

Hawaii Community Federal Credit Union v. Texas International Property Associates - NA NA, 88 USPQ2D 1761 (Nat'l Arb. Forum 2008)

**Hawaii Community Federal Credit Union v. Texas International
Property Associates - NA NA**

**National Arbitration Forum
88 USPQ2D 1761
Claim No. FA0806001210174**

Decided September 3, 2008

Headnotes

TRADEMARKS AND UNFAIR TRADE PRACTICES

[1] Registration and its effects — State registration (§315.05)

Types of marks — Secondary meaning (§327.02)

Paragraph 4(a)(1) of Uniform Domain Name Dispute Resolution Policy of Internet Corporation for Assigned Names and Numbers, which requires complainant to prove that respondent's domain name is identical or confusingly similar to trademark or service mark "in which the Complainant has rights," requires only that complainant possess rights in mark that can be legally enforced to prevent another from infringing that mark, since policy places no limitations or restrictions on genesis of complainant's "rights," their extent, or nature of underlying examination or process that ultimately yielded those rights; in present case, complainant's mark, which is registered in state of Hawaii, is not exempt from coverage under policy, since mark registered under Hawaii's statutory scheme must be sufficiently distinctive to distinguish goods and services of applicant from marks applied to similar goods or services of others, and since trademark registrations issued by state can be judicially enforced against any unauthorized use that is likely to cause confusion.

[2] Infringement; conflicts between marks — Likelihood of confusion — Particular marks — Confusion likely (§335.0304.03)

Respondent's "hawaiicommunityfcu.com" Internet domain name is confusingly similar to complainant's trademark "Hawaii Community Federal Credit Union," since respondent's substitution of abbreviation "fcu" for words "federal credit union," and its addition of generic top-level domain ".com," are insufficient to confer sufficient distinctiveness on domain name to avoid user confusion, and since use of abbreviation is likely to exacerbate, not reduce, potential for Internet user confusion, in view of naming conventions currently used in forming

domain names.

[3] Acquisition, assignment, and maintenance of marks — Acquisition through use — Priority of use (§305.0503)

Acquisition, assignment, and maintenance of marks — Assignment, licenses, and franchises (§305.06)

Respondent has no legitimate rights or interests in disputed Internet domain name "hawaiicommunityfcu.com," which is confusingly similar to complainant's trademark "Hawaii Community Federal Credit Union," since complainant has never authorized respondent to use complainant's mark, or any mark confusingly similar thereto, since respondent has no relationship or association with complainant whatsoever, since there is no evidence that respondent has ever been commonly known by disputed domain name, since complainant acquired exclusive trademark rights in "Hawaii Community Federal Credit Union" more than three years before respondent registered domain name, and since respondent's use of domain name to divert users to "hitfarm" Web site does not constitute bona fide offering of services, and is unquestionably commercial in nature.

[4] Infringement; conflicts between marks — Willful (§335.11)

Respondent registered and used disputed Internet domain name "hawaiicommunityfcu.com" in bad faith, since record indicates that respondent was aware of complainant's "Hawaii Community Federal Credit Union" trademark, and well-known meaning of abbreviation "fcu" for words "federal credit union," at time respondent registered domain name, since respondent, in spite of that knowledge, intentionally chose and registered disputed domain name in order to opportunistically exploit its potential to generate user confusion for respondent's benefit, in form of revenue derived from users who are diverted to respondent's "hitfarm" Web site and click on any sponsored links found there, and since fact that those links were selected by third party is of no consequence.

Case History and Disposition

Complaint filed by Hawaii Community Federal Credit Union, pursuant to Uniform Domain Name Dispute Resolution Policy of Internet Corporation for Assigned Names and Numbers, against respondent Texas International Property Associates - NA NA. Complainant requests that Internet domain name "hawaiicommunityfcu.com" be transferred from respondent to complainant. Transfer granted.

Attorneys:

Kasey Weirich, of Hawaii Community Federal Credit Union, Hawaii, USA, for complainant.

Gary Wayne Tucker, Texas, USA, for respondent.

Opinion Text

Opinion By:

Michaelson, panelist.

PARTIES

Complainant is *Hawaii Community Federal Credit Union* ("Complainant"), represented by *Kasey Weirich*, of *Hawaii Community Federal Credit Union*, Hawaii, USA. Respondent is *Texas International Property Associates—NA NA* ("Respondent"), represented by *Gary Wayne Tucker*, of *Law Office of Gary Wayne Tucker*, Texas, USA.

REGISTRAR AND DISPUTED DOMAIN NAME

The domain name at issue is <*hawaiicommunityfcu.com*>, registered with *Compana, Llc*.

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.

Mr. Peter L. Michaelson, Esq. as Panelist.

