



WIPO Arbitration and Mediation Center

ADMINISTRATIVE PANEL DECISION

Associated Bank Corp. v. Texas International Property Associates

Case No. D2007-0334

1. The Parties

The Complainant is Associated Bank Corp., Green Bay, Wisconsin, United States of America, represented by Reinhart Boerner Van Deuren s.c., United States of America.

The Respondent is Texas International Property Associates, Dallas, Texas, United States of America, represented by Law Office of Gary Wayne Tucker, United States of America.

2. The Disputed Domain Name and Registrar

The disputed domain name <associtedbank.com> is registered with Compana LLC (the "Registrar").

3. Procedural History

The Complaint was brought pursuant to the Uniform Domain Name Dispute Resolution Policy (the "Policy"), 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 Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules") as approved on October 24, 1999, and the World Intellectual Property Organization Supplemental Rules for Uniform Domain Name Dispute Resolution Policy in effect as of December 1, 1999, (the "Supplemental Rules").

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") in email form on March 6, 2007, and in hard copy form, along with accompanying Exhibits 1-12, on March 8, 2007. In response to a request issued by the Center on April 20, 2007, the Complainant filed an amended version of the Complaint later on the same day. To simplify the ensuing decision, all references to the Complaint will be to the Amended Complaint unless the specific context mandates otherwise.

Pursuant to paragraph 4(d) of the Policy, the Complainant selected the Center as the ICANN approved administrative dispute resolution service provider to administer this proceeding. Through the Complaint, the Complainant requested a single-member panel.

After receiving the original Complaint, the Center, in accordance with paragraph 5 of the Supplemental Rules, verified that the Complaint complied with the formal requirements of the Rules and the Supplemental Rules. In that regard, on March 9, 2007, the Center requested confirmation from the Registrar as to whether the Registrar received a copy of the Complaint from the Complainant and to confirm contact and registrant information set forth in the Complaint relative to the disputed domain name. The Center also requested the Registrar to specify, for the domain name: (a) whether the Policy applies to that name, (b) whether the registrant has submitted, in its registration agreement, to the jurisdiction at the location of the principal office of the registrar for court adjudication of disputes concerning or arising from the use of that name, (c) the language of the registration agreement, and (d) whether that name will remain "locked" during the proceeding.

Subsequently, on April 16, 2007, the Registrar provided its response to the Center through which the Registrar specified name and contact information pertinent to the disputed domain name to the extent present in its Whois database, and confirmed that the Respondent is listed as the registrant for the name. The response also confirmed that Compana LLC is the registrar of the disputed domain name, and stated that the Policy applied to the disputed domain name and the registration agreement is in English.

The Center verified that the Complaint, once amended, satisfied the formal requirements of the Policy, the Rules and the Supplemental Rules.

On April 23, 2007, the Center formally notified the Respondent, by email letter, of the filing of the Complaint, including an indication that the Center was forwarding a complete copy of the Complaint to the Respondent, together with all its Annexes, by both courier and email. The Complaint and its accompanying documents, and all subsequent communications associated therewith, were provided in the preferred manners and to the addresses as mandated by paragraphs 2(a), 2(b) and 4(a) of the Rules.

Hence, the notification to the Respondent having occurred on April 23, 2007, under paragraph 4(c) of the Rules, this administrative proceeding is deemed to have commenced on that date.

Having reviewed the Complaint and all preceding and succeeding correspondence between the Center and the Registrar, the Panel agrees with the determination of the Center that the Complaint and its handling met the requirements of the Rules and the Supplemental Rules.

The Respondent was then provided with a 20 calendar day period, expiring on May 13, 2007, to file its Response with the Center and serve a copy of the Response on the Complainant.

The Respondent timely filed its Response with the Center, in email form on May 13, 2007 and subsequently in hard-copy on May 23, 2007 together with accompanying Exhibits A-D.

On May 18, 2007, the Complainant filed a supplemental filing, specifically a Rebuttal (to the Response) , by email with the Center, and on May 23, 2007 in hard-copy form, together with Exhibit A.

