

ADMINISTRATIVE PANEL DECISION

UHS of Delaware, Inc. v. Private Domain, Above Privacy / Mira Holdings, Inc.
Case No. D2022-3835

1. The Parties

Complainant is UHS of Delaware, Inc., United States of America (“United States”), represented by Williams Mullen, P.C., United States.

Respondent is Private Domain, Above Privacy, United States / Mira Holdings, Inc., United States, represented by Law Office of Howard M. Neu, P.A., United States.

2. The Domain Name and Registrar

The disputed domain name <prominencehealth.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 October 13, 2022. On October 13, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On October 17, 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 (Registration Private, Domains By Proxy, LLC, DomainsByProxy.com). The Center sent an email to Complainant on October 18, 2022, the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. Complainant filed an amended Complaint on October 20, 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 October 21, 2022. In accordance with the Rules, paragraph 5, the due date for Response was November 10, 2022. On November 4, 2022, the Respondent requested an extension for Response and the due date for Response was subsequently extended to November 14, 2022. The Response was filed with the Center November 14, 2022.

The Center appointed Robert A. Badgley, Martin Schwimmer and Warwick A. Rothnie as panelists in this matter on December 12, 2022. The Panel finds that it was properly constituted. Each member of 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 Parties have raised various factual allegations and legal issues, the consideration of which is not essential to a disposition of this dispute under the UDRP. The Panel will endeavor to confine its discussion to those points which are needed to resolve this case.

Complainant describes itself as “one of the largest and most respected providers of hospital and healthcare services in the United States”. Complainant provides services online at a website accessible via the domain name <prominencehealthplan.com>, a domain name which it has owned since April 8, 2014, and Complainant provides in-person services at six office locations.

Complainant holds several registered trademarks, including the word mark PROMINENCE HEALTH PLAN, registered with the United States Patent and Trademark Office (“USPTO”), Reg. No. 4,846,923, registered on November 3, 2015, in connection with *inter alia* “health insurance administration”. According to Complainant, its trademarks are “extremely well known” and “incredibly well recognized by consumers”. Notwithstanding these superlatives, there is no evidence in the record to support these assertions about renown.

The Domain Name was originally registered on March 7, 2014, which is prior to Complainant’s first use of the trademark PROMINENCE HEALTH PLAN in commerce, and prior to Complainant’s first trademark registration (November 3, 2015). Complainant alleges, however, that Respondent is not the original registrant of the Domain Name. According to Complainant:

“Complainant resolved a dispute with the previous owner of the domain name <prominencehealth.com>, and, as a result, the parties intended to transfer the domain name to Complainant. However, upon information and belief, Respondent acquired the disputed domain name <prominencehealth.com> on or about November 8, 2021 (as reflected by the “updated date” shown in the Whois report) after the previous owner’s registration of the domain name unintentionally lapsed and the domain name was released.”

Complainant’s account of the “dispute” with the prior owner of the Domain Name, the terms of the settlement with that other party, and the circumstances under which a transfer of the Domain Name failed to occur, is very thin on detail.

Respondent describes itself as “a professional domain name investor who owns over 1,000 domains including ‘CooperativeHealth.com’, ‘MintHealth.com’, and ‘PermanentHealth.com’”. Respondent claims that the disputed Domain Name is “a valuable two-word generic domain with an estimated value of more than [USD] 3,300”, according to a GoDaddy appraisal tool. Respondent asserts that it sold the domain name <universityhealth.com> for USD 66,000 in October 2022.

According to Respondent, it acquired the Domain Name on April 15, 2021 (more than six months earlier than Complainant alleged) by paying USD 755 at an auction. Respondent asserts that, at the time it acquired the Domain Name, it performed a USPTO search for “PROMINENCE HEALTH”, and there was no exact match for that trademark registration in the USPTO database. However, Complainant’s registered mark PROMINENCE HEALTH PLAN does appear among the USPTO search results (according to an exemplary screenshot annexed to the Response).

The Domain Name currently resolves to a parking page with various hyperlinks, such as “Health Care Services” and “Medical Services”. According to the Complaint, clicking these links leads the user to the websites of Complainant’s competitors. Complainant alleges that these are “paid” links for which

Respondent derives income.

According to Respondent, the Domain Name “has been ‘parked’ at professional monetizer, Bodis.com since acquisition and is offered for general sale at Afternic.com”. Respondent denies that the Domain Name has ever been offered directly to Complainant for sale, and Respondent denies that the health-related business whose website is accessible via a hyperlink at the parking page is “a competitor of Complainant”.

