

## **ADMINISTRATIVE PANEL DECISION**

**Benefitfocus.com, Inc. v. James Healy, Benetitfocus**  
**Case No. D2023-1341**

### **1. The Parties**

Complainant is Benefitfocus.com, Inc., United States of America ("United States"), represented by Nelson Mullins Riley & Scarborough, L.L.P., United States.

Respondent is James Healy, Benetitfocus, United States.

### **2. The Domain Name and Registrar**

The disputed domain name <benetitfocus.com> is registered with PDR Ltd. d/b/a PublicDomainRegistry.com (the "Registrar").

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on March 28, 2023. On March 29, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On March 30, 2023, the Registrar transmitted by email to the Center its verification response, confirming that Respondent is listed as the registrant and providing the contact details.

The Center verified that 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 Respondent of the Complaint, and the proceedings commenced on March 31, 2023. In accordance with the Rules, paragraph 5, the due date for Response was April 20, 2023. Respondent did not submit any response. Accordingly, the Center notified Respondent's default on April 21, 2023.

The Center appointed Scott R. Austin as the sole panelist in this matter on April 26, 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 following facts appear from the Complaint (as amended solely to add the Registrar-provided registrant information) and its annexes, which have not been contested by Respondent.

Founded in 2000 and headquartered in Charleston, South Carolina, Complainant provides industry-leading, cloud-based benefits administration technology services to employers and health plans under the mark BENEFITFOCUS (the “BENEFITFOCUS Mark”)

Complainant asserts its services help organizations simplify the complexity of benefits administration while engaging people in the right healthcare and benefit programs for them and their families. Complainant’s solutions are based on a multi-tenant architecture, feature a user-friendly interface and support a broad line-up of benefits including core medical benefits, as well as dental, life, disability insurance, mental health, financial wellness and others.

Complainant also shows it incorporates the BENEFITFOCUS Mark into its official domain name <benefitfocus.com> which Complainant registered on April 6, 2000, and has been used since that time to access Complainant’s official BENEFITFOCUS Mark website (“Official Website”) to promote and offer its products and render its services to its to its customers under the BENEFITFOCUS Mark.

Complainant owns numerous trademark registrations around the world for the BENEFITFOCUS Mark for its benefits administration services, including the following incontestable trademark registrations of record with the United States Patent and Trademark Office (“USPTO”):

United States Registration No. 2,496,059, BENEFITFOCUS, registered on October 9, 2001, for providing online resource management services in International Class 35, claiming a first use date of May 15, 2000; and

United States Registration No. 4,565,511, BENEFITFOCUS, registered on July 8, 2014, for a downloadable application to research a range of employee benefits related authorized information in International Class 9, claiming a first use date of September 29, 2013.

The Whois record shows the disputed domain name was registered on February 27, 2023, and Complainant states that to the best of its knowledge the disputed domain name has never resolved to an active website and shows evidence of such inactivity when accessed on March 23, 2023.

On March 6, 2023, Complainant’s counsel sent a cease-and-desist letter via email to Respondent, from whom Complainant had received no reply as of the filing date of the Complaint.

#### **5. Parties’ Contentions**

##### **A. Complainant**

Complainant contends that the disputed domain name is confusingly similar to Complainant’s trademark; that Respondent has no rights or legitimate interests in respect of the disputed domain name; and that the disputed domain name was registered and is being used in bad faith.

##### **B. Respondent**

Respondent did not reply to Complainant’s contentions.

## 6. Discussion and Findings

There are no exceptional circumstances within paragraph 5(f) of the Rules to prevent this Panel from determining the present dispute based upon the Complaint (as amended), notwithstanding the failure of any person to lodge a substantive formal Response in compliance with the Rules. Under paragraph 14 of the Rules, where a party does not comply with any provision of the Rules, the Panel shall “draw such inferences therefrom as it considers appropriate”.

Where no substantive Response is filed, however, Complainant must still make out its case in all respects under paragraph 4(a) of the Policy. To succeed, Complainant must demonstrate that the requirements for each of the elements listed in paragraph 4(a) of the Policy have been satisfied.

The Panel will address its findings on each of these elements in more detail below.

The standard of proof under the Policy is often expressed as the “balance of the probabilities” or “preponderance of the evidence” standard. Under this standard, an asserting party needs to establish that it is more likely than not that the claimed fact is true. See, WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”), section 4.2.

### A. Identical or Confusingly Similar

Ownership of a nationally registered trademark constitutes *prima facie* evidence that the complainant has the requisite rights in a mark for purposes of paragraph 4(a)(i) of the Policy. [WIPO Overview 3.0](#), section 1.2.1. Complainant claims trademark rights in the BENEFITFOCUS Mark for its employment benefits administration technology goods and services in its registrations for the BENEFITFOCUS Mark dating back to 2000. Sufficient evidence has been submitted in the form of electronic copies of valid and subsisting trademark registration documents in the name of Complainant and therefore, Complainant has demonstrated it has rights in the BENEFITFOCUS Mark. See *Advance Magazine Publishers Inc., Les Publications Conde Nast S.A. v. Voguechen*, WIPO Case No. [D2014-0657](#).

