

## **ADMINISTRATIVE PANEL DECISION**

Fox Media LLC v. Bill Biersdorf

Case No. D2022-4600

### **1. The Parties**

The Complainant is Fox Media LLC, United States of America (“United States”), represented by Greenberg Traurig, LLP, United States.

The Respondent is Bill Biersdorf, United States.

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

The disputed domain name <fox.org> is registered with Network Solutions, LLC (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on December 1, 2022. On December 2, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On December 6, 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 (REDACTED FOR PRIVACY, Fox Research Institute) and contact information in the Complaint. The Center sent an email communication to the Complainant on December 8, 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 December 12, 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 December 13, 2022. In accordance with the Rules, paragraph 5, the due date for Response was January 2, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on January 5, 2023.

The Center appointed William F. Hamilton as the sole panelist in this matter on January 10, 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.

On January 27, 2023, the Panel issued Administrative Panel Procedural Order No. 1. The Panel noted that all relevant means of communications proscribed by the Rules were employed by the Center when formally notifying the Respondent of the Complaint and that the Center's case notification obligations had been duly satisfied. In reviewing the nearly 150 pages of annexes appended to the case file however, the Panel observed that in a cease-and-desist letter sent by the Complainant to the Respondent's Registrar-confirmed email address, the Complainant included an alternate possible email address for the Respondent.

The Panel notes that the Complainant's investigation showed the Respondent seems to have previously worked for the University of South Florida (USF). It is also noted that the Respondent did not reply to the either Complainant's cease-and-desist letter or its reminder using the USF email address.

Out of an abundance of caution, the Panel instructed the Center to provide notice of the present dispute to the Respondent using the email address "[...]@usf.edu" and granted the Respondent a three (3) day period (through January 30, 2023) in which to indicate whether it wished to participate to this proceeding. The Panel extended the Decision due date to at least February 1, 2023. The Respondent did not submit any Response or otherwise communicate in respect of the case.

#### **4. Factual Background**

The Complainant, a wholly owned subsidiary of Fox Corporation, is a one of the world's largest entertainment and media companies. The Complainant owns and operates 28 full power broadcast television stations in the United States that distribute sports, entertainment, and syndicated content including 1,000 hours of local news every week.

The Complainant owns numerous registrations around the world for the trademark FOX (the "Mark"). While the Complainant's first registration of the Mark with the United States Patent and Trademark Office was obtained on November 30, 1993, the Complainant and its predecessor companies have used the Mark for over 100 years since 1915. The Complainant owns and operates the domain names <fox.com>, <foxnews.com>, and <foxsports.com> (in addition to numerous other domains incorporating the term "Fox").

The disputed domain name was registered on May 18, 1996. The disputed domain name does not resolve to an active website but was used in a fraudulent email scheme.

#### **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") ".org".

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 also asserts that email accounts related to the disputed domain name were used to send fraudulent emails with the goal of phishing information from unsuspecting persons by impersonating Complainant's employee.

## **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 gTLD ".org". The gTLD of the disputed domain name, in this case ".org", 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 to 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.

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 any Internet user would assume the disputed domain name resolves to a website sponsored or affiliated with the Complainant. [WIPO Overview 3.0](#), section 2.5.1. Moreover, rights or legitimate use of the dispute domain name cannot be established by fraudulent email conduct associated with the disputed domain name. Prior UDRP panels have held that the use of a domain name for illegal activity, such as phishing, unauthorized account access/hacking, impersonation/passing off, or other types of fraud, can never confer rights or legitimate interests on a respondent. See section 2.13, [WIPO Overview 3.0](#).

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.

First, the Mark is extremely well-known in the United States, and the Respondent is listed with the Registrar as having a Florida, United States address. It strains credulity to believe that the Respondent was not aware of the Mark and the Complainant's services when registering the disputed domain name.

Second, the Complainant has submitted evidence tending to show that the disputed domain name was utilized in connection with a phishing attempt. See amended Complaint, Annexes 14 and 15. Such improper use of a domain name is paradigmatic evidence of bad faith. *National Westminster Bank plc. v. Sites / Michael Vetter*, WIPO Case No. [D2013-0870](#) (phishing constitutes bad faith use).

Moreover, the Panel finds that the Respondent's use of the disputed domain name to perpetuate a fraud by sending phishing emails while impersonating the Complainant's employee, amounts to use in bad faith for purposes of paragraph 4(b) of the Policy.

Prior UDRP panels have held that "given that the use of a domain name for per se illegitimate activity such as the sale of counterfeit goods or phishing can never confer rights or legitimate interests on a respondent, such behavior is manifestly considered evidence of bad faith". See section 3.1.4, [WIPO Overview 3.0](#).

Prior UDRP panels have also held that "the use of a domain name for purposes other than to host a website may constitute bad faith. Such purposes include sending email, phishing, identity theft, or malware distribution. [...] Many such cases involve the respondent's use of the domain name to send deceptive emails, e.g., to obtain sensitive or confidential personal information from prospective job applicants, or to solicit payment of fraudulent invoices by the complainant's actual or prospective customers". See section 3.4, [WIPO Overview 3.0](#).

Fourth, 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 <fox.org> be transferred to the Complainant.

*/William F. Hamilton/*

**William F. Hamilton**

Sole Panelist

Date: February 1, 2023