

ADMINISTRATIVE PANEL DECISION

Delta Dental of Illinois v. Dean Granger
Case No. D2024-1888

1. The Parties

The Complainant is Delta Dental of Illinois, United States of America (“United States”), represented by Polsinelli PC, United States.

The Respondent is Dean Granger, United States.

2. The Domain Name and Registrar

The disputed domain name <ddpil-internal.com> is registered with NameCheap, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on May 3, 2024. On May 6, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On May 6, 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 (Redacted for Privacy) and contact information in the Complaint. The Center sent an email communication to the Complainant on May 7, 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 10, 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 Respondent of the Complaint, and the proceedings commenced on May 16, 2024. In accordance with the Rules, paragraph 5, the due date for Response was June 5, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on June 10, 2024.

The Center appointed W. Scott Blackmer as the sole panelist in this matter on June 17, 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.

The Panel issued Administrative Panel Procedural Order Number 1 on July 1, 2024, and Administrative Panel Procedural Order Number 2 on August 2, 2024, inviting the Complainant to submit further evidence in support of its claimed common law trademark, its prior use of the disputed domain name, and security issues relating to the disputed domain name, with an opportunity for the Respondent to reply. The Complainant submitted material in response to these procedural orders; the Respondent did not.

4. Factual Background

The Complainant is an independently operated member company of the Delta Dental Plans Association, one of the largest dental benefits insurance carriers in the United States. Founded in 1967, the Complainant is organized as a corporation established under the laws of the State of Illinois, United States, and headquartered in Naperville, Illinois, with a principal website at “www.deltadentalil.com” (the “Complainant’s website”). The Complainant serves more than two million dental patients in Illinois and other states.

The Complainant adopted the names Delta Dental Plan of Illinois and Delta Dental of Illinois in 1984, abbreviated DDPIIL or DDIL, respectively, using both DDPIIL and DDIL as marks in advertising and publicity. The record includes examples of this practice from the Complainant’s website screenshots, correspondence, and news releases as early as 2003 and 2004. The Complainant registered the disputed domain name in 2000, incorporating the DDPIIL mark, and used it for more than twenty years for a password-controlled “internal” website to submit individual and group insurance applications. The Complainant does not explain exactly when and how it allowed its former registration of the disputed domain name to lapse. The Complainant’s website currently emphasizes DDIL more than DDPIIL as an abbreviation, and neither appears with a “TM” or “SM” symbol claiming an unregistered trademark or service mark, nor are these abbreviations specifically mentioned as marks in the “Trademark Statement” on the website’s “Terms and Conditions” page.

The Registrar reports that the disputed domain name was registered again on January 10, 2024, by the Respondent Dean Granger, an individual listing a postal address in the State of New Hampshire, United States and a contact email address using the domain name <financeleaseaccounting.com>, a domain name that resolves only to a landing page with third-party, pay-per-click (“PPC”) advertising links. The disputed domain name does not resolve to an active website.

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 disputed domain name is confusingly similar to the Complainant’s unregistered DDPIIL mark, which the Respondent is not licensed to use. The Complainant asserts that the Respondent has no rights or legitimate interests in the disputed domain name and registered it only in bad faith to “target customers” of the Complainant and “to gain unauthorized access” to the Complainant’s “confidential information”, including user credentials, patient health information, and social security numbers. The Respondent has not used the disputed domain name for a website to date, but the Complainant relies on the “passive holding doctrine” of *Telstra Corporation. Ltd. v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#), and its progeny, arguing that DDPIIL and DDIL are well-known trademarks and there is no conceivable legitimate purpose for the Respondent to register and use a confusingly similar domain name.

B. Respondent

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

6. Discussion and Findings

Paragraph 4(a) of the Policy provides that a complainant must demonstrate each of the following:

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

Under paragraph 15(a) of the Rules, “[a] Panel shall decide a complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable”.

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 of WIPO Panel Views on Selected UDRP Questions, Third Edition, (“[WIPO Overview 3.0](#)”), section 1.7.

