

ADMINISTRATIVE PANEL DECISION

Outschool, Inc. v. 蒋黎 (leed johnny)

Case No. D2024-0969

1. The Parties

The Complainant is Outschool, Inc., United States of America (“USA”), represented by Messner Reeves LLP, USA.

The Respondent is 蒋黎 (leed johnny), China.

2. The Domain Name and Registrar

The disputed domain name <outschol.com> is registered with Alibaba Cloud Computing (Beijing) Co., Ltd. (the “Registrar”).

3. Procedural History

The Complaint was filed in English with the WIPO Arbitration and Mediation Center (the “Center”) on March 7, 2024. On March 8, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On March 11, 2024, 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 (OUTSCHOL.COM) and contact information in the Complaint. The Center sent an email communication to the Complainant on March 14, 2024, 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 17, 2024.

On March 14, 2024, the Center informed the parties in Chinese and English, that the language of the registration agreement for the disputed domain name is Chinese. On March 17, 2024, the Complainant requested English to be the language of the proceeding. The Respondent did not submit any comment on the Complainant’s submission.

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 28, 2024. In accordance with the Rules, paragraph

5, the due date for Response was April 17, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on April 18, 2024.

The Center appointed Deanna Wong Wai Man as the sole panelist in this matter on April 22, 2024. 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 May 13, 2024, the Panel issued the Procedural Order No. 1 (the "Procedural Order"), in which the Panel noted that the disputed domain name predates the registration dates of the trademarks adduced by the Complainant and that the Complainant did not address this in the Complaint, but limited itself to claiming that it has prior use rights, without substantiating this or providing any evidence thereof. In the Procedural Order, the Panel requested the Complainant to clarify and elaborate on the legal basis of the Complainant's claim to prior rights with supporting evidence, of any registered or unregistered trademarks rights/prior use rights it claims to have accrued before the registration date of the disputed domain name, by May 20, 2024. The Respondent was invited to submit its comments on such additional evidence by May 27, 2024. The Complainant submitted its response and evidence on May 20, 2024. The Respondent did not respond.

4. Factual Background

The Complainant is a company active in the educational sector, headquartered in the USA. The Complainant particularly offers an online marketplace of virtual classes on a variety of topics.

The Complainant provides evidence that it owns an international trademark portfolio for the trademark OUTSCHOOL, including but not limited to the USA trademark registration No. 5,816,699 registered on July 30, 2019 and International Trademark Registration No. 1501048 registered on October 16, 2019, designating jurisdictions including China and the European Union. The Complainant also has a strong online presence and also owns a portfolio of official domain names incorporating its OUTSCHOOL mark, including <outschool.com>.

The disputed domain name was registered on September 11, 2018, and is therefore of an earlier date than the abovementioned registered trademarks of the Complainant, as set out in the Procedural Order. In response to the Procedural Order, the Complainant then submitted evidence showing that it has been using its OUTSCHOOL marks since April 29, 2015 and therefore supporting its claim to a prior unregistered trademark. The Complainant also submits evidence that the disputed domain name directs to an active landing website which contains what are purported to be pay-per-click links to third party online education websites (also containing a privacy policy pop-up window).

5. Parties' Contentions

A. Complainant

The Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the disputed domain name.

Notably, the Complainant contends the disputed domain name is confusingly similar to its trademark for OUTSCHOOL, since it is nearly identical to it, omitting only one letter "o", which, it claims, constitutes an intentional misspelling of this trademark. The Complainant argues that its trademark OUTSCHOOL is well-known, intensely used and famous and contends that the Respondent is not a licensee of the Complainant nor is the Respondent otherwise authorized to use the Complainant's OUTSCHOOL mark for any purpose.

The Complainant also argues that it has not given the Respondent permission to use the mark and that the Respondent is not commonly known under the disputed domain name. Furthermore, the Complainant

argues that the Respondent has registered the disputed domain name to display spam links that purport to offer goods and services identical to Complainant's, which, the Complainant argues, would indicate intentional cybersquatting and spam. The Complainant also contends that the Respondent knowingly registered the disputed domain name containing a near exact reproduction (and intentional misspelling) of the well-known OUTSCHOOL mark to capitalize on consumer recognition of the OUTSCHOOL mark and its association with the categories of goods/services listed on the website at the disputed domain name. The Complainant essentially argues that in the above circumstances, the Respondent has no legitimate rights or interests in the disputed domain name and the registration and use of the disputed domain name are made in bad faith.

The Complainant requests the transfer of the disputed domain name.

