

ADMINISTRATIVE PANEL DECISION

Xero Limited v. MD Noyon ALI, HostSeba / Tahmina Yeasmin Chowdhury,
Xero Experts

Case No. D2024-3886

1. The Parties

The Complainant is Xero Limited, New Zealand, represented by Hudson Gavin Martin, New Zealand.

The Respondents are MD Noyon ALI, HostSeba, Bangladesh / Tahmina Yeasmin Chowdhury, Xero Experts, Bangladesh, represented by Old Bailey Chambers, Bangladesh.

2. The Domain Name and Registrar

The disputed domain name <xero-experts.com> is registered with Cosmotown, Inc. (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on September 24, 2024. On September 24, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On September 26, 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 (AN INDIVIDUAL/ORGANISATION OF UNKNOWN IDENTITY) and contact information in the Complaint. The Center sent an email communication to the Complainant on September 27, 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 October 1, 2024.

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 4, 2024. In accordance with the Rules, paragraph 5, the due date for Response was October 24, 2024. On October 22, 2024, the Respondent requested an extension of four calendar days for submitting the Response. The Response was filed with the Center on October 28, 2024.

The Center appointed W. Scott Blackmer as the sole panelist in this matter on November 7, 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.

4. Factual Background

The Complainant was incorporated in New Zealand as Accounting 2.0 Limited on July 6, 2006, producing accounting software for small businesses. The company changed its name to Xero Live Limited in November 2006 and then changed its name to Xero Limited on April 30, 2008. Headquartered in Wellington, New Zealand, the Complainant was listed on the New Zealand Stock Exchange in 2007 and the Australian Stock Exchange in 2012. Forbes characterized the Complainant as the “World’s Most Innovative Growth Company” in 2014 and 2015.

In the fiscal year ending March 31, 2020, the period in which the disputed domain name was registered, the Complainant earned operating revenues of more than NZD 718 million, a 30 percent increase over the prior fiscal year. At that time (March 2020), the Complainant’s XERO-branded services were being used by over 1.28 million paying subscribers worldwide, serviced from offices in New Zealand, Australia, Singapore, United Kingdom, United States of America (“United States”), and Canada. In May 2020, IDC MarketScape identified the Complainant as a “global leader” and “top tool” in the field of SaaS (software as a service) and cloud-enabled small business finance and accounting applications.

The Complainant’s cloud-based service offerings include features such as paying bills, claiming expenses, connecting to bank accounts, accepting payments, tracking projects, administering payroll, managing inventory, producing accounting reports, and sending invoices. These services are advertised and facilitated through the Complainant’s website at “www.xero.com”, a domain name acquired by the Complainant in 2006. The Complainant has other XERO-based domain names that are used for websites or redirect to its principal website, such as <xeroaccounting.com> and <xeropayments.us>. The Complainant advertises its services as well on several social media platforms and in other channels. The Complainant’s principal website received more than 50 million visits in the year ending February 5, 2020.

The Complainant has relevant trademark registrations including the following:

Mark	Jurisdiction	Registration Number	Registration Date	Goods or Services
XERO (word)	Australia	1145998	November 10, 2006	International classes 9, 16, 35, 36, 38, 41, and 42;
XERO (word)	United States	3850387	September 21, 2010	International classes 36 and 42;
XERO (word)	New Zealand	758103	May 2, 2007	(Same as above for Australia)
XERO (word)	United Kingdom	UK00905867361	March 12, 2008	International classes 9, 36, and 38.

The Registrar reports that the disputed domain name was created on February 5, 2020, and is registered to the Respondent MD Noyon ALI, HostSeba, listing a postal address in Bangladesh and a Gmail contact email address. After sending notice of the Complaint in this proceeding, the Center received an email characterizing this first Respondent as “resellers” and providing “the actual contact information” of the second Respondent, Tahmina Yeasmin Chowdhury of Bangladesh. The Response was then filed by legal counsel on behalf of Xero Experts, “an independent business registered in Bangladesh, represented by its Proprietor, Tahmina Yeasmin Chowdhury”. The Response refers to Ms. Chowdhury as the “beneficial owner” of the disputed domain name. Given that the first named Respondent is the registrant of record, but

Ms. Chowdhury and her business Xero Experts are evidently the real parties in interest, and their apparent direction connection to the first named Respondent, the Panel refers to all of these persons collectively as the "Respondent". The Panel accepts the Response as representing their common position in the absence of any other response submitted in the proceeding.

