On these facts, the Ninth Circuit sensibly concluded that Hise was not a cybersquatter, given the minor, nominal change in ownership. Hise effectively controlled the subject website both before and after the change in the registration, and that clearly was what mattered. See *id.* at 1030–31. The Ninth Circuit’s decision is inapposite and does not apply to this case, where, contrary to *GoPets*, the initial registrant (an unidentified Texas Company) sold the domain name to SSN, an unrelated party. Thus, *GoPets* is factually inapposite. Moreover, in direct contrast to *GoPets*, numerous courts have held that a “re-registration” is a “registration” within the meaning of the ACPA. As these cases illustrate, the Ninth Circuit’s decision in *GoPets* is contrary to the plain text and statutory purpose of the ACPA, as there is no basis to “read additional words into the statute such as initial or creation.” *Jysk Bed’N Linen v. Dutta-Roy*, 810 F.3d 767, 777 (11th Cir. 2015) (“We accordingly will not read additional words into the statute such as initial or creation. The plain meaning of register includes a re-registration.”). The underlying rationale for the Ninth Circuit’s decision—a public policy concern that innocent persons would be subject to ACPA liability for minor, periodic re-registrations of domain names—is best addressed through the bad faith intent to profit inquiry. Clearly, a person who simply re-registers a domain name due to a periodic re-registration requirement does not act with a bad faith intent to profit in doing so. Such a situation is quite different from the facts of this case, where an unrelated third party purchased the domain name.”

explanation of why it acquired the Domain Name. On the one hand (returning to the “property” argument), Respondent claims to have wanted to enjoy the property rights accrued by the prior registrant, while on the other hand, Respondent claims to have registered the Domain Name because it reflected the common terms “work” and “number.” Respondent made no attempt to reconcile these alternative professed motivations.

On the second point – Respondent’s claimed intention to use the Domain Name only in connection with the dictionary words of which it is comprised, and not to target Complainant’s trademark – the Panel is dubious. First, despite Respondent’s professed motivation, Respondent’s website did not, and still does not, deal with the common words “work” and “number.” Instead, the site featured hyperlinks closely associated with the services Complainant provides under its mark.

Second, and with reference to the five prior cases in which Respondent was found in bad faith, one of the domain names was <tysonsfoodscareer.com>. Given the fact that TYSON FOODS is a well-known mark, it is clear that Respondent was targeting a trademark in that case. See *Tyson Foods, Inc. v. Domain Administrator*, See <PrivacyGuardian.org> / *Site Matrix, LLC, Domain Administrator*, WIPO Case No. [D2018-2050](#). In addition, another of the five cases involved the famous trademark CBS. See *CBS Broadcasting Inc. v. Domain Administrator / Site Matrix, LLC*, Forum Claim No. 1874037.

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 incorporates its discussion above in the “Rights or Legitimate Interests” section. As discussed above, on this record, the Panel finds it more likely than not that Respondent targeted Complainant’s mark when registering the Domain Name in order to derive PPC revenue. With respect to Respondent’s alteration of the PPC links after the Complaint was filed, the Panel is sympathetic to the possibility that this could in some circumstances show lack of an intent to target Complainant but also observes that, if applied too reflexively, such post-complaint conduct could provide carte blanche for a respondent to wash its hands of previous conduct and this would undermine the purpose and logic of the UDRP. While a respondent’s conduct should be regarded anew in each case based on the facts at hand, there is no compelling reason here to depart from the general rule that post-complaint conduct does not allow a respondent to efface pre-complaint bad faith.

The Panel finds that the overall circumstances here fall within the meaning of the above-quoted Policy

paragraph 4(b)(iv).

The Panel also finds that Respondent is in bad faith within the meaning of the above-quoted Policy paragraph 4(b)(ii). As noted above, Respondent has been found to be a cybersquatter in five previous cases under the UDRP.

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 <worknumber.com> be transferred to Complainant.

*/Robert A. Badgley/*

**Robert A. Badgley**

Sole Panelist

Date: October 9, 2023