



## NATIONAL ARBITRATION FORUM

### DECISION

Combined Insurance Group Ltd v. iclicks c/o Michael Mayder  
Claim Number: FA0905001261538

#### PARTIES

Complainant is **Combined Insurance Group Ltd** (“Complainant”), represented by **Philip J. Foret**, of **Dilworth Paxson LLP**, Pennsylvania, USA. Respondent is **iclicks c/o Michael Mayder** (“Respondent”), represented by **Karen J. Bernstein**, of **Law Offices of Karen J. Bernstein, LLC**, New York, USA.

#### REGISTRAR AND DISPUTED DOMAIN NAME

The domain name at issue is **<cheapautosinsurance.com>**, registered with **Godaddy.com, Inc.**

#### PANEL

The undersigned certifies that he or she has acted independently and impartially and to the best of his or her knowledge has no known conflict in serving as Panelist in this proceeding.

Diane Cabell, Robert T. Pfeuffer and Paul M. DeCicco, as Panelists.

#### PROCEDURAL HISTORY

Complainant submitted a Complaint to the National Arbitration Forum electronically on May 6, 2009; the National Arbitration Forum received a hard copy of the Complaint on May 7, 2009.

On May 7, 2009, Godaddy.com, Inc. confirmed by e-mail to the National Arbitration Forum that the **<cheapautosinsurance.com>** domain name is registered with Godaddy.com, Inc. and that the Respondent is the current registrant of the name. Godaddy.com, Inc. has verified that Respondent is bound by the Godaddy.com, Inc. registration agreement and has thereby agreed to resolve domain-name disputes brought by third parties in accordance with ICANN’s Uniform Domain Name Dispute Resolution Policy (the “Policy”).

On May 14, 2009, a Notification of Complaint and Commencement of Administrative Proceeding (the “Commencement Notification”), setting a deadline of June 3, 2009 by which Respondent could file a Response to the Complaint, was transmitted to Respondent via e-mail, post and fax, to all entities and persons listed on Respondent’s registration as technical, administrative and billing contacts, and to postmaster@cheapautosinsurance.com by e-mail.

A timely Response was received and determined to be complete on June 3, 2009. Complainant’s Additional Submission was received on June 8, 2009. Respondent’s Additional Submission was received on June 15, 2009. Each submission was timely pursuant to The Forum’s Supplemental Rule #7. On June 17, 2009, Complainant emailed another Additional Submission to the National Arbitration Forum which it subsequently forwarded to the Panel on that same date.

On June 11, 2009, pursuant to Respondent's request to have the dispute decided by a three-member Panel, the National Arbitration Forum appointed Ms. Diane Cabell, Hon. Robert T. Pfeuffer and Mr. Paul M. DeCicco as Panelists.

## RELIEF SOUGHT

Complainant requests that the domain name be transferred from Respondent to Complainant.

## PARTIES' CONTENTIONS

### A. Complainant

Complainant contends as follows:

Complainant owns a United States service mark registration for the CHEAP AUTO INSURANCE mark, No. 3,576,266 issued in February of this year. Complainant's U.S. Registration covers insurance services, namely insurance brokerage services and insurance agency services. Complainant owns all of the substantial goodwill in the CHEAP AUTO INSURANCE mark associated with Complainant's widespread and continuous use of the mark in United States commerce for greater than 16 years, since at least as early as April 1, 1993.

Complainant currently owns a Pennsylvania registration for the CHEAP AUTO INSURANCE mark for insurance and financial services bearing Pennsylvania Registration No. 2,826,318. Furthermore, Complainant also owns other Pennsylvania registrations for the marks CHEAP AUTO INSURANCE NETWORK and CHEAP AUTO INSURANCE SOLUTIONS for insurance and financial services bearing Pennsylvania Registration Nos. 2,826,311 and 2,826,314, respectively. *See Id.* at ¶ 24. These Pennsylvania registrations cover insurance and financial services and issued on July 13, 1998.

Since 1993, Complainant has used and continues to use its CHEAP AUTO INSURANCE mark in connection with identifying and otherwise promoting, marketing, and advertising its insurance services and providing its insurance services, insurance brokerage services, and insurance agency services. In 1996, Complainant expanded use of its CHEAP AUTO INSURANCE mark onto the Internet to identify its business online through its website. Thus, for greater than 16 years, Complainant has used its CHEAP AUTO INSURANCE mark in the insurance industry, initially, through traditional print advertising and later developed Internet-based operations throughout United States commerce.

Further to the marks cited as a basis for relief in the Complaint, Complainant also relies on substantial common law rights and goodwill established in the CHEAP AUTO INSURANCE mark through its use to identify and promote Complainant's business.

The primary strategy of the <cheapautosinsurance.com> website is to divert Internet users to the site and then to direct users to websites owned and operated by competitors of Complainant or to insurance carriers. This strategy of capturing and redirecting Internet users is a blatant attempt to trade off of the well-known and distinctive brand name of Complainant.

The WHOIS information for the disputed domain name shows that Respondent registered the domain name on August 7, 2003. The creation date of the disputed domain name is well after Complainant's first use and registration of its CHEAP AUTO INSURANCE mark in 1993. Complainant only recently became aware of the <cheapautosinsurance.com> website.

Cheapautosinsurance.com is identical or confusingly similar to a trademark/service mark in which Complainant has rights.

This is a case of typosquatting. Respondent has intentionally adopted Complainant's well-known mark and merely added the letter "s" in the disputed **<cheapautosinsurance.com>** domain name. Respondent added a single letter to Complainant's mark in the disputed domain name in an attempt to intercept and divert traffic from Complainant's website by preying on common typing errors. Respondent is trading off of Complainant's goodwill in its distinctive CHEAP AUTO INSURANCE mark.

