

ADMINISTRATIVE PANEL DECISION

Equifax Inc. v. Domain Holdings

Case No. D2023-0102

1. The Parties

The Complainant is Equifax Inc., United States of America (“United States” or “USA”), represented by The GigaLaw Firm, Douglas M. Isenberg, Attorney at Law, LLC, United States.

The Respondent is Domain Holdings, New Zealand.

2. The Domain Name and Registrar

The disputed domain name <equifaxs.com> is registered with Internet Domain Service BS Corp (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on January 10, 2023. On January 10, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On January 11, 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 (Domain Admin, Whois Privacy Corp.) and contact information in the Complaint. The Center sent an email communication to the Complainant on January 12, 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 January 13, 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 January 16, 2023. In accordance with the Rules, paragraph 5, the due date for Response was February 5, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on February 6, 2023.

The Center appointed Wilson Pinheiro Jabur as the sole panelist in this matter on February 13, 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 provider of information solutions and human resources business process outsourcing services for businesses, governments, and consumers, originally incorporated under the laws of the State of Georgia (USA) in 1913, dating its predecessor back to 1899.

Among its services, the Complainant offers a credit reporting service that provides consumers with a summary of their credit history, and certain other information, reported to credit bureaus by lenders and creditors.

The Complainant, in addition to being the registrant of the domain name <equifax.com>, which was created on February 21, 1995, largely used in connection with its primary website, is the owner of the following, amongst 218 others in 56 countries or jurisdictions worldwide (Annex 9 to the Complaint), trademark registrations:

- United States Trademark Registration No. 1,027,544 for the service mark EQUIFAX, in class 36, filed on March 10, 1975, and registered on December 16, 1975, subsequently renewed;
- United States Trademark Registration No. 1,045,574 for the service mark EQUIFAX, in class 35, filed on July 9, 1975, and registered on August 3, 1976, subsequently renewed; and
- United States Trademark Registration No. 1,644,585 for the service mark EQUIFAX, in classes 35, 36, and 42, filed on February 9, 1990, and registered on May 14, 1991, subsequently renewed.

The disputed domain name was registered on June 9, 2005. Presently and when the Complaint was filed, no active webpage resolves from the disputed domain name.

5. Parties' Contentions

A. Complainant

The Complainant asserts to operate or have investments in 24 countries in North America, Central and South America, Europe, and the Asia Pacific region, counting with approximately 11,000 people worldwide and being a member of the Standard & Poor's (S&P) 500 Index, having its common stock traded on the New York Stock Exchange (NYSE) under the symbol EFX.

The Complainant further states that previous panels under the Policy have found that the Complainant has rights in and to the EQUIFAX trademark, having panels stated that: the "Complainant's trademark EQUIFAX is well-known". (*Equifax Inc. v. Super Privacy Service LTD c/o Dynadot / Babacan Gunduz*, WIPO Case No. [D2021-3814](#)); the EQUIFAX trademark "enjoy[s] a wide reputation and can be considered as a well-known trademark in the industry." (*Equifax Inc. v. Balticsea LLC, Balcsea LLC*, WIPO Case No. [D2022-2497](#)); "the notoriety of the Complainant and of its [EQUIFAX] Trade Mark in respect of the wide range of services provided by the Complainant under the [EQUIFAX] Trade Mark" (*Equifax Inc. v. Daiyu Shao*, WIPO Case No. [D2022-0913](#)); "the notoriety of the [EQUIFAX] Mark" (*Equifax Inc. v. Rakshita Mercantile Private Limited*, WIPO Case No. [D2022-1947](#)); and that the "Complainant's [EQUIFAX] mark is well-known" (*Equifax Inc. v. Domain Controller, Yoyo Email / Yoyo.Email Ltd.*, WIPO Case No. [D2015-0880](#)).

According to the Complainant, the disputed domain name is confusingly similar to the Complainant's EQUIFAX trademark, containing the EQUIFAX trademark in its entirety, simply adding the letter "s" at the end, what does nothing to alleviate the confusing similarity between the disputed domain name and the Complainant's trademark.

Furthermore, the Complainant asserts that the Respondent has no rights or legitimate interests in respect of the disputed domain name given that:

- (i) the Complainant has never assigned, granted, licensed, sold, transferred or in any way authorized the Respondent to register or use the EQUIFAX trademark in any manner;
- (ii) by failing to use the disputed domain name in connection with an active website the Respondent clearly has not used the disputed domain name “in connection with a *bona fide* offering of goods or services” and, therefore, cannot establish rights or legitimate interests pursuant to paragraph 4(c)(i) of the Policy; and
- (iii) the Respondent has never been commonly known by the disputed domain name and has never acquired any trademark or service mark rights in the disputed domain name.

Furthermore, the Complainant points out that given that the EQUIFAX trademark is a famous trademark, protected by 221 registrations in 56 countries or jurisdictions worldwide, it is implausible that the Respondent was unaware of the Complainant when registering the disputed domain name. Also according to the Complainant, given the fame of the Complainant’s trademark, there was opportunistic bad faith on the Respondent’s side when registering the disputed domain name. As to the use of the disputed domain name in bad faith the Complainant contends that the passive holding of a domain name has already been found an indicator of the Respondent’s bad faith, which in this case is further corroborated by the Respondent’s concealment of its true identity due to the retention of a privacy protection service and the impossibility to identify any good faith use to which the disputed domain name may be put.