PROCEDURAL HISTORY

The Complaint was brought pursuant to the Uniform Domain Name Dispute Resolution Policy ("Policy"), available at <icann.org/services/udrp/udrppolicy24oct99.htm>, which was adopted by the Internet Corporation for Assigned Names and Numbers (ICANN) on August 26, 1999, and approved on October 24, 1999, and in accordance with the ICANN Rules for Uniform Domain Name Dispute Resolution Policy ("Rules") as approved on October 24, 1999, as supplemented by the National Arbitration Forum Supplemental Rules for Uniform Domain Name Dispute Resolution Policy then in effect ("Supplemental Rules").

Complainant submitted a Complaint to the National Arbitration Forum ("Forum") electronically on June 16, 2008; the Forum received

Page 1763

a hard copy of the Complaint on June 30, 2008.

On June 18, 2008, *Compana, Llc* confirmed by e-mail to the Forum that the <*hawaiicommunityfcu.com*> domain name is registered with *Compana, Llc* and that Respondent is the current registrant of the name. *Compana, Llc* has verified that Respondent is bound by the *Compana, Llc* registration agreement and has thereby agreed to resolve domain-name disputes brought by third parties in accordance with the Policy.

On July 8, 2008, a Notification of Complaint and Commencement of Administrative Proceeding (the "Commencement Notification"), setting a deadline of July 28, 2008 by which Respondent could file a Response to the Complaint, was transmitted to Respondent via e-mail, post and

Full Text of Cases (USPQ2d)

fax to all entities and persons listed on Respondent's registration as technical, administrative and billing contacts, and to postmaster@hawaiicommunityfcu.com by e-mail.

A timely Response was received and determined to be complete on July 28, 2008.

On August 6, 2008, pursuant to Complainant's request to have the dispute decided by a single-member Panel, the Forum appointed Mr. Peter L. Michaelson, Esq. as Panelist and set a due date of August 20, 2008 to receive the decision from the Panel. Owing to unexpected time conflicts experienced by the Panel all of which constituted unforeseen circumstances, the Forum, at the request of the Panel, extended this due date to September 3, 2008.

RELIEF SOUGHT

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

PARTIES' CONTENTIONS

A. Complainant

1. Confusing similarity/identical

Complainant contends that the disputed domain name is confusingly similar to its mark HAWAII COMMUNITY FEDERAL CREDIT UNION.

Specifically, Complainant alleges that the disputed domain name consists of the words "HAWAII COMMUNITY" followed by the letters "FCU", with the latter being a commonly known abbreviation for "federal credit union".

Hence, Complainant concludes that it has met the requirements of paragraph 4(a)(i) of the Policy.

2. Rights and legitimate interests

Complainant contends that, for any of various reasons, Respondent has no rights or legitimate interests in the disputed domain name under paragraph 4(a)(ii) of the Policy.

First, Complainant states that Respondent is not associated, in any manner, with Complainant.

Second, Complainant alleges that Respondent's ownership, registration and operation of the name, particularly given its inclusion of the abbreviation "FCU", implies to Internet users that Respondent is associated, in some fashion, with a federal credit union. Given that no such association exists, Respondent could potentially use the name in conjunction with some malicious activity towards members of Complainant's credit union, such as through phishing and/or constructing and operating a mock website which would mimic Complainant's current website, all to Complainant's ultimate detriment.

Third, inasmuch as the name specifically references Complainant—given the meaning generally accorded to the abbreviation "FCU", Respondent, which is named "Texas International Property Associates," is highly unlikely to be known by or identifiable through the name.

Lastly, Respondent is not making either a bona fide or legitimate fair use of the name. Specifically, Respondent uses the name to point to a site which contains a listing of sponsored (pay-per-click) links which forward Internet users, who click on any such link, to a non-specific URL that pertains to the disputed domain name. By so using the name, Respondent is misleadingly diverting those users to third-party sites that have nothing to do with Complainant and its services. Furthermore, Respondent's website, resolvable through the name is also an adult dating site and also has references to personal webcams, webcam chat, flirt chat, online dating, and gay chat, none of which has any relevance to any federal credit union, let alone Complainant and its services, but any of which could potentially mislead Internet users and tarnish Complainant's mark. Such a use does not constitute either a fair use or a legitimate *bona fide* use of the disputed domain name.

3. Bad faith use and registration

Complainant contends that, for any one of multiple reasons, Respondent has registered

Page 1764

and is using the disputed domain name in bad faith, hence in violation of paragraph 4(a)(iii) of the Policy.

First, Complainant alleges that Respondent uses the name in a pay-per-click environment that is designed to lure Internet users away from Complainant's website.

Second, Respondent has registered the name in order to prevent Complainant from reflecting its trademark in a name.

Third, Complainant alleges that Respondent, through its use of the name as an address of a website of sponsored links, having no connection whatsoever with Complainant or its services, is intentionally attempting to attract, for commercial gain, Internet users to Respondent's site by creating a likelihood of confusion with Complainant's site.

