

ADMINISTRATIVE PANEL DECISION

Get ODK Inc. v. Privacy Protection / Nasir Rashid
Case No. D2022-1203

1. The Parties

The Complainant is Get ODK Inc., United States of America (“United States”), represented by John Berryhill, Ph.d., Esq., United States.

The Respondent is Privacy Protection, United States / Nasir Rashid, United Kingdom.

2. The Domain Name and Registrar

The disputed domain name <odkcentral.com> is registered with Sav.com, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on April 6, 2022. On April 6, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On April 6, 2022, 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 and contact information in the Complaint. The Center sent an email communication to the Complainant on April 9, 2022 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 amended Complaint on April 11, 2022.

The Center verified that the Complaint together with the amended 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 April 12, 2022. In accordance with the Rules, paragraph 5, the due date for Response was May 2, 2022. The Response was filed with the Center on April 29, 2022. The Complainant submitted a supplemental filing on May 4, 2022.

The Center appointed Warwick A. Rothnie as the sole panelist in this matter on May 9, 2022. 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 provider of open-source software, in particular a software package known as ODK.

ODK is a set of tools for distributed data capture especially the development of form-based applications for use on mobile devices. The ODK software is used to build forms to collect text and numbers, GPS traces, scan barcodes, and can play video. The ODK software can be used to create web forms and submissions which can be synchronized when connections are available or restored. A particular feature is the ability to use it, or applications developed with it, to collect data in environments where there is no or limited network access for later synchronization upon return to base or when network access is restored.

The ODK software package includes a number of components. These include a server application, ODK Central; ODK Build, a drag and drop form designer; a data collection client, ODK Collect, an Android app for filling out forms; ODK Briefcase, a Java application for fetching and pushing forms; and ODK Cloud, which is the Complainant's official managed hosting service, a paid service.

The Complainant makes its software available from the website at "www.getodk.org".

The software tools were originally developed and released by the Complainant's predecessor some 13 years ago under the name Open Data Kit. A second fork or variant also developed and in July 2020, a memorandum of understanding was reached with the team developing the second fork to rationalise the branding whereby it was agreed that the Complainant's version would be identified as ODK and the other team's version would be identified as ODK-X.

The first public beta of ODK Central was announced to the community in September 2018. The first non-beta version was released on August 3, 2020

According to the Complaint, the Complainant's software has been used under the name ODK by aid and government organisations in disaster relief operations including most recently in Poland to process refugees from the Ukrainian conflict. According to information published by the American Red Cross, the Complainant's ODK software had some 2,500,000 users in the last year and was being used by the Red Cross Red Crescent network on some 12,000 devices in Southern Asia, and East and West Africa. The World Health Organisation has been using the ODK software since 2015 in the development and testing of its malaria vaccine, the official launch of which was announced on October 5, 2021.

In October 2020, the United States Centers for Disease Control and Prevention (the CDC) included the ODK software in its Guide to Global Digital tools for COVID-19 Response. In addition to the use of the software in the World Health Organization's malaria trial, the CDC's guide reported that 85,000 teachers in Honduras were using the ODK software to monitor and report on the progress of some 1.8 millions students. Seventy thousand enumerators were using the ODK software in Nigeria in food supply chains. Other applications were reported in Somalia, South Sudan, Niger, Kenya, the Philippines, Zimbabwe, Burundi, and Rwanda.

The software is open-source software but made available on terms that require users to comply with Branding Guidelines. The Branding Guidelines include terms that:

"Domain names, websites, and social media: Proper use of our Marks on websites to name or accurately describe ODK's products, services or technology is permitted. The use of our Marks should not be misleading or likely to cause confusion as to whether the web site is affiliated with ODK or whether the products, services or technology are offered by ODK. ODK reserves the right to request you to remove our mark from your domain name, web site, account name, or publication if we deem its use to be inappropriate.

- Individuals or organizations must not use a “odk” or “getodk” top-level domain. Any principal or secondary level domain name, with or without commercial intent, should not be identical to or virtually identical to any of our Marks.

- Individuals or organizations should not use “*odk*” or “*getodk*” in their domain names. Do not register any domain name containing our Marks and do not claim any trademark or similar proprietary rights in the domain name. For example, “ODKtech.com”, “ODK-group.com”, or “GetODKNow.com” are not allowed without asking for permission.