B. Respondent

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

6. Discussion and Findings

6.1 Preliminary Issue: Language of the Proceeding

The language of the Registration Agreement for the disputed domain name is Chinese. Pursuant to the Rules, paragraph 11(a), in the absence of an agreement between the parties, or unless specified otherwise in the registration agreement, the language of the administrative proceeding shall be the language of the registration agreement.

The Complaint was filed in English. The Complainant requested that the language of the proceeding be English for several reasons, including the fact that the disputed domain name is entirely in English script and that the website hosted at the disputed domain name comprises English words such as "Online Classes", "Online Training Course", and "Online Schools"; the fact that the Respondent, has previously subjected itself to, and has been involved in numerous UDRP proceedings that were conducted in English; the fact that the Respondent's name and email address are in English; the allegation that an order for a translation of the Complaint will result in unnecessary additional expenses for the Complainant and unnecessarily delay these proceedings and the allegation that earlier WIPO panels have found in previous decisions against the Respondent that the Respondent has engaged in a pattern of abusive practices.

The Respondent did not make any specific submissions with respect to the language of the proceeding.

In exercising its discretion to use a language other than that of the registration agreement, the Panel has to exercise such discretion judicially in the spirit of fairness and justice to both parties, taking into account all relevant circumstances of the case, including matters such as the parties' ability to understand and use the proposed language, time and costs (see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 4.5.1).

Having considered all the matters above, the Panel determines under paragraph 11(a) of the Rules that the language of the proceeding shall be English.

6.2 Substantive Issues

A. Identical or Confusingly Similar

It is well accepted that the first element functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the Complainant's trademark and the disputed domain name. [WIPO Overview 3.0](#), section 1.7.

Based on the evidence submitted, the Panel finds the Complainant has shown rights in respect of a trademark or service mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1. The Panel notes that the registered trademarks proven by the Complainant do not predate the registration date of the disputed domain name, but this is not a prerequisite under the first element of the Policy.

The Panel finds the entirety of the mark is reproduced within the disputed domain name, be it with the omission of one letter “o”, which, however, does not alter in any way the overall impression of the disputed domain name or its general perception in terms of pronunciation, meaning or concept. Accordingly, the disputed domain name is confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

Based on the available record, the Panel finds the first element of the Policy has been established.

B. Rights or Legitimate Interests

As to the second and third elements of the Policy, the Panel shall first determine the extent to which Complainant can be considered to own trademark rights in the OUTSCHOOL mark which predate the registration of the disputed domain name, as claimed by the Complainant, since this has a clear impact on the outcome of the Panel’s assessment under the second and third elements.

In the Complaint and in the Complainant’s response to the Procedural Order, the Complainant argues that it has been using its OUTSCHOOL marks since April 29, 2015. The Complainant substantiates these claims mainly with a dated printout of its website (used as a specimen of use for its USA trademark application) and with a number of third-party media articles about the Complainant and its activities, all predating the registration date of the disputed domain name. The Complainant also argues that the filing date of its USA trademark for OUTSCHOOL, namely on January 18, 2018 or nearly 9 months before the registration date of the disputed domain name, would mean it “clearly had rights prior to Respondent registering the disputed domain name on September 11, 2018”. The Panel disagrees with this latter broad general contention. Until a trade mark has been registered formally, the Panel must consider trademark applications that have not yet been granted as merely unregistered trademarks.

Regarding the establishment of unregistered trademark rights, the [WIPO Overview 3.0](#), section 1.3 states in this regard “to establish unregistered or common law trademark rights for purposes of the UDRP, the complainant must show that its mark has become a distinctive identifier which consumers associate with the complainant’s goods and/or services. Relevant evidence demonstrating such acquired distinctiveness (also referred to as secondary meaning) includes a range of factors such as (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 this case, the Panel notes that following the Procedural Order, the Complainant provided a range of circumstantial evidence as to the Complainant’s actual commercial use of its trademarks prior to the registration date of the disputed domain name. On that basis – and also noting the earlier timing of the relevant trademark application, the Panel is prepared to recognize that on the registration date of the disputed domain name it would be public information that the Complainant was providing commercial services to the public under the trade name OUTSCHOOL. Furthermore, the Panel also notes that based on the actual use of the disputed domain name by the Respondent in this case, the Respondent seems to have been targeting the Complainant’s unregistered mark for OUTSCHOOL with the registration of the disputed domain name, which supports the Complainant’s assertion that its mark had already achieved significance as a source identifier at that point, see [WIPO Overview 3.0](#), section 1.3. Therefore, on the balance of probabilities, the Panel accepts that the Complainant’s rights in the mark for OUTSCHOOL predate the registration of the disputed domain name by the Respondent.