Accordingly, pursuant to the Rules and Supplemental Rules, by email letter dated May 25, 2007, the Center contacted the undersigned, Mr. Peter L. Michaelson, requesting his service as a Sole Panelist for this dispute. Subsequently, on the same day, Mr. Michaelson accepted and returned, by facsimile to the Center, a fully executed Statement of Acceptance and Declaration of Impartiality and Independence. The Center, through an email letter dated May 31, 2007, notified the Parties of the appointment of Mr. Michaelson as Sole Panelist.

Based on the deadline set forth in paragraph 15 of the Rules, a decision was to be issued by the Panel to the Center on or before June 14, 2007. Owing to unexpected time conflicts experienced by the Panel all of which constituted unforeseen circumstances, the Center, at the request of the Panel, extended this due date to June 28, 2007.

4. Factual Background

A copy of the Whois registration record for the disputed domain name appears in Exhibit A to the Complaint. As indicated on this record, the disputed domain name was registered on February 28, 2005.

A. Complainant's "ASSOCIATED BANK" Mark

The Complainant owns a United States trademark registration for the term ASSOCIATED BANK in block letters. The Complainant has provided, in Exhibit 6 to the Complaint, a copy of its registration certificate as issued by the US Patent and Trademark Office (PTO) for that mark. Pertinent details of this registration are as follows:

ASSOCIATED BANK
United States registration 3,087,029; registered: May 2, 2006
filed: October 15, 2004

This mark is registered for use in connection with "banking services, financing services, fund investment services, financial management services, financial analysis and consultation services, financial portfolio management services, financial services in the nature of investment security, investment advice services, investment management services, estate trust management services, and insurance agency services", all in international class 36. The entry states that both first use and first use in commerce of this mark, when used in conjunction with these services, commenced as of December 31, 1970.

B. The Parties and their Interaction

The Complainant, a publicly traded corporation on the NASDAQ, is an established banking institution with, at the end of 2006, more than 300 locations and approximately \$21 billion dollars in total assets. See a copy of the Complainant's 2006 Annual Report which appears in Exhibit A to Complainant's Supplemental Filing. This report in "2006 Financial Highlights", on page 1a, provides basic historical financial information (specifically diluted earnings per share, dividends per share and assets at period end) for the Complainant for each of the years 2001-2006.

The Complainant has used its ASSOCIATED BANK name in the United States since at least as early as December 31, 1970 and on the Internet since at least as early as 1999. The Complainant owns various domain names which incorporate its mark, specifically: <associatedbank.com>, <associatedbank.net>, <associatedbank.org>, <associatedbank.info>, <associatedbank.biz> and <associatedbank.us>, all of which have been registered between 1999-2002. A copy of registration records, currently obtainable through the WhoIs database, for all these names appears in Exhibit 5 to the Complaint.

The Complainant has invested a substantial amount of money and effort in advertising and promoting its services under its mark. Consequently, the Complainant states that, as a result, its mark has become highly distinctive of its services and, through that mark, it has achieved a significant degree of consumer goodwill, recognition and reputation.

The Complainant recently became aware that Respondent registered the disputed domain name which currently directs visitors to a website that offers links to a variety of financial services companies located in the United States, including companies that provide services directly competitive with those which the Complainant currently offers. This website also includes links to "Associated Bank Wisconsin" and "Associated Bank", where both names include the Complainant's ASSOCIATED BANK Mark and the former includes the state (Wisconsin) where the Complainant is headquartered. However, these "Associated Bank" links direct users to a variety of competing banks and lenders. None of the links contained on the Respondent's website links to the Complainant's website. A hard-copy of a screen shot of the home page of the Respondent's website appears in Exhibit 7 to the Complaint.

On January 16, 2007, the Complainant's Counsel sent a letter (a copy of which appears in Exhibit 8 to the Complaint), via email and courier, to the Respondent demanding it cease and desist from any further use of the disputed domain name and transfer that name to the Complainant. Later, the same day, January 16, 2007, the Respondent's Counsel replied, via an e-mail letter (a copy of which appears in Exhibit 9 to the Complaint), stating that his client would look into the Complainant's claim and reply back in fifteen days.

On February 5, 2007, and after having received no reply from the Respondent's Counsel, the Complainant's Counsel sent a second demand letter (a copy of which appears in Exhibit 10 to the Complaint) to the latter. The Respondent's Counsel replied back later that same day by e-mail letter (a copy of which appears in Exhibit 11 to the Complaint) stating that his client would not transfer the name to the Complainant.