- Non-commercial projects may use “odk” or “getodk” in their domain names, but should ask for permission before registering the domain. ODK may register the domain and point it to the name servers provided by the requester or instruct the requester to do so.

[...]”

There are also a range of prohibited uses including use of the ODK Marks in any way that suggests an affiliation with or endorsement by ODK if it is not true.

According to the Response, the Respondent registered the disputed domain name on August 22, 2021. Until recently, it resolved to an active website. Shortly before the Complaint was filed, the website featured prominently on the top left of the landing page a “logo” – ODK Central Managed Services (in which the words “Managed Services” are in much smaller type than “ODK CENTRAL”). The introductory paragraph on the landing page stated:

“Accelerated ODK solution to get started

With years of experience in data collection and managing ODK our expert system engineers are ready to provide you managed ODK central services on our managed Cloud or other providers like google [sic] Cloud, AWS, Digital Ocean etc.”

Other sections included prominent headings “ODK Central – Collect Data”, “ODK Central – Cloud Deployed The quickest way to start” and “Why ODK Central Nextgen cloud services.”

In the footer of the page, there is a copyright notice “Copyright © 2022 ODK Central (Managed Services). All Rights Reserved.” At the very bottom of the page there was a statement in small type “A company by Nextgen Global Ltd UK”.

According to the Complaint, the Respondent’s registration of the disputed domain name and the associated website came to the Complainant’s attention when contacted by a customer who had mistakenly sought to subscribe to the Respondent’s services in the belief it was dealing with the Complainant. At that time, the Respondent appeared to be offering to provide “Standard” service for USD 95 per month, “Professional” service for USD 249 per month, and “Custom” service on application.

The Complainant first lodged a DMCA notice which led to some changes to the website. There was also correspondence between the Respondent, an associated director of the NextGen company and the Complainant in November and December 2021 into January 2022.

At the outset of the correspondence, the Complainant asked the Respondent if there was “a demo” of the Respondent’s services as the link on the website was not working. The Respondent’s reply acknowledged that the website was not fully functional as it was still under development.

At the point where the Complainant pointed out that the disputed domain name itself was misleading and in breach of the Branding Guidelines, the Respondent’s representative rejected the Complainant’s proposal to transfer the disputed domain name for out of pocket costs and a small premium:

“but [the] business that can be generated with our domain name makes it a high value domain. So selling it for less than USD 100k is not feasible at this point.”

On March 18, 2022, the Complainant applied to register ODK as a trademark in the United States in respect of downloadable software in International Class 9. That application is still pending and not been assigned to an examining attorney yet.

In the Response, the Respondent states (among other things):

“To avoid further trademark issues i have discontinued using ODKCENTRAL.com as main domain. And i am going to list it for sale on domain markets. If Mr Yaw want it he should send me an offer. I think i do have this right to sell as i have registered the domain before any trademark was there.”

At the time this decision is being prepared, the disputed domain name redirects to a website at “www.datalogics.org” from which the Respondent appears to offer paid services to set up and operate an ODK server.

This website is headed with a “Data Logics Managed Services” logo. It has a number of sections with headings like “Accelerated ODK solution to get started” and “ODK Central - Collect Data” with extensive references to “ODK”.

At the bottom of the page, the browser is directed “Contact with your queries at support@datalogics.org”.

The footer repeats the “Data Logics Managed Services” logo with a strapline “Our services are based on ODK Central (an Open Source Software) for Data Collection.” It also includes a copyright notice “Copyright © 2022 Data Logics Ltd (ODK Managed Services). All Rights Reserved.” and ends with a notice “Ownership of all logos, trademarks, and registered trademarks is retained by the respective owners. The names of companies, products, and services mentioned on this website are only for identifying reasons. The use of these names, logos, and trademarks does not indicate that they are endorsed.”

5. Discussion and Findings

Paragraph 4(a) of the Policy provides that in order to divest the Respondent of the disputed domain name, the Complainant must demonstrate each of the following:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and
- (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.

Paragraph 15(a) of the Rules directs the Panel to decide the Complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable.

