

ADMINISTRATIVE PANEL DECISION

Elsevier Inc. v. Hal Vanderstein, duncan wang
Case No. D2024-1710

1. The Parties

The Complainant is Elsevier Inc., United States of America ("United States"), represented by Nelson Mullins Riley & Scarborough, L.L.P., United States.

The Respondents are Hal Vanderstein, United States, and duncan wang, United States.

2. The Domain Names and Registrar

The disputed domain names <hesi-a2.com>, <hesi-cat-testbank.com>, <hesi-test-bank.com> are registered with Internet Domain Service BS Corp (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on April 23, 2024. On April 24, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On April 25, 2024, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain names which differed from the named Respondent (Domain Admin, Whois Privacy Corp.) and contact information in the Complaint.

The Center sent an email communication to the Complainant on April 25, 2024, with the registrant and contact information of nominally multiple underlying registrants revealed by the Registrar, requesting the Complainant to either file separate complaint(s) for the disputed domain names associated with different underlying registrants or alternatively, demonstrate that the underlying registrants are in fact the same entity and/or that all domain names are under common control. The Complainant filed an amended Complaint on April 26, 2024.

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 Respondents of the Complaint, and the proceedings commenced on May 1, 2024. In accordance with the Rules, paragraph 5, the due date for Response was May 21, 2024. The Respondents did not submit any response. Accordingly, the Center notified the Parties of the Respondents' default on May 29, 2024.

The Center appointed Ingrīda Kariņa-Bērziņa as the sole panelist in this matter on June 7, 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 Delaware corporation that offers publishing services. In 2006, the Complainant acquired Health Education Systems Incorporated, a United States company that develops and markets preparatory material for nursing licensing exams under the HESI mark. The Complainant is the proprietor of United States Trademark Registration No. 3424996 for HESI (word mark), registered on May 13, 2008 for services in classes 35, 41 and 42, claiming a date of first use of January 31, 1990.

The disputed domain name <hesi-test-bank.com> was registered on November 4, 2022. It resolves to a website featuring the ELSEVIER and HESI marks purporting to offer "HESI Test Bank Questions and Answers."

The disputed domain name <hesi-a2.com> was registered on February 2, 2018. It resolves to a website purporting to offer "HESI A2 ENTRANCE EXAM TEST BANK" materials and containing links to the <hesi-test-bank.com> website. The disputed domain name <hesi-cat-testbank.com> was registered on November 3, 2022. It also resolves to a website purporting to offer material related to the "HESI RN Computer Adaptive Test Bank" and likewise containing links to the <hesi-test-bank.com> website.

5. Parties' Contentions

A. Complainant

The Complainant's contentions may be summarized as follows:

1. Request to consolidate proceedings

The Complainant requests consolidation of the proceedings for the following reasons: the websites to which the <hesi-a2.com> and <hesi-cat-testbank.com> domain names resolve contain multiple hyperlinks that redirect users to the various pages within the website hosted at the disputed domain name <hesi-test-bank.com> domain name. The <hesi-test-bank.com> and <hesi-a2.com> domain names were registered by the same entity. Two of the three disputed domain names <hesi-cat-testbank.com> and <hesi-test-bank.com> were registered nearly contemporaneously via the same registrar. The older domain name, <hesi-a2.com> is linked to the more recently registered <hesi-test-bank.com> domain name, suggesting common control over all three domains by a single entity. All the disputed domain names target the Complainant's HESI mark and resolve to websites offering test prep materials that appear to infringe the Complainant's copyrighted test questions and answers.

2. Substantive contentions

The Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the disputed domain names.

Notably, the Complainant contends that its predecessor in interest began using the HESI mark dating back at least as early as 1990, predating the registration of the earliest of the disputed domain names by 28 years. The disputed domain names incorporate the HESI mark in its entirety. The Respondents are not known by the HESI mark and there is no evidence that the Respondents have any rights therein. The websites feature the Complainant's HESI mark and unlawfully purport to offer for sale the Complainant's copyrighted proprietary test preparatory materials.

B. Respondents

The Respondents did not reply to the Complainant's contentions.

