



WIPO Arbitration and Mediation Center

ADMINISTRATIVE PANEL DECISION

BlackRock, Inc. v. blackrockfinancialservices.com

Case No. D2007-1627

1. The Parties

The Complainant is BlackRock, Inc., New York, New York, United States of America, represented by Edward Angell Palmer & Dodge LLP, United States of America.

The Respondent is blackrockfinancialservices.com, Jamaica, New York, United States of America, represented pro se.

2. The Domain Name and Registrar

The disputed domain name <blackrockfinancialservices.com> is registered with GoDaddy.com, Inc. (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 November 2, 2007, and in hard copy form, along with accompanying Exhibits A-H, on November 6, 2007.

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 November 5, 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 November 5, 2007, the Registrar provided its response to the Center through which it 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 that name. The response also confirmed that: (a) it received a copy of the Complaint, (b) GoDaddy.com, Inc. is the registrar, (c) the Respondent submitted to the jurisdiction of the courts at the location of the principal office of the Registrar, (d) the registration agreement is in English; and (e) indicated that the name will remain locked during the proceeding.

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

On November 8, 2007, the Center formally notified the Respondent 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 exhibits, by courier, and, without those exhibits, by 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 November 8, 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 the correspondence, including that 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 November 28, 2007, to file its Response with the Center and the Complainant.

Though by November 28, 2007, the Center had not received a formal Response to the Complaint from the Respondent; on November 29, 2007, the Center received an email message from the Respondent which purported to be a Response - though one day late. Though the Response is untimely, it is only so by one day. Inasmuch as this period of time is minimal and no prejudice has evidently occurred to the Complainant by virtue of the Respondent’s one-day delay, the Panel, acting in its sole discretion, has considered the Response and will discuss it below.

Pursuant to the Rules and Supplemental Rules, by an email letter dated December 4, 2007, the Center contacted the undersigned, Mr. Peter L. Michaelson, requesting his service as a Sole Panelist for this dispute. Subsequently, on that same day, Mr. Michaelson accepted and returned, by e-mail to the Center, a fully executed Statement of Acceptance and Declaration of Impartiality and Independence. The Panel finds that it was properly constituted. The Center, through an email letter dated December 7, 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 December 21, 2007. However, owing to unexpected time conflicts experienced by the Panel which constituted unforeseen circumstances, the Center, at the Panel's request, extended the due date to January 4, 2008.

This dispute concerns one domain name, specifically <blackrockfinancialservices.com>.

The language of this proceeding is English.

4. Factual Background

As indicated in the WhoIs registration record provided in Exhibit A to the Complaint, the Respondent registered the disputed domain name on March 23, 2007.

A. The Complainant's BLACKROCK Marks

The Complainant owns two US trademark registrations for the word BLACKROCK, in block letters, by itself or with additional words. For each of these registrations, the Complainant has provided, in Exhibit C to the Complaint, a hard-copy printout of a corresponding record from the publicly accessible Trademark Applications and Registrations Retrieval (TARR) on-line database provided by the United States Patent and Trademark Office. Pertinent details of these registrations are as follows:

1. BLACKROCK (block letters)
United States registration 2,417,737; registered: January 2, 2001

This mark is registered for use in connection with "investment management services; investment advice; risk management; stock brokerage services, namely the sales, marketing and distribution of investment company shares; mutual fund brokerage services; mutual fund administration and transfer agency services" in international class 36. The registration record states that both first use and first use in commerce of this mark, when used in conjunction with these services commenced as of June 22, 1992.

2. BLACKROCK FINANCIAL MANAGEMENT (block letters)
United States registration 2,241,410; registered: April 27, 1999.

This mark is registered for use in connection with "financial advisory and asset management services, excluding development or syndication of commercial real estate" in international class 36. The registration record states that both first use and first use in commerce of this mark, when used in conjunction with these services also commenced as of June 22, 1992.