The disputed domain name creates a likelihood of confusion with Complainant's mark CHEAP AUTO INSURANCE. Registrant adopted Complainant's mark in total, deleted the spaces between the words, and added the letter "s" at the end of the word "Auto". Furthermore, the ".com" suffix has no bearing on the likelihood of confusion analysis.

The "Cheapautosinsurance" aspect of the disputed domain name is nearly phonetically and visually equivalent to Complainant's CHEAP AUTO INSURANCE mark. Because Respondent's domain name Cheapautosinsurance.com is nearly phonetically and visually equivalent to Complainant's mark, the disputed domain name is likely to cause confusion among Internet users as to Complainant's affiliation, or association with, Respondent's website which provides links to websites of competitors of Complainant as well as other insurance providers and carriers.

Respondent should be considered as having no rights or legitimate interests with respect to Cheapautosinsurance.com. Respondent's adoption of Complainant's CHEAP AUTOS INSURANCE mark and the addition of the letter "s" after the word "Auto" is typosquatting. Typosquatting is conclusory evidence that a respondent lacks rights or legitimate interests in a disputed domain name.

With respect to Policy ¶ 4(a)(ii), none of the three protections for domain name registrants provided in Policy ¶ 4(c)(i)-(iii), including that the Respondent is making a bona fide offering of goods or services, is commonly known by the domain name, and is making a legitimate noncommercial or fair use of the domain name, are available to Respondent.

In combination with the aforementioned typosquatting, the disputed domain name is being used to operate a website providing insurance services that compete directly with Complainant. The website provides links to third party commercial websites offering products and services in the auto insurance industry. The owners of the third-party websites offer insurance products and services in competition with Complainant.

Accordingly, and prior to notice of this dispute, Respondent has not been using Cheapautosinsurance.com with a bona fide offering of goods or services, thus rendering Policy ¶ 4(c)(i) inapplicable.

Respondent is not commonly known as Cheapautosinsurance.com. The WHOIS information for Cheapautosinsurance.com provides Domains by Proxy, Inc., as the Registrant, Administrative Contact, and Technical Contact. There is no indication from Respondent's WHOIS information that it was commonly known by the domain name prior to the domain name's registration. It was only after Complainant filed its initial complaint that the registrant is now identified as "iclicks c/o Michael Mayder."

Respondent is not authorized to use Complainant's well-known and distinctive CHEAP AUTO INSURANCE mark. Accordingly, Respondent is not commonly known by Cheapautosinsurance.com, thus making Policy ¶ 4(c)(ii) inapplicable.

Respondent is obtaining commercial gain by diverting consumers to its directory at **<cheapautosinsurance.com>**, which contains a search function for auto insurance information, quotes, and links to insurance agents by zip code. The website also provides links to websites of competitors of Complainant and directs Internet users to insurance agents and carriers.

Thus, Respondent is trading off of the goodwill associated with Complainant's mark and creating a false notion of approval by, or association and affiliation with, Complainant. Accordingly, Respondent is not making a legitimate noncommercial or fair use of Cheapautosinsurance.com, thus making Policy ¶ 4(c)(iii) inapplicable.

The domain name Cheapautosinsurance.com has been registered and is being used in bad faith pursuant to Policy ¶ 4(b)(iii) and Policy ¶ 4(b)(iv). Respondent is typosquatting by adopting a domain name with the addition of one letter to Complainant's mark CHEAP AUTO INSURANCE. Respondent's typosquatting creates a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of Respondent's website. Furthermore, using typosquatting to divert Internet users to competitors of complainant constitutes bad faith registration and use pursuant to Policy ¶ 4(b)(iii).

**<Cheapautosinsurance.com>** is being used to attract users to the site, which is a web directory featuring links to Complainant's competitors in the insurance industry. Further, Respondent is actually aware that it is trading off of Complainant's goodwill. Respondent's site utilizes Complainant's well-known and distinctive mark. The combination of actual knowledge of Complainant's mark and the adoption of a confusingly similar domain name is evidence of bad faith.

Complainant requests the Panel to issue a decision that the domain name registration for Cheapautosinsurance.com be transferred to Complainant pursuant to Rule 3(b)(x). Policy ¶ 4(i).

#### B. Respondent

Respondent contends as follows:

Complainant's CHEAP AUTO INSURANCE mark is not "well known" and "distinctive." Complainant cannot claim superior rights in the mark, especially since it ceased use of the mark for a period of over three years - a time period when Respondent registered the disputed domain name and used it. In addition, Complainant has failed to provide evidence that Respondent lacks legitimate rights in the www.cheapautosinsurance.com domain name, especially since Respondent is commonly known by the domain name and offers *bona fide* services.

Respondent never heard of the mark when it registered the domain name. It was not until the instant proceeding was initiated that Respondent knew anything about the mark. Respondent did not register or use the domain name in bad faith.

Respondent iclicks is an Internet advertising company owned by WeDirect LLC. It refers Internet traffic to automobile dealers, insurance companies, and educational providers. Complainant also provides search marketing services to businesses. In or around early August of 2003, WeDirect's Chief Operating Officer searched online looking for automobile insurance and found that the automobile insurance being offered to the public was just too expensive, so he thought the words "cheap," "autos," and "insurance" would be the type of descriptive terms Internet users would use in a search engine like Google when looking for comparative insurance companies offering low rates on automobile insurance. On or about August 7, 2003. Respondent

registered the at-issue domain name through a privacy shield. The website referenced by the domain name has been in continuous operation since that date offering Internet users a web portal to compare auto insurance rates among competitors. Respondent has invested substantial sums in building and marketing the website referenced by the domain name and has become commonly known by such name. Since August, 2003 when Respondent registered the domain name, Respondent has generated large profits in referring Internet traffic to automobile insurance companies. Therefore, transfer of the domain name to Complainant would result in significant damage to Respondent and a windfall to the Complainant.

