

## **ADMINISTRATIVE PANEL DECISION**

biBerk Insurance Services, Inc. v. Dipak Kumbhakar  
Case No. D2024-2432

### **1. The Parties**

The Complainant is biBerk Insurance Services, Inc., United States of America (“United States”), represented by Baker & McKenzie, United States.

The Respondent is Dipak Kumbhakar, India.

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

The disputed domain name <biberk.xyz> 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 June 13, 2024. On June 14, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On June 14, 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 (Privacy Protected Domain Registrant, Domains By Proxy, LLC) and contact information in the Complaint. The Center sent an email communication to the Complainant on June 17, 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 June 17, 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 June 26, 2024. In accordance with the Rules, paragraph 5, the due date for Response was July 16, 2024.

The Respondent did not submit any formal response. However, the Respondent sent an email communication to the Center on June 29, 2024 stating: “Dear Team, I am writing in response to your recent

email regarding the domain disputed concerning biber.xyz. I needed a domain for my adsense work so got the domain suggestions from ChatGpt and I was unaware that the domain name was in violation of your company's trademark. As per your request, I have taken immediate action and cancelled the domain from my account which I bought from Godaddy. Please let me know if there are any further steps I needed to take or if there is any additional information you require to resolve this matter". Accordingly, the Center notified the Commencement of Panel Appointment Process on July 17, 2024.

The Center appointed Zoltán Takács as the sole panelist in this matter on July 25, 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**

Founded in 2015 the Complainant is a member of Berkshire Hathaway Insurance Group.

Berkshire Hathaway Inc. ("Berkshire Hathaway"), a multinational holding company and the ultimate parent company of the Complainant is the seventh largest public company in the world.

The Complainant uses an automated online analytical system to make quotes and issue policies to more than 200,000 customers in the United States, offering insurance products to small businesses, including commercial auto, general liability and workers' compensations.

The Complainant is owner of the United States Trademark Registration No. 5345976 for the BIBERK mark, registered since November 28, 2017 for various insurance services.

The Complainant is also owner of the domain name registration <biberk.com> which was registered on May 6, 2016, and resolves to its corporate website that is the main point of contact between the Complainant and its customers.

The disputed domain name was registered on March 26, 2024, and resolved to an English language webpage which prominently displayed the Complainant's BIBERK mark with the Respondent's apparent offering information on various insurance products.

Currently the disputed domain name does not resolve to a website and is inactive.

#### **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:

- if the applicable Top-Level Domain ("TLD") ".xyz" is disregarded the disputed domain name is identical to its BIBERK mark;
- the Respondent has no rights or legitimate interests in respect of the disputed domain name since it is unable to rely on any of the circumstances set out in paragraphs 4(c)(i), (ii), or (iii) of the Policy;
- the Respondent has registered the disputed domain name with knowledge of its mark and used it to falsely suggest affiliation with the Complainant which is evidence of bad faith.

The Complainant requests that the disputed domain name be transferred from the Respondent to the Complainant.

## **B. Respondent**

The Respondent sent the above-mentioned informal email communication to the Center but did not file a formal response and contested the Complainant's contentions.

In spite of the Respondent's statement on his cancellation of the disputed domain name from his account at the Registrar and the Registrar's written confirmation of the removal of the disputed domain name from the Respondent's account, the Whois record for the disputed domain name indicates that it is still being registered in the name of the Respondent with expiration date of March 26, 2025.

## **6. Discussion and Findings**

A complainant must evidence each of the three elements required by paragraph 4(a) of the Policy in order to succeed on the complaint, namely that:

- (i) the 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 domain name; and
- (iii) the domain name has been registered and is being used in bad faith.

### **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 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 BIBERK mark is reproduced within the disputed domain name combined with the applicable TLD ".xyz" which is viewed as a standard registration requirement and as such is disregarded under the first element confusing similarity test. Accordingly, the disputed domain name is identical to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), sections 1.7 and 1.11.1.

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 Respondent is not affiliated with the Complainant in any way and has never been authorized by the Complainant to register and use a domain name incorporating its BIBERK trademark.

Under the circumstances of the case the use of the disputed domain name for a webpage that prominently displayed the Complainant's BIBERK mark and apparently provided information about insurance (the Complainant's field of activities) does not amount to a bona fide offering of goods and services, or legitimate noncommercial fair use.

In addition, the composition of the disputed domain name, namely being identical to the Complainant's mark supports the finding of the risk of implied affiliation of the disputed domain name with the Complainant and thus cannot confer any rights or legitimate interests on the Respondent. [WIPO Overview 3.0](#), section 2.5.1.

The Panel finds that 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.

The Respondent alleges that he "got the domain suggestions from ChatGpt" and that he "was unaware that the domain name was in violation of your company's trademark". The Panel is not inclined to accept these allegations of the Respondent of being unaware of the Complainant's BIBERK trademark for the following reasons:

- the Complainant's BIBERK trademark is inherently distinctive and unique to the Complainant; and
- the evidence submitted by the Complainant shows that the Respondent expressly related the disputed domain name to the Complainant's industry by referring to "insurance products" on the disputed domain name's website at which he prominently used the Complainant's BIBERK mark, the priority of which predates the registration of the disputed domain name.

While not of any particular relevance to the outcome of this case, the Panel notes that whether the idea for a particular domain name was (as is claimed here) suggested by ChatGPT (which it is noted is based on the input of the user) or another name generator (sometimes called a "name spinner"), the registration of a domain name is the responsibility of the registrant, and the Policy elements will be viewed through that lens.

Therefore, in view of the Panel the Respondent must have had the Complainant's business and trademark in mind at the time of registration of the disputed domain name and obtained it to target the Complainant and its trademark through false association, which is evidence of bad faith. Paragraph 4(b)(iv) of the Policy.

As mentioned above, currently the disputed domain name does not resolve to any active website. However, the current passive holding of the disputed domain name does not prevent a finding of bad faith under the Policy when considering the totality of the circumstances. [WIPO Overview 3.0](#), section 3.3.

In this context the Panel notes the distinctiveness of the Complainant's mark, the composition of the disputed domain name as mentioned above and that any good faith use to which the inherently misleading disputed domain name may be put appears to be implausible.

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 <biberk.xyz> be transferred to the Complainant.

*/Zoltán Takács/*

**Zoltán Takács**

Sole Panelist

Date: August 8, 2024