

## **ADMINISTRATIVE PANEL DECISION**

Capitol Federal Savings Bank v. Om Prakash  
Case No. DCO2024-0086

### **1. The Parties**

The Complainant is Capitol Federal Savings Bank, United States of America (“United States”), represented by Hovey Williams LLP, United States.

The Respondent is Om Prakash, India.

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

The disputed domain name <capitolfederalbank.co> 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 November 15, 2024. On November 15, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On November 15, 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, Domains By Proxy, LLC) and contact information in the Complaint. The Center sent an email communication to the Complainant on November 18, 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 November 20, 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 November 26, 2024. In accordance with the Rules, paragraph 5, the due date for Response was December 16, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on December 19, 2024.

The Center appointed Andrea Jaeger-Lenz as the sole panelist in this matter on January 2, 2025. 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 federally chartered capitol stock savings bank founded in 1893 and seated in the federal state of Kansas, United States. Since at least 1938, it has been offering its banking and financial services using the business name and trademark CAPITOL FEDERAL. The services offered under this sign nowadays include a wide array of financial services including credit card transaction processing, financial analysis and consultation, financing, financial asset management, investment, real estate related and insurance services (Annex 4).

The trademarks owned by the Complainant include the following (Annex 5):

- United States trademark no. 4184937 CAPITOL FEDERAL (word), registered on August 7, 2012, for services in Class 36;
- United States trademark no. 5912316 CAPITOL FEDERAL (word), registered on November 19, 2019, for services in Classes 35 and 36.

The Complainant is offering its services in brick-and-mortar branch locations as well as online through its website and downloadable mobile applications. It owns, since February 10, 1996, the domain name <capfed.com> which directs to its principal website. (Exhibits A and B to Annex 4).

The disputed domain name was created on October 20, 2024 (Annex 1). On October 22, 2024, it was redirected to the Complainant's own website at <capfed.com> (Annex 4 at 10). At the time of filing of the present Complaint, it resolved to a website that was parked with the Registrar stating that the domain name is active and available for sale (Annex 6) with a sales listing at a one-time fee for Premium Domain Purchase of USD4,900 (Annex 7).

#### **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 it owns trademark and business name rights that predate the creation of the disputed domain name by far. The disputed domain name incorporates its CAPITOL FEDERAL mark in its entirety, adding only the generic term "bank". Accordingly, with the Top-Level Domain ".co", which the Complainant deems to be generic, to be disregarded the disputed domain name is confusingly similar to the Complainant's CAPITOL FEDERAL Mark.

Further, the Complainant puts forth that the Respondent, upon the Complainant's information and belief, is not commonly known by the disputed domain name and has never granted a license to the Respondent to use its CAPITOL FEDERAL mark. According to the Complainant, there is no evidence that before any notice to the Respondent of this dispute the Respondent used or prepared to use the disputed domain name in connection with a bona fide offering of goods or services under the Complainant's mark. The Complainant asserts that, on the contrary, on October 22, 2024, according to its anti-phishing vendor, the disputed domain name was automatically redirecting users to its "www.capfed.com" website (Annex 4 at 10), and, at the time of filing the Complaint, the disputed domain name resolved to a webpage that is parked with the Registrar

stating that the domain name is active and available for sale (Annexes 6 and 7). In addition, the Complainant cites its IT provider as having determined that the disputed domain name was related to a malicious operation (Annex 8). Consequently, none of these findings leads to the conclusion that the disputed domain name was used in connection with a bona fide offering of goods or services or gives rise to any rights or legitimate interests on the Respondent's side. Concluding, the Complainant deems it unlikely that any bona fide offering is intended in the future; rather, the disputed domain name is set up to intentionally deceive Internet users regarding a connection with the Complainant.

Lastly, the Complainant argues that the disputed domain name was registered and is being used in bad faith. On registration in bad faith, the Complainant is of the opinion that its CAPITOL FEDERAL mark is well-known through longstanding use. Further, the fact that the disputed domain name was created using this exact same term in combination with a generic term identifying the services that this mark is used for, namely "bank", and moreover using the help of a privacy shield, speaks for the fact that the Respondent was in full knowledge of the Complainant, its business and its trademarks. As to use in bad faith, the Complainant again points to the initial redirection of the disputed domain name to its "www.capfed.com" website and the documented intention of the Respondent to sell the disputed domain name for commercial gain. Finally, the Complainant assumes that the disputed domain name was to be used for a spoofing scheme, creating a counterfeit website and/or email address for phishing purposes.

## **B. Respondent**

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

## **6. Discussion and Findings**

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

Although the addition of other terms, here "bank", 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 mark 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.

Panels have held that the use of a domain name for an illegitimate activity, here, claimed impersonation of the Respondent by the initial redirection of the disputed domain name to the Complainant's own website as made credible by the Complainant in Annex 4 at 10, can never confer rights or legitimate interests on a respondent. [WIPO Overview 3.0](#), section 2.13.1.

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.

Given that the scenarios described in UDRP paragraph 4(b) are non-exclusive and merely illustrative, even where a complainant may not be able to demonstrate the literal or verbatim application of one of the above scenarios, evidence demonstrating that a respondent seeks to take unfair advantage of, abuse, or otherwise engage in behavior detrimental to the complainant's trademark would also satisfy the complainant's burden. [WIPO Overview 3.0](#), section 3.1.

The facts presented by the Complainant fit into the rationale of paragraph 4(b)(i) of the Policy, namely there are circumstances indicating that the Respondent has registered or acquired the disputed domain name primarily for the purpose of selling, renting, or otherwise transferring the disputed domain name to the Complainant who is the owner of the trademark or to a competitor of the Complainant, for valuable consideration in excess of the Respondent's documented out-of-pocket costs directly related to the disputed domain name.

The Panel notes that the Respondent created the disputed domain name fully copying the Complainant's trademark, adding a term related to the Complainant's business, and – as made credible by the Complainant in Annex 4 at 10 and uncontested by the Respondent - only two days later redirected the disputed domain name to the Complainant's own company website. This, whether the Complainant's trademark be well-known or not, is, in the Panel's view, clearly indicative of the Respondent having known and targeted the Complainant and its trademark upon the creation and registration of the disputed domain name. Further, the Respondent evidently sought to sell the disputed domain name, if not to the Complainant itself, then to a competitor or other third party interested in making use of the Complainant's trademark, for a valuable consideration USD4,900, which is by far likely exceeding the assumed costs of the registration of the disputed domain name (Annex 7). While this may not be indicative of use in bad faith per se, in connection with the actual string of the disputed domain name it certainly is, given that any use of the disputed domain name would inevitably lead to a likelihood of confusion of Internet users as to the source, affiliation or endorsement of a website or email address connected to the disputed domain name and thus to profit from the Complainant's trademark. [WIPO Overview 3.0](#), section 3.1.1.

Having reviewed the record, the Panel accordingly 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 <capitolfederalbank.co> be transferred to the Complainant.

*/Andrea Jaeger-Lenz/*

**Andrea Jaeger-Lenz**

Sole Panelist

Date: January 16, 2025