Complainant's federal registration for the mark issued in February, 2009, almost six years after Respondent registered the at-issue domain name. Further, Complainant did not have common law rights in the mark prior to Respondent's registration date of the domain name, August 7, 2003, since Complainant ceased use of the mark for a period of over three years and it was during that period of abandonment that Respondent registered the at-issue domain name and used it.

Complainant contends that the mark is "wellknown" and "distinctive" without providing any supporting evidence to show it acquired secondary meaning in the mark before Respondent registered the domain name. Ordinarily, proof of secondary meaning includes evidence such as length and amount of sales under the mark, the nature and extent of advertising, consumer surveys and media recognition.

The Pennsylvania state trademark registration submitted by Complainant does not prove that the mark is "well-know" or "distinctive." Complainant's federal trademark registration of the mark does not help it either. Prior to federal registration of a trademark, the Complainant does not enjoy the benefit of any presumption of the exclusive right to use a mark afforded by registrations and must prove that its mark is distinctive.

Complainant cannot prove "distinctiveness" since it disclaimed the words "Auto Insurance" in its federal registration of the mark and thus the mark is weak and entitled to a limited scope of protection. It follows that Complainant cannot make out a case for secondary meaning in the mark at common law here.

Even if Complainant were permitted to claim secondary meaning in the disclaimed portions of the mark, it cannot. Complainant's attempts to prove secondary meaning through printouts of its website located at [www.cheap-auto-insurance.com](http://www.cheap-auto-insurance.com) spanning from approximately 1996 to the present, an advertisement or two in a local newspaper, and one small classified 2001 advertising listing in *The National Enquirer* that consists of three lines with the heading "Cheap Auto Insurance." In addition, all the printouts of Complainant's Website from 1999 to 2002 displayed the words, "Coming Soon" on the homepage suggesting that the mark was not actively being used during that time period, at least outside the State of Pennsylvania, so Complainant did not have any common law rights years before Respondent registered the domain name. Therefore, it appears that Complainant had virtually no common law rights dating back to 1999.

It is well settled that a domain name comprised of descriptive terms may be used to attract Internet traffic even where the domain name is confusingly similar to the registered mark of a complainant. Since the domain name is comprised of the descriptive, if not, generic terms, "cheap," "auto," and "insurance," Respondent was free to register the domain name and there is no confusing similarity between the domain name and Complainant's mark.

Complainant cannot have exclusive rights in the mark. "Cheap auto insurance" (and variations of

the phrase thereof) is a "generic term."

"Cheap" is a self-laudatory descriptive designation and cannot be protected unless secondary meaning is proven, which Complainant has failed to evidence, and "cheap," "auto," and "insurance" are constantly used in advertisements related to offering inexpensive automobile insurance.

Respondent has had a legitimate interest in the disputed domain name long before Complainant commenced the instant arbitration proceeding. Respondent has used the domain name, which contains common words, for over five years before the instant proceedings were initiated. A close inspection of Complainant's Website reveals that is not an insurance broker at all. Like Complainant, Respondent is also in the business of driving traffic to major automobile insurance companies through its Website, and the mark is a generic or descriptive phrase to which Complainant has no exclusive rights, so Respondent has a legitimate interest in the Domain.

Respondent offers *bona fide* services under the domain name. Respondent's business is commonly known by the domain name. Its use of the domain name is a *bona fide* offering of services under the Policy since it has been consistently selling Internet traffic to automobile insurance companies under the domain name since at least as early as August 2003.

General allegations of bad faith are insufficient to carry its burden. Complainant fails to specify with particularity the facts and circumstances supporting its allegations of Respondent's bad faith registration of the domain name. Complaint contends that Respondent registered the domain name in bad faith because (1) it is a "typosquatter"; (2) it uses the domain name to "attract users to the site, which is a web directory featuring links to Complainant's competitor in the insurance industry"; and (3) that "Respondent is actually aware that it is trading off of Complainant's goodwill" by using the mark.

Respondent denies these bald allegations. Unsupported allegations of Respondent's purported bad faith in registering and using a domain name is not enough to satisfy Policy ¶4(b). Further, because the mark consists of a generic phrase and uses the domain name in a descriptive fashion there is no violation of the Policy. Under the circumstances, Respondent cannot be found to have registered the domain name in bad faith.

In addition, Complainant's attempt to cast dispersions on Respondent's standard practice of registering domain names using a privacy shield to protect its privacy and avoid spam e-mails is unavailing since registration of a domain name by proxy is not indicative of bad faith intent, especially when the complainant had no difficulty initiating the proceeding against the proper respondent.

Complainant mislabels Respondent as a "typosquatter." Typosquatting involves famous trademarks whose registrations predated by many years respondent's registration of a phonetically equivalent or misspelled domain name. Respondent registered the domain name during a period of time when Complainant abandoned the mark and Complainant fails to prove its mark is "famous." Respondent never heard of the mark until the Complaint was filed, did not intentionally register the domain name with Complainant's mark in mind, and never offered to sell the domain name to Complainant (or any other third party, for that matter), or disrupt Complainant's business.

Complainant abandoned its rights in the mark before respondent registered the domain

name. Respondent registered the domain name during a period of time after Complainant ceased use of the mark. It is well settled that three years of non-use of a trademark is *prima facie* abandonment of the mark.

