



CANADIAN INTERNATIONAL INTERNET DISPUTE RESOLUTION CENTRE
DOMAIN NAME DISPUTE
ADMINISTRATIVE PANEL DECISION

CIIDRC case number: 13941-UDRP

Decision date: November 2, 2020

Panel: Peter L. Michaelson, Esq.

Disputed Domain Name: <open-text.org>

Complainants: Open Text Corporation, Ontario, Canada; and Open Text SA ULC, Nova Scotia, Canada

Respondent: Host Master; Charleston, KN

Registrar: Tucows. Inc.

1. PROCEDURAL HISTORY

The Complaint was filed with the Canadian International Internet Dispute Resolution Centre (the "Centre") on September 23, 2020.

On September 28, 2020, in response to a verification request from the Centre, the Registrar transmitted, by e-mail, to the Centre its verification response disclosing registrant and contact information for the disputed domain name and confirmed that it placed the name on registrar lock.

The Centre verified that the Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the "Policy"), the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules") and the CIIDRC Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the "Supplemental Rules").

In accordance with the paragraphs 4 of the Rules and 5 of the Supplemental Rules, on September 28, 2020, the Centre formally notified Respondent of the Complaint and that the proceedings commenced on that date. In accordance with the paragraph 5 of the Rules, the Centre set the due date for Response to October 19, 2020. As of October 19, 2020, Respondent did not submit any Response. Accordingly, on October 19, 2020, the Centre notified the parties of Respondent's default.

The Centre appointed Peter L. Michaelson as the sole panelist in this matter on October 22, 2020. 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 Centre to ensure compliance with paragraph 7 of the Rules.

The Centre set November 5, 2020 as the due date to receive the decision from the Panel.

2. FACTS ALLEGED BY THE PARTIES

As reflected in the registration record for the disputed domain name in the public Whois database (a copy of that record appears in Annex 2 to the Complaint), the disputed domain name <open-text.org> was registered on June 24, 2020 and will expire on June 24, 2021.

Domain Name: open-text.org
13941-UDRP

A. Complainant's OPENTEXT Marks

As indicated in the Complaint, Complainants collectively own numerous trademark registrations in Canada and counterpart registrations in many foreign countries, including, e.g., Australia, China, European Community, United States and United Kingdom for the terms "OPENTEXT" and "OPEN TEXT" in block letters (word marks), with those terms appearing either by themselves or with additional words, (all collectively referred to as the "OPENTEXT Marks"). Complainant has provided, in Annex 7 to the Complaint, a non-exhaustive list of those registrations along with copies of a sample of its registration certificates for those marks. Pertinent details of one of its Canadian registrations are as follows:

1. OPEN TEXT (words)
Canadian registration number: TMA646346
Filed: December 4, 2001; Registered: August 23 2005

This registration covers the following goods and services in international classes 9, 20, 35, 38, 39, 41, 42 and 44: GOODS: (1) Computer software, namely, search engine software supporting key word searching on a computer network. (2) Computer software for searching, managing and working collaboratively on documents, namely, knowledge management computer software in the nature of integrated database and communications applications useful for creating and storing computer generated data or, documents in a document management database which is accessible to users of a computer network whereby the users of the computer network can create, store, organize in the document management database, search for, access, retrieve and make changes to documents which are in common use by the users of the document management database.

SERVICES: (1) Computer services, namely, the provision of the licensed use and access to search engine software. (2) Computer services, namely, the provision of the licensed use and access to knowledge management software. (3) Consulting services in the field of computer software to provide for the implementation of knowledge management methods in a computer network. (4) Consulting services in the field of computer software, namely, the custom design and development of knowledge management computer software, and the integration of suites of computer programs, useful for searching, managing and working collaboratively on documents, namely, computer software in the nature of database and communications applications useful for creating and storing computer generated data or, documents in a document management database which is accessible to users of a computer network whereby the users of the computer network can create, store, organize in the document management database, search for, access, retrieve and make changes to documents which are in common use by the users of the document management database. (5) Consulting services in the field of computer software and knowledge management to provide for the management of electronically stored documents and the processing of information stored in such documents. (6) Consulting services, namely, workshops, classes and seminars to train participants in the use of computers, computer software and computer networks to implement knowledge management methods in a computer system. (7) Support and maintenance of computer software. (8) Online information services, namely, providing a public and member driven global computer network site for collection of electronic business services including a range of secure, hosted, structured and ad hoc group collaboration tools, including email, chat, projects, discussions, conferencing, training and notification; vertically focused content delivered through online catalogues, news feeds and industry communities; and online transactions such as auctions, bidding and procurement, delivery scheduling, payment, electronic process integration, virtual projects, intranets and extranets.