On February 7, 2007, the Complainant's Counsel sent a third letter (a copy of which appears in Exhibit 12 to the Complaint) to the Respondent's Counsel in order to provide the Respondent with one more opportunity to transfer the Domain Name without additional legal action being taken against it. No reply to that letter was received.

5. Parties' Contentions

A. Complainant

(i) Identical or Confusingly Similar

The Complainant contends that the disputed domain name, <associtedbank.com>, is confusingly similar to the Complainant's ASSOCIATED BANK Mark.

Specifically, the Complainant contends that the only difference between the name and the mark is that the former omits a second letter "a" from the mark and constitutes a common misspelling of the mark.

Hence, the Complainant believes that it has satisfied the confusing similarity/identity requirement in paragraph 4(a)(i) of the Policy.

(ii) Rights or Legitimate Interests

The Complainant contends that the Respondent has no rights or legitimate interests in the disputed domain name pursuant to paragraph 4(a)(ii) of the Policy.

First, the Complainant states that the Respondent is not using the name in a legitimate commercial manner. Specifically, whenever an Internet user enters the name into his (her) browser, that user is directed to the Respondent's website which provides various links to United States financial service companies that offer products directly competitive with those of the Complainant. Further, inasmuch as that website also contains links to "Associated Bank Wisconsin" and "Associated Bank", which ostensibly are used to denote a connection with the Complainant, nevertheless these "Associated Bank" links direct users to a variety of competing banks and lenders, none of which is associated with the Complainant. Hence, the Respondent's website is clearly intended to take advantage of individuals who misspell the Complainant's name when entering its domain name into their browser. Hence, the Complainant is ostensibly alleging that the Respondent, in registering and using the name, is engaged in so-called "typo-squatting".

Second, the Complainant states that the Respondent does not have any permission, either express or implied, from the Complainant to use and/or register any domain name which incorporates the Complainant's ASSOCIATED BANK Mark, nor has Respondent ever conducted business under that mark.

(iii) Registered and Used in Bad Faith

The Complainant contends that the Respondent registered and is now using the disputed domain name in bad faith under paragraph 4(a)(iii) of the Policy.

First, the Complainant contends that, inasmuch as it has used its ASSOCIATED BANK Mark for over 10 years and has registered and uses five domain names, each containing the mark, and the Respondent is using the disputed domain name for its website that promotes financial services competitive with those currently offered by the Complainant, then the Respondent either knew, or should have known, of the Complainant's trademark rights prior to when it registered the disputed domain name. Moreover, inasmuch as that the disputed domain name is an intentional misspelling of the Complainant's mark, the Respondent intentionally registered the name to primarily to take advantage of, trade off of and profit from the Complainant's trademark rights

and reputation, and, through its current use of the name, is doing so. Hence, the Respondent registered and is using the name in bad faith.

Second, the Complainant contends that the Respondent, by refusing to transfer the name to the Complainant for the Respondent's documented out-of-pocket expenses or otherwise respect the Complainant's trademark rights, registered the name in order to: (a) prevent the Complainant from using the name, (b) sell the name to the Complainant for a profit, and/or (c) attract, for commercial gain, Internet users to the Respondent's website by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of the Respondent's website with the Complainant, when, in fact, no such relationship exists between the parties.

B. Respondent

(i) Identical or Confusingly Similar

The Respondent contends that the Complainant has no enforceable rights in its ASSOCIATED BANK Mark and, to the extent such rights do exist, the disputed domain name is not confusingly similar to that mark.