Since there is absolutely no mention of CHEAP AUTO INSURANCE on any of the web shots until October, 2006, well over three years after Respondent registered the domain name, and Complainant failed to adduce any evidence to show that it acquired secondary meaning in its so-called common law rights prior to registration of the domain name, Respondent could not have registered the domain name in bad faith. Therefore, Complainant had no trademark rights in the mark at the time Respondent registered the domain name in or around August, 2003.

Respondent had no knowledge of Complainant when it registered the domain name and registration of a trademark by a complainant after the registration of the domain name at issue precludes a finding of bad faith registration. At the time it registered the domain name, Respondent had no knowledge of Complainant or its business and had no intention to capitalize on the mark, especially since it concerned such a generic phrase as "cheap autos insurance."

Complainant fails to evidence that Respondent used the domain name in bad faith. Respondent did not use the domain name in bad faith. As discussed above, Complainant did not have common law rights at the time Respondent registered the domain name, and Complainant did not apply for federal registration of the mark until July 27, 2006, almost three years after Respondent registered the domain name. It was not until February 19, 2009, over six years after Respondent registered the domain name that Complainant obtained its Certificate of Registration. Therefore, it would be nearly impossible for Respondent to have had actual knowledge of the domain name over the last five plus years.

Respondent did not intend to cause confusion with Complainant's mark or to disrupt or target Complainant's business. Complainant fails to evidence how Respondent purportedly intended to cause confusion with the mark or disrupt or target Complainant. Nowhere does Complainant contend that it has had instances of actual confusion between its mark and Respondent's domain name. Respondent never intended to disrupt or to target Complainant by its use of the domain name, especially when it did not know of Complainant's mark.

Indeed, Respondent has been continuously operating a website located at the domain name (consisting of a descriptive and/or a generic phrase) for almost six years, and since Complainant did not have federal trademark rights until over five years after Respondent registered the domain name it would be virtually impossible to say that Respondent intended to cause confusion with Complainant's mark or disrupt or target Complainant's business, especially when Complainant had abandoned its mark prior to Respondent's registration of the domain name, and it did not resume use of the mark until years after Respondent had been operating under the domain name.

A Finding of Reverse Domain Hijacking should be found here. Complainant knew that it had no superior rights in the mark before it filed its Amended Complaint because Respondent registered the domain name back in August, 2003, well after Complainant stopped using the mark. It also knew that it did not have a well-known and distinctive mark. Nevertheless, Complainant brought its Amended Complaint against Respondent and abused the UDRP

process by doing so.

Complainant never contacted Respondent in the five plus years since Respondent registered the domain name to put Respondent on notice of its so-called trademark rights. Instead, it calculatingly waited for its fraudulently procured federal trademark to issue so it could try to use it against Respondent by abusing the UDRP dispute resolution process to gain possession of Respondent's lawful registration of the domain name. Complainant's intentional abuse of the administrative process should not be sanctioned. The Complainant knew, when it filed the Amended Complaint, that the registration of the domain name preceded by over five years (or three years, at the least) any rights that the Complainant may have acquired in the words "cheap auto insurance." This is sufficient to find reverse domain name hijacking pursuant to Paragraph 15(e) of the Rules.

### C. Additional Submissions

Complainant contends in its Additional Submission as follows:

The domain name at issue is the nearly visually and phonetically equivalent to Complainant's mark. The disputed domain name is used primarily to attract Internet traffic by providing an informational resource for auto insurance throughout at least the United States, if not the world. In addition, the disputed domain name provides commercial listings of United States-based auto insurance carriers and search functions to provide auto insurance quotes based on zip codes in the United States to Internet users.

There is no indication that Respondent's WHOIS information would even suggest that Respondent is commonly-known by the domain name.

Respondent completely ignores Complainant's (a) common law rights established through greater than 16 years of longstanding and continuous use by Complainant in its traditional brick and mortar insurance agency, and (b) federal rights recognized by the U.S. Patent and Trademark Office's granting of a registration on the Principal Register. Complainant's use of its mark long predates the registration of the domain name in dispute -- a relevant requirement under ICANN rules. Furthermore, Respondent diminishes the content of the site -- a commercial site competing directly with Complainant's business -- while admittedly embracing illegitimate and unauthorized use of Complainant's own mark in the process.

The Respondent's use of the domain name cannot be considered legitimate noncommercial or fair use. Respondent's argument -- that Complainant's mark is descriptive and possibly generic -- is flawed. Complainant's mark has been determined to be distinctive by the U.S. Patent and Trademark Office ("USPTO") -- not descriptive or even generic. Complainant has used its mark for greater than 16 years.

Complainant's rights are established in its mark by way of its longstanding and continuous use of the mark. The CHEAP AUTO INSURANCE mark has been in use for over 16 years and is the subject of a United States Registration since February 17, 2009. Complainant has used the mark continuously since April 1, 1993 in connection with its brick and mortar insurance agency and through print media and advertising, and then later through its website launched on July 12, 1996 after the onset of the Internet. Over the years since 1993, Complainant has spent several million dollars in marketing and advertising its products and services using the CHEAP AUTO INSURANCE mark.



Complainant owns substantial common law rights in the CHEAP AUTO INSURANCE mark based on extensive use since April 1, 1993, if not earlier. In fact, Complainant's common law rights were already established by August 7, 2003 -- the date of registration of the domain name. Further, Complainant provided evidence of its Pennsylvania registration and the date of its first use of the CHEAP AUTO INSURANCE mark, both of which long precede Respondent's date of domain name registration.

The Lanham Act expressly provides that "no disclaimer . . . shall prejudice or affect the applicant's or registrant's right then existing or thereafter arising in the disclaimed matter, . . . if the disclaimer matter be or shall have become distinctive of his goods and services."