The Panel finds the Complainant has sufficiently established unregistered trademark or service mark rights for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.3. The Complainant claimed continuing use of the abbreviations DDPIIL and DDIL as unregistered marks since 1984 and ultimately furnished evidence of use since at least 2003. Other Panels have similarly found “limited unregistered rights for the purposes of the Policy” in cases where there was some evidence of the source-identifying nature of the claimed mark and abuse was likely in the circumstances. See, e.g., *Greenspring Associates, Inc. v. Lisa Knowles, Victoria capital pty*, WIPO Case No. [D2019-0265](#), and *PEMF Supply, LLC v. Domain Administrator, PrivacyGuardian.org / Gregory Lewis, American Healthcare Foundation*, WIPO Case No. [D2019-0235](#).

The entirety of DDPIIL is reproduced within the disputed domain name. Accordingly, the disputed domain name is confusingly similar to DDPIIL for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

Moreover, the Panel finds DDIL is recognizable within the disputed domain name, differing in the abbreviation only by the addition of the letter “p”. Accordingly, the disputed domain name is confusingly similar to DDIL for the purposes of the Policy. [WIPO Overview 3.0](#), sections 1.7. and 1.9. (misspellings).

Although the addition of other terms (here, “internal” following a hyphen) may bear on assessment of the second and third elements, the Panel finds the addition of such term does not prevent a finding of confusing similarity between the disputed domain name and the Complainant's marks 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 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. The disputed domain name does not correspond to the Respondent’s name, the key element of the disputed domain name is not a dictionary word, and the Respondent has not associated the disputed domain name with a website that can be assessed.

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 was likely aware of the Complainant and its DDPIIL and DDIL marks, because they are distinctive abbreviations that have been in circulation for decades, and the Respondent combined DDPIIL with “-internal”, selecting exactly the same domain name as the Complainant was previously using for internal purposes (which does not have any apparent meaning other than a connection to the internal use by the Complainant). This is unusual in selecting a “.com” domain name, which is normally intended for the public, not internal use, and raises the suspicion that the Respondent meant to emulate the Complainant in phishing emails or some other fraud scheme, if not through an imitative website. Any domain name meant for “internal” use is more likely to entail login credentials that, if divulged or captured, could compromise the operator’s server or network. The Complainant raises precisely this concern.

Paragraph 4(b) of the Policy sets out a list of non-exhaustive circumstances that may indicate that a domain name was registered and used in bad faith, but other circumstances may be relevant in assessing whether a respondent’s registration and use of a domain name is in bad faith. [WIPO Overview 3.0](#), section 3.2.1.

Panels have found that the non-use of a domain name, (including a blank or “coming soon” page) would not prevent a finding of bad faith under the doctrine of passive holding. Having reviewed the available record, the Panel finds the non-use of the disputed domain name does not prevent a finding of bad faith in the circumstances of this proceeding. Although panelists will look at the totality of the circumstances in each case, factors that have been considered relevant in applying the passive holding doctrine include: (i) the degree of distinctiveness or reputation of the complainant’s mark, (ii) the failure of the respondent to submit a response or to provide any evidence of actual or contemplated good-faith use, and (iii) the respondent’s concealing its identity or use of false contact details (noted to be in breach of its registration agreement). [WIPO Overview 3.0](#), section 3.3. Having reviewed the available record, the Panel notes the distinctiveness and reputation of the Complainant’s trademark, and the composition of the disputed domain name, as discussed above, and finds that in the circumstances of this case the passive holding of the disputed domain name does not prevent a finding of bad faith under the Policy.

Panels have held that the use of a domain name for illegal activity (here, claimed to be the risk of phishing and attacks on the Complainant's internal network, as the former use of the disputed domain name was to collect insurance applications with login credentials and confidential personal information) also constitutes bad faith. [WIPO Overview 3.0](#), section 3.4. The Respondent has been given multiple opportunities to reply the Complainant's concerns about these security issues and has not done so, and the Respondent has not come forward to offer any legitimate reasons for registering the disputed domain name after the Complainant's registration lapsed. 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 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 <ddpil-internal.com> be transferred to the Complainant.

/W. Scott Blackmer/

W. Scott Blackmer

Sole Panelist

Date: August 23, 2024