With Complainant’s rights in the BENEFITFOCUS Mark established, the remaining question under the first element of the Policy is whether the disputed domain name is identical or confusingly similar to Complainant’s BENEFITFOCUS Mark. It is well accepted that the first element functions primarily as a standing requirement and that the threshold test for confusing similarity involves a “reasoned but relatively straightforward comparison between the complainant’s trademark and the disputed domain name”. [WIPO Overview 3.0](#), section 1.7.

Prior UDRP panels have also held “in cases where a domain name incorporates the entirety of a trademark, or where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar to that mark for purposes of UDRP standing”. See, *L’Oréal, Lancôme Parfums et Beauté & Cie v. Jack Yang*, WIPO Case No. [D2011-1627](#); see also, *Wal-Mart Stores, Inc. v. MacLeod d/b/a/ For Sale*, WIPO Case No. [D2000-0662](#).

A side-by-side comparison between the disputed domain name and Complainant’s Mark shows the disputed domain name is almost identical to the BENEFITFOCUS Mark. Complainant’s BENEFITFOCUS Mark is incorporated in its entirety except the substitution of the “f” in the leading term “benefit” with a “t” to reconfigure Complainant’s mark so that this alteration is focused on the center of the BENEFITFOCUS Mark. Complainant’s registered BENEFITFOCUS Mark is incorporated into and remains recognizable in the disputed domain name, followed only by the Top-Level Domain (“TLD”) “.com”. Prior UDRP panels have found the TLD, being viewed as a standard registration requirement, may typically be disregarded under the paragraph 4(a)(i) analysis. See, [WIPO Overview 3.0](#), section 1.11.1; see also *L’Oréal v. Tina Smith*, WIPO Case No. [D2013-0820](#).

Complainant contends that the disputed domain name must be considered confusingly similar to Complainant’s Mark because the substituted “t” reconfiguration noted above is a purposeful misspelling of

Complainant's BENEFITFOCUS Mark and Complainant's Mark remains recognizable within the disputed domain name. Prior panels have held that a deliberate misspelling of a trademark registered as a domain name, which is intended to confuse Internet users, must be confusingly similar by design. See [WIPO Overview 3.0](#), section 1.9; See also *Allstate Insurance Company v. Rakshita Mercantile Private Limited*, WIPO Case No. [D2011-0280](#); *Humana Inc. v. Cayman Trademark Trust*, WIPO Case No. [D2006-0073](#)

Based on the above, this Panel finds that the substitution of the letter "t" for the first "f" in Complainant's registered BENEFITFOCUS Mark does not prevent a finding of confusing similarity between the disputed domain name and Complainant's BENEFITFOCUS Mark.

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

## **B. Rights or Legitimate Interests**

Under the second element of the Policy, a complainant is first required to make out a *prima facie* case that the respondent lacks rights or legitimate interests in the disputed domain name. If a complainant makes that showing, the burden of production on this element shifts to the respondent to come forward with relevant evidence of such rights or legitimate interests in the domain name. If the respondent fails to come forward with such evidence, a complainant is generally deemed to have satisfied the second element. [WIPO Overview 3.0](#), section 2.1. See also, *Malayan Banking Berhad v. Beauty, Success & Truth International*, WIPO Case No. [D2008-1393](#).

Complainant has established, *prima facie*, that Respondent lacks rights or legitimate interests in the disputed domain name. First, Complainant asserts that Respondent is not sponsored by or affiliated with Complainant in any way, nor has Complainant given Respondent permission or license to use Complainant's trademarks in any manner, including in domain names. Prior UDRP panels have held "In the absence of any license or permission from Complainant to use its trademark, no actual or contemplated *bona fide* or legitimate use of the Disputed Domain Name could reasonably be claimed". *Sportswear Company S.P.A. v. Tang Hong*, WIPO Case No. [D2014-1875](#).

Second, Complainant contends Respondent is not commonly known by the disputed domain name, which evinces a lack of rights or legitimate interests under Policy paragraph 4(c)(ii). Complainant has shown in the Whois information evidence submitted in its annexes that Respondent, as registrant of the disputed domain name, identified as "James Healy" is not commonly known by the disputed domain name because it clearly bears no resemblance to it, nor to the BENEFITFOCUS Mark or <benefitfocus.com> domain name. Similarly, while Respondent's registrant organization tracks the terms comprising the disputed domain name, a Google search Complainant conducted for "Benetifocus" set forth in an attached Annex to the Complaint did not reveal any results for any entity known by that name; rather, "the search suggest/questions whether the searcher meant to search for Complainant".

Prior UDRP panels have held where no evidence, including the Whois record for the disputed domain name, suggests that Respondent is commonly known by the disputed domain name, then Respondent cannot be regarded as having acquired rights to or legitimate interests in the disputed domain name within the meaning of Policy paragraph 4(c)(ii). See *Moncler S.p.A. v. Bestinfo*, WIPO Case No. [D2004-1049](#).