Respondent's contention that because "Cheap Autos Insurance" is being used by others somehow limits Complainant's rights under the ICANN standard is wrong. Respondent is improperly relying on third party use.

Respondent's date of registration does not create a legitimate interest in the disputed domain name. Respondent argues it has such a legitimate interest because it has registered the domain name before the date of registration of Complainant's federal registration. Respondent, cites no authority for the proposition that established common law rights are trumped by a later-in-time domain name registration which would allow a respondent to adopt a confusingly similar domain name. Respondent cannot claim that it has superior rights to Complainant's mark CHEAP AUTO INSURANCE. With regard to the date that Respondent registered the domain name, Complainant's use of its mark long preceded registration of the domain name by many years. The domain name was subsequently registered 10 year later. Respondent's subsequent registration and later use of the confusingly similar domain name for commercial websites competing directly with Complainant fails to exhibit rights or legitimate interests in the domain name.

Complainant has provided no authorization to Respondent to use Complainant's mark. Respondent is not a licensee of Complainant, nor has it received any permission or consent to use the trademark; Complainant has prior rights in its trademark which precede Respondent's registration of the domain name; and Respondent is not commonly known by the disputed domain name. Consequently, Respondent has no legitimate rights or interests in the disputed domain name.

Furthermore, Respondent does not appear to directly argue under Policy ¶4(c), any of the three fact patterns that show it has rights or legitimate interests. While Respondent denies -- without any concrete evidence -- that it was aware of Complainant prior to this dispute, this contention is neither relevant nor credible. It is simply not believable that Respondent was unaware of a direct competitor in the insurance industry. Respondent's claim is particularly suspect given the fact that it explicitly caters to consumers of auto insurance -- the same consumers of Complainant's services -- and purports to provide the directory for auto insurance.

Respondent does not -- and indeed cannot -- refute the essential elements that sustain Complainant's burden under the policy.

Respondent's assertion of reverse domain name hijacking must fail where Respondent has failed to offer any support for its meritless claim. Complainant established longstanding common law rights in the CHEAP AUTO INSURANCE mark before Respondent registered the domain name. Respondent does not have an unassailable right or legitimate interest in the disputed domain name or the clear lack of bad faith registration and use. Moreover, Complainant has met its other

burdens by establishing the elements of the ICANN Policy and Rules for transfer of the domain name. The Complaint was brought knowing that Respondent does not possess legitimate interests. Complainant has established rights in the service mark. Respondent chooses to ignore these determinative facts.

There is no evidence of harassment from Complainant, and the accusations and presumptions filed against Respondent are well within the scope of what UDRP Panels finds acceptable from a trademark owner who discovers a domain name that may infringe its trademark rights. Moreover, enforcing ones rights through UDRP proceedings is not bad faith.

Respondent contends in his Additional Submission as follows:

Complainant's Additional Submission, along with its supporting documentation, should be disregarded entirely. The Addition Submission contains nothing new and repeats the same arguments made in the Complaint: 1) it has a "well known" and "distinctive" trademark; 2) that Respondent has no rights or interest in the Domain Name; and 3) that because Respondent has a confusingly similar domain name to the at-issue mark and uses the domain name as a business it registered and used the domain name in bad faith. Complainant fails on all counts. Complainant had no trademark rights in CHEAP AUTO INSURANCE as of the critical date the domain name was registered and, therefore, Respondent could not have registered the disputed domain name in bad faith because it did not have any actual knowledge of Complainant when it registered the domain name.

Complainant presents no radio or television advertising, no widespread media coverage, or customer surveys in support of its Additional Submission to prove that the public identifies Complainant as of the source of the CHEAP AUTO INSURANCE mark at issue.

Complainant cannot bootstrap use of other trade names such as Combined Insurance Group and Insure Direct to show any trademark usage of the CHEAP AUTO INSURANCE mark in the gap of time between May 2003 and October 2006.

Respondent did not register the domain name in bad faith because Complainant had no trademark rights at that time. Had Respondent run a trademark search of the United States Patent and Trademark Office at the time of the domain name's registration, it would have never seen any trademark registration for CHEAP AUTO INSURANCE owned by Complainant or its predecessor in interest. Complainant did not file a trademark application for the mark until over three years after the domain name was registered. Further, Respondent has a legitimate interest in the domain name and offers bona fide services because it has a right to under the Policy. "Cheap," "auto," and "insurance" are common words. Respondent uses those words in a descriptive manner to sell cheap auto insurance. The documentation Complainant presents in its Additional Submission was clearly available when it originally filed its Amended Complaint. The Complainant's Additional Submission is in violation of the Forum's Rule 7(1).

Complainant's Additional Submission with 68 annotated footnotes, another self-serving supplemental, and over 700 pages of exhibits is nothing more than an attempt to circumvent the shorter "five day" response period under Forum's Rule 7 by "sandbagging" Respondent and forcing it to incur additional fees to file the instant Reply. It is evident therefore, that the Additional Submission is an attempt to make an end-run around the page limitation imposed by the Forum's Rule 4(a). Accordingly, the Panel should disregard Complainant's Additional

Submission.

## FINDINGS

Complainant has trademark rights in the mark CHEAP AUTO INSURANCE by virtue of its registration of such mark with the USPTO and Pennsylvania registration.

There is no compelling evidence that Respondent was aware of Complainant's trademark rights or should have been aware of such rights, if any existed, at the time Respondent registered the disputed domain name.

Respondent operates a legitimate business at a website referenced by the disputed domain name.

## DISCUSSION

Paragraph 15(a) of the Rules for Uniform domain name Dispute Resolution Policy (the "Rules") instructs this Panel to "decide a complaint on the basis of the statements and documents submitted in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable."