B. The Parties and their Activities

Complainant, Open Text Corporation, is the parent company of Complainant, Open Text SA ULC. The latter is an indirect subsidiary of the former. This corporate relationship is shown in an Officer's Certificate appearing in Annex 1 to Complaint. For simplicity, both Open Text SA ULC and Open Text Corporation will hereinafter be referred to as simply "Complainant", unless a specific reference is made to either entity.

Complainant, Open Text Corporation, was incorporated in 1991, is Canada's largest software company, globally providing multiple software products and related services in Enterprise Information Management (EIM) for large and mid-sized corporations, government agencies, educational establishments, and professional service firms across a wide range of industries. OpenText is recognized around the world in the EIM software space. Gartner, a large worldwide technology research organization, named Complainant as a market leader in the EIM space and a leader in the Content Services Platform space for 15 consecutive years. A copy of an associated 2019 press release from Complainant appears in Annex 5 to the Complaint. Complainant OpenText had revenues for 12

months ending June 20, 2020 of approximately CAN \$ 3.11B and is a publicly traded company listed on the NASDAQ and the Toronto Stock Exchanges. OpenText employs over 14,000 people worldwide and has offices worldwide with its headquarters in Waterloo, Ontario, Canada. A list of some of its global office locations appears in Annex 6 to the Complaint.

Since 1991, Complainant has continuously used its mark OPEN TEXT in connection with the sale of its software products and related services.

Respondent uses a privacy screen, available through the Registrar, to prevent public access to its contact information from appearing in the WhoIS database. Upon Complainant's request to the Registrar, the latter disclosed Respondent's true identity to Complainant.

When Complainant became aware of the disputed domain name, it immediately sent a takedown notice letter to the hosting service provider (Nice IT Services Group Inc.) of Respondent's website to which the name resolves and sent a demand letter to Respondent regarding its unauthorized use of the name. In response, the former evidently took down Respondent's website as the name, as of the filing date of the Complaint, no longer resolves to a webpage -- as shown by the error message appearing in a screenshot provided in Annex 11 to the Complaint. However, prior to Respondent's website having been taken down, that website identically replicated, page for page and in its entirety, the content of Complainant's website. In that regard, compare Annex 12 to the Complaint which provides screenshots of pages of Complainant's website to Annex 13 which provides screenshots to corresponding pages of Respondent's website.

3. CONTENTIONS OF THE PARTIES

A. Complainant

(i) Identical or Confusingly Similar

Complainant contends that the disputed domain name is either confusing similar or identical to its mark OPENTEXT.

Specifically, the disputed domain name contains this mark to which a hyphen has been added between the words "OPEN" and "TEXT" and to which the generic top-level domain (gTLD) ".org" has been appended, with the former addition failing to sufficiently distinguish the name from the mark so as to avoid confusing Internet users and the latter addition being disregarded, as purely functional in nature, for assessing confusion or identity under the Policy.

Hence, Complainant believes that it has satisfied the confusing similarity/identity requirement in paragraph 4(a)(i) of the Policy.

(ii) Rights or Legitimate Interests

Complainant contends that, for several reasons, Respondent has no rights or legitimate interests in the disputed domain name pursuant to paragraphs 4(a)(ii) and 4(c) of the Policy.

Specifically, Complainant has not authorized, licensed or permitted Respondent to register or use the disputed domain name or any of Complainant's OPENTEXT marks. Consequently, any use of the disputed domain name by Respondent would infringe Complainant's exclusive rights in its marks.

Further, there is no evidence that Respondent's use of, or demonstrable preparations to use, the name is made in connection with a *bona fide* offering of goods or services within the meaning of paragraph 4(c)(i) of the Policy.

Respondent has not demonstrated that it has been commonly known by the name nor has Respondent acquired any trademark or service mark rights in the name within the meaning of paragraph 4(c)(ii) of the Policy.

Lastly, Respondent is not making a legitimate non-commercial or fair use of the name, without intent for commercial gain to misleadingly divert consumers or tarnish any of Complainant's OPENTEXT marks within the

meaning of paragraph 4(c)(iii) of the Policy.

(iii) Registered and Used in Bad Faith

Complainant also contends that Respondent has registered and is using the disputed domain name in bad faith in violation of paragraphs 4(a)(iii) and 4(b) (iv) of the Policy.

