

ADMINISTRATIVE PANEL DECISION

Pension Benefit Guaranty Corporation v. C S, CS
Case No. D2023-4921

1. The Parties

The Complainant is Pension Benefit Guaranty Corporation, United States of America (United States), internally represented.

The Respondent is C S, CS, United Kingdom.

2. The Domain Name and Registrar

The disputed domain name <pbgcpay.net> 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 November 27, 2023. On November 30, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On November 30, 2023, the Registrar transmitted by email to the Center its verification response:

- (a) confirming the disputed domain name is registered with it;
- (b) confirming the language of the registration agreement is English; and
- (c) disclosing registrant and contact information for the disputed domain name which differed from the named Respondent (GoDaddy.com d/b/a Domains By Proxy, LLC) and contact information in the Complaint.

The Center sent an email communication to the Complainant on December 1, 2023 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 4, 2023.¹

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”).

¹ The Complainant removed one domain name from the Complaint upon receipt of the Center’s notice of multiple underlying registrants.

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on December 5, 2023. In accordance with the Rules, paragraph 5, the due date for Response was December 25, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on December 26, 2023.

The Center appointed Warwick A. Rothnie as the sole panelist in this matter on January 3, 2024. 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 United States federal government agency established in 1974 under Title IV of the Employee Retirement Income Security Act (ERISA), Pub.L. 93- 406, 88 Stat. 829 (Sept. 2, 1974). Its primary mission is to guarantee pension benefits for employees and retirees of insolvent companies and under-funded pension plans.

According to the Complainant's 2022 Annual Report, the Complainant's programs provided retirement security for over 33 million American workers, retirees, and beneficiaries. The Complainant's activities fall into two main programs: the Multiemployer Program and the Single-Employer Program. The Multiemployer Program protects about 11.2 million workers and retirees in about 1,360 pension plans. The Single-Employer Program protects about 22.3 million workers and retirees in about 23,800 pension plans.

In the 2022 fiscal year, the Complainant made benefit payments of over USD 7 billion to more than 960,000 participants.

The Complainant provides these services under its own name. The Complainant has also promoted itself and used in its corporate stationery since 1975 a "logo":



In addition, the Complainant's promotional materials and corporate communications repeatedly refer to itself by the acronym "PBGC".

The Complainant also promotes its services and provides online access to its client businesses, workers and retirees from the website at "www.pbgc.gov".

According to the WhoIs report, the disputed domain name was registered on March 13, 2020.

It does not appear to have resolved to an active website.

Despite the Respondent's address apparently being in London in the United Kingdom, the Complainant points to technical evidence showing that the disputed domain name is being hosted on a server in the United States.

5. Discussion and Findings

No response has been filed. The Complaint and Written Notice have been sent, however, to the Respondent at the electronic and physical coordinates confirmed as correct by the Registrar in accordance with paragraph 2(a) of the Rules. Bearing in mind the duty of the holder of a domain name to provide and keep up to date correct WhoIs details, therefore, the Panel finds that the Respondent has been given a fair opportunity to present his or its case.

When a respondent has defaulted, paragraph 14(a) of the Rules requires the Panel to proceed to a decision on the Complaint in the absence of exceptional circumstances. Accordingly, paragraph 15(a) of the Rules requires the Panel to decide the dispute on the basis of the statements and documents that have been submitted and any rules and principles of law deemed applicable.

Paragraph 4(a) of the Policy provides that in order to divest the Respondent of the disputed domain name, the Complainant must demonstrate each of the following:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and
- (ii) the Respondent has no rights or legitimate interests in respect of the disputed domain name; and
- (iii) the disputed domain name has been registered and is being used in bad faith.

A. Identical or Confusingly Similar

The first element that the Complainant must establish is that the disputed domain name is identical with, or confusingly similar to, the Complainant's trademark rights.

It is well accepted that the first element functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the Complainant's trademark and the disputed domain name. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, ("[WIPO Overview 3.0](#)"), section 1.7.