The disputed domain name resolves to a website (the "Respondent's website") headed "XERO EXPERTS", with the tagline, "Xero Accounting, Migration, APP Integration & Automation Specialist". The website describes XERO online accounting features and repeats the Complainant's mark in multiple places (without a trademark symbol), including an identical figurative trademark of the Complainant, but does not link to the Complainant's website or include a disclaimer or explanation of the Respondent's relationship with the Complainant. The Respondent's website touts "award-winning Xero trainers and consultants" but does not identify them or the website operator. There is a contact page with a web contact form, as well as postal addresses and telephone numbers in the United Kingdom and Bangladesh. Prices for services are quoted in pounds sterling. There is no copyright notice or company information about "Xero Experts", and Ms. Chowdhury's name does not appear on the website.

The Complainant states that in May 2020, shortly after registering the disputed domain name, the Respondent joined the Complainant's partnership program, which is open to accountants and bookkeepers and entails a free subscription to the Complainant's products and access to support and training resources. The Respondent agreed to the Complainant's Partner Agreement, attached to the Complaint, which requires adherence to the Complainant's Brand Guidelines, both as updated "from time to time" at the Complainant's discretion. In May 2020, these prohibited the partner from using the XERO name or logo in the partner's "business name, product name, service offering, URL, or any social media accounts". As updated, the current version of the Partner Agreement says that partners must "adhere to the Xero Partner Brand Guidelines, including not using or registering XERO as part of [its] trade marks, company names, business names or domain names". The Complainant provides "badges" instead to signify partner status at different levels, establishing a standardized system of training and certification to aid consumers in choosing service providers. The Brand Guidelines restrict partners to using the XERO mark only as part of the partner status badge. Such partnership information and badge status does not appear on the Respondent's website.

The Complainant's legal representative sent the Respondent Xero Experts a cease-and-desist letter by email dated June 26, 2024, reminding the Respondent of its status as a "Xero gold partner" and stating that the Respondent had registered and used the disputed domain name in breach of the Partnership Agreement and warranted enforcement for trademark infringement and violation of the UDRP. The letter demanded transfer of the disputed domain name. The Respondent declined, and this proceeding followed.

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 that the disputed domain name is confusingly similar to its XERO mark, incorporating the distinctive mark in its entirety. The Complainant asserts that the Respondent has no permission to use the mark and no legitimate interests because it is in violation of the terms of the Partnership Agreement prohibiting use of the mark in domain names and does not include the required badges, a disclaimer, or otherwise accurately disclose its relationship with the Complainant on the website associated with the disputed domain name. Moreover, the Respondent enhances the implied sponsorship of the Complainant by displaying the Complainant's blue-and-white, circular XERO logo in many places on the Respondent's website.

The Complainant urges a finding of bad faith on the ground that the Respondent has intentionally attempted to attract Internet users to its site for commercial gain by falsely suggesting sponsorship or affiliation with a

confusingly similar domain name, reinforced by the misleading display of the Complainant's logo on the Respondent's website without an accurate identification of the Respondent and its partner status. There was no commercial agreement with the Complainant when the Respondent registered the disputed domain name, so the implied association was misleading from the start, and after the Respondent entered in to the Partnership Agreement, the Respondent violated its terms, thus reflecting bad faith in the use of the disputed domain name.

B. Respondent

The Respondent contends that the Complainant has not satisfied all three of the elements required under the Policy for a transfer of the disputed domain name. The Respondent first argues that "xero" is a dictionary word that could not be protected under trademark law in Bangladesh and is not in fact registered as a trademark in Bangladesh. The Respondent argues that there is no confusing similarity with the disputed domain name in any event, because the addition of the term "experts" suggests a third-party consultancy and the Respondent's website "expressly" identifies Xero Experts as an "independent provider of third-party services". (The Panel does not find that phrase on the Respondent's website, although a page on "Outsourced Accounting Service for Accounting Firms" includes a reference to the Respondent as "one of the top Xero accounting firms in the UK").

