

ADMINISTRATIVE PANEL DECISION

Fox News Network, LLC and Fox Media LLC v. Registration Private, Domains By Proxy, LLC / mike mobile
Case No. D2022-1547

1. The Parties

Complainants are Fox News Network, LLC and Fox Media LLC, United States of America (“United States” or “U.S.”), represented by Wiley Rein LLP, United States.

Respondent is Registration Private, Domains By Proxy, LLC, United States / mike mobile, United States.

2. The Domain Name and Registrar

The disputed domain name <foxnewsflorida.com> (the “Domain Name”) 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 April 29, 2022. On April 29, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On May 2, 2022, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Domain Name which differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to Complainants on May 4, 2022, providing the registrant and contact information disclosed by the Registrar, and inviting Complainants to submit an amendment to the Complaint. Complainants filed an amended Complaint on May 6, 2022.

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 Respondent of the Complaint, and the proceedings commenced on May 10, 2022. In accordance with the Rules, paragraph 5, the due date for Response was May 30, 2022. Respondent did not submit any response. Accordingly, the Center notified Respondent’s default on May 31, 2022.

The Center appointed John C McElwaine as the sole panelist in this matter on June 10, 2022. 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

Complainants are United States-based companies in the business of news and entertainment.

Complainant, Fox Media, LLC, is the owner of the following United States trademark registrations alleged to be relevant to this matter:

- FOX NEWS, U.S. Reg. No. 2708769, registered April 22, 2003 in International Class 38.
- FOX NEWS, U.S. Reg. No. 2697433, registered March 18, 2003 in International Class 41.
- FOX NEWS, U.S. Reg. No. 5170377, registered March 28, 2017 in International Class 9.
- FOX NEWS, U.S. Reg. No. 2697434, registered March 18, 2003 in International Class 38.
- FOX NEWS, U.S. Reg. No. 2697436, registered March 18, 2003 in International Class 41.
- FOX NEWS, U.S. Reg. No. 5185099, registered April 18, 2017 in International Class 9.

Collectively, these registrations are referred to as the “FOX NEWS Mark.” Complainant, Fox News Network, LLC, is a licensee of these trademarks.

As part of their news services, Complainants operate a website located at “www.foxnews.com”.

On March 3, 2022, Respondent registered the Domain Name with the Registrar. The Domain Name is used for an email scam but does not resolve to a functioning website.

5. Parties’ Contentions

A. Complainants

Complainants contend that the Domain Name should be transferred because each of the three elements required in paragraph 4(a) of the Policy has been established.

With respect to the first element of the Policy, Complainants contend that the Domain Name is confusingly similar to Complainants’ FOX NEWS Mark. Complainants point out that the Domain Name fully reproduces FOX NEWS Mark, with “fox news” positioned at the beginning of the Domain Name. Complainants further contend that the addition of the geographic descriptor “Florida” and the Top-Level Domain (“TLD”) “.com” do not lessen the likelihood of confusion.

With respect to the second element of the Policy, Complainants contend that they did not authorize Respondent to use the FOX NEWS Mark and Respondent did not use the Domain Name in connection with a *bona fide* offering of goods or services. Instead, Complainants provided evidence in the form of an email that Respondent has used the Domain Name to pose as an employee of Complainants to contact a Florida-based condominium association, claiming to be conducting an investigation on behalf of Complainants. Complainants further claim there is no evidence that Respondent is commonly known by the Domain Name.

With respect to the third element of the Policy, Complainants allege that Respondent’s use of the Domain Name to send emails posing as an employee of Complainant constitutes bad faith. Complainants further allege that Respondent’s use of false contact information when registering the Domain Name constitutes bad faith. Complainants provided evidence that Respondent used a privacy registration service to conceal his identity.

B. Respondent

Respondent did not reply to the Complainants' contentions.

6. Discussion and Findings

Even though Respondent has defaulted, paragraph 4 of the Policy requires that, in order to succeed in this UDRP proceeding, Complainants must still prove their assertions with evidence demonstrating:

- (i) the Domain Name is identical or confusingly similar to a trademark or service mark in which Complainants have rights;
- (ii) 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.

Because of Respondent's default, the Panel may accept as true the reasonable factual allegations stated within the Complaint and may draw appropriate inferences therefrom. See *St. Tropez Acquisition Co. Limited v. AnonymousSpeech LLC and Global House Inc.*, WIPO Case No. [D2009-1779](#); *Bjorn Kassoe Andersen v. Direction International*, WIPO Case No. [D2007-0605](#); see also paragraph 5(f) of the Rules ("If a Respondent does not submit a response, in the absence of exceptional circumstances, the Panel shall decide the dispute based upon the complaint"). Having considered the Complaint, the Policy, the Rules, the Supplemental Rules and applicable principles of law, the Panel's findings on each of the above cited elements are as follows.