B. Respondent

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

6. Discussion and Findings

Paragraph 4(a) of the Policy sets forth the following three requirements which have to be met for this Panel to order the transfer of the disputed domain name to the Complainant:

- (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.

The Complainant must prove in this administrative proceeding that each of the aforesaid three elements is present in order to obtain the transfer of the disputed domain name.

A. Identical or Confusingly Similar

The Complainant has established rights in the EQUIFAX trademark, duly registered.

The Panel finds that the disputed domain name reproduces the Complainant’s trademark in its entirety, with the mere addition of a letter “s”, which does not prevent a finding of confusing similarity. As recognized by past UDRP panels, the first element involves a “comparison of the domain name and the textual components of the relevant trademark to assess whether the mark is recognizable within the disputed domain name” (WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ([“WIPO Overview 3.0”](#)), section 1.7).

The first element of the Policy has therefore been established.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a non-exclusive list of circumstances that indicate a respondent's rights to or legitimate interests in a disputed domain name. These circumstances are:

- (i) before any notice 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, in spite of not having acquired 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.

The Respondent, in not formally responding to the Complaint, has failed to invoke any of the circumstances, which could demonstrate, pursuant to paragraph 4(c) of the Policy, any rights to or legitimate interests in the disputed domain name. This entitles the Panel to draw any such inferences from such default as it considers appropriate pursuant to paragraph 14(b) of the Rules. Nevertheless, the burden of proof is still on the Complainant to make a *prima facie* case against the Respondent.

In that sense, and according to the evidence submitted, the Complainant has made a *prima facie* case against the Respondent that the Respondent has not been commonly known by the disputed domain name, and neither has the Complainant ever assigned, granted, licensed, sold, transferred or in any way authorized the Respondent to register or use the EQUIFAX trademark in any manner.

Also, the absence of any indication that the Respondent has rights in a term corresponding to the disputed domain name, or any possible link between the Respondent and the Complainant that could be inferred from the details known of the Respondent or the webpage relating to the disputed domain name, corroborate with the Panel's finding of the absence of rights or legitimate interests.

The composition of the disputed domain name, namely a typographical variation of the Complainant's well-known trademark, reflects the Respondent's illicit intent to mislead unsuspecting Internet users expecting to find the Complainant and unaware of the misspelled disputed domain name, which cannot confer upon the Respondent rights or legitimate interests.

Another element to consider is the fact that no active use of the disputed domain name appears to have taken place which makes it even more difficult to conceive which rights or legitimate interests the Respondent would have in a domain name that reproduces in its entirety the Complainant's trademark.

Under these circumstances and absent evidence to the contrary, the Panel finds that the Respondent does not have rights or legitimate interests with respect to the disputed domain name.

C. Registered and Used in Bad Faith

The Policy indicates in paragraph 4(b) that bad faith registration and use can be found in view of:

- (i) circumstances indicating that the Respondent has registered or acquired the disputed domain name primarily for the purpose of selling, renting, or otherwise transferring it to the Complainant who is the owner of a trademark relating to the disputed domain name or to a competitor of the 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 website or other 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 website or location.

Past UDRP panels have already dealt with the question of whether the "passive holding" of a domain name could constitute bad faith. Section 3.3 of the [WIPO Overview 3.0](#) states that "[f]rom the inception of the UDRP, panelists have found that the non-use of a domain name (including a blank or 'coming soon' page) would not prevent a finding of bad faith under the doctrine of passive holding. While panelists will look at the totality of the circumstances in each case, factors that have been considered relevant in applying the passive holding doctrine include: (i) the degree of distinctiveness or reputation of the complainant's mark, (ii) the failure of the respondent to submit a response or to provide any evidence of actual or contemplated good-faith use, (iii) the respondent's concealing its identity or use of false contact details (noted to be in breach of its registration agreement), and (iv) the implausibility of any good faith use to which the domain name may be put".

In the present case, the passive holding of the disputed domain name by the Respondent amounts to the Respondent acting in bad faith, given that the Respondent has provided no evidence whatsoever of any actual or contemplated good faith use of the disputed domain name. In addition to that, in the circumstances of this case, it is not possible to conceive of any plausible actual or contemplated active use of the disputed domain name by the Respondent that would not be illegitimate, such as by being a passing off, an infringement of consumer protection legislation, or an infringement of the Complainant's rights under trademark law.

The registration and use of the disputed domain name in bad faith are further corroborated in the present case in view of the following circumstances:

- (i) the well-known nature of the Complainant's trademark and the confusing similarity between the disputed domain name and said trademark indicate that the Respondent is most likely to have the Complainant and its trademark in mind when registering the disputed domain name;
- (ii) the disputed domain name has been resolving to an inactive webpage, and the Respondent has provided no evidence whatsoever of any actual or contemplated good faith use of the disputed domain name;
- (iii) the lack of reply by the Respondent, without giving any explanation on its choice of the confusingly similar disputed domain name or a formal response to the Complaint on the merits;
- (iv) the Respondent's choice to retain a privacy protection service to conceal its true identity; and
- (v) the indication of what it appears false contact information not having the Center fully delivered communication to the Respondent.

For the reasons stated above, the Respondent's conduct amounts, in this Panel's view, to bad faith registration and use of the disputed domain name.

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, <equifaxs.com>, be transferred to the Complainant.

/Wilson Pinheiro Jabur/

Wilson Pinheiro Jabur

Sole Panelist

Date: February 27, 2023