First and specifically, the Respondent contends that the name is formed of a combination of two words "associated", though admittedly misspelled, and "bank", wherein "associated" is a descriptive term and "bank" is a generic one. In that regard, the Respondent points to the website at "www.dictionary.com" which defines "associated" as "[t]o join as a partner, ally, or friend; [t]o connect or join together; combine; [t]o connect in the mind or imagination" and "bank" as "an institution for receiving, lending, exchanging, and safeguarding money and, in some cases, issuing notes and transacting other financial business." Consequently, when these two words are joined together, the resulting composite term conveys a meaning of "a partnership or alliance of financial institutions". Thus, the Respondent contends that the mark "ASSOCIATED BANK" has a well-established generic meaning to describe banks that have some mutual relationship. In that regard, the Respondent points to European Commission Decision "86/507/EEC: Commission Decision of 30 September 1986 relating to a proceeding under Article 85 of the EEC Treaty (IV31.362 - Irish Banks' Standing Committee)" (a copy of which appears in Exhibit A to the Response) which notes that, in Ireland, an "associated bank" is a type of statutorily created bank under Provision 12 of the Central Bank Act of 1942 (a copy of that provision appears in Exhibit C to the Response). Thus, the Respondent contends that inasmuch as the composite mark has a well-known generic meaning, it can not possess any valid and enforceable trademark rights.

Second, the Respondent points to the prosecution history of the Complainant's federal trademark application (which ultimately issued as the Complainant's ASSOCIATED BANK registration) and particularly to an office action therein (a copy of which appears in Exhibit D to the Response) where the United States Trademark Examiner apparently viewed the terms "associated" and "bank" and the composite mark formed of the two as being merely descriptive.

Third, the Respondent points to the fact that the disputed domain name was registered on February 28, 2005 which is prior to the May 2, 2006 date – and in fact by more than a year – on which the Complainant's ASSOCIATED BANK Mark was registered. In view of this, the Respondent contends that the Complainant is required to prove that it

has common law rights, i.e., that it has acquired secondary meaning, in its mark, which predate February 28, 2005 – any evidence of which is not reflected in the Complaint.

Lastly, the Respondent contends that it is not engaged in “typo-squatting” as the disputed domain name reflects a variation of a common descriptive term, i.e., “associated bank” and not a distinctive and famous mark.

(ii) Rights or Legitimate Interests

The Respondent contends, contrary to the Complainant’s allegations, that it has rights or legitimate interests in the disputed domain name.

First, the Respondent states that the links on its website are provided by Google and are triggered by search requests entered by Internet users to the Google search engine. Generally, the links will be for those who provide associated banking services as used in a descriptive and/or generic sense. There is no intent to target the Complainant. The Respondent has no control over what terms advertisers bid on at Google and thus, inasmuch as Google provides the links, has no control over what links appear on the Respondent’s website. Therefore, the Respondent is not responsible for the potentially offending content inasmuch as a third-party, here Google, controls the content on the Respondent’s website.

Second, the Respondent contends that it may use descriptive or generic terms, as is the case here, in a commercial domain name regardless of whether they are federally registered as a trademark. Moreover, the fact that advertising revenues may be generated by the Respondent’s activity demonstrates a legitimate interest. The Respondent registered and began using the <associtedbank.com> domain before receiving notice of the present dispute and prior to the date on which Complainant secured a federal registration for its alleged mark.

(iii) Registered and Used in Bad Faith

The Respondent disputes the Complainant’s allegations that it registered and uses the disputed domain name in bad faith.

First, Respondent contends that it registered the domain name on February 28, 2005, prior to the date, May 2, 2006, on which the Complainant’s mark was registered. Respondent states that as of the latter date, it neither had any constructive knowledge of the Complainant’s mark nor any actual knowledge of either the Complainant or its mark, particularly since the Complainant operates only in three states nearly a thousand kilometers from the Respondent. Further, the Respondent contends that when it registered the name, it believed, and still believes, that the Complainant’s ASSOCIATED BANK Mark is generic and/or merely descriptive. Consequently, the Respondent did not register the name in bad faith.

Second, the Respondent states that it is in the business of providing locating services through which Internet users locate providers of desired goods and services through entry of common, well-known generic, descriptive and geographically descriptive terms, and is so using the name in connection with that business. Moreover, the Respondent is not attempting to pass itself off as the Complainant or any other bank. Hence, the Respondent is not using the disputed domain name in bad faith.

Lastly, the Respondent contends that where a mark is a common term with substantial third party use, as it believes is the case here, a complainant must proffer evidence that

demonstrates that a respondent has specifically intended to confuse consumers seeking out the complainant, but no such evidence of actual confusion exists in the record.

