

ADMINISTRATIVE PANEL DECISION

LexisNexis Risk Solutions Inc. v. Privacy service provided by Withheld for Privacy ehf / Tim Baxter
Case No. D2022-1759

1. The Parties

The Complainant is LexisNexis Risk Solutions Inc., United States of America (“United States”), represented by Nelson Mullins Riley and Scarborough LLP, United States.

The Respondent is Privacy service provided by Withheld for Privacy ehf, Iceland / Tim Baxter, United States.

2. The Domain Name and Registrar

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

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on May 16, 2022 involving the Disputed Domain Name and other two domain names.¹ On May 16, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On May 16, 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 August 23, 2022, providing again 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 August 29, 2022.

The Center verified that the Complaint together with the amended Complaints satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the “Policy” or “UDRP”), the Rules for

¹ On May 16, 2022, the Center also transmitted by email to another registrar a request for registrar verification in connection with the other two domain names. On May 24, 2022, this registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the other two domain names, which differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to the Complainant on May 30, 2022, providing the registrant and contact information disclosed by this registrar, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed an amended Complaint on June 1, 2022. The registrant of the other two domain names and the Complainant subsequently settled these two domain names, and they were removed from the current proceeding on August 23, 2022.

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 August 30, 2022. In accordance with the Rules, paragraph 5, the due date for Response was September 19, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on September 26, 2022.

The Center appointed Colin T. O'Brien as the sole panelist in this matter on September 29, 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

Founded in 1997, the Complainant, LexisNexis Risk Solutions Inc., is a global data and analytics company that provides data and technology services, analytics, predictive insights, and fraud prevention for a wide range of industries. The Complainant has offices throughout the United States as well as in Australia, Brazil, China, Hong Kong, China, India, Ireland, Israel, the Philippines, and the United Kingdom.

The Complainant’s customers include businesses within the insurance, financial services, healthcare, and corporate sectors as well as the local, state, and federal government, law enforcement and public safety.

The Complainant’s predecessor in interest applied and obtained the VITALCHEK trademark, United States federal trademark registrations Reg. No. 1760462 (issued March 23, 1993) and Reg. No. 1763486 (issued April 6, 1993) for the trademark  VitalChek (the “VITALCHEK Marks”). The Complainant’s United States registrations for the VITALCHEK Marks are incontestable under 15 U.S.C. § 1065.

The Complainant’s predecessor in interest registered the <vitalchek.com> domain name on August 22, 1995.

The Respondent’s Disputed Domain Name <vitalchek-online.com> was registered on October 14, 2021, and was previously used to host a website allegedly offering vital record procurement services similar to the Complainant’s services at the time of filing of the Complaint.

5. Parties’ Contentions

A. Complainant

The Complainant’s customers include businesses within the insurance, financial services, healthcare, and corporate sectors as well as the local, state, and federal government, law enforcement and public safety officials.

The Complainant has provided under the VITALCHEK Marks a convenient service that allows customers to order official copies or replacements of government-issued birth, death, marriage, and divorce records easily and securely.

The Complainant obtained its common law rights in the VITALCHEK Marks nearly thirty-five (35) years before the Respondent registered the Disputed Domain Name and obtained its registered rights in the VITALCHEK Mark around thirty (30) years before Respondent registered the Disputed Domain Name. The Complainant had valid and existing rights in the VITALCHEK Marks that existed prior to and at the time the Respondent registered the Disputed Domain Name.

The Disputed Domain Name wholly incorporates the VITALCHEK Marks plus the additional non-distinctive term “-online.” The addition of this term does not prevent the Disputed Domain Name from being confusingly similar to the Complainant’s VITALCHEK Marks.

The Respondent is not commonly known by, and is not likely to be known by, the Complainant’s well-known and distinctive VITALCHEK Marks and there is nothing in the record to date to indicate otherwise. A publicly available search of the Whois record also shows that the Respondent has never been commonly known by the Disputed Domain Name, and thus, lacks rights and legitimate interest in the Disputed Domain Name.