The Complainant has sought leave to make a supplemental filing to address matters which have arisen in the Response and since the Complaint was filed which it could not therefore reasonably have anticipated or to correct a potential misunderstanding.

Apart from documents requested by the Panel pursuant to paragraph 12 of the Rules, neither the Policy nor the Rules expressly provide for supplemental filings. Their admissibility is therefore in the discretion of the Panel bearing in mind the requirements under paragraph 10 of the Rules to ensure that the proceeding is

conducted with due expedition and both parties are treated equally, with each party being given a fair opportunity to present its case.

The Panel accepts it was prudent for the Complainant to make the supplemental filing in light of the arguments made in the Response and, for that reason, will admit it into the record.

A. Identical or Confusingly Similar

The first element that the Complainant must establish is that the disputed domain name is identical with, or confusingly similar to, the Complainant's trademark rights.

There are two parts to this inquiry: the Complainant must demonstrate that it has rights in a trademark at the date the Complaint was filed and, if so, the disputed domain name must be shown to be identical or confusingly similar to the trademark.

As the Respondent points out, the Complainant does not have or rely on a registered trademark. The Complaint, however, is based on the Complainant's claim to rights in ODK as an unregistered trademark. It has long been recognised that rights in an unregistered trademark, if proven, can satisfy the requirement for trademark rights under the Policy. See *e.g.*, WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.3.

As section 1.3 of the [WIPO Overview 3.0](#) sets out, however, a successful claim of rights in an unregistered trademark requires the Complainant to demonstrate that the posited sign has in fact become a distinctive identifier associated by the relevant public with the Complainant's relevant goods and services. For this purposes, specific evidence supporting the acquired distinctiveness must be provided not just a bare assertion. That is particularly the case where, as here, the posited trademark is a three-letter acronym.

[WIPO Overview 3.0](#), section 1.3 provides that relevant evidence could include 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. These factors are matters which would typically be addressed but are in the end only illustrative of the matters which may support a claim to rights in an unregistered trademark. It is always necessary to consider the import of the evidence actually advanced in the particular case.

In the present case, the Complainant has provided evidence that its software has been provided extensively around the world in many countries under or by reference to the sign ODK and, at least since August 2020, one of the core components has been designated ODK Central. Moreover, the Complainant has provided evidence that key players in the market for software of the kind provided by the Complainant recognise that ODK distinguishes the Complainant's software from other sources. These players include global organisations like the World Health Organisation and the Red Cross Red Crescent network and a leading authority on infectious diseases control, the United States CDC.

Moreover, it scarcely needs the Complainant's supplemental filing to point out that the very nature of the use made by the Respondent and the services it seeks to provide from its website is predicated on the Respondent's expectation that the public recognises ODK as signifying the Complainant's software application and products made using it.

Accordingly, the Panel finds that the Complainant has proven for the purposes of the Policy ownership of ODK and at least arguably ODK Central as an unregistered trademark for its software application.

The second stage of this inquiry simply requires a visual and aural comparison of the disputed domain name to the proven trademarks. This test is narrower than and thus different to the question of "likelihood of confusion" under trademark law. Therefore, questions such as the scope of the trademark rights, the geographical location of the respective parties and other considerations that may be relevant to an

assessment of infringement under trademark law are not relevant at this stage. Such matters, if relevant, may fall for consideration under the other elements of the Policy. See e.g., [WIPO Overview 3.0](#), section 1.7.

In undertaking that comparison, it is permissible in the present circumstances to disregard the generic Top-Level Domain (gTLD) component as a functional aspect of the domain name system. [WIPO Overview 3.0](#), section 1.11.

Disregarding the “.com” gTLD, the disputed domain name consists of the Complainant’s core trademark, ODK, and the term “central”. As this requirement under the Policy is essentially a standing requirement, the addition of such a term does not preclude a finding of confusing similarity. See e.g., [WIPO Overview 3.0](#), section 1.8. Apart from anything else, the Complainant’s trademark remains visually and aurally recognisable within the disputed domain name. Indeed, it is at least arguable that the disputed domain name is identical to the branding of the Complainant’s server component, ODK Central. However, it is unnecessary to decide the case on that basis.

Accordingly, the Panel finds that the Complainant has established that the disputed domain name is confusingly similar to the Complainant’s trademark and the requirement under the first limb of the Policy is satisfied.

