

ADMINISTRATIVE PANEL DECISION

Microsoft Corporation v. Whois Agent, Domain Protection Services, Inc. /
Kieu Duong
Case No. D2022-1889

1. The Parties

The Complainant is Microsoft Corporation, United States of America (“United States”), represented by Dinsmore & Shohl LLP, United States.

The Respondent is Whois Agent, Domain Protection Services, Inc., United States / Kieu Duong, Viet Nam.

2. The Domain Name and Registrar

The disputed domain name <theimpossiblequiz.online> (the “Disputed Domain Name”) is registered with Name.com, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on May 25, 2022. On May 28, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On May 29, 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 Jun 14, 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 amendment to the Complaint on June 28, 2022.

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 June 29, 2022. In accordance with the Rules, paragraph 5, the due date for Response was July 19, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on July 21, 2022.

The Center appointed Nick J. Gardner as the sole panelist in this matter on August 17, 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 the well-known technology company that develops, manufactures, licenses, supports, and sells computer hardware and software solutions, among many other computer and software-related products and services. The Complainant's product offerings include numerous computer and video games, including game software distributed under the trademark IMPOSSIBLE QUIZ. The IMPOSSIBLE QUIZ mark is used with a well-known and unique logic-based quiz program. While not actually impossible, the quiz has a high degree of difficulty, often requiring unconventional thought-processes to solve the answers. The IMPOSSIBLE QUIZ game was first offered online in a non-downloadable format in February 2007, and later offered as a downloadable game starting in September 2007. The Complainant is the owner of trademark registrations for the words IMPOSSIBLE QUIZ – see for example U.S. Registration No. 4,089,162 for IMPOSSIBLE QUIZ, covering “downloadable computer and video game programs; video and computer game software for use with computers, television or handheld gaming devices.” This registration issued on January 17, 2012. These trademarks are referred to as the IMPOSSIBLE QUIZ trademark in this decision.

The Disputed Domain Name was registered on May 13, 2019. The filed evidence shows it has been linked to a website (the “Respondent’s Website”) which offers, without permission, either copies of the Complainant’s copyrighted computer game program for download and/or the ability to play online the Complainant’s copyrighted computer game program. It also provides similar access to other third party computer games.

5. Parties’ Contentions

A. Complainant

The Complainant’s contentions can be summarized as follows.

The Disputed Domain Name is confusingly similar to the IMPOSSIBLE QUIZ trademark. Addition of the word “the” does not produce a material difference in this respect. The addition of the generic Top-Level Domain (“gTLD”) “.online” suffix is a minor difference mandated by domain name conventions. It is not sufficient to distinguish the Disputed Domain Name from IMPOSSIBLE QUIZ trademark.

The Respondent has no rights or legitimate interests in the term “IMPOSSIBLE QUIZ”. Providing unauthorized copies of the Complainant’s copyright software is illegal and cannot establish a legitimate interest. Even if the Disputed Domain Name is viewed as one associated with a website offering the genuine IMPOSSIBLE QUIZ software, that alone does not suffice to give the Respondent rights or a legitimate interest in the Disputed Domain Name. The use must be in connection with a *bona fide* offering of legitimate goods. It is well-established that an offering of genuine goods or services is considered *bona fide* only under limited circumstances. Failure to meet strict criteria often referred to as the *Okidata* criteria precludes any claim to rights or legitimate interests in the domain name. These criteria, include at minimum that “[r]espondent must use the site to sell only the trademarked goods; otherwise, it could be using the trademark to bait Internet users and then switch them to other goods.” *Okidata Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#). Here, the Respondent’s Website offers users access to a significant number of games other than the Complainant’s IMPOSSIBLE QUIZ game. As such, the Disputed Domain Name is not being used to provide only the trademarked goods, and therefore does not constitute a *bona fide* offering of goods and services. Consequently, even if it is found that the Disputed Domain Name is being used with the actual goods associated with the mark, that use does not provide the Respondent with any rights or legitimate interests in the Disputed Domain Name. The *Okidata* criteria also require that the website

associated with the disputed domain name prominently and accurately disclose the relationship between the reseller and the trademark owner. No such information is provided on the Respondent's Website. As such, the use of the Disputed Domain Name cannot constitute a use in connection with a *bona fide* offering of goods or services.

In consequence the Complainant alleges that the Disputed Domain Name was registered and is being used in bad faith. The Complainant relies upon (a) the fact that the Respondent almost certainly had actual knowledge of the Complainant's rights in the IMPOSSIBLE QUIZ trademark at the time it registered the Disputed Domain Name; (b) the diversion of the Complainant's customers to a different website to create confusion with the Complainant's mark and thereby to attract Internet users to the Respondent's website for its own commercial gain; (c) the Respondent's infringing and illegal activity in providing access to the Complainant's software; and (d) the Respondent's use of a privacy protection service in the registration of the Disputed Domain Name in order to conceal his/her identity. The Complainant says these circumstances, taken together with the fact that the Respondent has no legitimate interests in the Disputed Domain Name, combine to demonstrate that the Respondent has acted in bad faith.

B. Respondent

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

6. Discussion and Findings

Preliminary Matters

The Panel notes that no communication has been received from the Respondent. However, given the Complaint and Written Notice were sent to the relevant addresses disclosed by the Registrar, then the Panel considers that this satisfies the requirement in paragraph 2(a) of the Rules to "employ reasonably available means calculated to achieve actual notice". Accordingly, the Panel considers it is able to proceed to determine this Complaint and to draw inferences from the Respondent's failure to file any Response. While the Respondent's failure to file a Response does not automatically result in a decision in favour of the Complainant, the Panel may draw appropriate inferences from the Respondent's default (see, e.g., *Verner Panton Design v. Fontana di Luce Corp*, WIPO Case No. [D2012-1909](#)).