Paragraph 4(a) of the Policy requires that the Complainant must prove each of the following three elements to obtain an order that a domain name should be cancelled or transferred:

- (1) the domain name registered by the Respondent is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;
- (2) the Respondent has no rights or legitimate interests in respect of the domain name; and
- (3) the domain name has been registered and is being used in bad faith.

### **Identical and/or Confusingly Similar**

Complainant has rights in the CHEAP AUTO INSURANCE mark pursuant to Policy ¶ 4(a)(i) due to its trademark registration with the United States Patent and Trademark Office ("USPTO") (Reg. No. 3,576,266 issued Feb. 17, 2009). Its rights in the CHEAP AUTO INSURANCE mark date back to its filing of the application for the trademark registration on July 27, 2006 regarding registration of the mark for use in connection with Complainant's insurance brokerage services. *See AOL LLC v. Interrante*, FA 681239 (Nat. Arb. Forum May 23, 2006) (finding that where the complainant had submitted evidence of its registration with the USPTO, "such evidence establishes complainant's rights in the mark pursuant to Policy ¶ 4(a)(i)."). Complainant also demonstrates right by virtue of its Pennsylvania registration.

Although Respondent contends that the <cheapautosinsurance.com> domain name is comprised of common, descriptive terms and as such cannot be found to be identical to Complainant's mark, such a determination is not relevant to the Policy's ¶ 4(a)(i). This section considers only whether Complainant has rights in the mark and whether the disputed domain name is identical or confusingly similar to Complainant's mark. *See Vance Int'l, Inc. v. Abend*, FA 970871 (Nat. Arb. Forum June 7, 2007) (finding that because the complainant had received a trademark registration for its VANCE mark, the respondent's argument that the term was generic failed under Policy ¶ 4(a)(i)); *see also David Hall Rare Coins v. Tex. Int'l Prop. Assocs.*, FA 915206 (Nat. Arb. Forum Apr. 9, 2007) ("Respondent's argument that each individual word in the mark is unprotectable and therefore the overall mark is unprotectable is at odds with the anti-dissection principle of trademark law.").

Accordingly, the Panel gives paragraph 4(a)(i) its plain meaning. As used in that section “has rights” means that in order to go forward a Complainant must have rights at the time of filing its Complaint not, as other panels have conjectured, at the time of the domain name’s registration. *See Xoft Inc. v. Name Administration Inc. (BVI)*, FA 1154179 (Nat. Arb. Forum Apr. 25, 2008) holding the “relevant time for the determination of whether or not Complainant has rights in a mark is the time that Respondent registered the disputed domain name. *See also Phoenix Mortgage Corp. v. Toggas*, D2001-0101 (WIPO Mar. 30, 2001) (“[Policy ¶ 4(a)(i)] necessarily implies that the complainant’s [trademark] rights predate the respondent’s registration and use of the Domain Name. Any other interpretation would allow a junior trademark user to challenge a prior domain name registration, a possibility that is obviously contrary to the intent of the Policy and to trademark law generally”). Whether or not Complainant’s rights predate Respondent’s registration of the disputed domain name is irrelevant to Policy ¶ 4(a)(i), but is relevant to determinations pursuant to Policy ¶ 4(a)(ii) and (iii). *See AB Svenska Spel v. Zacharov*, D2003-0527 (WIPO Oct. 2, 2003) (holding that the UDRP Policy does not require a complainant to have registered its trademark prior to the respondent’s registration of the domain name under Policy ¶ 4(a)(i) but may prevent a finding of bad faith under Policy ¶ 4(a)(iii)).

Complainant’s mark is confusingly similar to the disputed domain name. The **<cheapautosinsurance.com>** domain name consists of Complainant’s CHEAP AUTO INSURANCE mark with the letter “s” added to the word “auto,” the spaces removed, and the generic top-level domain “.com” added to the end. *See Bond & Co. Jewelers, Inc. v. Tex. Int’l Prop. Assocs.*, FA 937650 (Nat. Arb. Forum Apr. 30, 2007) (finding that the elimination of spaces between terms and the addition of a gTLD do not establish distinctiveness from the complainant’s mark under Policy ¶ 4(a)(i); *see also Barnesandnoble.com LLC v. Your One Stop Web Shop*, FA 670171 (Nat. Arb. Forum May 3, 2006) (finding that the additions of the letter “s” and generic top-level domains to the disputed <barnesandnobles.info> and <barnesandnobles.biz> domain names failed to avoid the confusing similarity between the domain names and the complainant’s BARNESANDNOBLE.COM mark pursuant to Policy ¶ 4(a)(i)). The Panel notes that the meaning of Cheap Autos Insurance and Cheap Auto Insurance may not be the same but finds the similarities in sight and sound between the domain name and the mark to predominate.

### **Rights or Legitimate Interests**

Under paragraph 4(a)(ii) of the Policy, Complainant must first make out a *prima facie* showing that Respondent lacks rights or legitimate interests in the disputed domain name. The threshold for such showing is low. *See Starwood Hotels & Resorts Worldwide, Inc. v. Samjo CellTech.Ltd.*, FA 406512 (Nat. Arb. Forum Mar. 9, 2005). Once a *prima facie* case is established, the burden shifts to Respondent who must demonstrate that it nevertheless has rights or legitimate interests in the domain name at issue.

Complainant asserts that Respondent is not commonly known by the **<cheapautosinsurance.com>** domain name. The WHOIS information for the disputed domain name identifies Respondent as “iclicks c/o Michael Mayder.” Complainant urges that it does not and did not authorize or licensee Respondent to use the CHEAP AUTO INSURANCE mark in a domain name. The Panel therefore concludes that Complainant has made a *prima facie* showing that the Respondent lacks rights and interest in the at-issue domain name.