C. Complainant's Supplemental Filing (Rebuttal)

Although the Rules and Supplemental Rules do not specifically and expressly provide for any supplemental filings by either party to an UDRP proceeding, the Panel has the sole discretion to admit and consider any such filings that have been made. Acting in its discretion, the Panel has admitted and fully considered the Complainant's Rebuttal. The Panel summarizes the salient points of that filing as follows.

First, under United States law, the Complainant's trademark registration being on the Principal Register constitutes *prima facie* evidence of the information stated thereon, including that the Complainant's date of first use of its mark dates back to December 1970 and that, through exclusive and substantial use of the mark over the past 37 years, the mark has acquired distinctiveness. Given this, there is no need for the Complainant to separately prove that it has either common law or secondary meaning in its mark.

Second, the Complainant again emphasizes that that Respondent clearly registered the disputed domain name, which is nearly identical to the Complainant's mark, for the purpose of profiting from Internet users who seek the Complainant's website. Each of the Complainant's five domain names – which include the Complainant's ASSOCIATED BANK Mark – were registered years before the Respondent registered the misspelled version of the Complainant's mark as the disputed domain name. Hence, not only did Respondent have constructive notice of Complainant's trademark rights, but also the Respondent registered the intentionally misspelled version of the Complainant's mark as its domain name for the specific purpose of causing consumer confusion and profiting from the Complainant's trademark rights.

6. Discussion and Findings

A. Trademark Invalidity

As a threshold issue, the Respondent raises an allegation to the effect that the Complainant's ASSOCIATED BANK Mark is either generic, by virtue of it being a composite mark formed of two generic terms and has a meaning consistent with the combined meaning of those terms, or is highly descriptive. Given this view, the Respondent then ostensibly contends that this mark is not capable of distinctively identifying the Complainant's services, and consequently has no significance as a federal trademark when used in conjunction with the services recited in the Complainant's corresponding trademark registration.

Questions of trademark invalidity, including questions of whether a mark is generic or highly descriptive and hence not susceptible to legal exclusivity as a valid federal trademark, are simply not within the purview of a UDRP proceeding and are best left for either court adjudication or inter-partes adjudication before appropriate governmental bodies having requisite jurisdiction and competence to handle such issues. Not only are such questions outside the very limited and focused jurisdiction afforded to UDRP panels under the Policy, but, moreover, the summary and rather abbreviated nature of UDRP proceedings totally precludes the establishment of a fully developed factual record that must underlie the determination of such questions. See, *SPX Corporation v. Hevun Diversified Corporation*, NAF Case No. FA 791657 (November 13, 2006); *Classic Media, Inc. v. Royal*, WIPO Case No. D2006-0208

(June 19, 2006); *Lockheed Martin Corp. v. The Skunkworx Custom Cycle*, WIPO Case No. D2004-0824 (January 18, 2005); *Register.com, Inc. v. Wolfgang Reile*, NAF Case No. FA 208576 (January 27, 2004); *United States Office of Personnel Management v. MS Tech. Inc.*, NAF Case No. FA 198898 (December 9, 2003); and *Lake at Las Vegas Joint Venture v. Principal Equiti, Inc.*, WIPO Case No. D2002-0758 (October 4, 2002).

To the extent the Respondent wishes to contest the continued validity of the Complainant's ASSOCIATED BANK Mark on the basis that this mark is either generic or highly descriptive, the Respondent must do so through an appropriate administrative and/or judicial avenue that has appropriate jurisdiction over the issue, such as by filing an action in the USPTO to cancel the Complainant's federal registration or alternatively instituting federal litigation. Absent the Respondent having done so and attained a final ruling in its favor, this Panel is constrained to defer, as it must, to the USPTO for its initial determination, implicit in its having granted a registration to the Complainant for its mark, that the Complainant's ASSOCIATED BANK Mark has acquired sufficient distinctiveness and thus qualifies for continued federal trademark protection and enjoys all the rights afforded thereby.

Therefore, given the inability of this Panel to address the invalidity issue raised by the Respondent, then, as far as this proceeding is concerned, the Panel is not precluded from finding that the disputed domain name is either identical or confusingly similar to the Complainant's ASSOCIATED BANK Mark.

B. Identical or Confusingly Similar

The Panel finds that the disputed domain name is confusingly similar to the Complainant's ASSOCIATED BANK Mark.