The Respondent claims it has been using the disputed domain name to make a bona fide offering of services, with a corresponding business name that is legally registered in Bangladesh, and that it is widely known under this name.

The Respondent denies bad faith, contending that it does not imply affiliation with the Complainant as the name "experts" suggests a third party and the website content supports that understanding.

6. Discussion and Findings

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 of WIPO Panel Views on Selected UDRP Questions, Third Edition (["WIPO Overview 3.0"](#)), section 1.7.

The Complainant has shown rights in respect of a trademark or service mark (XERO) for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1. The Policy does not require that the mark be registered in the Respondent's country of residence.

The entirety of the mark is reproduced within the disputed domain name. Accordingly, the disputed domain name is confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

Although the addition of other terms (here, the term "experts") may bear on assessment of the second and third elements, the Panel finds the addition of such a term does not prevent a finding of confusing similarity between the disputed domain name and the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

The Panel finds the first element of the Policy has been established.

B. Rights or Legitimate Interests

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.

The Respondent claims a legitimate interest in the disputed domain name for a bona fide business, with a corresponding name by which it is known. The trade license for Xero Experts shows a business starting date of July 1, 2022, months after the domain name registration, and the Respondent has not submitted evidence of sales, advertising, industry, or media recognition to support the claim of being “commonly known” by a corresponding name.

In any event, the use of the disputed domain name confusingly similar to the Complainant’s trademark could not be deemed to be in connection with a “bona fide” commercial offering if it targeted the mark and was not justified as a legitimate fair use, such as nominative fair use by a service provider. [WIPO Overview 3.0](#), section 2.8 summarizes the consensus view on how service providers may establish fair use in that sense, with reference to the leading case of *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#). The Respondent does not meet one of the Oki Data criteria, which requires accurate disclosure of the Respondent’s relationship with the trademark holder. The Respondent’s website repeatedly displays the Complainant’s mark and logo and describes the Complainant’s products, but it does not have a clear and prominent disclosure of the Respondent’s relationship with the Complainant; rather it suggests the disputed domain name is operated by, or at least closely associated with, the Complainant, which is not the case. This is inherently problematic for consumers and threatens the Complainant’s reputation if there are issues with products or services. Further, as the [WIPO Overview 3.0](#) emphasizes, “The Oki Data test does not apply where any prior agreement, express or otherwise, between the parties expressly prohibits (or allows) the registration or use of domain names incorporating the complainant’s trademark.” In that event, the agreement prevails, and there is such an agreement here, which expressly prohibits the Respondent from using the XERO mark in a domain name or displaying it on a website other than as part of the Complainant’s partnership badge program. Thus, before the Respondent joined the partnership program, it had no legitimate interest in registering and using the disputed domain name without disclosing its (lack of) a relationship with the Complainant, under the Oki Data test, and after the Respondent signed the Partnership Agreement, it could no longer claim a legitimate interest in using the disputed domain name in violation of the terms of that agreement.

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 was clearly aware of the Complainant and its mark, building a website and a business around a XERO consultancy. The mark is entirely incorporated in the disputed domain name and the addition of the term “experts”, while it may suggest a third party, is ambiguous and could also suggest a site sponsored by the Complainant, which indeed trains and certifies experts and administers an international, multi-level partnership program in which the Respondent participates. Thus, the confusingly similar disputed domain name must be viewed as an attempt to misdirect Internet users for commercial gain, as described in the Policy, paragraph 4(b)(iv). The Respondent has failed to establish grounds for legitimate, nominative fair use as a reseller, as detailed in the preceding section, which otherwise could have offered an alternative, legitimate motive.

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. The Respondent’s violation of the Partnership Agreement, apparently from the outset and also after a warning letter from the Complainant, further supports the inference of bad faith, as does the fact that the Respondent’s website obscures the identity of the website operator as well as its relationship with the Complainant. It is telling that the Response does not address the Partnership Agreement and its clear restrictions on using the Complainant’s marks.

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 <xero-experts.com> be transferred to the Complainant.

/W. Scott Blackmer/

W. Scott Blackmer

Sole Panelist

Date: November 22, 2024