

ADMINISTRATIVE PANEL DECISION

Equifax Inc. v. DNS Admin, Buntai LTD

Case No. D2023-3447

1. The Parties

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

The Respondent is DNS Admin, Buntai LTD, Switzerland.

2. The Domain Name and Registrar

The disputed domain name <invoiceequifax.com> (“Disputed Domain Name”) is registered with Key-Systems GmbH (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on August 12, 2023. On August 14, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On August 16, 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) and contact information in the Complaint. The Center sent an email communication to the Complainant on August 16, 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 August 16, 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 August 18, 2023. In accordance with the Rules, paragraph 5, the due date for Response was September 7, 2023. The Respondent did not submit a formal Response, but sent an email communication to the Center on September 7, 2023, seeking a time extension of four calendar days to submit the Response pending potential settlement negotiations.

On September 11, 2023, the Center invited the Complainant to submit a request for suspension by September 18, 2023, if the parties wish to explore settlement options. The Complainant indicated it has not received the Respondent's email communication to the Center on September 7, 2023. The Respondent forwarded the said email communication to the Complainant on September 12, 2023. The Complainant did not submit a request for suspension by September 18, 2023. On September 21, 2023, the Center informed the parties that it will proceed to panel appointment.

The Center appointed Gabriela Kennedy as the sole panelist in this matter on October 5, 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 company incorporated under the laws of the State of Georgia, US in 1913. The Complainant provides information solutions, human resources business process outsourcing services, and credit reporting services for its customers worldwide. The Complainant owns word and figurative trademarks for or containing EQUIFAX (the "Complainant's Trademark") around the globe.

The relevant trademark registrations include, *inter alia*, US Trademark Registration No. 1027544 for EQUIFAX in Class 36 registered on December 16, 1975, US Trademark Registration No. 1045574 for EQUIFAX in Class 35 registered on August 3, 1976, and US Trademark Registration No. 1644585 for EQUIFAX in Classes 35, 36 and 42 registered on May 14, 1991. Apart from the above trademark registrations, the Panel notes that the Complainant also holds Switzerland Trademark Registration No. 390465 for EQUIFAX in Class 16 registered on March 11, 1992, where the Respondent is apparently located.

The Complainant's Trademark is also fully incorporated in the Complainant's domain name <equifax.com> which resolves to the Complainant's website at "www.equifax.com".

The Disputed Domain Name was registered on June 8, 2023. At the date of this decision, the Panel notes that the Disputed Domain Name resolves to an inactive webpage at "http://ww1.invoiceequifax.com/", with messages stating "can't reach this page" and the Disputed Domain Name's "server IP address could not be found". At the time of filing the Complaint, the Disputed Domain Name redirected to a website of one of the Complainant's competitors.

5. Parties' Contentions

A. Complainant

- (a) The Disputed Domain Name is identical or confusingly similar to the Complainant's Trademark. The Complainant's Trademark is reproduced in its entirety. Apart from the Complainant's Trademark, the remaining element in the Disputed Domain Name is the term "invoice", which does not prevent a finding of confusing similarity between the Disputed Domain Name and the Complainant's Trademark.
- (b) The Respondent has no rights or legitimate interests in the Disputed Domain Name. The Respondent has not obtained any authorization from the Complainant to use the Complainant's Trademark as part of a domain name or otherwise. The Respondent is not known by the Disputed Domain Name. Moreover, the Respondent demonstrated that as of August 11, 2023, the Disputed Domain Name was being used to redirect Internet traffic to a website for one of the Complainant's primary competitors (the "Complainant's competitor"). This does not constitute a *bona fide* offering of goods or services or legitimate or fair use of the Disputed Domain Name.

- (c) Both the Respondent's registration and use of the Disputed Domain Name establish the Respondent's bad faith. Given the history of the EQUIFAX brand and reputation that the Complainant has acquired in the Complainant's Trademark, and the fact that the Complainant has previously filed two UDRP domain name complaints against the Respondent, the Respondent must have been fully aware of the existence of the Complainant's rights in the Complainant's Trademark when the Respondent registered and/or used the Disputed Domain Name. The redirection of the Disputed Domain Name to a website for the Complainant's competitor also demonstrates the Respondent's bad faith. Moreover, the Respondent has been party to more than ten previous UDRP domain name disputes in the year of 2023 alone. Therefore, the Respondent has registered and used the Disputed Domain Name in bad faith.

B. Respondent

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

6. Discussion and Findings

Under paragraph 4(a) of the Policy, the Complainant is required to prove each of the following three elements:

- (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 by the Respondent in bad faith.

A. Identical or Confusingly Similar

The Panel accepts that the Complainant has rights in the Complainant's Trademark, based on its various trademark registrations such as those listed in Section 4.

The Disputed Domain Name incorporates the Complainant's Trademark in its entirety with the addition of the word "invoice". UDRP panels have consistently found that the addition of other terms to a mark (whether descriptive, geographical, pejorative, meaningless, or otherwise) will not prevent a finding of confusing similarity under the first element. See section 1.8 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"). The Panel therefore agrees with the Complainant that the additional word does not prevent a finding of confusing similarity between the Disputed Domain Name and the Complainant's Trademark.

Furthermore, it is well established that the generic Top-Level Domain ("gTLD"), ".com" in this case, may be disregarded. See section 1.11.1 of the [WIPO Overview 3.0](#).

As such, the Panel finds that the Disputed Domain Name is confusingly similar to the Complainant's Trademark, and accordingly, paragraph 4(a)(i) of the Policy is satisfied.