The Panel also notes this is a case where one Respondent ("Domain Protection Services, Inc.") appears to be a privacy or proxy service.

The Panel in this case adopts the approach of most UDRP panels, as outlined in WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)") at section 4.4.5, as follows:

"Panel discretion

In all cases involving a privacy or proxy service and irrespective of the disclosure of any underlying registrant, the appointed panel retains discretion to determine the respondent against which the case should proceed.

Depending on the facts and circumstances of a particular case, e.g., where a timely disclosure is made, and there is no indication of a relationship beyond the provision of privacy or proxy registration services, a panel may find it appropriate to apply its discretion to record only the underlying registrant as the named respondent. On the other hand, e.g., where there is no clear disclosure, or there is some indication that the privacy or proxy provider is somehow related to the underlying registrant or use of the particular domain name, a panel may find it appropriate to record both the privacy or proxy service and any nominally underlying registrant as the named respondent."

In the present case the Panel considers the substantive Respondent to be Kieu Duong and references to the Respondent are to that person.

Substantive Matters

To succeed, in accordance with paragraph 4(a) of the Policy, the Complainant must satisfy the Panel that:

- (i) the Disputed Domain Name is identical with 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;
- (iii) the Disputed Domain Name has been registered and is being used in bad faith.

A. Identical or Confusingly Similar

The Complainant has rights in the IMPOSSIBLE QUIZ trademark. The Panel finds the Disputed Domain Name is confusingly similar to this trademark. It reproduces the trademark in its entirety and simply adds the word “the” to it. Omission of the space between “impossible” and “quiz” is a trivial difference which in any case is mandated by technical considerations. Previous UDRP panels have consistently held that domain names are identical or confusingly similar to a trademark for purposes of the Policy “when the domain name includes the trademark, or a confusingly similar approximation, regardless of the other terms in the domain name” (*Wal-Mart Stores, Inc. v. Richard MacLeod d/b/a For Sale*, WIPO Case No. [D2000-0662](#)). It is established that, where a mark is the distinctive part of a disputed domain name, the disputed domain name is considered to be confusingly similar to the registered mark (*DHL Operations B.V. v. DHL Packers*, WIPO Case No. [D2008-1694](#)).

It is also well established that the gTLD, in this case “.online”, does not affect the Disputed Domain Name for the purpose of determining whether it is identical or confusingly similar. See, for example, *Rollerblade, Inc. v. Chris McCrady*, WIPO Case No. [D2000-0429](#).

Accordingly the Panel finds that the Disputed Domain Name is confusingly similar to the Complainant's trademark and hence the first condition of paragraph 4(a) of the Policy has been fulfilled.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a list of circumstances any of which is sufficient to demonstrate that a respondent has rights or legitimate interests in a domain name:

- (i) before any notice to the respondent of the dispute, use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a *bona fide* offering of goods or services; or
- (ii) the respondent has been commonly known by the 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 domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

None of these apply in the present circumstances. The Complainant has not authorised, licensed, or permitted the Respondent to register or use the Disputed Domain Name or to use IMPOSSIBLE QUIZ trademark. The Complainant has prior rights in the IMPOSSIBLE QUIZ trademark which precede the Respondent's acquisition of the Disputed Domain Name. The Complainant has therefore established a *prima facie* case that the Respondent does not have any rights or legitimate interests in the Disputed Domain Name and thereby the burden of production shifts to the Respondent to produce evidence

demonstrating rights or legitimate interests in respect of the Disputed Domain Name (see, for example, *Do The Hustle, LLC v. Tropic Web*, WIPO Case No. [D2000-0624](#); *Croatia Airlines d.d. v. Modern Empire Internet Ltd.*, WIPO Case No. [D2003-0455](#)).

The Panel finds that the Respondent has failed to produce any evidence to establish its rights or legitimate interests in the Disputed Domain Name. Accordingly the Panel finds the Respondent has no rights or any legitimate interests in the Disputed Domain Name and the second condition of paragraph 4(a) of the Policy has been fulfilled.

C. Registered and Used in Bad Faith

In the present circumstances the Panel concludes that the Respondent chose to register a name comprising the Complainant's trademark combined with the word "the" in order to facilitate a scheme where the Respondent's Website offered access to and/or download of unauthorized copies of the Complainant's software. This leads the Panel to conclude the registration and use were in bad faith.

Under paragraph 4(b) of the Policy a non-exhaustive list of factors evidencing registration and use in bad faith comprises:

- (i) circumstances indicating that you have registered or you have acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the 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 your documented out-of-pocket costs directly related to the domain name; or
- (ii) you have registered the 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 you have engaged in a pattern of such conduct; or
- (iii) you have registered the domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your 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 your web site or location or of a product or service on your web site or location.

In the present circumstances the Panel agrees with the Complainant that factor (iv) applies as the Respondent was seeking to achieve commercial gain by offering access to and/or download of the Complainant's software. It was also offering software from third parties. It is not clear to the Panel whether the Respondent was making any charges for the software it offered but the Respondent's Website clearly carries advertising and is of a commercial nature. The Panel concludes that the Respondent was intentionally trying to attract for commercial gain Internet users to the Respondent's Website in the manner contemplated by 4(b)(iv) above. The Panel also notes that the Respondent has not filed a Response and hence has not availed herself/himself of the opportunity to present any case of good faith that she/he might have. The Panel infers that none exists.

Accordingly, the Panel finds that the Disputed Domain Name has been registered and is being used in bad faith and the third condition of paragraph 4(a) of the Policy has been fulfilled.

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 <theimpossiblequiz.online> be transferred to the Complainant.

/Nick J. Gardner/

Nick J. Gardner

Sole Panelist

Date: August 31, 2022