B. Respondent

1. Confusing similarity/identical

Respondent disputes Complainant's contention of confusing similarity for the simple reason that Complainant has not shown that it has any trademark rights in the term "Hawaii Community Federal Credit Union" as required under paragraph 4(a)(1) of the Policy, thus Complainant has failed to qualify under that paragraph.

Specifically, in support of its view, Respondent argues that: (a) despite the fact that Complainant has a "registered trademark," its registration is not federal in nature but rather state-issued; and (b) Complainant has apparently confused a trade name registration in the State of Hawaii with registration of a trademark, with Complainant apparently having the former but not the latter.

Moreover, as best understood by the Panel, Respondent takes the position that, if Complainant has an Hawaiian State trademark registration, then that registration conveys no

exclusive trademark rights for the simple reason that prior panels have held that state trademark registrations are not examined and thus do not represent persuasive evidence of ownership of a valid, distinctive trademark citing to, *inter alia*, *Aquascape Designs, Inc. v. Vertical Axis, Inc.*, FA 629222 (Nat. Arb. Forum March 7, 2006).

Further, Respondent contends that, absent any federal registration, Complainant is relegated to showing that it has rights under a common law mark, but the record is devoid of any evidence that it has established such rights.

2. Rights and legitimate interests

Respondent, contrary to Complainant's view, argues that it has rights and legitimate interests in the disputed domain name.

First, Respondent contends that click-through sites, such as the one it operates, constitute a *bona fide* offering of goods and services in the absence, as here, of any bad faith on the part of Respondent in registering and using the name. In that regard, Respondent admits it contracts with "Hitfarm," which connects its own websites to Respondent's site, but does so to offer a legitimate business of targeted advertising searches. Those searches are undertaken by Google and Yahoo in accordance with their terms of business and are triggered by search requests entered by Internet users who visit Respondent's site. Respondent has no control over what terms for which advertisers bid on either Google or Yahoo and hence what terms will appear on Respondent's website. Respondent further bases its view, citing to, *inter alia*, *Admiral Ins. Servs. v. Dicker*, D2005-0241 (WIPO June 4, 2005), with the proposition that a domain name holder is not responsible for potentially offending content where that holder has a contract with third-parties, such as Google or Yahoo, which control the content.

Second, Respondent contends that it is simply using descriptive, generic and geographic terms which it combined together into a composite term as a commercial domain name, which it is legitimately entitled to do so regardless of whether the composite term is federally-registered or, as here, not, and with registration of the composite term as the disputed domain name merely being on a "first come, first served basis".

3. Bad faith use and registration

Respondent disputes Complainant's position that registered and used the disputed domain name in bad faith.

First, Respondent states that on the date, March 18, 2006, on which the name was registered and continuing to the present, no federally registered trademark existed for the mark "HAWAII COMMUNITY FEDERAL CREDIT UNION." Further, on March 18, 2006, Respondent, being separated by "some 3700 miles and a large part of the Pacific Ocean," was unaware of Complainant. Absent such knowledge and hence any intent to harm Complainant, there can be no bad faith registration. Moreover, to the extent Complainant had any trademark rights, those rights were established after the date on which the name

was registered and hence should not be applied retroactively against Respondent.

Full Text of Cases (USPQ2d)

Second, Respondent contends that Complainant has failed to demonstrate, as required, that Respondent intended to confuse consumers who then sought out Complainant.

Third, Respondent has registered thousands of domain names which consist, as here, of electronically registered generic words and descriptive phrases to which no other party can claim exclusive use. Such actions are a legitimate business and are done in good faith.

Last, Respondent did not register the name to sell to Complainant or any other party.

FINDINGS

A copy of the WHOIS registration record for the disputed domain name appears in Exhibit C to the Response. As indicated, the domain name was registered on March 18, 2006.

A. Complainant's HAWAII COMMUNITY FEDERAL CREDIT UNION Mark

Complainant owns a state trademark registration, issued by the Department of Commerce and Consumer Affairs of the State of Hawaii, for the terms "HAWAII COMMUNITY FEDERAL CREDIT UNION" in stylized form and with a design element, and on which this dispute is based. In Exhibit 1 to the Complaint, Complainant has provided a copy of its registration certificate for this mark, the pertinent details of which are as follows:

HAWAII COMMUNITY FEDERAL CREDIT UNION

(stylized lettering with design)

State of Hawaii Trademark Registration No. 4,002,127

Renewed: April 21, 2003; Expires: June 18, 2013

This mark is currently registered for use in connection with "promoting thrift among its members and creating a source of credit for provident and productive purposes."

B. The Parties

Complainant is a federally chartered credit union which provides financial services to more than 35,000 members in the State of Hawaii.