The burden of production shifts to the Respondent to affirmatively show that it has rights or interests in the at-issue domain name. Paragraph 4(c) of the Policy lists three independent

circumstances in particular, without limitation, that shall demonstrate that a respondent has rights or legitimate interests in respect of a domain name for the purposes of ¶ 4(a)(ii) of the Policy. To wit:

- (i) before any notice of the dispute, the Respondent's 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 and services; or
- (ii) the Respondent, as an individual, business, or other organization, has been commonly known by the domain name, even if no trademark or service mark rights have been acquired; or
- (iii) the Respondent is making a legitimate non-commercial 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.

Policy ¶ 4(c).

Complainant establishes that Respondent is not commonly known by the disputed domain name and has not been granted rights in such name. The Respondent's claim that it is commonly known by the domain name is unavailing and contrary to Respondent's own contentions that the domain name is being used in a descriptive rather than nominative sense. Therefore, Respondent cannot avail itself of Policy ¶ 4(c)ii to show that it has rights or legitimate interests in respect of the domain name.

Respondent claims that it is using the domain name to describe or suggest its services, and not in a trademark sense. A trademark owner by choosing a descriptive phrase as its trademark must accept the result that such mark may be fairly used in a primary or descriptive sense. "Fair use" of a trademark is generally held to be the reasonable and good faith use of a descriptive term that is another's trademark to describe rather than to identify the user's goods, services or business. While Respondent may be using the at-issue putative trademark commercially, the instant use is a "fair use" and as discussed below there is no compelling evidence showing that the primary intent of Respondent was to "misleadingly divert consumers or tarnish the ... mark at issue." Therefore Respondent demonstrates legitimate interest in the domain name pursuant to Policy ¶ 4(c)iii.

Respondent is using the **<cheapautosinsurance.com>** domain name to provide information and advertisements for products and services in a manner directly competitive with Complainant's business. Respondent derives revenue from this use through the accrual of referral or click-through fees, or otherwise. Respondent's competing business undisputably commenced before Complainant notified Respondent of the instant dispute. Ordinarily such a competing business use might not be *bona fide* pursuant to Policy ¶ 4(c)i. *See Computerized Sec. Sys., Inc. v. Hu*, FA 157321 (Nat. Arb. Forum June 23, 2003) ("Respondent's appropriation of [Complainant's] SAFLOK mark to market products that compete with Complainant's goods does not constitute a bona fide offering of goods and services."); *Glaxo Group Ltd. v. WWW Zban*, FA 203164 (Nat. Arb. Forum Dec. 1, 2003) (finding that the respondent was not using the domain name within the parameters of Policy ¶¶ 4(c)(i) or (iii) because the respondent used the domain name to take advantage of the complainant's mark by diverting Internet users to a competing commercial site); *see also Bank of Am. Corp. v. Nw. Free Cmty. Access*, FA 180704 (Nat. Arb. Forum Sept. 30, 2003) ("Respondent's demonstrated intent to divert Internet users seeking Complainant's website to a website of Respondent and for Respondent's benefit is not a bona fide offering of goods or

services under Policy ¶ 4(c)(i) and it is not a legitimate noncommercial or fair use under Policy ¶ 4(c)(iii).”). As discussed elsewhere herein, the disputed mark is generic or descriptive then it is free for all to use. Accordingly anyone (including Respondent) would have rights or legitimate interests in using it. See, *Tough Traveler, Ltd. v. Kelty Pack, Inc.*, D2000-0783 (WIPO Sept. 28, 2000) (finding that the respondent had a legitimate interest in the domain name <kidcarrier.com> because it was a generic term for a class of products that the respondent sells); see also *Shirmax Retail Ltd. v. CES Mktg., Inc.*, AF-0104 (eResolution Mar. 20, 2000) (“[G]iven the generic nature of the domain name, [Respondent] has at least a tenable argument that its use on the web merely for the purpose of redirecting visitors to a different site constitutes a legitimate fair use, as long as this use is not misleading to consumers and does not tarnish a trademark.”).

As mentioned throughout there is no evidentiary basis from which we can find that Respondent registered and used the domain name for the purpose capitalizing the mark’s trademark value. Rather it appears that Respondent’s intent was to use the domain name to describe or suggest the services provided on its website. Indeed, the Panel finds that Respondent reasonably believes that the Complainant’s mark is generic. Even if the Complainant’s claims or Complainant were known to Respondent at the time of domain name registration, Respondent would not be forced to rely on such claims given that the at-issue mark was unregistered at that time and is wholly generic. Respondent thus benefits from a fair use defense under Policy ¶ 4(c)(iii). *Id.*

For the reasons stated above the Panel finds that Respondent has legitimate rights or legitimate interests in respect of the domain name.

### **Registration and Use in Bad Faith**

Complainant fails to meet its burden of proof to demonstrate bad faith registration and use under Policy ¶ 4(a)(iii). See *Starwood Hotels & Resorts Worldwide, Inc. v. Samjo CellTech.Ltd*, FA 406512 (Nat. Arb. Forum Mar. 9, 2005) (finding that the complainant failed to establish that the respondent registered and used the disputed domain name in bad faith because mere assertions of bad faith are insufficient for a complainant to establish Policy ¶ 4(a)(iii); see also *Graman USA Inc. v. Shenzhen Graman Indus. Co.*, FA 133676 (Nat. Arb. Forum Jan. 16, 2003) (finding that general allegations of bad faith without supporting facts or specific examples do not supply a sufficient basis upon which the panel may conclude that the respondent acted in bad faith).