B. Rights or Legitimate Interests

The second requirement the Complainant must prove is that the Respondent has no rights or legitimate interests in the disputed domain name.

Paragraph 4(c) of the Policy provides that the following circumstances can be situations in which the Respondent has rights or legitimate interests in a disputed domain name:

- (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 a name corresponding to the [disputed] domain name in connection with a *bona fide* offering of goods or services; or
- (ii) [the Respondent] (as an individual, business, or other organization) 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.

These are illustrative only and are not an exhaustive listing of the situations in which a respondent can show rights or legitimate interests in a domain name.

The onus of proving this requirement, like each element, falls on the Complainant. Panels have recognized the difficulties inherent in proving a negative, however, especially in circumstances where much of the relevant information is in, or likely to be in, the possession of the respondent. Accordingly, it is usually sufficient for a complainant to raise a *prima facie* case against the respondent under this head and an evidential burden will shift to the respondent to rebut that *prima facie* case. The ultimate burden of proof, however, remains with the Complainant. See e.g., [WIPO Overview 3.0](#), section 2.1.

The Complainant does not object to the Respondent providing services to users and potential users of the Complainant’s software. Nor does the Complainant object to some use of its trademark on the Respondent’s website to refer to the Complainant’s software appropriately.

However, the Complainant states that it has not authorised the Respondent to use the disputed domain name. Nor is the Respondent affiliated with it.

The disputed domain name is not derived from the Respondent's name. Nor is there any suggestion of some other name by which the Respondent is commonly known from which the disputed domain name could be derived. There is no suggestion that the Respondent holds any trademarks for the disputed domain name.

The Respondent registered the disputed domain name after the Complainant began using its trademark.

In addition, the Complainant points out that the Respondent's disputed domain name involves use in contravention of the Branding Guidelines which, according to the Complainant, form part of the terms on which the Respondent can use the Complainant's software. Further, the nature and content of the disputed domain name itself carries with it a high risk of implied affiliation. See [WIPO Overview 3.0](#), section 2.5.

Moreover, the content of the Respondent's website conveyed the impression that it is the Complainant's official website or, at least, it can reasonably be misunderstood as that. And also, as the Complainant contends, the website (at least before the Complaint was filed did not clearly disclose the nature of the Respondent's relationship with the Complainant. While the disputed domain name is redirecting to a website with a different URL and using a "Data Logics" logo, the nature of the Respondent's relationship with the Complainant is not clearly disclosed and, further, the use of the disputed domain name to redirect to that website carries a very high risk of implied affiliation contrary to fact.

These matters, taken together, are more than sufficient to establish a *prima facie* case under the Policy that the Respondent has no rights or legitimate interests in the disputed domain name.

The Respondent contends that his search prior to registering the disputed domain name confirmed the Complainant did not own any trademark rights. The Respondent may also contend that the Complainant does not have rights as it is not using the trademark commercially.

It is correct that the Complainant does not hold any registered trademarks, however as discussed in section 5.A. above, the Complainant's rights under the Policy are not limited to registered trademarks only.

Secondly, it should be noted that the fact that the Complainant makes available open-source software does not provide the Respondent with rights or legitimate interests or exclude the Complainant's right to bring a Complaint under the Policy. See *e.g.*, *Mozilla Foundation and Mozilla Corporation v. Whois Privacy, Private by Design, LLC / Nguyen Vo, Dao Nguyen, Phuc Tran, Tran Vu, Phuc Nguyen, and Alex James*, WIPO Case No. [D2021-0310](#), in relation to the Mozilla Firefox browser software. In addition, it appears from the Complainant's website that it does in fact offer paid services for its ODK Cloud managed hosting service.

Accordingly, the Panel finds the Complainant has established the second requirement under the Policy also.

C. Registered and Used in Bad Faith

Under the third requirement of the Policy, the Complainant must establish that the disputed domain name has been both registered and used in bad faith by the Respondent. See *e.g.*, *Burn World-Wide, Ltd. d/b/a BGT Partners v. Banta Global Turnkey Ltd* WIPO Case No. [D2010-0470](#).

