



WIPO Arbitration and Mediation Center

ADMINISTRATIVE PANEL DECISION

Allstate Insurance Company v. Aardvark (a/k/a Joseph Bologna, John Day, Paul Day, Jay Arby, Jay Bologna), and d/b/a Aardvark Internet Services, Allstate Information Exchange, Inc., Allstate.org, Inc., and Professional Publications

Case No. D2001-1346

1. The Parties

- 1.1 The Complainant is Allstate Insurance Company, a corporation organized and existing under the laws of the State of Illinois, United States of America, having its principal place of business at 2775 Sanders Road, Northbrook, Illinois, United States of America.
- 1.2 The Respondent is Aardvark, an entity doing business, and also known as Joseph Bologna, Jay Arby, Jay Bologna, Paul Day, and John Day, and doing business as Allstate Information Exchange, Inc., Allstate.org, Inc, Allstate Information Exchange, Professional Publications, and Aardvark Internet Services with addresses at Delft University, 2628 CD Delft, Delft, the Netherlands 56, and 2323 Del Prado Boulevard, Suite 7-110, Cape Coral, Florida, United States of America, hereinafter collectively and individually referred to as "Respondent."

2. The Domain Name and Registrar

- 2.1 The domain name at issue is <allstate.org>.
- 2.2 The domain name is registered with Tucows, Inc. ("Tucows"), a registrar having its principal place of business in Toronto, Ontario, Canada.

3. Procedural History

- 3.1 A Complaint was submitted electronically to the WIPO Arbitration and Mediation Center on November 12, 2001, and the signed original together with four copies forwarded by express courier was received on November 13, 2001. An

Acknowledgment of Receipt was sent by the WIPO Center to the Complainant, dated November 19, 2001. On December 4, 2001, the WIPO Center received additional copies of the Complaint.

- 3.2 On November 19, 2001, Tucows confirmed by e-mail that the domain name at issue is registered with Tucows, is currently on hold status, and that the Respondent is the current registrant of the name. The registrar also forwarded the requested Whois details, and confirmed that the Policy is in effect.
- 3.3 The WIPO Center determined that the Complaint satisfies the formal requirements of the Policy, the Rules for Uniform Domain Name Dispute Resolution Policy (the "Uniform Rules") and the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the "Supplemental Rules"). The Panel has independently determined and agrees with the assessment of the WIPO Center that the Complaint is in formal compliance with the requirements of the Uniform Rules, and the Supplemental Rules. The Complainant elected to have the dispute settled by a three-member Panel providing as its three Administrative Panel nominees, Professor Frederick M. Abbott, Dennis Arthur Foster, and David W. Plant. The required fees for a three-member Panel were paid on time and in the required amount by the Complainant.
- 3.4 No formal deficiencies having been recorded, on November 21, 2001, a Notification of Complaint and Commencement of Administrative Proceeding (the "Commencement Notification") was transmitted to the Respondent (with copies to the Complainant, Tucows, and ICANN), setting a deadline of December 11, 2001, by which the Respondent could file a Response to the Complaint. The Commencement Notification was transmitted to the Respondent by courier and by e-mail to the e-mail addresses indicated in the Complaint. In any event, evidence of proper notice is provided by the evidence in the record of the Respondent's participation in these proceedings.
- 3.5 A Response was received in hardcopy on December 12, 2001. An Acknowledgment of Receipt of Response was sent by the WIPO Center on December 19, 2001.
- 3.6 On November 29, 2001, in electronic format, and on December 4, 2001, in hardcopy, the WIPO Center received an "Addendum" to the Complaint.
- 3.7 On December 7, 2001, the WIPO Center received an email from the Delft University of Technology, stating that it was not the registrant of the domain name at issue, and that the address given in the Whois is incorrect and incomplete, and that Delft University is not a proper party Respondent to this proceeding.
- 3.8 Together with the Response, on December 12, 2002, the WIPO Center received a copy of a Complaint and a Motion for Injunction filed with the United States District Court in and for the Middle District of Florida, Case No. 2:01-CV-645-FTM-29DNF, filed on behalf of Joseph Bologna, a/k/a Jay Arby, and d/b/a Allstate Information Exchange, and Aardvark Internet Services, and Allstate.org, Inc, and Allstate Information Exchange, Inc. against Allstate Insurance Company and the World Intellectual Property Organization and its Arbitration and Mediation Center, and seeking to enjoin Intercosmos Media Group, Inc. d/b/a/ directNIC.com and the

Internet Corporation For Assigned Names and Numbers, Tucows, Inc., Dennis Arthur Foster, Frederick M. Abbott, and David W. Plant.