A. Identical or Confusingly Similar

Paragraph 4(a)(i) of the Policy requires Complainants show that the Domain Name is identical or confusingly similar to a trademark or service mark in which Complainants have rights. Ownership of a trademark registration is generally sufficient evidence that a complainant has the requisite rights in a mark for purposes of paragraph 4(a)(i) of the Policy. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.2. On this point, Complainants have provided evidence that Complainant, Fox Media, LLC, is the owner of at least 19 trademark registrations in the United States containing the words "Fox News".

It is well-established that the addition of other terms to a trademark in a domain name does not avoid a finding of confusing similarity. See [WIPO Overview 3.0](#), section 1.8 ("Where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element."); *Mastercard International Incorporated v. Dolancer Outsourcing Inc.*, WIPO Case No. [D2012-0619](#); *Air France v. Kitchkulture*, WIPO Case No. [D2002-0158](#); *DHL Operations B.V., and DHL International GmbH v. Diversified Home Loans*, WIPO Case No. [D2010-0097](#). The Domain Name contains Complainants' FOX NEWS Mark in its entirety, as the dominant element. The addition of the geographic descriptor "Florida" does not avoid a finding of confusing similarity between the Domain Name and the FOX NEWS Mark.

Accordingly, the Panel finds that the Domain Name is confusingly similar to Complainants' FOX NEWS Mark in which Complainants have valid trademark rights. Therefore, Complainants have satisfied paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

Under the Policy, paragraph 4(a)(ii), Complainants have the burden of establishing that Respondent has no rights or legitimate interests in the Domain Name. Complainants need to only make a *prima facie* showing

on this element, at which point the burden of production shifts to Respondent to present evidence that it has rights or legitimate interests in the Domain Name. If Respondent has failed to do so, Complainants are deemed to have satisfied its burden under paragraph 4(a)(ii) of the Policy. See *Vicar Operating, Inc. v. Domains by Proxy, Inc. / Eklin Bot Systems, Inc.*, WIPO Case No. [D2010-1141](#); see also *Nicole Kidman v. John Zuccarini, d/b/a Cupcake Party*, WIPO Case No. [D2000-1415](#); *Inter-Continental Hotels Corporation v. Khaled Ali Soussi*, WIPO Case No. [D2000-0252](#).

The Policy, paragraph 4(c), provides a non-exhaustive list of circumstances in which a respondent could demonstrate rights or legitimate interests in a contested domain name:

- “(i) before any notice to you of the dispute, your use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a *bona fide* offering of goods or services; or
- (ii) you (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or
- (iii) you are making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.”

Complainants contend there is no right or legitimate interest in holding a domain name for the purpose of trading upon Complainants’ mark and perpetrating an Internet fraud. Complainants further contend that Complainants have not authorized Respondent to register the Domain Name, that Respondent has not demonstrated any attempt to use the Domain Name in connection with a *bona fide* offering of goods or services, and that Respondent is not commonly known by the Domain Name.

Respondent has not denied any of Complainants’ assertions and has not put forth any evidence showing that he has a right or legitimate interest in the Domain Name. The Panel observes that the Domain Name does not resolve to any active webpage, but rather has been used to send emails in an attempt to pose as an employee of Complainants for fraudulent purposes.

Moreover, the Panel finds that purpose of registering the Domain Name was to engage in an email scam or a phishing scheme, none of which is a *bona fide* offering of goods or services. [WIPO Overview 3.0](#), section 2.13.1 (“Panels have categorically held that the use of a domain name for illegal activity (e.g., the sale of counterfeit goods or illegal pharmaceuticals, phishing, distributing malware, unauthorized account access/hacking, impersonation/passing off, or other types of fraud) can never confer rights or legitimate interests on a respondent.”); see also, *CMA CGM v. Diana Smith*, WIPO Case No. [D2015-1774](#) (finding that the respondent had no rights or legitimate interests in the disputed domain name, “such phishing scam cannot be considered a *bona fide* offering of goods or services nor a legitimate noncommercial or fair use of the Domain Name”). The undisputed evidence of impersonation, deception and fraud nullifies any possible basis for the acquisition of rights or legitimate interests by Respondent. See *Afton Chemical Corporation v. Meche Kings*, WIPO Case No. [D2019-1082](#).