Respondent's website at <hawaiicommunityfcu.com> is linked to a "Hitfarm" website which performs a targeted advertising search, using the disputed domain name as input, to display a list of links related to that name and through which Respondent earns click-through (pay-per-click) revenue. Specifically (and rather unfortunately the pleadings are rather sparse on salient details), once an Internet user reaches Respondent's site, that user is then diverted to the "Hitfarm" website. The latter site, given that the user attempted to reach a site addressed by the disputed domain name, undertakes a search, apparently through either Google or Yahoo, to ultimately yield sponsored advertising links related to that particular name. "Hitfarm" then displays those links on the page returned to the user with Respondent earning revenue each time the user clicks on one of those links.

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.

Trademark Validity/State Registrations

Respondent expends significant energy and ink in arguing that inasmuch as applications for state trademark registrations, such as the Hawaiian trademark registration here, are not subjected to the same or even a similar level of scrutiny as a federal trademark application would encounter in the United States Patent and Trademark Office (USPTO), then the resulting state trademarks, once registered, are not sufficiently distinctive and thus effectively convey no rights of exclusivity to their owners. Hence, Respondent basically concludes that state registrations cannot provide sufficient rights to a complainant under paragraph

Page 1766

4(a)(1) of the Policy, thus necessitating that Complainant relegate itself to proving that either it has a federal trademark registration or that it has acquired adequate rights, through use, to a sufficiently distinctive common law (unregistered) trademark.

Respondent's views are sorely misplaced.

[1] First, paragraph 4(a)(1) is not as limited as Respondent would have this Panel believe. In that regard, all that this paragraph requires is that a domain name be one which contains a mark in which "the complainant has rights." As plainly evident, this paragraph contains no limitation or restriction on the genesis of those rights, their extent or the nature of the underlying examination or process that ultimately yielded those rights. The Policy does not define the term "rights." Given that, it seems rather reasonable to this Panel to proceed under well-known canons of statutory construction which mandate that words in a statute or regulation and in the absence of any definition or language therein to the contrary, are to be accorded their plain meaning. Consequently, the wording "complainant has rights" in paragraph 4(a)(1) can be simply interpreted to mean that Complainant must possess rights in a mark that can be legally enforced to prevent another from infringing the mark.

Full Text of Cases (USPQ2d)

As will shortly become clearly evident, trademark registrations issued by the State of Hawaii can be judicially enforced against any unauthorized third-party use that is likely to cause confusion. Accordingly, this Panel sees no plausible reason to interpret paragraph 4(a)(1) in a manner, as Respondent now urges, contrary to its plain meaning to exempt such registrations from coverage under the Policy.

This Panel, based on its own experience over many years with state trademark registrations across a number of different states in the US, takes judicial notice of the well-known fact that a state trademark issuing authorities subject their trademark applications to considerably less rigor than would the USPTO. Nevertheless, the level of such scrutiny is irrelevant to this Panel, as long as that which results from whatever process is used at a state level yields trademark rights that can be judicially enforced.

Such is indeed the case here. This conclusion becomes rather self-evident from simply examining, even just cursorily, the governing Hawaiian statutes in force that govern its trademark system—which clearly Respondent did not do.

Specifically, first, HRS (Hawaiian Revised Statutes) §482-21 defines a mark capable of being registered as “[a] mark by which the goods or services of any applicant for registration may be distinguished from the goods or services of others” and then lists various exceptions, none of which is relevant here (but all of which are similar to those enumerated in §2 of the Lanham Act which governs federal trademarks). Under HRS §482-22, any person may “file in the office of the director [of the Department of Commerce and Consumer Affairs]... an application for registration of that mark setting forth ...:

- (1) the name and business address of the person ... applying for registration ...,
- (2) the goods or services on or in connection with which the mark is used, the mode or manner in which the mark is used on or in connection with such goods and services, and the class in which the goods or services fall;
- (3) the date on when the mark was first used anywhere, and the date when it was first used in this State ...; and
- (4) a statement that the applicant is the owner of the mark, the mark is in use, and to the knowledge of the person verifying the application, no other person has registered, either federally or in this State, or has the right to use, the mark either in the identical form thereof or in such near resemblance thereto as to be likely, when applied to the goods or services of the other person, to cause confusion, to cause mistake, or to deceive ...”.

