

ADMINISTRATIVE PANEL DECISION

UHS of Delaware, Inc. v. Sola Mustapha, Tzuriel Technologies Inc
Case No. D2022-3940

1. The Parties

Complainant is UHS of Delaware, Inc., United States of America (“United States” or “U.S.”), represented by Williams Mullen, P.C., United States

Respondent is Sola Mustapha, Tzuriel Technologies Inc, United States.

2. The Domain Name and Registrar

The disputed domain name <prominencehealth.org> is registered with GoDaddy.com, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on October 20, 2022. On October 21, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On October 24, 2022, 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 October 27, 2022. In accordance with the Rules, paragraph 5, the due date for Response was November 16, 2022. An informal Response was filed with the Center on October 27, 2022.

The Center appointed Scott R. Austin as the sole panelist in this matter on November 23, 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

Complainant states in its Complaint and provides evidence in the respective Annexes sufficient to support that Complainant is one of the largest providers of hospital, healthcare, and medical services in the United States as well as healthcare insurance plans and related services offered online and in-person at six office locations under the trademark PROMINENCE and the same term incorporated into its trademark “PROMINENCE HEALTH PLAN” (collectively the “PROMINENCE Marks”). Complainant also incorporates the PROMINENCE Marks into its registered domain name <prominencehealthplan.com>, registered on April 8, 2014, used to promote the same hospital, healthcare and medical services on its official website at “www.prominencehealthplan.com” (the “Official PROMINENCE Marks Website”).

Complainant has used the PROMINENCE Marks for a range of healthcare, medical, and health insurance services for over 8 years and owns multiple trademark registrations in the U.S., including U.S. Trademark Registration No. 4846923 PROMINENCE HEALTH PLAN, registered on November 3, 2015, and claiming a first use date of July 1, 2014.

The disputed domain name was registered on May 5, 2021 and resolves to a parked page that includes links to Complainant’s competitors and listed online for sale at a price of USD \$9,888.

5. Parties’ Contentions

A. Complainant

Complainant contends that the disputed domain name is identical or 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 file a formal Response in reply to Complainant’s contentions but as noted above filed an informal Response indicating an interest in settling the case, albeit for a claimed reimbursement fee.

6. Discussion and Findings

There are no exceptional circumstances within paragraph 5(e) 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. Procedural Matter: Consideration of Respondent's Unsolicited Informal Communication

The Panel has also reviewed the informal communications Respondent sent to the Center on October 27, 2022. In an email on October 27, 2022, the Center received a submission from an email address associated with Respondent as confirmed by the Registrar for the disputed domain name after the Complaint was filed.

The email stated: "Hi, Thanks for the update. As you noted below:

Should the Parties wish to settle this dispute (in which case USD 1,000 will be refunded to the Complainant), a copy of WIPO's Standard Settlement Form is attached. The form is not intended to be an agreement itself, but only summarizes the outcome of the parties' settlement talks. Can we settle this dispute without having to go through the UDRP process? That way, the complaint could just reimburse me the \$1,000 for my company's investment in this domain without having to go through a lengthy legal process. I would like us to settle this amicably. We're a small domain investing firm.

Thank you!

Best regards,

Sola"

This email was received after the disputed domain name had been locked by the Registrar and will be treated as coming from Respondent; the Panel notes however that Complainant chose to forego settlement, never responding to the email or filing the referenced settlement form, resulting in this proceeding moving forward. The Panel finds Respondent's email is not in the form of a formal response including the oath or affirmation required for the filing of a "formal response", but it has been considered nonetheless.

B. 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 PROMINENCE Marks for its hospital, medical, and healthcare insurance plan services in its registrations for the PROMINENCE Marks dating back to 2014. 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 PROMINENCE Marks. See *Advance Magazine Publishers Inc., Les Publications Conde Nast S.A. v. Voguechen*, WIPO Case No. [D2014-0657](#).

With Complainant's rights in the PROMINENCE Marks 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 PROMINENCE Marks. 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 essentially identical to the PROMINENCE Marks as well as the domain name used for Complainant's Official PROMINENCE Marks Website. Complainant's PROMINENCE Mark is incorporated in its entirety and the dominant feature of Complainant's registered PROMINENCE HEALTH PLAN Mark is incorporated into the disputed domain name followed only by the Top-Level Domain ("TLD") ".org". 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; see also *L'Oréal v Tina Smith*, WIPO Case No. [D2013-0820](#).

