

## **ADMINISTRATIVE PANEL DECISION**

**Benefitfocus.com, Inc. v. Privacy Service Provided by Withheld for Privacy ehf / Amy Sutherland**  
**Case No. D2022-1857**

### **1. The Parties**

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

The Respondent is Privacy Service Provided by Withheld for Privacy ehf, Iceland / Amy Sutherland, United States.

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

The disputed domain name <benefitfocus.online> 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 23, 2022. On May 24, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On May 24, 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 May 25, 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 amended Complaint on May 25, 2022.

The Center verified that the Complaint together with the amended 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 1, 2022. In accordance with the Rules, paragraph 5, the due date for Response was June 21, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on June 22, 2022.

The Center appointed William F. Hamilton as the sole panelist in this matter on July 1, 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 a health benefits administration technology company founded in 2000 to provide services to employers, health plans, and employees. The Complainant currently provides services to 25 million individuals in the United States and other countries.

The Complainant operates its principal website at the domain <benefitfocus.com>.

The Complainant holds numerous trademark registrations for the mark BENEFITFOCUS (the “Mark”) with the United States Patent and Trademark Office, the earliest of which is Reg. No. 24966059, dated October 9, 2001.

The disputed domain name was registered on July 11, 2022. The disputed domain name resolves to a website offering pay-per-click links to other websites purporting to offer employee health insurance, benefits, and related products similar to the services and products offered by the Complainant.

The Complainant sent a “cease and desist” letter to the Respondent on April 21, 2022.

#### **5. Parties’ Contentions**

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

The Complainant asserts the disputed domain name is confusingly similar to the Mark because the disputed domain name entirely adopts the Mark followed only by the general Top-Level Domain (“gTLD”) “online.”

The Complainant asserts that the Complainant never authorized the Respondent to use the disputed domain name, that the Respondent is not generally known by the disputed domain name, and that the Respondent has never engaged in any *bona fide* commercial activity in connection with the disputed domain name.

The Complainant asserts that the disputed domain name was registered to confuse and lure unsuspecting Internet users to the Respondent’s website where the Respondent provides pay-per-click links to alternative websites purportedly offering similar services to the services offered by the Complainant. The Complainant also asserts that the disputed domain name is configured with MX capabilities which may be used send fraudulent emails with the goal of phishing information from unsuspecting persons.

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

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

#### **6. Discussion and Findings**

Under paragraph 4(a) of the Policy, to succeed the Complainant must satisfy the Panel that:

- (i) the disputed domain name is identical 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; and,

(iii) the disputed domain name was registered and is being used in bad faith.

#### **A. Identical or Confusingly Similar**

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

The disputed domain name is composed only of the Complainant's Mark followed by the gTDL ".online." The gTLD of the disputed domain name, in this case ".online", may be disregarded for the purposes of assessment under the first element, as it is viewed as a standard registration requirement. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.11.1.

The Complainant has met its burden under paragraph 4(a)(i) of the Policy.

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

The Panel finds that the Respondent has no rights or legitimate interests in the disputed domain name.

The Complainant has specifically disavowed providing the Respondent with permission to use the disputed domain name or the Mark. The Respondent is not affiliated with the Complainant and does not have any business relationship with the Complainant. There is no evidence that the Respondent has conducted any *bona fide* business under the disputed domain name or is commonly known by the disputed domain name. *Compagnie de Saint Gobain v. Com-Union Corp.*, WIPO Case No. [D2000-0020](#).

The Complainant has thus established a *prima facie* case in its favor, which shifts the burden of production on this point to the Respondent. The Respondent, however, has failed to come forth with any evidence showing any rights or legitimate interests in the disputed domain name.

Furthermore, the nature of the disputed domain name, which unabashedly adopts the Mark in its entirety, carries a risk that Internet user will assume the disputed domain name resolves to a website sponsored or affiliated with the Complainant. See [WIPO Overview 3.0](#), section 2.5.1.

The facts and circumstances presented to the Panel demonstrate that the Respondent does not have any rights or legitimate interests in the disputed domain name. The Complainant has met its burden under paragraph 4(a)(ii) of the Policy.

#### **C. Registered and Used in Bad Faith**

Under paragraph 4(b) of the Policy, bad faith may be established by any one of the following scenarios:

(i) circumstances indicating that the respondent has registered or acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name 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 the respondent's documented out-of-pocket costs directly related to the domain name; or

(ii) the respondent has 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 the respondent has engaged in a pattern of such conduct; or

(iii) the respondent has registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, the respondent has intentionally attempted to attract, for commercial gain, Internet users to its website 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 the respondent's website or location or of a product or service on the respondent's website or location.

The Panel finds the disputed domain name was registered and is being used in bad faith.

A simple Internet search, normally undertaken before registering a domain name, would have disclosed the Complainant's Mark. The Mark is not a common or descriptive term. It is a coined expression. Purported willful blindness does not avoid a finding of bad faith registration and use.

Beyond any willful blindness, it is apparent that such an Internet search by the Respondent was not undertaken because there is little doubt that the Respondent was aware of the Complainant's Mark when registering the disputed domain name as shown by the fact that the Respondent's website features classic pay-per-click links to websites purportedly offering the same products and services as the Complainant.

Finally, even if these obvious conclusions are disregarded, it is difficult to conceive of any use that the Respondent might make of the disputed domain name without the Complainant's consent that would not involve bad faith. See, e.g., *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. D2000-0003.

The Complainant has met its burden under 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 <benefitfocus.online> be transferred to the Complainant.

*/William F. Hamilton/*

**William F. Hamilton**

Sole Panelist

Date: July 14, 2022