Once an application for registration is filed, under HRS §482-23(a), it is then subject to examination: “[u]pon the filing of an application for registration and payment of the application fee, the director shall cause the application to be examined for conformity with this part.” Examination includes determining whether that mark is unregistrable under §482-21(1)-(6) where, of particular note, paragraph (5) precludes those marks from registration that are:

- (a) merely descriptive or descriptively misdescriptive of the applicants’ goods or services with which the mark is used,
- (b) primarily geographically descriptive or deceptively misdescriptive of those goods or

services, or

Page 1767

(c) is primarily a surname;

and paragraph (6) precludes those marks that consist “of a mark which so resembles a mark registered in this State or a mark or trade name previously used by another and not abandoned, as to be likely, when used on or in connection with the goods or services of the applicant to cause confusion or mistake or to deceive.” Moreover, §482-23(e) specifies that “if an earlier-filed application is granted registration, then other applications seeking registration for the same or confusingly similar marks for the same or related goods or services shall be rejected. Any rejected applicant may bring an action for cancellation of the registration upon grounds of prior or superior rights to the mark” It bears emphasizing that §482-21 expressly mandates that states “nothing in this paragraph shall prevent the registration of a mark used by the applicant which has become distinctive of the applicant’s goods or services.” Consequently, by collectively viewing HRS §482-23 in conjunction with §482-21 as they must be, the Panel is left with but one simple and patently obvious conclusion: a mark, registrable under this statutory scheme, must be sufficiently distinctive, so as to distinguish the goods and services of its applicant, from marks applied to similar goods or services of others, else registration will be refused.

Once a mark is so registered, it can be judicially enforced through the Hawaiian State Courts. In that regard, HRS §482-24 states in pertinent part: “[t]he original or copy ... of a certificate of registration issued under this part shall be admissible in evidence as sufficient proof of the registration or a mark in any action or judicial proceeding in any court of this State.” Infringement is defined under HRS §482-31 as being use by any person who “uses without the consent of the registrant, any reproduction, counterfeit, copy, or colorable imitation of a mark registered under this part in connection with the sale, distribution, offering for sale, or advertising of any goods or services on or in which such use is likely to cause confusion or mistake, or to deceive, as to the source of origin of such goods or services” As remedies to infringement, a trademark owner may seek, under HRS §482-35, injunctive or monetary relief and/or court-ordered destruction of infringing goods as well as, in the case of willful infringement or bad faith actions, treble damages and attorneys’ fees, this provision stating, in pertinent part:

“[t]he owner of a mark registered under this part may proceed by suit to enjoin the manufacture, use, display, or sale of any counterfeits or imitations of the mark and any court of competent jurisdiction may grant *injunctions* to restrain such manufacture, use, display or sale ... and may require the defendants to *pay ... all profits* derived from and *all damages* suffered by reason of such wrongful manufacture, use, display or sale; and the court may also order that any counterfeits or imitations ... *be destroyed*. The court ... may enter judgment for an amount not to exceed *three times the lost profits and damages* incurred by the owner, and award *reasonable attorneys’ fees* to the owner when the court finds that the defendants committed the wrongful acts knowingly or in bad faith.”
[emphasis added]

Hence, there can be absolutely no question that the statutory regime in place in Hawaii for issuing state trademark registrations, sharply contrary to Respondent’s contention, yields

trademark rights that are predicated on marks that have attained sufficient distinctiveness with those rights capable of judicial enforcement and moreover susceptible to being tested, through a cancellation action, to assess the continued validity of those rights. Consequently, those rights clearly qualify for protection under paragraph 4(a)(1) of the Policy.

Respondent cites to the *Aquascape Designs* decision in support its view that state trademark registrations are uniformly invalid to convey trademark rights sufficient to invoke Paragraph 4(a)(1) of the Policy. There, the panel expresses its rather conclusory view, as the only reference to state trademarks and notably without considering the underlying statutory framework, through its statement, in pertinent part: “Complainant’s Illinois State trademark registrations are not examined and thus do not represent persuasive evidence of ownership of a valid, distinctive trademark.” In light of the discussion above, this view, at least in the context of Hawaiian trademark registrations, is patently incorrect.

Having found that a trademark system merely yields protectable rights, it is clearly outside the purview, jurisdiction and competence of this Panel or, in this Panel’s mind, any ICANN panel to scrutinize the severity of the underlying examination that resulted in those rights or challenge the validity of any ensuing registration. Rather, the Panel must

Page 1768

simply defer to the actions and decisions of any governmental body charged with issuing any such registrations and leave a party, desirous of pursuing such a challenge, to prosecute it solely before the appropriate administrative and/or judicial forums legally empowered to entertain such challenges.