While we make no express finding as to whether or not Complainant had rights in the at-issue mark at the time of the domain name’s registration, the Panel assumes *ad arguendo* throughout its decision that Complainant did have common law rights at such time. However as discussed above concerning rights and legitimate interests, the mere fact of such rights does not demonstrate that Respondent knew of or had reason to believe that such rights existed (if in fact they did). Complainant must in effect show that at the time Respondent registered the domain name that Respondent had the intent to trade on or abuse Complainant’s mark.

Complainant asserts that since Respondent operates in the same area of commerce as Respondent that Respondent must have known of Complainant’s common law rights in the CHEAP AUTO INSURANCE mark at the time it registered the disputed domain name. Complainant does not successfully demonstrate that its mark is “famous” or even well known. Respondent denies even knowing of the Complainant’s existence prior to registration. But even if it did know of the Complainant, say through Complainant’s website, it would be reasonable for Respondent to assume that Complainant was using the CHEAP AUTO INSURANCE phrase in a descriptive sense rather than a trademark sense or that Complainant was unreasonable in claiming trademark

rights in the overtly descriptive mark.

The at-issue mark is clearly suggestive of Complainant's (and Respondent's) services and most likely the services of numerous third parties. The mark was not a registered trademark at the time Respondent registered the domain name. Furthermore the prior trademark registration for the mark was abandoned. The mark appears to be generic and descriptive of the services being offered rather than indicative of the source of such services. *See Target Brands, Inc. v. Eastwind Group*, FA 267475 (Nat. Arb. Forum July 9, 2004) (holding that the respondent's registration and use of the <target.org> domain name was not in bad faith because the complainant's TARGET mark is a generic term); *see also Miller Brewing Co. v. Hong*, FA 192732 (Nat. Arb. Forum Dec. 8, 2003) (finding that because the respondent was using the <highlife.com> domain name, a generic phrase, in connection with a search engine, the respondent did not register and was not using the disputed domain name in bad faith).

Therefore, without being shown compelling direct or circumstantial evidence of Respondent having a foul motive in registering the domain name, and in light of the benign circumstances presented in the record which explains the reason for the particular domain name being registered by the Respondent, the Panel concludes that it was more likely than not that the Respondent was unaware that the Complainant had rights in the CHEAP AUTO INSURANCE mark at the time the domain name was registered (if in fact Complainant did have rights) and that Respondent registered the domain name primarily for its descriptive value.

Additionally, Respondent has not violated any of the factors listed in Policy ¶ 4(b) or engaged in any other conduct that would constitute bad faith registration and use pursuant to Policy ¶ 4(a) (iii). *See Societe des Produits Nestle S.A. v. Pro Fiducia Treuhand AG*, D2001-0916 (WIPO Oct. 12, 2001) (finding that where the respondent has not attempted to sell the domain name for profit, has not engaged in a pattern of conduct depriving others of the ability to obtain domain names corresponding to their trademarks, is not a competitor of the complainant seeking to disrupt the complainant's business, and is not using the domain name to divert Internet users for commercial gain, lack of *bona fide* use on its own is insufficient to establish bad faith); *see also Starwood Hotels & Resorts Worldwide, Inc. v. Samjo CellTech.Ltd*, FA 406512 (Nat. Arb. Forum Mar. 9, 2005) (finding that the complainant failed to establish that respondent registered and used the disputed domain name in bad faith because mere assertions of bad faith are insufficient for a complainant to establish UDRP ¶ 4(a)(iii)).

Since there is no showing of bad faith, the Complaint fails.

### **Reverse Domain Name Hijacking**

Even if the Complainant has failed to satisfy its burden under the Policy, this does not necessarily render a finding of reverse domain name hijacking against Complainant for bringing the instant claim. *See ECG European City Guide v. Woodell*, FA 183897 (Nat. Arb. Forum Oct. 14, 2003) ("Although the Panel has found that Complainant failed to satisfy its burden under the Policy, the Panel cannot conclude on that basis alone, that Complainant acted in bad faith.")

Here Complainant has satisfied Policy ¶ 4(a)(i). *See Gallup, Inc. v. PC+s.p.r.l.*, FA 190461 (Nat. Arb. Forum Dec. 2, 2003) (finding no reverse domain name hijacking where complainant prevailed on the "identical/confusingly similar" prong of the Policy). Complainant has also made out a *prima facie* showing that Respondent lacks rights or legitimate interests in respect of the at-issue domain name.

It thus does not appear that the Complaint was prosecuted in bad faith notwithstanding the smothering volume of irrelevant and marginally relevant material filed by Complainant's counsel, and notwithstanding counsel's disregard of the spirit of both the applicable Rules addressing page limitation and the UDRP's underlying objective of brevity of process might be characterized as harassing. Indeed, Complainant's presents at colorable evidence in support of a finding that Respondent lacked rights and/or interests in the domain name and some colorable evidence that Respondent acted in bad faith pursuant to Policy 4(a)iii although not compelling. *See Church in Houston v. Moran*, D2001-0683 (WIPO Aug. 2, 2001) (noting that a finding of reverse domain name hijacking requires bad faith on the complainant's part, which was not proven because the complainant did not know and should not have known that one of the three elements in Policy ¶ 4(a) was absent).

Therefore Respondent's request for a finding of Reverse Domain Name Hijacking is denied.

### **DECISION**

Having failed to establish all three elements required under the ICANN Policy, the Panel concludes that relief shall be **DENIED**.

Respondent's claim of Reverse Domain Name Hijacking is **DENIED**.

Paul M. DeCicco (Chair),  
Diane Cabell and Robert T. Pfeuffer, Panelists  
Dated: June 25, 2009

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