From a simple comparison of the name and the mark, no doubt exists that the disputed domain name is, for all practical purposes, nearly identical to that mark. The only difference between the name and that mark is the omission of a letter "a" from the mark and the appending of a gTLD (generic top level domain) ".com" to the mark, with the latter being totally irrelevant in assessing confusing similarity or identity under paragraph 4(a) of the Policy and thus ignored.

It is now very well-established in UDRP precedent, including numerous decisions previously rendered by this Panel, that minor variations, such as adding short letter or number groups or even generic words to a mark, are each 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. Omitting a single letter "a" from the mark here such that the term "associated" becomes in the domain name "associted" is clearly such a minor, if not rather trifling, variation. See, e.g., *Gerber Childrenswear Inc. v. David Webb*, WIPO Case No. D2007-0317 (April 24, 2007); *SPX Corp. v. Hevun Diversified Corp.*, NAF Case No. FA791657 (November 13, 2006); *Google Inc. v. Burns*, NAF Case No. FA 726096 (August 16, 2006); *The Cheesecake Factory Inc. and The Cheesecake Factory Assets Co., LLC v. Say Cheesecake*, WIPO Case No. D2005-0766 (September 12, 2005); *Napster, Inc. v. Vinscani*, WIPO Case No. D2005-0531 (July 19, 2005); *Caesars Entertainment Inc. v. Nova Internet Inc.*, WIPO Case No. D2005-0411 (June 22, 2005); *Lockheed Martin Corporation v. The Skunkworx Custom Cycle*, WIPO Case No. D2004-0824 (January 18, 2005); *Lockheed Martin Corp. v. Deborah Teramani*, WIPO Case No. D2004-0836 (December 1, 2004); and *National Collegiate Athletic Assoc. v. Dusty Brown*, WIPO Case No. D2004-0491 (August 30, 2004); and *Lane-Labs USA, Inc. v. Powell Productions*, NAF Case

No. FA 155896 (July 1, 2003).

Furthermore, the Panel notes, although more relevant under the second and third elements of the Policy, that even though the Complainant's ASSOCIATED BANK Mark was registered by the USPTO on May 2, 2006 which is over a year after the Respondent registered the disputed domain name on February 28, 2005, ample evidence exists of record that the Complainant has been continuously using its ASSOCIATED BANK Mark in commerce for certainly several years and at least as many as 37, prior to the February 28th registration date. In that regard, one only need consider the Complainant's Annual Report which provides historical financial information for the Complainant from as early as 2001; the five domain names which the Complainant registered between 1999-2002, each of which contains the Complainant's ASSOCIATED BANK Mark; and the Complainant's claim, in its United States trademark registration that it first used its mark in commerce as early as December 31, 1970. The Respondent has disputed none of this evidence. All this evidence points to and sufficiently confirms the Complainant's common law trademark rights and the exclusivity associated therewith well preceded the date on which the Respondent registered the domain name. Well-settled UDRP precedent, including numerous decisions of this Panel, have upheld the protectible status of common law rights under the Policy. See, e.g., *Utada Hikaru v. Taylor Domains*, WIPO Case No. D2007-0367 (May 25, 2007) and *Utada Hikaru v. Leonard Meng Lee*, WIPO Case No. D2007-0366 (May 25, 2007); "*Maria Bartiromo*" and *Dave Walton*, WIPO Case No. D2007-0242 (April 11, 2007); *Animals for Advertising, Inc. v. Cathryn Long*, WIPO Case No. D2007-0049 (March 30, 2007); *William M. Krings v. Hugo Hernandez*, WIPO Case No. D2006-0237 (April 18, 2006); *Sound Unseen, Ltd.; Apple Bottoms, LLC; and Cornell Haynes p/k/a "Nelly" v. Patrick Vanderhorst*, WIPO Case No. D2005-0636 (August 18, 2005); and *True Blue Productions, Inc. v. Chris Hoffman*, WIPO Case No. D2004-0930 (December 22, 2004). Furthermore, the panel in *United States Postal Service v. Consumer Info. Org.*, NAF Case No. FA 95757 (November 27, 2000), held: "The UDRP does not discriminate between registered and unregistered marks." In *Exario Network Inc. v. THE DOMAIN NAME YOU HAVE ENTERED IS FOR SALE*, eResolution Case No. AF-0536 (December 11, 2000), the panel recognized: "It is well established that a complainant need not own a registered trademark to invoke the policy. It is sufficient that a complainant have rights in an unregistered trademark." In that regard, also see *Sand Hill Wholesale of Ohio v. Hatton*, NAF Case No. FA 95970 (December 18, 2000), and *David Taylor Cadillac/Buick Co. v. Spider Works, Ltd.*, NAF Case No. FA 95832 (November 30, 2000). Similarly, see *American Home Products Corp. v. Healthy Futures*, WIPO Case No. D2000-0454 (August 3, 2000); *Cho Yong Pil v. ImageLand, Inc.*, WIPO Case No. D2000-0229 (May 10, 2000); *SeekAmerica Networks, Inc. v. Tariq Masood and Solo Signs*, WIPO Case No. D2000-0131 (April 13, 2000); and *Bennett Coleman & Co. Ltd. v. Steven S Lalwani and Bennett Coleman & Co. Ltd. v. Long Distance Telephone Company*, WIPO Case No. D2000-0014 and D2000-0015 (March 11, 2000).