5. Parties’ Contentions

A. Complainant

Complainant asserts that it has established all three elements required under the Policy for a transfer of the Domain Name.

B. Respondent

Respondent’s essential arguments are reflected above in the “Factual Background” section.

6. Discussion and Findings

Paragraph 4(a) of the Policy lists the three elements which Complainant must satisfy with respect to the Domain Name:

- (i) the Domain Name is identical or confusingly similar to a trademark or service mark in which Complainant has rights; and
- (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.

A. Identical or Confusingly Similar

The Panel concludes that Complainant has rights in the trademark PROMINENCE HEALTH PLAN through registration demonstrated in the record. The Panel also concludes that the Domain Name is confusingly similar to that mark. The omission of the word “plan” does not prevent the mark from being recognizable in the Domain Name, since the dominant portion of the mark – PROMINENCE HEALTH – is entirely reproduced in the Domain Name.

Complainant has established Policy paragraph 4(a)(i).

B. Rights or Legitimate Interests

Pursuant to paragraph 4(c) of the Policy, Respondent may establish its rights or legitimate interests in the Domain Name, among other circumstances, by showing any of the following elements:

- (i) before any notice to you [Respondent] 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 [Respondent] (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 [Respondent] 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.

The Panel concludes that Respondent lacks rights or legitimate interests in connection with the Domain Name. Respondent claims that it is a domain name investor, and that it holds several two-word domain names (*i.e.*, two words in the Second-Level Domain) containing the word “health”. Respondent viewed this Domain Name as being worth several times the price (USD 755) for which Respondent bought the Domain Name at auction in April 2021.

Respondent is correct that acquiring domain names for resale is not in itself an illegitimate undertaking. In this case, however, the Panel concludes that Respondent’s acquisition of this Domain Name is not legitimate. Respondent admittedly conducted a USPTO trademark search, which revealed Complainant’s registered trademark, PROMINENCE HEALTH PLAN. That trademark is obviously very similar to the Domain Name. In the Panel’s view, the similarity is so close that Respondent should have realized that it would be capitalizing on Complainant’s registered trademark by acquiring the Domain Name and selling it for a profit.

Complainant has established Policy paragraph 4(a)(ii).

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy provides that the following circumstances, “in particular but without limitation”, are evidence of the registration and use of the Domain Name in “bad faith”:

- (i) circumstances indicating that Respondent has registered or has acquired the Domain Name primarily for the purpose of selling, renting, or otherwise transferring the Domain Name registration to Complainant who is the owner of the trademark or service mark or to a competitor of that Complainant, for valuable consideration in excess of its documented out of pocket costs directly related to the Domain Name; or
- (ii) that Respondent has registered the Domain Name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that Respondent has engaged in a pattern of such conduct; or
- (iii) that Respondent has registered the Domain Name primarily for the purpose of disrupting the business of a competitor; or
- (iv) that by using the Domain Name, Respondent has intentionally attempted to attract, for commercial gain, Internet users to Respondent’s website or other online location, by creating a likelihood of confusion with Complainant’s mark as to the source, sponsorship, affiliation, or endorsement of Respondent’s website or location or of a product or service on Respondent’s website or location.

The Panel concludes that Respondent registered and used the Domain Name in bad faith under the Policy. The Panel incorporates its discussion above in the “Rights or Legitimate Interests” section.

It is clear that Respondent was aware of Complainant’s registered mark when acquiring the Domain Name. That mark turned up in a search Respondent admits to having performed. The Panel also concludes that Respondent registered the Domain Name for the purpose of resale more likely than not to Complainant. This conduct constitutes bad faith within the meaning of the Policy.

Further, pending sale, the Domain Name resolves to a parking page which features what appear to be pay-per-click (“PPC”) links. Respondent states that the Domain Name “has been ‘parked’ at professional monetizer Bodis.com since acquisition”. As the holder of the Domain Name, Respondent is responsible for the use to which it is put, in the absence of evidence showing efforts to suppress targeting of another’s trademark. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, section 3.5.

Complainant has established Policy paragraph 4(a)(iii).

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 <prominencehealth.com> be transferred to Complainant.

/Robert A. Badgley/

Robert A. Badgley

Presiding Panelist

/Martin Schwimmer/

Martin Schwimmer

Panelist

/Warwick A. Rothnie/

Warwick A. Rothnie

Panelist

Date: December 26, 2022