

ADMINISTRATIVE PANEL DECISION

Essentia Health v. Privacy service provided by Withheld for Privacy ehf /
Richard Dunn
Case No. D2022-2769

1. The Parties

Complainant is Essentia Health, United States of America (“U.S.”), represented by Faegre Drinker Biddle & Reath LLP, U.S.

Respondent is Privacy service provided by Withheld for Privacy ehf, Iceland / Richard Dunn, U.S.

2. The Domain Name and Registrar

The disputed domain name <essentiahealthsystem.org> 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 27, 2022. On July 28, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. Also on July 28, 2022, 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 and contact information in the Complaint.

The Center sent an email communication to Complainant on July 29, 2022 providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. Complainant filed an amendment to the Complaint on August 1, 2022.

The Center verified that the Complaint together with the amendment to the 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 August 2, 2022. In accordance with the Rules, paragraph 5, the due date for Response was August 22, 2022. Respondent did not submit any response. Accordingly, the Center notified Respondent’s default on August 23, 2022.

The Center appointed Frederick M. Abbott as the sole panelist in this matter on August 29, 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

Complainant is the owner of registrations for the word, and word and design, service mark ESSENTIA HEALTH on the Principal Register of the United States Patent and Trademark Office (“USPTO”), including word registration number 4,844,627, registration dated November 3, 2015 in international class (IC) 44, covering healthcare services, medical services, hospitals and nursing homes, and; word and design registration number 4,844,626, registration dated November 3, 2015 in IC 44. Complainant is the owner of registration for the word service mark ESSENTIACARE on the Principal Register of the USPTO, registration number 5,212,824, registration dated May 30, 2017, in ICs 35, 36 and 44, covering managed care services, administration of preferred provider healthcare plans, and healthcare in the nature of health maintenance organizations, and further specified.

Complainant describes itself as an integrated health system with more than 2100 physicians and advanced practitioners providing patient services at various types of healthcare facilities. Complainant operates in 14 hospitals and approximately 73 clinic and outpatient care locations. Complainant has over 14,700 employees. Complainant operates a website at <essentiahealth.org> (with the domain name registered by Complainant on November 3, 2004).

According to the Registrar’s verification, Richard Dunn is registrant of the disputed domain name. According to a Whois Lookup furnished by Complainant, the record of registration for the disputed domain name was created on June 6, 2022. There is no evidence in the record of this proceeding to indicate that any party other than Respondent has owned or controlled the disputed domain name.

According to the information disclosed by the Registrar, the physical address in Respondent’s contact details in its record of registration of the disputed domain name is the address of Complainant’s headquarters in Minnesota, U.S.

Respondent has used the disputed domain name to direct Internet users to a website that appears from screenshots provided by Complainant to be a direct clone or replicant of Complainant’s website, including a warning to vendors to help prevent fraud. The URL on Respondent’s website shows the disputed domain name. Respondent has also used the disputed domain name as the email domain in at least one email purporting to originate with a fictional Strategic Procurement Manager of Complainant. This email of July 20, 2022 requests a vendor to supply a quote for 85 Lenovo notebook computers, with a deadline for providing a quotation of July 27, 2022.

5. Parties’ Contentions

A. Complainant

Complainant alleges that it owns rights in the trademark ESSENTIA HEALTH, and that the disputed domain name is confusingly similar to that trademark.

Complainant contends that Respondent lacks rights or legitimate interests in the disputed domain name because: (1) Respondent is using the disputed domain name neither in connection with a *bona fide* offering of goods or services nor for legitimate noncommercial or fair use purposes; (2) Respondent is using the disputed domain to perpetrate a fraudulent scheme by deceiving email recipients through use of Complainant’s trademark as the sender domain in email falsely appearing to originate from an employee of complainant; (3) there is no evidence that Respondent has been commonly known by Complainant’s

trademark, and; (4) Complainant has not licensed or otherwise authorized Respondent to use its trademark in the disputed domain name.

Complainant argues that Respondent registered and is using the disputed domain name in bad faith because: (1) registration and use of the disputed domain name to create Internet user confusion regarding the source of emails in order to perpetrate fraud constitutes bad faith; (2) creating a false email identity for the purpose of defrauding Complainant or third parties is evidence of bad faith; (3) associating the disputed domain name with a website that mirrors Complainant's website suggests that the disputed domain name is licensed by or controlled by Complainant and is evidence of bad faith, and; (4) Respondent's deliberate provision of false contact information in its record of registration of the disputed domain name is evidence of bad faith.

Complainant requests the Panel to direct the Registrar to transfer the disputed domain name to Complainant.

B. Respondent

Respondent did not reply to Complainant's contentions.

6. Discussion and Findings

It is essential to Policy proceedings that fundamental due process requirements be met. Such requirements include that a respondent have notice of proceedings that may substantially affect its rights. The Policy and the Rules establish procedures intended to ensure that respondents are given adequate notice of proceedings commenced against them and a reasonable opportunity to respond (see, e.g., Rules, paragraph 2(a)).