B. Rights or Legitimate Interests

The Panel accepts that the Complainant has not authorized the Respondent to use the Complainant's Trademark. There is no relationship between the Complainant and the Respondent, which would otherwise entitle the Respondent to use the Complainant's Trademark. Accordingly, the Panel is of the view that a *prima facie* case has been established by the Complainant and it is for the Respondent to show rights or legitimate interests in the Disputed Domain Name.

Once a complainant establishes a *prima facie* case in respect of the lack of rights or legitimate interests of a respondent in a disputed domain name, the respondent then carries the burden of demonstrating that it has rights or legitimate interests in the disputed domain name. Where the respondent fails to do so, a complainant is deemed to have satisfied paragraph 4(a)(ii) of the Policy. See section 2.1 of the [WIPO Overview 3.0](#).

The Respondent did not submit any Response either by the original deadline of September 7, 2023, or, as the Respondent requested, within four calendar days after the original deadline. The fact that the Respondent did not submit any Response does not automatically result in a decision in favor of the Complainant. However, the Respondent's failure to file a Response may result in the Panel drawing appropriate inferences from such default. The Panel may also accept all reasonable and supported allegations and inferences flowing from the Complainant as true (see *Entertainment Shopping AG v. Nischal Soni, Sonik Technologies*, WIPO Case No. [D2009-1437](#); and *Charles Jourdan Holding AG v. AAIM*, WIPO Case No. [D2000-0403](#)).

Pursuant to paragraph 4(c) of the Policy, the Respondent may establish rights or legitimate interests in the Disputed Domain Name by demonstrating any of the following:

- (i) before any notice to the Respondent of the dispute, the Respondent's use of, or demonstrable preparations to use the Disputed Domain Name or name corresponding to the Disputed Domain Name in connection with a *bona fide* offering of goods or services; or
- (ii) the Respondent has been commonly known by the Disputed Domain Name, even if the Respondent has acquired no trademark or service mark rights; or
- (iii) the Respondent is making a legitimate noncommercial or fair use of the Disputed Domain Name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

The Panel agrees with the Complainant that there is no evidence to show that the Respondent has trademark rights corresponding to the Disputed Domain Name, or that the Respondent has become known by the Disputed Domain Name.

There is no evidence to suggest that the Respondent's use of, or demonstrable preparations to use the Disputed Domain Name or name corresponding to the Disputed Domain Name, is in connection with a *bona fide* offering of goods or services or be regarded as legitimate noncommercial or fair use. The redirection of the Disputed Domain Name to a website for the Complainant's competitor suggests bad faith, which cannot be regarded as legitimate use.

Moreover, the composition of the Disputed Domain Name, which incorporates the Complainant's Trademark with the word "invoice" which is suggestive of the Complainant's credit report services, carries a risk of implied affiliation as it effectively impersonates or suggests sponsorship or endorsement by the Complainant. See section 2.5.1 of the [WIPO Overview 3.0](#).

Accordingly, the Panel finds that the Respondent has no rights or legitimate interests in the Disputed Domain Name and the Complainant has satisfied paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

The Disputed Domain Name incorporates the Complainant's Trademark preceded by the word "invoice". A quick Internet search conducted by the Panel shows that the top search results returned for the keyword "equifax" relate to the Complainant's services and/or third party websites providing information relating to the Complainant's services. More importantly, the Complainant has previously filed two domain name complaints against the Respondent, one of which was settled, and a transfer was ordered in the other (see *Equifax Inc. v. DNS Admin / Buntai LTD*, WIPO Case No. [D2023-2714](#)). Therefore, the Panel agrees with the Complainant that the Respondent must have been aware of the Complainant and its rights in the Complainant's Trademark when registering and using the Disputed Domain Name.

In addition, the Panel finds that the following factors support a finding that the Disputed Domain Name was registered and has been used by the Respondent in bad faith:

- (i) The Respondent's use of the Disputed Domain Name to redirect Internet traffic to a website for the Complainant's competitor supports a finding that the Respondent has registered the Disputed Domain Name to create a likelihood of confusion with the Complainant's Trademark for commercial gain. See section 3.1.4 of the [WIPO Overview 3.0](#).
- (ii) It is difficult to conceive of any plausible use of the Disputed Domain Name that would amount to good faith use, given that the Disputed Domain Name is confusingly similar to the Complainant's Trademark. Also, as discussed above, the Respondent lacks rights or legitimate interests in the Disputed Domain Name (see *Washington Mutual, Inc. v. Ashley Khong*, WIPO Case No. [D2005-0740](#)).
- (iii) The Respondent has a history of cybersquatting. In *Moderna, Inc. and ModernaTX, Inc. v. DNS Admin, Buntai LTD*, WIPO Case No. [D2023-0161](#), the panel found that the Respondent has "engaged in a bad faith pattern of cybersquatting". In 2023 alone, transfer was ordered against the Respondent in more than ten other UDRP proceedings, indicating the Respondent's pattern of bad faith. See section 3.1.2 of the [WIPO Overview 3.0](#).
- (iv) The Respondent failed to respond to the Complainant's contentions and has provided no evidence of its actual or contemplated good faith use of the Disputed Domain Name.

In the circumstances, the Panel finds that the Respondent registered and has been using the Disputed Domain Name in bad faith, and paragraph 4(a)(iii) of the Policy has been satisfied.

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 <invoiceequifax.com> be transferred to the Complainant.

/Gabriela Kennedy/

Gabriela Kennedy

Sole Panelist

Date: October 17, 2023