B. The Complainant

Since its founding in 1988, the Complainant provides global investment management services. As of June 30, 2007, the Complainant had over US \$ 1 Trillion in assets under management for its institutional and retail clients worldwide across fixed income, equity, liquidity, asset allocation/balanced assets, real estate and alternative strategies. The Complainant offers its services under its mark BLACKROCK in North and South America, Europe, Asia, Australia and the Middle East, and maintains offices in 18 major countries around the world. Various pages from the Complainant's web site appear in Exhibit E to the Complaint.

C. The Respondent

The Respondent's website purports to offer consumer financial services, including, *inter alia*, personal and mortgage loans, insurance, automobile loans and credit cards. The home page of that site states:

“BlackRockFinancialServices.com, a New York Based Global Financial Service with insurance, banking, finance, stocks, investment, trading, real estate services, and other financial services. Founded in 2007, our goal is to be *your* 1 stop financial firm.” [emphasis in original]

Hard copies of various web pages from the Respondent's site appear in Exhibit F to the Complaint.

5. Parties' Contentions

A. Complainant

(i) Identical or Confusingly Similar

The Complainant contends that the disputed domain name is confusingly similar to the Complainant's BLACKROCK marks.

Specifically, the Complainant states that the name incorporates the Complainant's mark BLACKROCK.

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.

Specifically, Complainant alleges that the Respondent does not own any trademark or service mark registrations that encompasses the disputed domain name or any variation thereof, is not commonly known by that name; and is not making a legitimate noncommercial or fair use of that name.

In that regard, the Complainant states that its search of a database provided by the New York Department of State, Division of Corporations yielded no results for entities (other than companies affiliated with the Complainant) registered with

formative names “blackrock financial” or “blackrockfinancial”. Similarly, a search which the Complainant conducted on <trademark.com> failed to reveal any federal, state or common law trademarks, owned by the Respondent, for the term “Blackrock Financial Services”.

(iii) Registered and Used in Bad Faith

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

In particular, the Complainant contends that Internet visitors who enter the disputed domain name, intending to reach the Complainant’s web site, are diverted to the Respondent’s site instead, which is neither affiliated with nor sponsored by the Complainant; hence, causing confusion. Further, since the Complainant has been using its BLACKROCK Marks since June 22, 1992 which is approximately 15 years prior to the date (March 23, 2007) on which the Respondent registered the name, then it is reasonable to assume that the Respondent knew of the Complainant’s trademark rights prior to when it registered the name and, in spite of such knowledge, registered the name to intentionally cause and exploit such confusion.

Furthermore, the Respondent exacerbates this confusion inasmuch as its web site (a hard-copy printout of the home page appears in Exhibit F to the Complaint) has several design elements that mimic corresponding elements on the home page of the Complainant’s web site: (a) a black and grey background, (b) a prominent link for “INVESTMENTS” located at a top-central portion of the page, and (c) purports to offer “market data” – the last feature being a major component of the services offered by the Complainant. A majority of the pages at the Respondent’s site contains banner advertisements for financial services and from which the Respondent presumably receives click-through and/or other financial gain. Moreover, to further disguise the Respondent’s exploitive nature by increasing its perception, among Internet users, as a legitimate financial services provider, the Respondent’s web site contains various web site features, such as a link to a displayable privacy policy, which those users would expect from and hence only associate with a legitimate site - which the Respondent’s site is clearly not.

Lastly, the Complainant alleges that, as indicated in the hard-copy printouts of search results from “www.eudip.com” and Google, and certain web pages returned thereby - all provided in Exhibit H to the Complaint, the Respondent registered several “BLACKROCK”-based domain names, e.g., <blackrockentertainment.com>, <blackrockwireless.com> and <blackrockdeals.com>, through which Internet visitors were offered various consumer goods for sale (e.g., televisions, mobile telephones, flash memory cards, and cameras) - none of which had any relationship whatsoever to the Complainant. Given this pattern of registration, the Respondent’s conduct here in registering the disputed domain name prevented the Complainant from reflecting its BLACKROCK marks in a domain name in violation of paragraph 4(b)(ii) of the Policy.

B. Respondent

As indicated previously, the Panel views the November 29, 2007 email message from the Respondent - which is all that the Respondent filed - as its Response. Through this message, the Respondent simply stated the purpose of its web site and its contention

that it purchased the disputed domain name in good faith. Specifically, that message stated in pertinent portions as follows:

“Blackrockfinancialservices.com was design to offer consumers in the USA auto loans, credit cards services, mortgages and personal loans along with personal services. ...