The Center formally notified the Complainant to Respondent at the email and physical addresses provided in its record of registration. Courier delivery of the Written Notice of the Complaint appears to have been successful, though the Panel notes that Respondent used Complainant's physical address in its contact details.¹ There is no indication of problems with the transmission of email to Respondent. The Center took those steps prescribed by the Policy and the Rules to provide notice to Respondent, and those steps are presumed to satisfy notice requirements.

Paragraph 4(a) of the Policy sets forth three elements that must be established by a complainant to merit a finding that a respondent has engaged in abusive domain name registration and use and to obtain relief. These elements are that:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which complainant has rights;
- (ii) 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.

Each of the aforesaid three elements must be proved by a complainant to warrant relief.

A. Identical or Confusingly Similar

Complainant has provided evidence of rights in the trademark ESSENTIA HEALTH, including by registration at the USPTO and through use in commerce.² See Factual Background *supra*. Respondent has not

¹ While it is not material to these proceedings, the Panel assumes that routine delivery of a courier package to Complainant's facilities, even if the address includes an individual not employed by Complainant, would not be out of the ordinary.

² For purposes of establishing confusing similarity, the panel does not consider it necessary address the trademark ESSENTIACARE. This is without prejudice to Complainant's rights in that trademark.

challenged Complainant's rights in that trademark. The Panel determines that Complainant owns rights in the trademark ESSENTIA HEALTH.

The disputed domain name directly and fully incorporates Complainant's ESSENTIA HEALTH trademark.³ The addition by Respondent of the term "system" to Complainant's trademark in the disputed domain name does not prevent a finding of confusing similarity. The Panel determines that the disputed domain name is confusingly similar to Complainant's trademark.

The Panel determines that Complainant owns rights in the trademark ESSENTIA HEALTH and that the disputed domain name is confusingly similar to that trademark.

B. Rights or Legitimate Interests

Complainant's allegations to support Respondent's lack of rights or legitimate interests in the disputed domain name are outlined above, and the Panel finds that Complainant has made a *prima facie* showing that Respondent lacks rights or legitimate interests in the disputed domain name.

Respondent has not replied to the Complaint and has not attempted to rebut Complainant's *prima facie* showing of lack of rights or legitimate interests.

Respondent's use of the disputed domain name as the sender domain in deceptive email that appears intended to defraud Complainant and/or third parties does not establish rights or legitimate interests in the disputed domain name. Respondent's use of the disputed domain name to direct Internet users to a clone of Complainant's website does not establish rights or legitimate interests. Such uses do not involve a *bona fide* offering of goods or services, and do not make legitimate noncommercial or fair use of Complainant's trademark. There is no indication that Respondent was commonly known by the disputed domain name, or established trademark rights in its terms, when it registered and began using the disputed domain name. Respondent was not authorized by Complainant to make use of its trademark in the disputed domain name.

Respondent's use of the disputed domain name does not otherwise manifest rights or legitimate interests.

The Panel determines that Complainant has established that Respondent lacks rights or legitimate interests in the disputed domain name.

C. Registered and Used in Bad Faith

In order to prevail under the Policy, Complainant must demonstrate that the disputed domain name "has been registered and is being used in bad faith" (Policy, paragraph 4(a)(iii)). Paragraph 4(b) of the Policy states that "for the purposes of paragraph 4(a)(iii), the following circumstances, in particular but without limitation, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith". These include that, "(iv) by using the domain name, [the respondent has] intentionally attempted to attract, for commercial gain, Internet users to [the respondent's] website or other online location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of [the respondent's] website or location or of a product or service on [the respondent's] website or location".

Respondent was aware of Complainant and its trademark when it registered and used the disputed domain name because Respondent created a clone of Complainant's website with which to associate the disputed domain name, and Respondent included Complainant's physical address in the contact details of the record of registration. Respondent was targeting Complainant and its business goodwill.

³ There is a space between the two terms in Complainant's trademark. This is not material from the standpoint of comparing the trademark to the disputed domain name as the domain name system (DNS) does not permit open spaces between terms.

Respondent has used the disputed domain name to create and send email, deliberately designed to appear as originating from Complainant, and that seek to defraud Complainant and/or third parties. This constitutes use of the disputed domain name for commercial gain to attract Internet users to Respondent's online location by creating confusion as to affiliation of Complainant and its trademark with Respondent's online location. In addition, without authorization from Complainant, Respondent cloned Complainant's website and associated the disputed domain name with that website. Such action is intended to confuse Internet users for commercial gain by associating Respondent's clone website with Complainant and its trademark, presumably to reinforce Respondent's deceptive use of the disputed domain name in its email scheme.

The Panel determines that Respondent registered and is using the disputed domain name within the meaning of paragraph 4(b)(iv) 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, <essentiahealthsystem.org>, be transferred to the Complainant.

/Frederick M. Abbott/

Frederick M. Abbott

Sole Panelist

Date: September 12, 2022