Furthermore, while the Respondent attempts to justify its view that the Complainant's ASSOCIATED BANK Mark is either generic or highly descriptive by virtue of the fact that the United States Trademark Examiner included definitions for the terms "associated" and "bank" in her office action, it becomes readily apparent, upon closer inspection of that action, that the Examiner recognized, that in spite of whatever descriptive nature that mark might otherwise have, by virtue of its prior use over an extended period of time, the mark had acquired requisite distinctiveness under § 2(f) of the Lanham Act to permit its registration. Therefore, this Panel categorically rejects the Respondent's view in deference to that of the USPTO.

Therefore, the Panel finds that the disputed domain name <associtedbank.com> is confusingly similar to the Complainant's ASSOCIATED BANK Mark as to cause confusion; hence, the Complainant has satisfied its burden under paragraph 4(a)(i) of the Policy.

C. Rights or Legitimate Interests

The Panel believes that the Respondent has not provided any basis that, in the circumstances here, would legitimize a claim to the disputed domain name under paragraph 4(c) of the Policy.

There is absolutely no evidence of record that the Respondent has ever been commonly known by the domain name. Nor could the Respondent ever become so known, in light of the Complainant's continuous use of its mark well prior to the date on which the Respondent registered the name without infringing on the exclusive trademark rights of the Complainant. See, *Treeforms, Inc. v. Cayne Industrial Sales, Corp.*, NAF Case No. FA 95856 (Nat. Arb. Forum December 18, 2000).

Further, no evidence exists of record that the Complainant has ever authorized the Respondent to utilize its ASSOCIATED BANK Mark or any mark confusingly similar thereto in conjunction with financial services which the Complainant provides under its mark, nor does the Complainant apparently have any relationship or association whatsoever with the Respondent. As such, any use to which the Respondent were to put the mark ASSOCIATED BANK or one confusingly similar thereto -- such as "associtedbank", in connection with the services provided by the Complainant or those similar thereto, would violate the exclusive rights now residing in the Complainant. See, e.g., *GoDaddy.com, Inc. v. GoDaddysDomain.com, Clark Signs, Graham Clark*, WIPO Case No. D2007-0303 (May 7, 2007); *Citgo Petroleum Corporation v. Richard Antinore*, WIPO Case No. D2006-1576 (March 14, 2007); *New Destiny Internet Group, LLC and Xplor Media, Inc. v. SouthNetworks*, WIPO Case No. D2005-0884 (October 14, 2005); *The Cheesecake Factory Inc., Napster and Caesars Entertainment, Inc.*, all cited *supra*; *Pelmorex Communications Inc. v. weathernetwork*, WIPO Case No. D2004-0898 (December 28, 2004); *Sybase, Inc. v. Analytical Systems*, WIPO Case No. D2004-0360 (June 24, 2004); *Caesars World, Inc. and Park Place Entertainment Corporation v. Japan Nippon*, WIPO Case No. D2003-0615 (September 30, 2003); *Leiner Health Services Corp. v. ESJ Nutritional Products*, NAF Case No. FA 173362 (September 16, 2003); *AT&T Corp. v. Roman Abreu d/b/a Smartalk Wireless*, cited *supra*; *MPL Communications, Limited et al v. IWebAddress.com*, NAF Case No. FA 97092 (June 4, 2001); *America Online, Inc. v. Xianfeng Fu*, WIPO Case No. D2000-1374 (December 11, 2000); and *Treeforms*, cited *supra*. Consequently, the Respondent could not legally acquire any public association between it and the mark ASSOCIATED BANK or one similar thereto, at least for the financial services rendered by the Complainant or similar services. Hence, based on the evidence before the Panel, the Respondent does not fall within paragraph 4(c)(ii) of the Policy.