As to whether the Respondent has any rights or legitimate interests in the disputed domain name, paragraph 4(c) of the Policy provides a list of circumstances in which the Respondent may demonstrate rights or legitimate interests in a disputed domain name.

Although the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the difficult task of “proving a negative”, requiring information that is often primarily within the knowledge or control of the respondent. As such, where a complainant makes out a prima facie case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name (although the burden of proof always remains on the complainant). If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element. [WIPO Overview 3.0](#), section 2.1.

Having reviewed the available record, the Panel finds the Complainant has established a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain name. The Respondent has not rebutted the Complainant’s prima facie showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the disputed domain name such as those enumerated in the Policy or otherwise.

Moreover, upon review of the facts and evidence submitted, the Panel notes that the disputed domain name directs to an active landing website which contains what are purported to be pay-per-click links to third party online education websites (also containing a privacy policy pop-up window). The Panel also notes that there are no elements in this case that point to the Respondent having made any reasonable and demonstrable preparations to use the disputed domain name in connection with a bona fide offering of goods or services. In the Panel’s view, these elements show that the Respondent’s intention was not to make any use of the disputed domain name as a bona fide provider of goods or services, or to make legitimate noncommercial use or fair use of the disputed domain name. Instead, it shows the Respondent’s clear intention to mislead and divert Internet users for commercial gain to this parking webpage offering pay-per-click links by taking unfair advantage of the goodwill and reputation of the Complainant’s trademarks for OUTSCHOOL, see also [WIPO Overview 3.0](#), section 2.9.

Based on the available record, the Panel finds the second element of the Policy has been established.

C. Registered and Used in Bad Faith

The Panel notes that, for the purposes of paragraph 4(a)(iii) of the Policy, paragraph 4(b) of the Policy establishes circumstances, in particular, but without limitation, that, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith.

In the present case, the Panel notes that the Respondent has registered a domain name which is confusingly similar to the Complainant’s trademarks, including an intentional spelling mistake or typo (also known as “typosquatting”). Given the existence of the Complainant’s prior unregistered trademarks for OUTSCHOOL and their public use (including on the Internet and in third party media publications as proven by the Complainant), the Panel considers that the Respondent has intentionally and opportunistically targeted the Complainant’s trademark by registering a typosquatted version of the Complainant’s official domain name. The Panel deducts from these efforts to consciously target the Complainant’s prior registered trademarks that the Respondent knew of the existence of the Complainant’s trademarks at the time of registering the disputed domain name – there really is no other reason to explain the registration of a typo domain of the mark of another. In the Panel’s view, these elements clearly indicate bad faith on the part of the Respondent, and the Panel therefore finds that it has been demonstrated that the Respondent registered the disputed domain name in bad faith.

Paragraph 4(b) of the Policy sets out a list of non-exhaustive circumstances that may indicate that a domain name was registered and used in bad faith, but other circumstances may be relevant in assessing whether a respondent’s registration and use of a domain name is in bad faith. [WIPO Overview 3.0](#), section 3.2.1.

Particularly, the Complainant provides evidence that the disputed domain name directs to an active landing website which contains what are purported to be pay-per-click links to third party online education websites (also containing a privacy policy pop-up window). The Panel concludes that such use constitutes an intentional attempt to attract, for commercial gain, Internet users to the Respondent's website by creating a likelihood of confusion with the Complainant's marks as to the source, affiliation, or endorsement of the disputed domain name. This constitutes direct evidence of the Respondent's bad faith under paragraph 4(b)(iv) of the Policy. Finally, the Panel also finds that the Respondent has been engaged in a pattern of trademark-abusive domain name registrations. In this regard, the Panel refers to the Complainant's evidence from which it is clear that the Respondent has been involved as a respondent in a number of previous similar UDRP cases in which the respective panels concluded that the Respondent had registered and used the respective domain names in bad faith, see for instance *Take-Two Interactive Software, Inc. v. johnny, leed johnny*, WIPO Case No. [D2020-1200](#). The preceding elements lead the Panel to conclude that the Respondent has used, and is using the disputed domain name in bad faith.

Based on the available record, the Panel finds that the Complainant has established the third element 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 <outschol.com> be transferred to the Complainant.

/Deanna Wong Wai Man/

Deanna Wong Wai Man

Sole Panelist

Date: June 3, 2024