- 3.9 On December 19, 2001, the WIPO Center transmitted an Acknowledgement of Receipt of Response. The WIPO Center noted that where legal proceedings have been brought, the Policy and Uniform Rules provide that the Panel shall have the discretion to decide whether to suspend or terminate proceedings, or to proceed to a decision. Therefore, the WIPO Center would proceed to appoint a Panel. The WIPO Center noted that Respondent had not nominated any candidates for the Panel and gave the Respondent until December 24, 2001, to make such nominations. The WIPO Center advised the Respondent that failure to so nominate candidates would result in appointment by the WIPO Center from its published list of candidates.
- 3.10 On January 3, 2002, not having received any nominations from Respondent, the WIPO Center notified the Respondent that the WIPO Center would proceed with the appointment from its published list of candidates.
- 3.11 On February 5, 2002, the WIPO Center transmitted its notice of appointment of Dennis A. Foster and Peter L. Michaelson to serve as panelists in this matter, noting that both had previously submitted a Statement of Acceptance and Declaration of Impartiality and Independence.
- 3.12 On February 25, 2002, the WIPO Center transmitted its Notification of Appointment of Administrative Panel and Projected Decision Date, appointing M. Scott Donahey to act as Presiding Panelist, and Dennis A. Foster and Peter L. Michaelson to act as Panelists. The WIPO Center noted that it had received Statements of Acceptance and Declarations of Impartiality and Independence from all Panelists, and set the date for submission of decision as March 11, 2002. The date for submission of decision was subsequently extended to March 21, 2002.

4. Factual Background

- 4.1 Complainant has registered the service mark ALLSTATE with the United States Patent and Trademark Office ("USPTO"), effective June 27, 1961 in connection with underwriting of particular types of insurance, effective June 11, 1963, in connection with insurance underwriting generally, effective December 3, 1963, in connection with the business of insurance, and effective March 20, 2001 in connection with investment and fund administration. Complainant has also registered the ALLSTATE service mark in Canada, the European Union, Germany, Indonesia, Spain, and the United Kingdom. Complaint, Annex 3.
- 4.2 Complainant is the largest publicly held personal lines insurer in the United States and provides insurance products to more than 14 million households. In the year 2000, Complainant generated approximately US\$29 billion in revenues from the sale of services under the ALLSTATE mark. In the same year, Complainant spent approximately US\$74,000,000 on advertising and promotions featuring the ALLSTATE mark.

- 4.3 Respondent registered the domain name at issue on July 17, 1998. Complaint, Annex 1.
- 4.4 The web site to which the domain name resolves contains comments and information critical of Complainant and Complainant's business activities. Under the name Allstate Information Exchange. The web site offers the electronic book "Allstate . . . the Fraud Keepers" to those who become "Dues Paying Members" of the Allstate Information Exchange. Complaint, Annex 6.
- 4.5 Respondent charges as much as US\$1,420 for full access to the Site. *Id.*
- 4.6 Respondent also offers unauthorized copies of Complainant's copyrighted materials on CD-ROMs for prices up to US\$1,760. *Id.*
- 4.7 Respondent solicits paid advertising on the site, charging fees of between US\$2 and US\$12 per inch per month. Complaint, Annex 7.
- 4.8 Respondent's web site contains links to commercial research and paralegal service sites, which are owned and operated by Respondent. The sites are commercial sites that require paid membership for use. Complaint, Annexes 8-11.