Moreover, given that the Respondent readily admits that the disputed domain name contains a common misspelling of the term "associated" and thus, in this Panel's mind, bears an extremely high degree of similarity to the Complainant's ASSOCIATED BANK Mark, it strains reason to think that the Respondent was totally unaware of the Complainant's mark when it registered the disputed domain name. Consequently, this Panel believes that the Respondent was fully aware of the Complainant's mark when it registered the disputed domain name and, in spite of that knowledge, subsequently used

that name as a vehicle to confuse Internet users and through such confusion opportunistically exploit the Complainant's goodwill for the Respondent's own pecuniary benefit. Hence, any claim which the Respondent may make to the disputed domain name is simply baseless and illegitimate.

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

D. Registered and Used in Bad Faith

The Panel believes that the Respondent's actions constitute bad faith registration and use of the disputed domain name.

As discussed above, the Panel finds that the Respondent was well aware of the Complainant and its ASSOCIATED BANK Mark when it registered the disputed domain name. Yet, in spite of that knowledge, the Respondent intentionally chose and registered the disputed domain name to opportunistically exploit its potential to generate user confusion, for the Respondent's eventual pecuniary benefit and to the Complainant's ultimate detriment.

In that regard, the Panel can think of no plausible reason why the Respondent would register a domain name that is a very common misspelling of the Complainant's mark if, in fact, the former had absolutely no intention of causing user confusion and then benefiting from it in some manner. Given well-known and now nearly universal website naming conventions, Internet users who seek to reach a particular website of an organization are very likely to form a domain name which includes the name of that organization followed by a common gTLD, often ".com". However, in doing so, those users may inadvertently and slightly mistype the name by entering into their browser an erroneous letter or number not in the mark, or omitting a letter or number from the mark. The Respondent admits that the term "associted" is a commonly misspelled variant of "associated". Therefore, in spite of the Respondent's assertions to the contrary, this Panel can only conclude that the Respondent's intention in registering and using the disputed domain name, as it did, was in fact to opportunistically exploit the Complainant's mark and reputation through Internet user confusion that would inevitably arise through spelling errors inadvertently entered by those users who then sought the Complainant's website but reached the Respondent's site instead.

Moreover, nothing exists on the Respondent's website which would lead any Internet user to reasonably infer other than that a connection, affiliation or relationship of some sort likely exists between the Respondent's website and the Complainant – when, in actuality, none exists. Thus, the Respondent's use of the name is highly likely to confuse, if not deceive, Internet users who visit that site but do so with the intention of visiting the Complainant's site instead. See *Christian Dior Couture v. Alex Roché*, WIPO Case No. DTV2007-0004 (June 15, 2007) and *Gerber Childrenswear*, cited *supra*.

When viewed in their entirety, the Respondent's actions completely negate any possible finding by this Panel that it acted in good faith to register and use the disputed domain name, and in fact undeniably show that the Respondent violated paragraph 4(a)(iii) of the Policy and specifically paragraph 4(b)(iv) thereof.

Thus, the Panel concludes that the Complainant has established its case under paragraph 4(a) of the Policy upon which the relief it now seeks can be granted.

7. Decision

Accordingly, under paragraphs 4(i) of the Policy and 15 of the Rules, the Panel now grants the relief sought by the Complainant.

The disputed domain name, <associtedbank.com>, is ordered transferred to the Complainant.

Peter L. Michaelson
Sole Panelist

Date: June 28, 2007