Specifically, as Respondent identically copied Complainant's website, page for page, and the name is nearly identical to Complainant's mark OPENTEXT, Respondent not only was clearly aware of Complainant, its goods and services, and the worldwide recognition its mark had attained when Respondent registered the name and but also deliberately registered the name with malicious intent. Respondent also could have registered the name for purpose of phishing Complainant's customers. These actions collectively reflect both bad faith registration and use. Bad faith registration is accentuated by Respondent's choice to employ a privacy screen to shield its identity on the Whois database from public scrutiny.

By registering the name under the conditions it did, Respondent primarily sought to use the name, in bad faith, in disrupting Complainant's business and/or attempting to attract, for commercial gain, Internet users to its website or other online location, by creating a likelihood of confusion with Complainant's mark OPENTEXT as to source, sponsorship, affiliation, or endorsement of Respondent's website or location or of a product or service on that site or location. Such confusion would likely deceive users who reach Respondent's website into falsely believing that the site is owned and operated by Complainant, when, in actuality, there is no connection between Complainant and that site.

B. Respondent

In view of the lack of any Response, this administrative proceeding continued by way of default. Hence, under paragraphs 5(f), 14(a) and 15(a) of the Rules, the Panel decided this proceeding on the basis of Complainant's undisputed factual allegations which the Panel finds are not inherently implausible.

4. DISCUSSION AND FINDINGS

In accordance with Paragraph 4 of the Policy, Complainant has the burden to prove that:

- i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which Complainant has rights;
- ii) Respondent has no rights or legitimate interests in the disputed domain name; and
- iii) the disputed domain name has been registered and is being used in bad faith.

The Panel will now address each of these elements in turn.

A. Identical or Confusingly Similar

The Panel finds that the disputed domain name is confusingly similar to Complainant's mark OPENTEXT.

From a simple comparison of the disputed domain name to Complainant's mark, no doubt exists that the disputed domain name is confusingly similar to it, if not nearly identical. The name consists of the term "OPENTEXT", with the two words "OPEN" and "TEXT" separated by a hyphen to form a composite term "open-text" to which the generic Top-Level Domain ("gTLD") ".org" has been appended, with the addition of a gTLD generally being ignored in assessing confusing similarity/identity. Well-established UDRP precedent holds that "[t]he applicable Top Level Domain ("TLD") in a domain name (e.g., ".com", ".org", ".net") is viewed as a standard registration requirement and as such is disregarded under the first element [paragraph 4(a)(i)] confusing similarity test." See *WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition*, § 1.11.

It is now very well-established in prior UDRP cases, including numerous decisions previously rendered by this Panel, that a minor variation to a mark is usually insufficient in and of itself, when used in forming a domain name that results from modifying the mark, to prevent confusing similarity. Respondent's addition of the hyphen to Complainant's mark to form the disputed domain name unquestionably constitutes such a minor variation. See, e.g., *Praxis Capital, Inc. v. John C. Martinez, The Praxeology Group LLC*, WIPO Case No. D2019-0254, *Kumfs*

Brand Limited v. George, WIPO Case No. D2016-1272; *Dubizzle Limited BVI v. Rana Anabtawi*, WIPO Case No. D2016-0843; *Chicago Mercantile Exchange Inc. and CME Group Inc. v. Domains By Proxy, LLC / Phupinder Gill*, WIPO Case No. D2015-1842; *Cummins Inc. v. Jamie Lent*, WIPO Case No. D2015-0188; *Staatliche Porzellan-Manufaktur Meissen GmbH v. Buy Meissen*, WIPO Case No. D2013-1687; *Forideas Pty Limited v. Movember Organization*, WIPO Case No. D2013-1385; *AlgaeCal Inc. v. AlgaeCal Fraud*, WIPO Case No. D2013-1248; *General Motors LLC v. Carol Schadt*, WIPO Case No. D2012-2106; *National Westminster Bank plc v. Steve Mart*, WIPO Case No. D2012-1711; *Tommy Bahama Group, Inc. v. Berno Group International*, WIPO Case No. D-2012-0531; *National Association of Realtors v. Hammerberg & Associates, Inc.*, WIPO Case No. D2012-0075; *Space Needle LLC v. Erik Olson*, WIPO Case No. D2011-0931; *Oakley, Inc. v. Kate Elsberry, Elsberry Castro*, WIPO Case No. D-2009-1286; and *Clearwire Legacy, LLC v. Leon Ganesh*, WIPO Case No. D2010-0148.

Hence, Complainant has satisfied its burden under paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

Based on the evidence of record here, the Panel finds that no basis exists which would appear to legitimize a claim of rights or legitimate interests by Respondent to the disputed domain name under paragraph 4(c) of the Policy.

