

ADMINISTRATIVE PANEL DECISION

Sitecore Corporation A/S v. Max Barrass
Case No. D2023-3992

1. The Parties

The Complainant is Sitecore Corporation A/S, Denmark, represented by Donahue Fitzgerald, United States of America (“United States”).

The Respondent is Max Barrass, Australia.

2. The Domain Name and Registrar

The disputed domain name <sitecore.design> 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 September 24, 2023. On September 25, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On September 25, 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 (Domains by Proxy, LLC) and contact information in the Complaint. The Center sent an email communication to the Complainant on September 26, 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 September 26, 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 October 2, 2023. In accordance with the Rules, paragraph 5, the due date for Response was October 22, 2023. The Respondent sent two informal emails to the Center on October 5, 2023.

The Center appointed Steven A. Maier as the sole panelist in this matter on October 27, 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 registered in Denmark. It is a customer experience management company, providing web content management and multichannel marketing automation software.

The Complainant is the owner of various registrations in multiple countries for trademarks comprising or including the mark SITECORE. Those registrations include, for example:

- European Union trademark registration number 003312758 for the word mark SITECORE, registered on April 28, 2005;
- United States trademark registration number 2954856 for a combined mark comprising the name SITECORE and a circular logo, registered on May 24, 2005; and
- Australia trademark registration number 1274024 for a figurative mark comprising the name SITECORE and a circular logo depicted in red (the "Figurative Trademark"), registered on November 25, 2008.

The Complainant operates a website at "www.sitecore.com", which it states it has used since the inception of its business in 2001.

The disputed domain name was registered on September 10, 2019.

The Complainant provides evidence that on September 6, 2023, the disputed domain name resolved to a website hosted by GitHub.com. The webpage was headed "Sitecore.Design" and prominently featured the Figurative Trademark. The Complainant submits that the website offered software derived from its own source code for download, although this is not apparent to the Panel from the material exhibited.

The Complainant exhibits "cease and desist" correspondence sent to the Respondent on May 22 and May 23, 2023, together with an email reply from the Respondent dated May 29, 2023, stating: "The domain is for sale for \$100,000 USD happy for your better offer."

5. Parties' Contentions

A. Complainant

The Complainant states that it has actively used the SITECORE trademark for over 20 years, and that the mark has become widely recognized as an identifier of the Complainant's products, including "Sitecore Experience Manager" and "Sitecore XConnect". It states that there are over 3,000 active SITECORE customers globally and that it works with 580 global development partners. The Complainant submits that it has spent millions of dollars on advertising and promoting its products under the SITECORE mark and exhibits media coverage concerning its business activities.

The Complainant submits that the disputed domain name is identical or confusingly similar to its SITECORE trademark.

The Complainant submits that the Respondent has no rights or legitimate interests in respect of the disputed domain name. It states that it has no relationship with the Respondent and has never authorized him to use its SITECORE trademark, that the Respondent has not commonly been known by the disputed domain name and that the Respondent is making neither *bona fide* commercial use nor legitimate noncommercial or fair use of the disputed domain name.

The Complainant submits that the disputed domain name was registered and is being used in bad faith. It contends that the Respondent was clearly aware of its SITECORE trademark when he registered the disputed domain name, and that he did so to misleadingly divert Internet users to his website for financial gain, and/or to sell the disputed domain name to the Complainant for an inflated sum.

The Complainant requests the transfer of the disputed domain name.

B. Respondent

The Respondent did not file a Response in the proceeding. In his informal emails to the Center, he stated:

“I have already responded to the original request to sell domain to the interested party and I have not heard back from them on it yet.

I have had the domain for more than 5 years now and it has not been an issue until now, so my offer still stands.

The domain is used as education purpose to help new users get started with sitecore. So this site is meant to help with spreading information and good ideas about Sitecore.

This site is providing a free service and supporting community through knowledge sharing.

We have a number of participants who have spent thousands of hours over the past 5 years sharing their knowledge and doing work to support the cause for free.”

6. Discussion and Findings

In order to succeed in the Complaint, the Complainant is required to show that all three of the elements set out under paragraph 4(a) of the Policy are present. Those elements are that:

- (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 Complainant has established that it is the owner of registered trademark rights in respect of the mark SITECORE. The disputed domain name is identical to that trademark, ignoring the Top-Level Domain (“TLD”) “.design”, which may typically be disregarded for the purpose of comparison under paragraph 4(a)(i) of the Policy. The Panel therefore finds that the disputed domain name is identical to a trademark in which the Complainant has rights.

B. Rights or Legitimate Interests

The Respondent submits that he has used the disputed domain name for free, educational purposes in connection with the Complainant’s software products. However, the Panel finds the disputed domain name to be inherently misleading, as inevitably suggesting to Internet users that it is owned or operated by, or otherwise affiliated with, the Complainant. This conclusion follows from the fact that the disputed domain name comprises the Complainant’s unadorned SITECORE trademark in full, together with the TLD “.design”, which does nothing to dispel the impression of an official connection with the Complainant. Furthermore, the website to which the disputed domain name has resolved prominently featured the Figurative Trademark.

The Respondent cannot establish rights or legitimate interests in circumstances where the disputed domain name is both inherently misleading and has been used deceptively, and he has provided no evidence that would support a finding of rights or legitimate interests in any event. The Panel therefore finds that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

C. Registered and Used in Bad Faith

It is clear from the Respondent's use of the disputed domain name that he was aware of both the Respondent's SITECORE trademark and the Figurative Trademark when he registered the disputed domain name, and that he registered the disputed domain name with an intention of calling the Complainant and its products to mind.

As observed above, the Panel finds the disputed domain name to be inherently misleading. It also finds that the website to which the disputed domain name has resolved (albeit its exact purpose is unclear) prominently features the Figurative Trademark and gives a false indication to Internet users of an affiliation between the disputed domain name and the Complainant. The Panel finds in these circumstances that the Respondent has used the disputed domain name in an attempt to divert Internet users to his website by misrepresenting a legitimate affiliation with the Complainant.

Furthermore, the Respondent has responded both to the Complainant's "cease and desist" correspondence, and to this proceeding, by reference to an offer to sell the disputed domain name to the Complainant for USD 100,000. Plainly this sum does not represent the Respondent's documented out-of-pocket costs directly related to the disputed domain name, nor does the Panel believe that there is any party other than the Complainant who could make legitimate use of the disputed domain name without impinging upon the Complainant's rights. The Panel infers in the circumstances that the Respondent registered the disputed domain name with the primary objective of selling it to the Complainant for an excessive price, in the circumstances contemplated by paragraph 4(b)(i) of the Policy.

The Panel therefore finds that the disputed domain name has been registered and is being used in bad faith.

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, <sitecore.design>, be transferred to the Complainant.

/Steven A. Maier/

Steven A. Maier

Sole Panelist

Date: November 7, 2023