

ADMINISTRATIVE PANEL DECISION

The Board of Trustees of the University of Illinois v. Han Ying Cheng Case No. D2024-2686

1. The Parties

The Complainant is The Board of Trustees of the University of Illinois, United States of America, represented by Smith, Gambrell & Russell, LLP, United States of America (United States).

The Respondent is Han Ying Cheng, Taiwan Province of China, represented by Chen & Lin Attorneys-at-Law, Taiwan Province of China.

2. The Domain Name and Registrar

The disputed domain name <uic.business> is registered with NameCheap, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on July 1, 2024. On July 3, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On July 3, 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 (Unknown) and contact information in the Complaint. The Center sent an email communication to the Complainant on July 4, 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 July 5, 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 July 16, 2024. In accordance with the Rules, paragraph 5, the due date for Response was August 5, 2024. The Respondent sent email communications to the Center on July 5, 8, 9, and 10. These emails included a request to suspend the proceedings so that settlement negotiations could occur.

On July 16, 2024, the Respondent's representative sent an email communication to the Center requesting the Complainant to formally request a suspension of proceedings to "allow the parties to discuss and negotiate a mutually satisfactory solution and settlement." On July 23, 2024, the Center sent a possible settlement email to the parties; however, the Complainant confirmed on the same day that it did not wish to suspend the proceedings and expressed their intention to proceed with the case.

The Center appointed Warwick A. Rothnie as the sole panelist in this matter on August 27, 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 university in Illinois based in Chicago.

According to the Complaint, it claims to have been using UIC as a trademark in connection with its educational services including providing courses of instruction at undergraduate, graduate and post-graduate level as well as professional, adult and continuing education courses in different fields, including medicine, teaching and business administration, since as early as 1982. It also claims to have been using UIC as a trademark in relation to goods such as stationary, clothing, caps and scarves, mugs and the like since as early as July 1985.

Amongst other things, the Complainant holds and promotes its services from a website to which the domain name <uic.edu> resolves. In this regard, the Panel notes that the Complainant hosts a website at "business.uic.edu". promoting its educational programs in business administration studies.

The Complaint includes evidence that the Complainant is the owner of two registered trademarks in the United States. The first of these, Registered Trademark No. 2,905,608 is for UIC. It has been registered in the Principal Register since November 30, 2004, in respect of goods and services in International Classes 16 (stationary), 21 (mugs), 24 (towels), 25 (clothing, hats, caps and scarves) and 41 (educational services). The claimed dates of first use in respect of the various classes of goods and services are consistent with the dates claimed in the Complaint.

For present purposes, it is not necessary to set out the details of the second, later Registered Trademark.

According to the Whois report, the disputed domain name was registered on June 21, 2024.

When the Complaint was filed, the disputed domain name resolved to a parking page featuring pay-per-click (PPC) advertising links to "Medical Dr Nearby", "Medical University" and "Best Consolidation Programs" and "Medical University", "Graduate Degree in Teaching" and "Medicine Hospital".

5. Discussion and Findings

Paragraph 4(a) of the Policy provides that in order to divest the Respondent of a 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.

Paragraph 15(a) of the Rules directs the Panel to decide the 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.

In the second of the Respondent's emails to the Center on July 8, 2024, the Respondent stated that she wished to cancel the disputed domain name immediately and wished to give it up without a refund. Subsequent emails from the Respondent including one from attorneys representing the Respondent maintained the position that the Respondent was willing to surrender the disputed domain name but it is less clear whether the Respondent was seeking some form of compensation in exchange as it was suggested settlement discussions should take place. For example, the Respondent's representative proposed transfer if "reasonable and appropriate" measures could be agreed and so subject to "discuss[ing] and negotiat[ing] a mutually satisfactory solution and settlement." The Complainant did not wish to pursue that avenue.

In these circumstances, no settlement having been agreed between the parties, the Panel considers it appropriate to consider the proceeding on its merits.

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.

Disregarding the generic Top Level Domain (gTLD) component of the disputed domain name as a functional aspect of the domain name system ([WIPO Overview 3.0](#), section 1.11), the disputed domain name is identical to the Complainant's Registered Trademark.

Accordingly, the Panel finds that 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 well after the Complainant registered its trademark (and also well after the Complainant claims to have commenced 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 Respondent has not disputed these matters.

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 efforts by the Respondent to suppress PPC advertising links which trade on the Complainant's trademark. The use of the disputed domain name to resolve to a parking page with PPC advertising links which lead to websites that at least partially compete with the Complainant's services, therefore, does not qualify as a good faith offering of goods or services in the circumstances of this case. [WIPO Overview 3.0](#), section 2.9.

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.

Other than to claim she has no intention of infringing on the Complainant's rights, the Respondent has not offered any explanation or attempted any justification for her registration and use (or intended use) of the disputed domain name in rebuttal of this prima facie case.

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. *Group One Holdings Pte Ltd v. Steven Hafto*, WIPO Case No. [D2017-0183](#).

The Panel is conscious that the disputed domain name consists of three letters (plus the gTLD) and so could potentially reference any number of different people or things or nothing at all.

The Respondent has taken part in the proceeding but has not offered any explanation or plan for her registration and use of the disputed domain name.

Unlike for example, *Banca Monte dei Paschi di Siena S.p.A v. Charles Kirkpatrick*, WIPO Case No [D2008-0260](#), the Respondent has not denied knowledge or awareness of the Complainant and its trademark.

The Respondent through its representative claims that "there was never any intention on [the Respondent's] part to infringe upon any of [the Complainant's] rights", and that "due to the short period from Ms. Cheng's registration of the Contested Domain Name to Ms. Cheng's receipt of a notice of the Complaint, Ms. Cheng has yet used the Contested Domain Name."

This last point is not strictly correct given the PPC links on the landing page of the disputed domain name (and which have presumably been provided by the Registrar).

The only evidence before the Panel from which the purpose of registration can be inferred, therefore, is the composition of the disputed domain name, and the evidence of use to resolve to a parking page with PPC links which direct to websites that at least partly compete with the Complainant's services. In the absence of any evidence to suppress PPC links that trade on the Complainant's trademark or any reasonable explanation for the registration from the Respondent, therefore, the Panel accepts the Complainant's allegation that the disputed domain name has been registered to take advantage of the disputed domain name's resemblance to the Complainant's trademark.

The Panel further notes that the Second Level Domain reproduces the UIC trademark in its entirety and is registered under the gTLD ".business". In this regard, the Panel notes the Complainant's claim that it provides different courses including in the field of business administration. In the exercise of its general powers under paragraph 10 of the Rules, the Panel has performed a Google search with the terms "UIC BUSINESS", and notes that this combination has been frequently used by the Complainant prior to the registration of the disputed domain name ("e.g.", one of the results being an Instagram profile under the name "UIC Business" with over 4,381 publications, the majority of which predate the registration of the disputed domain name). Similarly, the Complainant's Facebook account "UIC Business" was established in December 2012 and has more than 3,400 followers.

In the circumstances of this case, the Panel finds more likely than not that the disputed domain name has been registered intentionally attempting to attract Internet users to the Respondent's website for commercial gain by creating a likelihood of confusion with the Complainant's trademark. Paragraph 4(b)(iv) of the Policy.

Given the composition and the manner of use, therefore, the Panel finds that the disputed domain name has been both registered and used in bad faith.

Accordingly, the Complainant has established all three requirements under 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 <uic.business> be transferred to the Complainant.

/Warwick A. Rothnie/

Warwick A. Rothnie

Sole Panelist

Date: September 10, 2024