In various prior situations where respondents have urged this Panel to assess validity of federal trademark registrations, this Panel has uniformly and repeatedly refused to do so in favor of according significant deference to determinations of registerability made by the USPTO—the federal governmental body specifically mandated, in the first instance, with that responsibility and having the requisite expertise to do so. It is simply not within the purview of any ICANN panel to review and evaluate, let alone over-ride, the judgment of the USPTO on such questions. See, e.g., *MySpace, Inc. v. Edwin De Jesus, EDJ Assocs. Inc.*, D2007-1878 (WIPO March 12, 2008); *Tetris Holding, LLC v. Smashing Conceptions*, FA1030720 (Nat. Arb. Forum Sept. 11, 2007); *Gerber Childrenswear Inc. v. Webb*, D2007-0317 (WIPO April 24, 2007); *Lockheed Martin Corp. v. The Skunkworx Custom Cycle*, D2004-0824 [74 USPQ2d 1486] (WIPO Jan. 18, 2005); *Register.com, Inc. v. Reile*, FA208576 [70 USPQ2d 1351] (Nat. Arb. Forum Jan. 27, 2004); *U.S. Office of Personnel Mgmt v. MS Tech. Inc.*, FA198898 [70 USPQ2d 1333] (Nat. Arb. Forum Dec. 9, 2003), and *Lake at Las Vegas Joint Venture v. Principal Equiti, Inc.*, D2002-0758 (WIPO Oct. 4, 2002). As this Panel stated in the *MySpace* decision: “[O]nce the USPTO has made a determination that a mark is registerable, as it has here by issuing a registration to the Complainant for each of its MYSPLACE Marks, an ICANN panel is not empowered to nor should it disturb that determination.”

Such is the case here with Hawaiian State trademark registrations.

Absent Respondent having challenged the validity of the state registration at issue here and attained a final ruling from the courts of the State of Hawaii, as it must, that Complainant’s

Hawaiian registration is invalid for lack of distinctiveness and thus its mark is no longer susceptible of continued registration—which clearly Respondent has not done here, this Panel will simply defer, as it must, to the determination by the Director of the Department of Commerce and Consumer Affairs of the State of Hawaii, implicit in its having granted a registration to Complainant for its mark, that this mark is sufficiently distinctive and thus qualifies for continued state trademark protection and enjoys all the exclusive rights, including remedies for infringement, accorded thereby.

Identical and/or Confusingly Similar

The Panel finds that the disputed domain name is confusingly similar to Complainant's HAWAII COMMUNITY FEDERAL CREDIT UNION Mark.

First, Complainant, as it stated, has a trademark registration issued by the State of Hawaii, not as Respondent contends a state trade name registration. Hence, it appears that Respondent, rather than Complainant, is the one confused as to the nature of Complainant's state registration. Further, as the Panel discussed above, the Hawaiian State registration for Complainant's mark suffices to impart trademark rights protectable under paragraph 4(a)(1) of the Policy.

Given that, then, from a simple comparison of the disputed domain name, <*hawaiicommunityfcu.com*>, to Complainant's mark, no doubt exists that the name is confusingly similar to the mark.

[2] The only differences between the disputed domain name and the mark are the substitution of the abbreviation "FCU" for the terms "FEDERAL CREDIT UNION" and the appending the gTLD (generic top-level domain) ".com" to the terms "HAWAII COMMUNITY" to form the name—with the last addition being irrelevant in assessing confusing similarity or identity under paragraph 4(a) of the Policy and thus ignored. It is without question that "FCU" is a very well-known abbreviation for "federal credit union," hence being a difference of no significance.

It is now very well-established in UDRP precedent, including numerous decisions previously rendered by this Panel, that a minor variation, such as adding short letter or number groups or even generic or highly descriptive words to a mark, is usually insufficient in and of itself, when used in forming a domain name that results from modifying the mark, to confer requisite and sufficient distinctiveness to that name to avoid user confusion. Here, the Panel views substituting a widely recognized abbreviation for corresponding terms in a mark, such as here "FCU" for "federal credit union," is clearly one such minor variation as well. See, *in the context of minor variations, e.g., MySpace, Inc., cited supra*; and *322 W. 57th Owner LLC v. Admin. Domain*, D2008-0736 [88 USPQ2d 1491] (WIPO

Aug. 6, 2008); *Dreamworks Animation, LLC v. Creahq*, D2008-0505 (WIPO May 28, 2008); *Marvel Mfrg. Co. Inc. v. Koba Internet Sales, LF*, D2008-0265 [87 USPQ2d 1276] (WIPO May 5, 2008); *BlackRock, Inc. v. blackrockfinancialservices.com*, D2007-1627 (WIPO Jan. 4, 2008); *F. Hoffmann-La Roche AG v. Transliner Consultants*, D2007-1359 (WIPO Nov.14,

Full Text of Cases (USPQ2d)