Please know that our domain name was purchased in good faith. They [Complainant] also claimed that we are using our web site to make commercial gains. Let me ask you -- what purpose would a web site serve if it was not designed to make commercial gains. The only web site I can think of not designed for commercial gains is the Red Cross because they are a not for profit organization. Please know that our company is designed to make a profit.”

6. Discussion and Findings

A. Identical or Confusingly Similar

The Panel finds that the disputed domain name is confusingly similar to the Complainant’s BLACKROCK marks.

From a simple comparison of the name to the marks, no doubt exists that the disputed domain name is, for all practical purposes, confusingly similar to the BLACKROCK marks. The only differences between the name and the mark BLACKROCK are the addition, as a suffix, of the generic terms “financial services”, 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 a minor variation, such as adding short letter or number groups or even generic 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, adding the generic words “financial services” to the mark BLACKROCK is clearly one such minor variation. See, e.g., *F. Hoffmann-La Roche AG v. Transliner Consultants*, WIPO Case No. D2007-1359 (November 14, 2007); *National Football League v. Peter Blucher d/b/a BluTech Tickets*, WIPO Case No. D2007-1064 (September 24, 2007); *Toilets.com, Inc. v. Rons Porta Johns*, WIPO Case No. D2007-0952 (August 27, 2007); *Associated Bank Corp. v. Texas International Property Associates*, WIPO Case No. D2007-0334 (June 28, 2007); *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); *Lane-Labs USA, Inc. v. Powell Productions*, NAF Case

No. FA 155896 (July 1, 2003); and particularly *Cable News Network LP, LLP v. Elie Khouri d/b/a Channel News Network et al.*, NAF Case No. FA 117876 (December 16, 2002).

Further, such confusion, should it occur, would undoubtedly cause Internet users intending to access the Complainant's web site, but who were to reach the Respondent's site instead, to think that an affiliation of some sort exists between the Complainant and the Respondent, when, in fact, no such relationship would exist at all. See, e.g., *Google Inc. v. Jennifer Burns*, NAF Case No. FA 726096 (August 16, 2006); *Cheesecake Factory, Napster, Caesars Entertainment, Lockheed v. Skunkworx*, and *Lockheed v. Teramani*, all cited *supra*; see also *Register.com, Inc. v. Reile*, NAF Case No. FA 208576 (January 27, 2004); *Caesars World, Inc. and Park Place Entertainment Corp. 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); *American Family Life Assurance Company of Columbus v. defaultdata.com aka Brian Wick*, NAF Case No. FA 123896 (October 14, 2002); *AT&T Corp. v. Abreu*, WIPO Case No. D2002-0605 (Sept. 11, 2002); *L.F.P., Inc. v. B and J Properties*, NAF Case No. FA 109697 (May 30, 2002); *Peter Frampton v. Frampton Enterprises, Inc.*, WIPO Case No. D2002-0141 (April 17, 2002); *Spence-Chapin Services to Families and Children v. Stanley Wynman*, NAF Case No. FA 100492 (December 10, 2001); *Meijer, Inc. v. Porksandwich Web Services*, NAF Case No. FA 97186 (July 6, 2001); *MPL Communications, Limited et al v. IWebAddress.com*, NAF Case No. FA 97092 (June 4, 2001); *American Home Products Corporation v. Malgioglio*, WIPO Case No. D2000-1602 (February 19, 2001); *Surface Protection Industries, Inc. v. The Webposters a/k/a Mark's Paint Store, Inc.*, WIPO Case No. D2000-1613 (February 5, 2001); *Dollar Financial Group, Inc. v. VQM NET*, NAF Case No. FA 96101 (January 25, 2001); *eBAY Inc. v. G L Liadis Computing, Ltd. and John L. Liadis d/b/a G L Liadis Computing Ltd.*, WIPO Case No. D2000-1463 (January 10, 2001); *Treeforms, Inc. v. Cayne Industrial Sales Corp.*, NAF Case No. FA 95856 (December 18, 2000); *Pep Boys Manny, Moe and Jack of CA v. E-Commerce Today, Ltd.*, e Resolution Case No. AF-0145 (May 3, 2000).