There are two parts to this inquiry: the Complainant must demonstrate that it has rights in a trademark at the date the Complaint was filed and, if so, the disputed domain name must be shown to be identical or confusingly similar to the trademark.

The Complainant does not hold any registered trademarks. It contends, however, that it has rights in PBGC as an unregistered trademark. See for example [WIPO Overview 3.0](#), section 1.3. In that connection, the Panel notes that the Complainant has been using the acronym in a logo-form and as a plain acronym for almost 50 years. Having regard to the length of use and its extent involving many thousands of businesses covering millions of Americans, the Panel finds the Complainant has established the public in the United States is likely to identify the Complainant by its acronym and, accordingly, the Complainant has rights in PBGC as an unregistered trademark in both the logo-form and the plain acronym.

The Panel notes this conclusion is consistent with the conclusions reached by the panels in *Pension Benefit Guaranty Corporation v. John Smith, Whois Protection Service, LLC*, WIPO Case No. [D2008-1370](#), and *Pension Benefit Guaranty Corporation v. Belize Domain WHOIS Service Lt*, WIPO Case No. [D2008-1371](#).

The second stage of this inquiry simply requires a visual and aural comparison of the disputed domain name to the proven trademarks. This test is narrower than and thus different to the question of "likelihood of confusion" under trademark law. Therefore, questions such as the scope of the trademark rights, the geographical location of the respective parties, the date they were acquired and other considerations that may be relevant to an assessment of infringement under trademark law are not relevant at this stage. Such matters, if relevant, may fall for consideration under the other elements of the Policy. See e.g., [WIPO Overview 3.0](#), section 1.1.2.

In undertaking that comparison, it is permissible in the present circumstances to disregard the generic Top-Level Domain ("gTLD") component as a functional aspect of the domain name system. [WIPO Overview 3.0](#), section 1.11.

Insofar as the Complainant's rights subsist in the logo-form, it is also usual to disregard the design elements of a trademark under the first element as such elements are generally incapable of representation in a

domain name. Where the textual elements have been disclaimed in the registration or cannot fairly be described as an essential or important element of the trademark, however, different considerations may arise. See for example, [WIPO Overview 3.0](#), section 1.10. The figurative elements of the Complainant's trademarks are not so dominating that the verbal element cannot be considered an essential or important part of the trademarks in this case. Accordingly, it is appropriate to apply the usual rule.

Disregarding the ".net" gTLD, therefore, the disputed domain name consists of the Complainant's registered trademark and the term "pay". As this requirement under the Policy is essentially a standing requirement, the addition of this term does not preclude a finding of confusing similarity. See e.g., [WIPO Overview 3.0](#), section 1.8. Apart from anything else, the Complainant's trademark remains visually and aurally recognisable within the disputed domain name.

Accordingly, the Panel finds that the Complainant has established that the disputed domain name is confusingly similar to the Complainant's trademark and the requirement under the first limb of the Policy is satisfied.

B. Rights or Legitimate Interests

The second requirement the Complainant must prove is that the Respondent has no rights or legitimate interests in the disputed domain name.

Paragraph 4(c) of the Policy provides that the following circumstances can be situations in which the Respondent has rights or legitimate interests in a disputed domain name:

- (i) before any notice to [the Respondent] of the dispute, [the Respondent's] use of, or demonstrable preparations to use, the [disputed] domain name or a name corresponding to the [disputed] domain name in connection with a *bona fide* offering of goods or services; or
- (ii) [the Respondent] (as an individual, business, or other organization) has been commonly known by the [disputed] domain name, even if [the Respondent] has acquired no trademark or service mark rights; or
- (iii) [the Respondent] is making a legitimate noncommercial or fair use of the [disputed] domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

These are illustrative only and are not an exhaustive listing of the situations in which a respondent can show rights or legitimate interests in a domain name.

While the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the often impossible task of "proving a negative", requiring information that is often primarily within the knowledge or control of the respondent. As such, where a complainant makes out a *prima facie* case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element. [WIPO Overview 3.0](#), section 2.1.