Based on the above, this Panel finds that neither the omission of the trailing term “plan” from Complainant’s registered PROMINENCE HEALTH PLAN Mark nor the TLD “.org” would prevent a finding of confusing similarity between the disputed domain name and Complainant’s well-known PROMINENCE Marks, which is essentially identical as incorporated into the disputed domain name. Accordingly, the Panel finds the disputed domain name confusingly similar or identical to the PROMINENCE Marks in which Complainant has rights and Complainant has satisfied its burden under Paragraph 4(a)(i) of the Policy.

C. Rights or Legitimate Interests

Under the second element of the Policy, the complainant has to make out a *prima facie* case that the respondent does not have rights to or legitimate interests in the disputed domain name, upon which the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights to or legitimate interests in the dispute domain name. If the respondent fails to come forward with such evidence, a complainant is deemed to have satisfied the second element.

[WIPO Overview 3.0](#), section 2.1. See also *The American Automobile Association, Inc. v. Privacy--Protect.org et al.*, WIPO Case No. [D2011-2069](#).

Paragraph 4(a)(ii) of the Policy also directs an examination of the facts to determine whether a respondent has rights or legitimate interests in a domain name. Paragraph 4(c) lists a number of ways in which a respondent may demonstrate that it does have such rights or interests.

The first example, under paragraph 4(c)(i), is where “before any notice to you of the dispute, your use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a *bona fide* offering of goods or services”.

Here, the annex to the Complaint shows the disputed domain name resolves to a parking page targeting Complainant’s field of activity with links to competitors. Complainant contends these links were created to trick Internet users into believing that the disputed domain name would direct them to an official website offering Complainant’s products and services.

Prior UDRP panels have specifically found use of a disputed domain name to resolve to a parking page competing with or capitalizing on Complainant’s trademark does not represent a *bona fide* use of the disputed domain name pursuant to paragraph 4(c)(i) nor a legitimate noncommercial or fair use pursuant to paragraph 4(c)(iii). See *Microsoft Corporation v. Charilaos Chrischoou*, WIPO Case No. [D2004-0186](#); [WIPO Overview 3.0](#), section 2.9.

Based on the foregoing decisions and evidence submitted, this Panel finds the disputed domain name is not being used in connection with a *bona fide* offering of goods or services nor a legitimate noncommercial or fair use sufficient to demonstrate Respondent has any rights or legitimate interests in the disputed domain name under the factors specified by paragraphs 4(c)(i) or (c)(iii) of the Policy.

Complainant’s evidence of use in the Complaint as amended, also supports Complainant’s contention that Respondent cannot claim prior rights or legitimate interest in the disputed domain name because Complainant’s use of the PROMINENCE Marks precedes the registration of the disputed domain name by over 8 years.

The second example, under paragraph 4(c)(ii), is a scenario in which a respondent is commonly known by the domain name. Complainant states that Respondent is not related in any way to Complainant, does not carry out any activity for, nor have any business with Respondent. Neither has Complainant granted Respondent any license, permission, or authorization to use the PROMINENCE Marks, that are used and clearly recognizable in the disputed domain name or to apply for registration of the disputed domain name. Prior UDRP panels have found a lack of rights or legitimate interests under the second element of the Policy

based on such circumstances. See, e.g., *Charles Schwab & Co., Inc. v. Josh Decker d/b/a I GOT YOUR TIX*, WIPO Case No. [D2005-0179](#); *Guerlain S.A. v. H I Investments*, WIPO Case No. [D2000-0494](#).

Complainant also shows that Respondent is not commonly known by the disputed domain name because the Registrar identified the underlying registrant information in its verification process as Sola Mustapha, or registrant organization Tzuril Technologies Inc of the United States, which name and address Complainant named as Respondent in its amended Complaint. Respondent does not bear any resemblance to the disputed domain name whatsoever. Thus, there is no evidence in this case to suggest that Respondent is commonly known by the disputed domain name, that it is licensed or otherwise authorized to use Complainant's trademark, or that it has acquired any trademark rights relevant thereto. As such, the Panel finds this sub-section of the Policy is of no help to Respondent and the facts presented here support a finding of a lack of rights or legitimate interests in the disputed domain name. See *Confédération nationale du crédit mutuel v. Yu Ke Rong*, WIPO Case No. [D2018-0948](#); *Expedia, Inc. v. Dot Liban, Hanna El Hinn*, WIPO Case No. [D2002-0433](#).

Prior UDRP panels have also found that "use which intentionally trades on the fame of another cannot constitute a *bona fide* offering of goods or services. To conclude otherwise would mean that a Respondent could rely on intentional infringement to demonstrate a legitimate interest, an interpretation that is obviously contrary to the intent of the Policy". See *In Advance Magazine Publishers, Inc. v. Lisa Whaley*, WIPO Case No. [D2001-0248](#) (finding that "intentionally infringing use should not be viewed as *bona fide* use"). The disputed domain name clearly features unauthorized use of terms that are confusingly similar to Complainant's PROMINENCE Marks and its domain name used for the Official PROMINENCE Marks Website. Thus, Respondent is not making a legitimate noncommercial or fair use of the disputed domain name without intent for commercial gain.