Furthermore, by including the terms "financial services" with the Complainant's mark BLACKROCK to form the disputed domain name, the potential for user confusion is likely to be exacerbated, not reduced. The services which the Complainant offers through its mark are financial services. Hence, some Internet users who seek information on the Complainant's services are quite likely, given current naming conventions on the Internet used in forming domain names, to enter, as a domain name, the Complainant's mark BLACKROCK immediately followed by the general services of interest, here being "financial services", and concluding with ".com" as a widely used gTLD for web site associated with commercial organizations, thus yielding the disputed domain name. Rather than reaching the Complainant's web site, as expected from entry of that name into a browser, each of those users would instead be directed to the Respondent's web site through which that user would be offered various consumer-based financial services. Hence, those users would likely be deceived into thinking that the Respondent's site and the services offered there through were somehow affiliated, related to or sponsored by the Complainant - when, in fact, they are not. Thus, the Panel finds that that the disputed domain name here, which contains the terms "financial services", tends to aggravate, rather than ameliorate, user confusion - and that is very likely the reason why the Respondent chose it.

Therefore, the Panel finds that the disputed domain name <blackrockfinancialservices.com> is confusingly similar to the Complainant's

BLACKROCK marks as to cause confusion; hence, the Complainant has satisfied its burden under paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

Based on the evidence, including Respondent's brief e-mail Response, the Panel infers that no basis exists that, under the circumstances here, would legitimize a claim to the disputed domain name under paragraph 4(c) of the Policy.

The Complainant has never authorized the Respondent to utilize its mark BLACKROCK or any mark confusingly similar thereto in conjunction with the services with which the Complainant uses that 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 BLACKROCK or one confusingly similar thereto in connection with the identical or similar services to those currently provided by the Complainant would violate the exclusive trademark rights now residing with the Complainant. See, e.g., *F. Hoffmann-La Roche AG, National Football League, Toilets.com, Inc.*, and *Associated Bank*, all cited *supra*; *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 BLACKROCK or one similar thereto, at least for the services rendered by the Complainant, or, broadly speaking, any service likely perceived by its users to be so similar and/or to emanate from the Complainant.

Further, there is absolutely no evidence of record that the Respondent has ever been commonly known by the disputed domain name. Nor could the Respondent in this case ever become so known, in light of the Complainant's exclusive trademark rights, dating back approximately 15 years prior to the date (March 23, 2007) on which the Respondent registered the name, without infringing on the exclusive trademark rights of the Complainant. See, *Treeforms, Inc.*, cited *supra*.

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

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

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

C. 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.

The Panel believes that the Respondent was well aware of the Complainant and its mark BLACKROCK when the Respondent registered the disputed domain name. Yet, in spite of that knowledge, the Respondent intentionally chose and registered the name to opportunistically exploit its potential to generate user confusion for the Respondent's eventual pecuniary benefit.

In essence, by attracting Internet users to its web site under false pretenses, i.e., through the expectation that the Respondent's site was a source for financial services either provided by the Complainant or in some fashion related to, sponsored by or affiliated with the Complainant, when in fact it was neither and could not be, the Respondent then proceeded to solicit sales of its own consumer-related financial services from those users, through which the Respondent admittedly would receive financial gain. Moreover, the visual similarities between both the Respondent's and the Complainant's respective web sites only add further support for the Panel's finding that the Respondent's goal was to deceive those users and ultimately profit from that deception.

Consequently, the Respondent's web site very likely received increased visitor traffic and the Respondent itself received enhanced financial revenue, than it otherwise would have, had it used a different domain name totally dissimilar to any of the Complainant's BLACKROCK marks.

Hence, the Panel concludes 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 provided sufficient proof of its allegations, with respect to the disputed domain name, to establish a 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 grants the relief sought by the Complainant.

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

Peter L. Michaelson
Sole Panelist

Dated: January 4, 2008