Paragraph 4(b) identifies situations which may demonstrate that registration or use of a disputed domain name was not in bad faith under the Policy:

For the purposes of paragraph 4(a)(iii), the following circumstances, in particular but without limitation, if found by the Panel to be present, shall be evidence of the registration and use of [the disputed] domain name in bad faith:

(i) circumstances indicating that [the Respondent] has registered or [the Respondent has] acquired the [disputed] domain name primarily for the purpose of selling, renting, or otherwise transferring the [disputed] domain name registration to the Complainant who is the owner of the trademark or service mark or to a

competitor of that Complainant, for valuable consideration in excess of [the Respondent's] documented out-of-pocket costs directly related to the [disputed] domain name; or

(ii) [the Respondent has] registered the [disputed] 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 [the Respondent has] engaged in a pattern of such conduct; or

(iii) [the Respondent has] registered the [disputed] domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the [disputed] domain name, [the Respondent has] intentionally attempted to attract, for commercial gain, Internet users to [the Respondent's] web site or other on-line location, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of [the Respondent's] website or location or of a product or service on [the Respondent's] web site or location.

When the Complainant contacted the Respondent about a link to a demonstration of the Respondent's product offering as the link on the Respondent's website was not active, the Respondent acknowledged that his, or the associated company's, website was still in development. Accordingly, it is not clear from the record in this case if the Respondent is in fact offering the services purported to be offered from the website to which the disputed domain name resolves. For present purposes, the Panel proceeds on the basis that the Respondent, or the associated company, is genuinely offering the services advertised on the website.

Generally speaking, a finding that a domain name has been registered and is being used in bad faith requires an inference to be drawn that the respondent in question has registered and is using the disputed domain name to take advantage of its significance as a trademark owned by (usually) the complainant.

In the present case, there cannot be any doubt that the Respondent was well aware of the Complainant's trademark before registering the disputed domain name as the Respondent's services are directed at users and potential users of the Complainant's ODK software.

The nature or content of the disputed domain name also carries with it a very high risk of (at least) implied affiliation with the Complainant and its trademark. Apart from anything else, the distinctive element of the disputed domain name is the Complainant's trademark, ODK. The second element, the word "central", does not dispel or reduce that risk. First, it indicates or implies that it is the main or central point to access the Complainant's software. Secondly, the combined expression ODK Central is the name of the server component of the Complainant's software and so compounds the risk.

While the Respondent claims, mistakenly, to have thought the Complainant did not have trademark rights, the Panel considers it very likely that the Respondent appreciated the likelihood for confusion about the source, sponsorship or affiliation of a website using the disputed domain name when registering the disputed domain name.

The way the Respondent, or the associated company, used the disputed domain name following its registration reinforces that conclusion as, contrary to the Respondent's view, the Panel considers the content of the website could readily be misunderstood as the Complainant's website or provided in association with or endorsement by the Complainant. There was certainly no clear disclosure on the website of the nature of the relationship. Also, there is some, albeit limited, evidence of customer confusion.

Furthermore, while the Respondent was prepared to make changes to the content of the website in the face of the Complainant's objections, the Respondent was not prepared to surrender the disputed domain name. Instead, that the Respondent fully appreciated the value of the disputed domain name is further indicated by his fellow director's claim the disputed domain name was worth at least USD 100,000.

In the face of continued objection by the Complainant, the Respondent did set up a new website with a name and domain name that does not seem to trespass on the Complainant's rights and which the Complainant does not seem to object to. The Respondent, however, has not stopped using or surrendered the disputed domain name; instead, he has redirected it to the new (unobjectionable) website and says he has offered the disputed domain name up for sale.

The redirection to the new website is itself an impermissible attempt to continue taking advantage of the trademark significance of the disputed domain name. As is, in context, the apparent offering of the disputed domain name for sale with a further invitation for the Complainant to make an offer.

In these circumstances, the Panel considers the Complainant has demonstrated the registration and use of the disputed domain name falls within the circumstances outlined in paragraph 4(b)(iv) of the Policy.

Accordingly, the Complainant has established all three requirements under the Policy.

6. 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, <odkcentral.com>, be transferred to the Complainant.

/Warwick A. Rothnie/

Warwick A. Rothnie

Sole Panelist

Date: May 23, 2022