Complainant has never authorized Respondent to utilize Complainant's OPENTEXT Marks and has no relationship, affiliation or connection whatsoever with Respondent.

Further, Respondent's use of the name as a web address to resolve to a website that identically replicates Complainant's website, through which Respondent obviously seeks to divert Internet users intent on reaching Complainant's website to Respondent's own website instead, presumably for the purpose of exploit the ensuing confusion to illicitly secure some type of commercial gain from those users, does not constitute use of the name in connection with a *bona fide* offering of goods or services or reflect any prior demonstrable preparations to do so. Moreover, using a domain name that intentionally infringes the exclusive trademark rights of another, as is the case here, also fails to qualify as a *bona fide* use. Also, such use does not constitute a legitimate non-commercial or fair use either. Accordingly, Respondent fails to qualify under either paragraph 4(c)(i) or (iii) of the Policy.

Given Complainant's exclusive rights in its OPENTEXT Marks, which predate, by approximately 29 years, the date (June 24, 2020) on which Respondent registered the disputed domain name, Respondent could not legitimately acquire such a public association with any mark similar to those of Complainant — at least for the goods and services provided by Complainant under its OPENTEXT Marks — without interfering with the exclusive trademark rights of Complainant. See, e.g., *Philip Morris USA Inc. v. Daniele Kanai, iKiss LLC*, WIPO Case No. D2015-1527; *Valero Energy Corporation and Valero Marketing and Supply Company v. Lisa Katz, Domain Protection LLC / Domain Hostmaster, Customer ID: 62520014085963*, WIPO Case No. D2015-0787; and *Praxis Capital, Chicago Mercantile Exchange Inc., Cummins Inc. and Staatliche Porzellan-Manufaktur*, all cited supra. Consequently, Respondent is not commonly known by the disputed domain name or Complainant's mark and accordingly fails to qualify under paragraph 4(c)(ii) of the Policy.

Hence, Respondent fails to demonstrate that it has any rights or legitimate interests in the disputed domain name.

C. Registered and Used in Bad Faith

The Panel finds that Respondent's actions, with respect to the disputed domain name, constitute bad faith registration and use.

The Panel infers, from the facts of record -- particularly Respondent's subsequent replication of Complainant's website to which the name, nearly identical to Complainant's mark OPENTEXT, resolved coupled with the lack of any Response, that it is undeniable, that Respondent was well aware of Complainant and its mark OPENTEXT, and the reputation and exclusive rights which Complainant then had in that mark when Respondent registered the name. Yet, in spite of that knowledge and in the absence of any authority to do so from Complainant, Respondent intentionally registered the name for both: (a) its potential to cause significant confusion of Internet users between, on the one hand, the name and its website and, on the other, Complainant's mark, and (b) Respondent's ability to commercially benefit from that confusion. Moreover, the Panel further infers that, far more likely than not, Respondent, even before it registered the name, formulated its plan to intentionally cause such confusion by

effectively cloning an identical replica of Complainant's website reachable through a name which was to appear as close as possible to Complainant's mark, and then opportunistically profit thereby in some fashion. This constitutes bad faith registration.

It was only Complainant's quick and decisive action, upon discovering that the disputed domain name existed (shortly after it was registered), in issuing a take down notice letter to Respondent's web hosting service provider that presumably prevented Complainant from suffering potentially considerable injury to its reputation and financial injury to its business from Respondent's continued operation of its website and the disputed domain name as the address of that site.

Not only did Respondent use the name, which included Complainant's mark OPENTEXT, to address its website and cause confusion, it heightened the potential for such confusion by replicating Complainant's website in its entirety as its own. Doing so would likely disrupt Complainant's business and inflict harm on Complainant. This clearly reflects bad faith use.

Thus, Respondent has violated paragraphs 4(a) (iii) and 4(b)(iii) and 4(b)(iv) of the Policy.

Accordingly, the Panel concludes that Complainant has provided sufficient proof of its allegations, with respect to the disputed domain name, to establish a case under paragraph 4(a) of the Policy upon which the relief it now seeks can be granted.

5. DECISION and ORDER

For the above reasons, in accordance with Paragraph 4 of the Policy, Paragraph 15 of the Rules and Rule 10 of the Supplemental Rules, the Panel grants the relief sought by Complainant.

The Panel now orders that the disputed domain name <open-text.org> be transferred to Complainant.

Signed this day November 2, 2020.

SIGNATURE OF THE PANEL

Peter L. Michaelson, Esq., Panelist