Most importantly, Complainant's evidence shows the disputed domain name resolves to an inactive website. Respondent, therefore, is not making a legitimate noncommercial or fair use of the disputed domain name nor using it in connection with a *bona fide* offering of goods or services to confer a right or legitimate interest because there is no evidence the disputed domain name is being used at all. See *Valero Energy Corporation and Valero Marketing and Supply Company v. Valero Energy*, WIPO Case No. [D2017-0075](#).

These facts establish Complainant's *prima facie* showing. Respondent has not provided any basis on which that showing may be overcome. Complainant has, therefore, successfully met its burden under paragraph 4(a)(ii) of the Policy.

### C. Registered and Used in Bad Faith

Finally, Complainant must prove, by a preponderance of the evidence, that the disputed domain name has been registered and used in bad faith under paragraph 4(a)(iii) of the Policy. See, e.g., *Hallmark Licensing, LLC v. EWebMall, Inc.*, WIPO Case No. [D2015-2202](#). Paragraph 4(b) of the Policy sets out a non-exhaustive list of circumstances that point to bad faith conduct on the part of a respondent. The panel may, however, consider the totality of the circumstances when analyzing bad faith under Policy, paragraph 4(a)(iii) and may make a finding of bad faith that is not limited to the enumerated factors in Policy, paragraph 4(b). See *Do The Hustle, LLC v. Tropic Web*, WIPO Case No. [D2000-0624](#).

First, Complainant contends that since Complainant has developed a distinctive and widely recognized reputation in the BENEFITFOCUS trademark, Respondent was no doubt aware of the BENEFITFOCUS Mark and intentionally targeted them in making their decision to configure and register the disputed domain name essentially identical to Complainant's BENEFITFOCUS Mark except for a single letter intentional misspelling.

Given the widespread recognition of Complainant's BENEFITFOCUS Mark worldwide shown in the evidence noted under Section 4 above, including the United States, where Respondent appears to be located, the decades of registered use of the BENEFITFOCUS Mark prior to Respondent's assumed registration of the disputed domain name on February 27, 2023, Respondent likely had actual knowledge of Complainant's rights when it registered the disputed domain name, which shows bad faith registration. See *Alstom v. Domain Investments LLC*, WIPO Case No. [D2008-0287](#); see also *Accor v. Kristen Hoerl*, WIPO Case No. [D2007-1722](#).

Further the facts set forth above make it reasonable for the Panel to conclude it is more likely than not that Respondent targeted Complainant's trademark to use it to trade on Complainant's reputation and goodwill, and Respondent is found, therefore, to have registered and used the disputed domain name in bad faith. See *Tudor Games, Inc. v. Domain Hostmaster, Customer ID No. 09382953107339 dba Whols Privacy Services Pty Ltd / Domain Administrator, Vertical Axis Inc.*, WIPO Case No. [D2014-1754](#).

Second, as noted in 6B above, Respondent is passively holding the disputed domain name based on the browser flag it generates: "This site can't be reached" which represents either non-use or linking to an inactive website. Complainant contends that the disputed domain name has never resolved to an active page, as it has remained inactive since its registration. Prior UDRP panels have found under the doctrine of passive holding that the word bad faith "use" in the context of paragraph 4(a)(iii) does not require a positive act on the part of Respondent – instead, passively holding a domain name can constitute a factor in finding bad faith registration and use pursuant to Policy paragraph 4(a)(iii). [WIPO Overview 3.0](#), Section 3.3. See *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#); see also *Alitalia-Linee Aeree Italiane S.p.A v. Colour Digital*, WIPO Case No. [D2000-1260](#).

The disputed domain name here is confusingly similar to Complainant's BENEFITFOCUS Mark, and Respondent has made no use of the disputed domain name, factors which this Panel agrees with prior decisions should be duly considered in assessing bad faith registration and use. See *DCI S.A. v. Link Commercial Corp.*, WIPO Case No. [D2000-1232](#) (concluding respondent's passive holding of the domain name satisfies Policy paragraph 4(a)(iii)).

Third, bad faith use also seems especially appropriate given the totality of facts here. Respondent registered the disputed domain name in 2023, 23 years after Complainant began using its BENEFITFOCUS Mark, Respondent failed to submit a response or to provide any evidence of actual or contemplated good-faith use of the disputed domain name. Complainant's BENEFITFOCUS Mark has grown in recognition to the level of worldwide recognition, supporting the implausibility of any good faith use to which the disputed domain name may now be put. The factors present here are well-settled as supporting a finding of bad faith use for passive holding or non-use of a disputed domain name that is confusingly similar to a complainant's mark. See, *Instagram, LLC v. Asif Ibrahim*, WIPO Case No. [D2020-2552](#); [WIPO Overview 3.0](#), Section 3.3.

The Panel finds Complainant's arguments and evidence persuasive and has received no arguments or evidence from Respondent to the contrary. Considering all the circumstances, the Panel concludes that Respondent has registered and used the disputed domain name in bad faith and Complainant has satisfied paragraph 4(a)(iii) 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 <benetitfocus.com> be transferred to Complainant.

*/Scott R. Austin/*

**Scott R. Austin**

Sole Panelist

Date: May 8, 2023