2007); *Nat'l Football League v. Blucher*, D2007-1064 (WIPO Sept. 24, 2007); *Toilets.com, Inc. v. Rons Porta Johns*, D2007-0952 (WIPO Aug. 27, 2007); *Assoc. Bank Corp. v. Texas Int'l Prop. Assoc.*, D2007-0334 (WIPO June 28, 2007); *Gerber Childrenswear Inc. v. Webb*, D2007-0317 (WIPO April 24, 2007); *SPX Corp. v. Hevun Diversified Corp.*, FA791657 [81 USPQ2d 1621] (Nat. Arb. Forum Nov. 13, 2006); *Google Inc. v. Burns*, FA726096 (Nat. Arb. Forum Aug. 16, 2006); *Cheesecake Factory Inc. & Cheesecake Factory Assets Co., LLC v. Say Cheesecake*, D2005-0766 (WIPO Sept. 12, 2005); *Napster, Inc. v. Vinscani*, D2005-0531 (WIPO July 19, 2005); *Caesars Entm't Inc. v. Nova Internet Inc.*, D2005-0411 (WIPO June 22, 2005); *Lockheed Martin Corp. v. The Skunkworx Custom Cycle*, D2004-0824 [74 USPQ2d 1486] (WIPO January 18, 2005); *Lockheed Martin Corp. v. Deborah Teramani*, D2004-0836 (WIPO Dec. 1, 2004); *Nat'l Collegiate Athletic Assoc. v. Brown*, D2004-0491 [72 USPQ2d 1319] (WIPO Aug. 30, 2004); *Lane-Labs USA, Inc. v. Powell Prod.*, FA 155896 (July 1, 2003); and in particular *Cable News Network LP, LLP v. Khouri*, FA117876 [68 USPQ2d 1570] (Nat. Arb. Forum Dec. 16, 2002).

Moreover, by substituting the abbreviation "FCU" for the words "federal credit union" in Complainant's mark to form the disputed domain name, the potential for Internet user confusion is likely to be exacerbated, not reduced. In that regard, the services which Complainant offers through its mark are credit union services, such as providing loans and offering savings and related financial advice. Consequently, those Internet users who seek information on Complainant's services may well be quite likely, given current naming conventions on the Internet used in forming domain names and for sheer simplicity, to enter through their browsers, as a corresponding domain name, the first two words of Complainant's mark, i.e., "HAWAII COMMUNITY," followed by the abbreviation "FCU," rather than spelling out that abbreviation, and then concluding with ".com" (as a widely used gTLD for a business-oriented site) through which those users would then expect to reach Complainant's website. Rather than reaching Complainant's site, each of those users would instead be directed to Respondent's corresponding site through which that user would be offered third-party sponsored links having nothing to do with Complainant or its services. Hence, by using a well-known abbreviation instead of specific equivalent terms in the mark, those users would likely be deceived into thinking that Respondent's site and the links and goods and services offered there through were somehow affiliated, related to or sponsored by Complainant—when, in fact, they are not. Thus, the Panel finds that that the disputed domain name here, which contains the terms "HAWAII COMMUNITY" followed by the abbreviation "FCU" would tend to aggravate, rather than ameliorate, user confusion and do so to Respondent's ultimate benefit—and that is very likely the reason why Respondent chose that name. See *MySpace*, cited *supra*.

Therefore, the Panel finds that the disputed domain name is confusingly similar to Complainant's HAWAII COMMUNITY FEDERAL CREDIT UNION Mark as to cause confusion; hence, Complainant has satisfied its burden under paragraph 4(a)(i) of the Policy.

Rights or Legitimate Interests

Based on the evidence of record here, the Panel finds that no basis exists, under the circumstances here, that would legitimize a claim to the disputed domain name under paragraph 4(c) of the Policy.

[3] Complainant has never authorized Respondent to utilize its HAWAII COMMUNITY FEDERAL CREDIT UNION mark or any mark confusingly similar thereto, such as HAWAII COMMUNITY FCU, in conjunction with the services with which Complainant uses that mark or for similar services, nor does Complainant apparently have any relationship or association whatsoever with Respondent. As such, any use to which Respondent were to put Complainant's mark or one confusingly similar thereto in connection with the identical or even similar services to those currently provided by Complainant, those essentially being credit union services as recited in its state trademark registration, would violate the exclusive trademark rights now residing with Complainant. See, e.g., *MySpace*, *Blackrock*, *F. Hoffmann-La Roche AG*, *Nat'l Football League*, *Toilets.com, Inc.*, and *Associated Bank*, all cited *supra*. See also *GoDaddy.com*,

Page 1770

Inc., v. GoDaddysDomain.com, D2007-0303 (WIPO May 7, 2007); *Citgo Petroleum Corp. v. Antinore*, D2006-1576 (WIPO March 14, 2007); *New Destiny Internet Group, LLC & Xplor Media, Inc. v. SouthNetworks*, D2005-0884 (WIPO Oct. 14, 2005); *Cheesecake Factory Inc., Napster and Caesars Entm't, Inc.*, all cited *supra*; *Pelmorex Communications Inc. v. weathernetwork*, D2004-0898 (WIPO Dec. 28, 2004); *Sybase, Inc. v. Analytical Sys.*, D2004-0360 (WIPO June 24, 2004); *Caesars World, Inc. & Park Place Entm't Corp. v. Nippon*, D2003-0615 (WIPO Sept. 30, 2003); *Leiner Health Servs. Corp. v. ESJ Nutritional Products*, FA 173362 (Nat. Arb. Forum Sept. 16, 2003); *AT&T Corp. v. Abreu*, cited *supra*; *MPL Communications, Ltd. v. 1WebAddress.com*, FA 97092 (Nat. Arb. Forum June 4, 2001); *Am. Online, Inc. v. Fu*, D2000-1374 (WIPO Dec. 11, 2000); and *Treeforms, Inc. v. Cayne Indus. Sales, Corp.*, FA95856 (Nat. Arb. Forum Dec. 18, 2000). Consequently, Respondent could not legally acquire any public association between it and Complainant's HAWAII COMMUNITY FEDERAL CREDIT UNION mark or one similar thereto, at least for the services rendered by Complainant, or, broadly speaking, any service likely perceived by its users to be so similar and/or to emanate from or be related, in any fashion, to those then offered by Complainant.