Accordingly, Complainants made a *prima facie* showing of Respondent’s lack of any rights or legitimate interests and Respondent has failed to come forward to rebut that showing. As provided for by paragraph 14 of the Rules, the panel may draw such inference from Respondent’s default as it considers appropriate.

The panel finds that Respondent does not have rights or legitimate interests in the Domain Name and that Complainants have met their burden under paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

Under paragraph 4(a)(iii) of the Policy, Complainant must show that Respondent registered and is using the Domain Name in bad faith. A non-exhaustive list of factors constituting bad faith registration and use is set out in paragraph 4(b) of the Policy.

Here, Respondent registered the Domain Name to perpetrate an email scam or phishing scheme. Complainants' core FOX NEWS Mark was intentionally chosen when the Domain Name was registered to with the intent to pose as Complainants' reporters for the purpose of misleading third parties. In light of the email scam, there could be no other legitimate explanation except that Respondent intentionally registered the Domain Name to cloak his scam and deceive recipients into believing the emails were from Complainants. The Domain Name does not appear to have been registered for any other purpose as the Domain Name simply resolves to the Registrar's parking page. Such activity constitutes a disruption of Complainants' business and also establishes bad faith registration and use. *Securitas AB v. Whois Privacy Protection Service, Inc. / A. H.*, WIPO Case No. [D2013-0117](#) (finding bad faith based upon the similarity of the disputed domain name and the complainant's mark, the fact that the complainant is a well-known global security company and the fact that the disputed domain name is being used to perpetrate an email scam.)

In addition, the use of a deceptive domain name for an email scam has previously been found by panels to be sufficient to establish that a domain name has been registered and is being used in bad faith. See *Samsung Electronics Co., Ltd. v. Albert Daniel Carter*, WIPO Case No. [D2010-1367](#); *Securitas AB v. Whois Privacy Protection Service, Inc. / A. H.*, *supra*.

The fact that the Domain Name was used only for an email address and not in connection with a competing website does not obviate a finding of bad faith. Section 3.4 of the [WIPO Overview 3.0](#), panels have held that the use of a domain name for purposes other than to host a website may constitute bad faith. Such purposes include sending email, phishing, identity theft, or malware distribution.

Here, Complainants' FOX NEWS Mark is distinctive and well known enough to be worthy of investing the effort of running a fraudulent scheme. Complainants assert that Respondent registered the Domain Name to send emails posing as Complainants' reporters with the apparent purpose of misleading third parties. Such activity would constitute a disruption of Complainants' business and also establishes bad faith registration and use. *Securitas AB v. Whois Privacy Protection Service, Inc. / A. H.*, *supra* (Finding bad faith based upon the similarity of the disputed domain name and the complainant's mark, the fact that the complainant is a well-known global security company and the fact that the disputed domain name is being used to perpetrate an email scam.) As discussed above, Respondent used Complainants' name when communicating with third parties with the fraudulent purpose of misleading third parties. In light of the actions undertaken by Respondent, it is inconceivable that Respondent coincidentally selected the Domain Name without any knowledge of Complainants. See, e.g., *Arkema France v. Steve Co., Stave Co Ltd.*, WIPO Case No. [D2017-1632](#).

Moreover, in finding a domain name used only for an email scam was bad faith, the panel in *Kramer Law Firm, P.A. Attorneys and Counselors at Law v. BOA Online, Mark Heuvel*, WIPO Case No. [D2016-0387](#), pointed out that numerous UDRP panels have found such impersonation to constitute bad faith, even if the relevant domain names are used only for email. See, e.g., *Terex Corporation v. Williams Sid, Partners Associate*, WIPO Case No. [D2014-1742](#) ("Respondent was using the disputed domain name in conjunction with [...] an email address for sending scam invitations of employment with Complainant"); and *Olayan Investments Company v. Anthono Maka, Alahaji, Koko, Direct investment future company, ofer bahar*, WIPO Case No. [D2011-0128](#) ("although the disputed domain names have not been used in connection with active web sites, they have been used in email addresses to send scam emails and to solicit a reply to an 'online location'").

Respondent also used privacy registration service to conceal his identity when registering the Domain Name, another indication of bad faith. See [WIPO Overview 3.0](#), section 3.6; *Compagnie Générale des Etablissements Michelin v. Balticsea LLC*, WIPO Case No. [D2017-0308](#).

Based upon the foregoing, the Panel holds that Complainants have met their burden of showing that Respondent registered and is using the Domain Name in bad faith.

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 Domain Name, <foxnewsflorida.com>, be transferred to Complainants.

/John C McElwaine/

John C McElwaine

Sole Panelist

Date: June 24, 2022