Moreover, the nature of the disputed domain name, being essentially identical to Complainant's PROMINENCE Marks, carries a high risk of implied affiliation. [WIPO Overview 3.0](#), section 2.5.1; see also *Tata Sons Limited v. TATA Telecom Inc/Tata-telecom.com, Mr. Singh*, WIPO Case No. [D2009-0671](#).

In light of the above, and with no (formal) Response or other submission in this case to rebut Complainant's assertions and evidence, the Panel finds that the facts of this case demonstrate that Respondent has no rights or legitimate interests in the disputed domain name. Complainant has successfully met its burden under paragraph 4(a)(ii) of the Policy.

D. 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](#).

Complainant contends that there is no other explanation for Respondent to register the disputed domain name other than to target Complainant. Given its PROMINENCE Marks are well-known in their industry in the United States, and the disputed domain name incorporates essentially identical terms in their entirety, the Panel finds bad faith registration based on Respondent's actual knowledge of the PROMINENCE Marks given its widespread recognition in the United States where Respondent is located, and where the mark has been in use and registered for many years before Respondent registered the disputed domain name. Prior UDRP panels have found that where it would be implausible to believe that Respondent selected and was using the disputed domain name for any purpose other than to trade on Complainant's trademark rights and reputation, establishes a fact pattern that repeatedly has been held to constitute bad faith registration.

See *Alstom v. Domain Investments LLC*, WIPO Case No. [D2008-0287](#); see also *Houghton Mifflin Co. v. Weathermen, Inc.*, WIPO Case No. [D2001-0211](#).

Prior UDRP panels have also found where a respondent's actions indicate that respondent's primary intent with respect to the disputed domain name is to trade off the value of Complainant's Marks, constitutes bad faith. See *Herbalife International, Inc. v. Surinder S. Farmaha*, WIPO Case No. [D2005-0765](#).

Given the widespread recognition of Complainant's PROMINENCE Marks in the United States, where Respondent is located, and decades of use of the PROMINENCE Marks prior to Respondent's registration of the disputed domain name on May 5, 2021, the use of the disputed domain name has been to cause confusion with Complainant and therefore, the use and registration of the disputed domain name must be considered to be in bad faith. See *Empresa Brasileira de Telecomunicações S.A. Embratel v. Kevin McCarthy*, WIPO Case No. [D2000-0164](#).

Prior UDRP panels have also held that a respondent's selection of a disputed domain name that comprises the complainant's mark in its entirety may demonstrate a respondent's actual knowledge to support a finding of bad faith in registering and using the domain. See, e.g., *Lloyds Bank Plc v. Marc Wiese*, WIPO Case No. [D2015-0914](#); see also, *Heineken Brouwerijen B.V. v Mark Lott*, WIPO Case No. [D2000-1487](#). Moreover, panels have consistently found that the mere registration of a domain name that is identical or confusingly similar to a famous or widely known trademark by an unaffiliated entity can by itself create a presumption of bad faith. See [WIPO Overview 3.0](#), section 3.1.4.

As found by prior UDRP panels, use of the disputed domain name for a parking page competing with or capitalizing on Complainant's trademark demonstrates an indication that Respondent intentionally attempted to attract, for commercial gain, Internet users to its disputed domain name, by creating a likelihood of confusion with Complainant's PROMINENCE Marks as to the source, sponsorship, affiliation or endorsement of Respondent, and, therefore is evidence of registration and use of the disputed domain name in bad faith under paragraph 4(b)(iv) of the Policy. See *Association des Centres Distributeurs E. Leclerc - A.C.D Lec v. Milen Radumilo*, WIPO Case No. [D2017-2003](#).

Finally, Complainant has submitted evidence from a reverse Whois search to show that Respondent has systematically engaged in the business of registering thousands of domain names, a number of which appear to potentially incorporate the trademarks of others, to support Complainant's contention that Respondent is a serial cybersquatter that has registered the disputed domain name in bad faith. See, e.g., *American Airlines, Inc. v. Super Privacy Service LTD c/o Dynadot / Milen Radumilo*, WIPO Case No. [D2021-1242](#).

The Panel finds Complainant's arguments and evidence persuasive and has received no formal Response or 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, <prominencehealth.org> be transferred to Complainant.

/Scott R. Austin/

Scott R. Austin

Sole Panelist

Date: December 7, 2022