The Complainant has not authorized the Respondent to use the distinctive VITALCHEK Marks nor is the Respondent a licensee of the VITALCHEK Marks, which is owned exclusively by the Complainant.

The Respondent cannot assert that it has been using the Disputed Domain Name, prior to any notice of the present dispute, in connection with a *bona fide* offering of goods or services or that the Respondent has made demonstrable preparation to do so, in accordance with paragraph 4(c)(i) of the Policy.

The Respondent’s bad faith registration and use of the Disputed Domain Name is evidenced by the fact that the Respondent (i) registered the Disputed Domain Name primarily for the purpose of disrupting the business of a competitor under paragraph 4(b)(iii) of the Policy, and (ii) is attracting, for commercial gain, Internet users to the website, by creating a likelihood of confusion with the Complainant’s VITALCHEK Marks as to the source, sponsorship, affiliation, or endorsement of the websites under paragraph 4(b)(iv) of the Policy.

B. Respondent

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

6. Discussion and Findings

A. Identical or Confusingly Similar

The Complainant has demonstrated it owns registered trademark rights to the VITALCHEK Marks on the United States Principal Register. The addition of the term “-online” does not prevent a finding of confusing similarity as the Complainant’s VITALCHEK mark is clearly recognizable in the Disputed Domain Name. See section 1.8 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”).

Accordingly, the Disputed Domain Name is confusingly similar to the marks in which the Complainant has rights.

B. Rights or Legitimate Interests

The Complainant has presented a *prima facie* case that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name and has not been commonly known by the Disputed Domain Name. The fact that the Respondent obtained the Disputed Domain Name decades after the Complainant had begun using its VITALCHEK mark indicates that the Respondent sought to piggyback on the mark for illegitimate reasons, namely, create confusion and directly compete by drawing customers away with a similar mark. Further, the disputed domain name has been used to host a website allegedly offering vital record procurement services similar to the Complainant’s services.

After a complainant has made a *prima facie* case, the burden of production shifts to a respondent to present evidence demonstrating its rights or legitimate interests in the domain name. See, e.g., *Croatia Airlines d.d. v. Modern Empire Internet Ltd.*, WIPO Case No. [D2003-0455](#). Here, the Respondent has provided no evidence of any rights or legitimate interests in the Disputed Domain Name.

In the absence of any evidence rebutting the Complainant's *prima facie* case indicating the Respondent's lack of rights or legitimate interests in respect of the Disputed Domain Name, the Panel finds that the Complainant has satisfied paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

The Panel finds that the Complainant has satisfied its burden of proof in establishing the Respondent's bad faith in registration and use of the Disputed Domain Name. Paragraph 4(b)(iv) of the Policy states that evidence of bad faith may include a respondent's use of a domain name to intentionally attempt to attract Internet users, for commercial gain.

Due to the longstanding use and long-established registered rights in the VITALCHEK Marks, it is inconceivable that the Respondent registered the Disputed Domain Name without knowledge of the VITALCHEK Marks. The Disputed Domain Name, which incorporates the Complainant's VITALCHEK trademark in its entirety, is used for a website that was allegedly offering services identical to those offered by the Complainant, but the Complainant has established that the Respondent is not authorized to use the VITALCHEK Marks, nor is affiliated with the Complainant in any way. The facts establish a deliberate effort by the Respondent to cause confusion with the Complainant for commercial gain. Moreover, UDRP panels have consistently found that the mere registration of a domain name that is confusingly similar (particularly domain names incorporating the mark plus a descriptive term) to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith (see section 3.1.4 of the [WIPO Overview 3.0](#)). Under these circumstances, the Panel finds no plausible good faith reason for the Respondent's conduct and concludes that the Disputed Domain Name has been registered and used in bad faith.

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 <vitalchek-online.com> be transferred to the Complainant.

/Colin T. O'Brien/

Colin T. O'Brien

Sole Panelist

Date: October 13, 2022