The Respondent registered the disputed domain name almost 45 years after the Complainant began using its trademark.

The Complainant states that it has not authorised the Respondent to use the disputed domain name. Nor is the Respondent affiliated with it.

The disputed domain name is not derived from the Respondent's name. Nor is there any suggestion of some other name by which the Respondent is commonly known from which the disputed domain name could

be derived. From the available record, the Respondent does not appear to hold any trademarks for the disputed domain name.

There is no evidence before the Panel of any use of the disputed domain name in connection with a good faith offering of goods or services or in some other noncommercial or fair use. Nor is there any evidence of demonstrable preparations to use the disputed domain name in connection with such activities.

On the other hand, there is evidence before the Panel that the disputed domain name has been used in connection with unauthorised attempts to probe the Complainant's website. In addition, the composition of the disputed domain name – the mark plus the services-related term “pay” – carries a risk of implied affiliation with the Complainant, and there is a very real risk that the disputed domain name could be misused to mislead businesses and employees and retirees seeking to deal with the Complainant. [WIPO Overview 3.0](#), section 2.5.1.

These matters, taken together, are sufficient to establish a *prima facie* case under the Policy that the Respondent has no rights or legitimate interests in the disputed domain name. The basis on which the Respondent has adopted the disputed domain name, therefore, calls for explanation or justification. The Respondent, however, has not sought to rebut that *prima facie* case or advance any claimed entitlement. Accordingly, the Panel finds the Complainant has established the second requirement under the Policy also.

C. Registered and Used in Bad Faith

Under the third requirement of the Policy, the Complainant must establish that the disputed domain name has been both registered and used in bad faith by the Respondent. These are conjunctive requirements; both must be satisfied for a successful complaint: See e.g., *Burn World-Wide, Ltd. d/b/a BGT Partners v. Banta Global Turnkey Ltd*, WIPO Case No. [D2010-0470](#).

The Panel notes that, for the purposes of paragraph 4(a)(iii) of the Policy, paragraph 4(b) of the Policy establishes circumstances, in particular, but without limitation, that, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith.

The Complainant points out that there is a high risk of confusion because the root of the disputed domain name is identical to the Complainant's widely used acronym. Moreover, as discussed in Section 5B above, there does not appear to be any connection between the acronym “pgbc” and the Respondent, the Respondent's name or some (undisclosed) goods or services the Respondent is offering or proposing to offer. In these circumstances, the Complainant contends that the disputed domain name has been registered in connection with a scheme to mislead the public into wrongly associating the disputed domain name with the Complainant or otherwise engage in illegal activity.

Insofar as the disputed domain name may now be regarded as “dormant”, the Complainant invokes the well-known principle from *Telstra Corporation v Nuclear Marshmallows* WIPO Case No. [D2000-0003](#).

Given the close resemblance of the disputed domain name to the Complainant's trademark, there is a very real risk that the disputed domain name could be used to mislead the public. The disputed domain name is in effect an “instrument of fraud” in the sense originally explained by Adous LJ in *British Telecommunications Plc and Others v. One In A Million Ltd* [1998] EWCA Civ 1272 and decisions under the Policy such as *Skyscanner Limited v. Contact Privacy Inc. Customer 1244355693 / Mrs. K Ananthan* WIPO Case No. [D2019-0988](#) and *Warwickshire Oil Storage Limited v. WWOSLTD* WIPO Case No. [D2016-1482](#). Moreover, as already noted, the Respondent has not attempted to rebut the allegations or otherwise explain its conduct. Considering the circumstances of the case, the Panel finds the non-use of the disputed domain name does not prevent a finding of bad faith. [WIPO Overview 3.0](#), section 3.3.

In light of the foregoing, the Panel finds that the disputed domain name has been registered and used in bad faith.

Based on the available record, the Panel finds that the Complainant has established the third element of the Policy.

6. 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 <pbgcpay.net> be transferred to the Complainant.

/Warwick A. Rothnie/

Warwick A. Rothnie

Sole Panelist

Date: January 16, 2024