6. Discussion and Findings

6.1 Consolidation: Multiple Respondents

The amended Complaint was filed in relation to nominally different domain name registrants. The Complainant alleges that the domain name registrants are the same entity or mere alter egos of each other, or under common control. The Complainant requests the consolidation of the Complaint against the multiple disputed domain name registrants pursuant to paragraph 10(e) of the Rules.

The disputed domain name registrants did not comment on the Complainant's request.

Paragraph 3(c) of the Rules states that a complaint may relate to more than one domain name, provided that the domain names are registered by the same domain name holder.

In addressing the Complainant's request, the Panel will consider whether (i) the disputed domain names or corresponding websites are subject to common control; and (ii) the consolidation would be fair and equitable to all Parties. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (["WIPO Overview 3.0"](#)), section 4.11.2.

As regards common control, the Panel notes that the disputed domain names reflect similar naming patterns, consisting of the Complainant's HESI mark and various terms related to tests. The disputed domain names resolve to websites featuring the HESI mark and referencing the Complainant's proprietary materials. These websites are linked to each other. Two of the disputed domain names were registered by an entity with the same identity.

As regards fairness and equity, the Panel sees no reason why consolidation of the disputes would be unfair or inequitable to any Party.

Accordingly, the Panel decides to consolidate the disputes regarding the nominally different disputed domain name registrants (referred to below as "the Respondent") in a single proceeding.

A. Identical or Confusingly Similar

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 3.0](#), section 1.7.

The Complainant has shown rights in respect of a trademark or service mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The entirety of the Complainant's HESI mark is reproduced within the disputed domain names. Accordingly, the disputed domain names are confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

Although the addition of other terms (here, “a2”, “cat-testbank” and “test-bank”, along with hyphens) may bear on assessment of the second and third elements, the Panel finds the addition of such terms does not prevent a finding of confusing similarity between the disputed domain names and the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

The Panel finds the first element of the Policy has been established.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a list of circumstances in which the Respondent may demonstrate rights or legitimate interests in a disputed domain name.

Although 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 difficult 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 (although the burden of proof always remains on the complainant). 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.

Having reviewed the available record, the Panel finds the Complainant has established a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain names. The Respondent has not rebutted the Complainant’s prima facie showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the disputed domain names such as those enumerated in the Policy or otherwise.

In particular, the Panel notes that the disputed domain names reflect the Complainant’s HESI mark together with the terms “-a2”, “-cat-testbank” and “-test-bank,” referring to the types of tests for which the Complainant offers preparatory materials. Such a composition carries a risk of implied affiliation with the Complainant and cannot lead to a finding that the Respondent had rights or legitimate interests in the disputed domain name. See [WIPO Overview 3.0](#), section 2.5.1.

Panels have held that the use of a domain name for illegal activity (here, claimed unlawful offering of the Complainant’s proprietary content or impersonation/passing off) can never confer rights or legitimate interests on a respondent. [WIPO Overview 3.0](#), section 2.13.1.

The Panel finds the second element of the Policy has been established.

C. Registered and Used in Bad Faith

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.

In the present case, the Panel notes that the Respondent intentionally attempted to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the Complainant’s mark. The disputed domain names were registered more than a decade after the Complainant first registered its HESI mark and more than two decades after the Complainant’s predecessor in interest began using the HESI mark. The disputed domain names reflect the Complainant’s registered mark together with terms referring to the Complainant’s services, and therefore implies a connection to the Complainant. Under these circumstances, the Panel finds that the disputed domain name was registered in bad faith.

[WIPO Overview 3.0](#), section 3.1.

Panels have held that the use of a domain name for illegal activity (here, claimed unlawful offering of the Complainant's proprietary content or impersonation/passing off) constitutes bad faith. In this case, the Panel notes that the websites to which the disputed domain names resolve all feature the Complainant's mark and purport to offer to Internet users access to the Complainant's test preparatory materials.

[WIPO Overview 3.0](#), section 3.4. Having reviewed the record, the Panel finds the Respondent's registration and use of the disputed domain names constitutes bad faith under the Policy.

The Panel finds that the Complainant has established the third element 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 names <hesi-a2.com>, <hesi-cat-testbank.com> and <hesi-test-bank.com> be transferred to the Complainant.

/Ingrīda Kariņa-Bērziņa/

Ingrīda Kariņa-Bērziņa

Sole Panelist

Date: July 1, 2024