Further, there is absolutely no evidence of record that Respondent has ever been commonly known by the disputed domain name. Nor could Respondent in this case ever become so known, in light of Complainant's exclusive trademark rights, dating back certainly more than 3 years prior to March 18, 2006 on which Respondent registered the name (particularly since Complainant's 4,002,127 trademark registration specifically referenced above is a renewal in April 2003 of a pre-existing but then expiring state registration which, given a current 10-year life of Hawaiian state trademark registrations, presumably dated back to 1993) and the reputation, at least in the State of Hawaii, which Complainant's mark undoubtedly acquired since its initial registration and use. See, *MySpace* and *Treeforms, Inc.*, cited *supra*.

Hence, based on the evidence before the Panel, Respondent does not fall within paragraph 4(c)(ii) of the Policy.

Moreover, since Respondent's use of the name, which in this Panel's view infringes Complainant's trademark rights, can not constitute a *bona fide* offering of services and is unquestionably commercial in nature, Respondent's conduct does not fall within paragraphs 4(c)(i) or 4(c)(iii) of the Policy either.

Accordingly, the Panel concludes that Respondent has no rights or legitimate interests in the disputed domain name within paragraph 4(a)(ii) and 4(c) of the Policy.

Registration and Use in Bad Faith

The Panel finds that Respondent's actions, with respect to the disputed domain name, constitute bad faith registration and use under paragraph 4(a)(iii) of the Policy.

[4] The Panel believes that Respondent was well aware of at least Complainant's HAWAII COMMUNITY FEDERAL CREDIT UNION mark and the well-known meaning of the abbreviation FCU as "federal credit union" when the Respondent registered the disputed domain name. The formative portion "HAWAII COMMUNITY" of the Mark identically appears in the name and is then immediately followed by the abbreviation "FCU" for the remainder of the mark "FEDERAL CREDIT UNION" to form the entire name (ignoring the gTLD). Respondent asserts that it merely selects and joins together descriptive, generic and geographic names all selected in some "electronic" fashion, to form each of its domain names.

Hence, as best understood by the Panel, Respondent implicitly claims that the fact that its combination of two terms and an abbreviation here just happens to equate to Complainant's mark is simply a product of coincidence or happenstance, and nothing more. In light of all possible terms in the English language that are geographic, descriptive or generic, the probability of randomly forming the specific sequential combination here of the two particular terms (HAWAII being geographic, and COMMUNITY being generic) followed by an abbreviation (FCU) , that just happens to be a well-known equivalent for the rest of Complainant's mark, is so small as to be negligible. Thus, the Panel dismisses Respondent's claim that it had no prior knowledge of Complainant's Mark as being utterly implausible.

Consequently, in spite of that knowledge, Respondent intentionally chose and registered the name to opportunistically exploit its potential to generate user confusion for Respondent's eventual benefit, which here manifested itself as pecuniary revenue derived from Internet users, who expecting to reach Complainant's website, reached Respondent's site instead and clicked on any of the sponsored links as then furnished by Hitfarm and appearing

Page 1771

on the site. The fact that such links were selected by a third-party, here being Yahoo or Google, is of no consequence as Respondent benefitted from their use.

Accordingly, it is abundantly clear to this Panel that Respondent not only intentionally chose and registered the name to opportunistically exploit its potential to generate user confusion for Respondent's eventual benefit, but also ultimately used the name to achieve just that end, hence violating paragraph 4(b)(iv) of the Policy. See, e.g., *MySpace* and *F. Hoffmann-La Roche AG*, cited *supra*.

Thus, the Panel concludes that Complainant has provided sufficient proof of its allegations to establish a *prima facie* case under Paragraph 4(a) of the Policy upon which the relief it now seeks can be granted.

DECISION

In accordance with Paragraph 4(i) of the Policy and Paragraph 15 of the Rules, the relief sought by Complainant is hereby *GRANTED*.

Accordingly, the Panel orders that the disputed domain name, <*hawaiicommunityfcu.com*>, is to be *TRANSFERRED* from Respondent to Complainant.

- End of Case -
A0B7N0Y6Z5