5. Parties' Contentions

- 5.1 Complainant contends that Respondent has registered as a domain name a mark which is identical to the service mark registered and used by Complainant, that Respondent has no rights or legitimate interests in respect of the domain name at issue, and that Respondent has registered and is using the domain name at issue in bad faith, in that Respondent is using the domain name to attract users for commercial gain.
- 5.2 Respondent objects to the jurisdiction of the Panel.

6. Discussion and Findings

- 6.1 Complainant submitted an Addendum to Complaint, without first having sought permission from the Panel. Pursuant to the discretion given to the Panel in Uniform Rule 12, the Panel declines to accept the unsolicited submission.
- 6.2 Paragraph 15(a) of the Rules instructs the Panel as to the principles the Panel is to use in determining the dispute: "A Panel shall 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."
- 6.3 Since both the Complainant and Respondent are domiciled in the United States, to the extent that it would assist the Panel in determining whether the Complainant has met its burden as established by Paragraph 4(a) of the Policy, the Panel shall look to rules and principles of law set out in decisions of the courts of the United States.

- 6.4 Paragraph 4(a) of the Policy directs that the Complainant must prove each of the following:
- (1) that the domain name registered by the Respondent is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and,
 - (2) that the Respondent has no rights or legitimate interests in respect of the domain name; and,
 - (3) that the domain name has been registered and used in bad faith.
- 6.5 Paragraph 18(a) of the Uniform Rules provides that "*[i]n the event of any legal proceedings initiated prior to or during an administrative proceeding in respect of a domain-name dispute that is the subject of the complaint, the Panel shall have the discretion to decide whether to suspend or terminate the administrative proceeding, or to proceed to a decision.*"
- 6.6 The Panel notes that the legal proceeding was filed three months ago and that it was requested that such proceeding and the present UDRP proceeding be enjoined. Neither the Panel nor the WIPO Center has been served with a Notice of Injunction. Accordingly, unless and until the Panel or the WIPO Center receives a Notice of Injunction enjoining these proceedings from going forward, issued by a court of competent jurisdiction, the Panel believes that in the interest of efficiency it should proceed to a decision. The Panel notes that if the decision should go against the Respondent, who has sought to enjoin the proceedings, the Respondent's rights to appeal any Panel decision to a court of competent jurisdiction are preserved. See, Policy, Paragraph 4(k); Complaint, Paragraph [15], at 18.
- 6.7 The Panel decides that the domain name at issue is identical to the service mark in which Complainant has rights. *Digitronics Inventioneering Corporation v. @Six.Net Registered*, WIPO Case No. D2000-0008 (gTLD is to be ignored in comparison).
- 6.8 It could be argued that Respondent is making legitimate fair use of the domain name at issue by using it in conjunction with a site for expressing critical opinions of and commentary on Complainant's business practices. However, paragraph 4(c)(iii) of the Policy requires such use to be "*noncommercial*" and "*without intent for commercial gain to misleadingly divert consumers.*" In this case Respondent makes commercial use of the domain name at issue by charging fees, offering ads, and offering links to other commercial services. Thus, the Panel finds that Respondent has no rights or legitimate interests in respect of the domain name at issue. *The New York Times Company v. New York Internet Services*, WIPO Case No. D2000-1072.
- 6.9 Respondent has used the domain name at issue to intentionally attract Internet users to Respondent's web site for commercial gain by creating a likelihood of confusion with the complainant's mark. Policy, Paragraph 4(b)(iv). Even if the confusion is only initial confusion that is later clarified by reviewing the web site, where Respondent profits from this initial confusion by gaining web site traffic, this is bad faith registration and use. *National Football League Properties, Inc. and Chargers*

7. Decision

For all of the foregoing reasons, the Panel decides that the domain name registered by Respondent is identical to the mark in which the Complainant has rights, that the Respondent has no rights to or legitimate interests in respect of the domain name at issue, and that Respondent has registered and is using the domain name at issue in bad faith. Accordingly, the Panel requires that pursuant to paragraph 4(i) of the Policy the domain name <allstate.org> be transferred to the Complainant.

M. Scott Donahey
Presiding Panelist

Dennis A. Foster
Panelist

Peter L. Michaelson
Panelist

Dated: March 14, 2002