

## **ADMINISTRATIVE PANEL DECISION**

Benedictine College v. Host Master, 1337 Services LLC  
Case No. D2024-1748

### **1. The Parties**

The Complainant is Benedictine College, United States of America (“United States” or “US”), represented by Husch Blackwell LLP, United States.

The Respondent is Host Master, 1337 Services LLC, Saint Kitts and Nevis.

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

The disputed domain name <benedictinecollege.org> is registered with Tucows Inc. (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on April 25, 2024. On April 26, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On April 26, 2024, 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 (Tucows, Inc.) and contact information in the Complaint. The Center sent an email communication to the Complainant on May 2, 2024, 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 4, 2024.

The Center verified that the Complaint, together with the amendment to the Complaint/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 May 7, 2024. In accordance with the Rules, paragraph 5, the due date for Response was May 27, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on May 29, 2024.

The Center appointed Anna Carabelli as the sole panelist in this matter on June 11, 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 Catholic, liberal arts College based in Atchison, Kansas, providing courses at the college level since 1858 under the brand name BENEDICTINE COLLEGE.

The Complainant owns the following trademark registrations for BENEDICTINE COLLEGE:

- United States Trademark registration No. 2,016,927 (word mark), registered on November 19, 1996 (date of first use in commerce: July 1971), in Class 41;
- United States Trademark registration No. 3,408,720 (design mark), registered on April 8, 2008 in Class 41;

which are used by the Complainant to market and promote its educational services, including online through its official website available at "www.benedictine.edu".

The disputed domain name was registered on February 17, 2024. As per the evidence in the Complaint, the disputed domain name has been used as part of a phishing scheme to contact certain vendor and fraudulently place an order for 115 laptop units in the name of the Complainant. The evidence submitted in this regard consists of scam emails which pretended to be sent by the Complainant, signed by a person qualifying as "purchasing manager", using the email address [Redacted]@benedictinecollege.org.

At the time of this Decision the disputed domain name resolves to an inactive webpage displaying a notice that the site can't be reached.

#### **5. Parties' Contentions**

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

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

Notably, the Complainant contends that:

- The Complainant's trademark BENEDICTINE COLLEGE is well-known in the US and throughout the world, as a result of the Complainant's many years of consistent and continuous advertising, marketing and commercial success.
- The disputed domain name is confusingly similar to the Complainant's BENEDICTINE COLLEGE trademark since it entirely incorporates it.
- The Respondent has no rights or legitimate interests in the disputed domain name. The Respondent (i) is not commonly known by the disputed domain name, (ii) has no legitimate claim to any corresponding trademark or service mark rights, and (iii) is not using the disputed domain name in connection with a bona fide offering of goods or services or a legitimate noncommercial or fair use. Indeed, the disputed domain name has been used by the Respondent for conducting phishing activities.
- The disputed domain name was registered and is being used in bad faith. The Complainant has been using the BENEDICTINE COLLEGE trademark for over 50 years, and has extensively marketed and advertised its educational services using this trademark. Therefore, because of the reputation of the

BENEDICTINE COLLEGE trademark, and because of the Respondent's fraudulent conduct, it is inconceivable that the Respondent did not know of the Complainant. The Respondent is deliberately leveraging the power of the Complainant's trademark to attract for commercial gain Internet users by creating a likelihood of confusion with the BENEDICTINE COLLEGE mark and in an attempt to, at least, fraudulently collect money and/or equipment from vendors.

Based on the above the Complainant requests the disputed domain name be transferred to the Complainant.

## **B. Respondent**

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

## **6. Discussion and Findings**

Paragraph 15(a) of the Rules instructs the panel to decide the complaint based on the statements and documents submitted and in accordance with the Policy, the Rules and any rules and principles of law that it deems applicable.

Under paragraph 4(a) of the Policy, the complainant must prove 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.

Paragraph 4(b) of the Policy sets out four illustrative circumstances, which for the purposes of paragraph 4(a)(iii) of the Policy, shall be evidence of registration and use of a domain name in bad faith.

Paragraph 4(c) of the Policy sets out three illustrative circumstances any one of which, if proved by the respondent, shall be evidence of the respondent's rights to or legitimate interests in a disputed domain name for the purpose of paragraph 4(a)(ii) of the Policy above.

### **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 mark is reproduced within the disputed domain name. Accordingly, the disputed domain name is identical to the mark for the purposes of the Policy. The addition of the generic Top-Level Domain such as ".org" is viewed as a standard registration requirement and as such is typically disregarded under the first element confusing similarity test. [WIPO Overview 3.0](#), section 1.11.1.

Accordingly, 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 name. 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 name such as those enumerated in the Policy or otherwise. There is no indication before the Panel of any activity in relation to the disputed domain name that would give rise to rights or legitimate interests to the Respondent.

According to the evidence submitted by the Complainant - which has not been challenged by the Respondent - the disputed domain name has been used as part of a phishing scheme, to place an order for a great number of laptop units in the name of the Complainant.

Panels have held that the use of a domain name for illegal activity (such as phishing, impersonation/passing off, or other types of fraud) 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, in the Panel’s view it is difficult to believe that the Respondent did not have in mind the Complainant’s trademark when registering the disputed domain name. As discussed above, the uncontested evidence submitted by the Complainant shows that the disputed domain name has been used to send scam emails impersonating the Complainant.

This indicates that the Respondent knew and targeted the Complainant when registering the disputed domain name and suggests that the disputed domain name was registered in bad faith with a deliberate intent to create an impression of an association with the Complainant and to mislead Internet users into believing the disputed domain name as an official domain name of the Complainant.

Panels have held that the use of a domain name for illegal activity (such as phishing, impersonation/passing off, or other types of fraud) constitutes bad faith. [WIPO Overview 3.0](#), section 3.4.

Having reviewed the record, the Panel finds the Respondent’s registration and use of the disputed domain name constitutes bad faith under the Policy.

The fact that the disputed domain name does not currently point to an active website and merely resolves to a webpage stating, “This site can’t be reached”, does not prevent a finding of bad faith under the passive holding doctrine given the totality of the circumstances in the present case. [WIPO Overview 3.0](#), section 3.3.

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 name, <benedictinecollege.org> be transferred to the Complainant.

*/Anna Carabelli/*

**Anna Carabelli**

Sole Panelist

Date: June 24, 2024