



NATIONAL ARBITRATION FORUM

DECISION

Combined Insurance Group Ltd v. Xedoc Holding SA c/o domain admin
Claim Number: FA0905001261545

PARTIES

Complainant is **Combined Insurance Group Ltd** (“Complainant”), represented by **Philip J. Foret**, of **Dilworth Paxson LLP**, Pennsylvania, USA. Respondent is **Xedoc Holding SA c/o domain admin** (“Respondent”), represented by **Paul Raynor Keating**, Spain.

REGISTRAR AND DISPUTED DOMAIN NAME

The domain name at issue is <**cheapautoinsurance.com**>, registered with **Fabulous.com Pty Ltd**.

PANEL

The undersigned certifies that the panel has acted independently and impartially and to the best of his knowledge have no known conflict in serving as Panelists in this proceeding.

Daniel B. Banks, Jr.
Professor David E. Sorkin
Peter L. Michaelson, as Panelists.

PROCEDURAL HISTORY

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

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

On May 13, 2009, a Notification of Complaint and Commencement of Administrative Proceeding (the “Commencement Notification”), setting a deadline of June 2, 2009 by which Respondent could file a Response to the Complaint, was transmitted to Respondent via e-mail, post and fax, to all entities and persons listed on Respondent’s registration as technical, administrative and billing contacts, and to postmaster@cheapautoinsurance.com by e-mail.

Respondent's Response was received in hard copy on June 2, 2009. However, in that the hard copy was received subsequent to the Response deadline, the Response is considered deficient under ICANN Rule 5.

A timely additional submission was submitted by Complainant on June 9, 2009 and was considered by the Panel. Respondent filed a Response to Complainant's Supplemental Filing which was deemed deficient as not timely filed. Respondent then filed an Amended Response to Complainant's Supplemental Filing which is not provided for in the Rules. Since neither filing by Respondent affected the decision of the Panel, they were not considered.

On June 10, 2009, pursuant to Complainant's request to have the dispute decided by a three-member Panel, the National Arbitration Forum appointed Professor David E. Sorkin, Peter L. Michaelson and Daniel B. Banks, Jr., as Panelists.

RELIEF SOUGHT

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

PARTIES' CONTENTIONS

A. Complainant

Since 1993, Complainant has used and continues to use its CHEAP AUTO INSURANCE mark in connection with identifying, promoting and providing insurance services. The mark has accrued substantial goodwill through its use in commerce and Complainant has invested substantial financial and other resources in developing, protecting and using its brand and mark in connection with its auto insurance business.

Complainant has continuously used its CHEAP AUTO INSURANCE mark or derivatives thereof in conjunction with its Internet website <cheap-auto-insurance.com> since 1996. The website provides users the ability to access pages relating to Complainant's insurance services for each of the 50 United States as well as the District of Columbia.

Complainant owns a Pennsylvania registration for the CHEAP AUTO INSURANCE mark for insurance and financial services which was issued on July 13, 1998.

Complainant also owns other Pennsylvania registrations for the marks CHEAP AUTO INSURANCE NETWORK and CHEAP AUTO INSURANCE SOLUTIONS for insurance and financial services. Those were also issued on July 13, 1998.

On February 17, 2009, Complainant obtained a U.S. service mark registration for the CHEAP AUTO INSURANCE mark which covers insurance services. Complainant owns all of the substantial goodwill in the mark associated with Complainant's widespread and continuous use of the mark for greater than 16 years. Complainant claims substantial common law rights in the mark through its use to identify and promote Complainant's business.

Respondent's <**cheapautoinsurance.com**> domain name, which was registered on September 10, 1998, provides a business advertising website for the auto insurance industry. It also provides information and links to contacts for insurance brokerages, agents, and insurance carriers and provides insurance quotes for insurance carriers in Pennsylvania. The website also displays Complainant's trademark throughout all of the pages of the website.

Respondent only recently launched the offending website in 2009 after years of keeping the domain name inactive or parked or using it to post a single page with a "For Sale" sign.

Complainant contends that the disputed domain name is identical or confusingly similar to a trademark/service mark in which Complainant has rights and in which the Respondent should be considered as having no rights. Respondent's adoption of Complainant's mark is cybersquatting and is conclusory evidence that Respondent lacks rights or legitimate interests in the disputed domain name. Also, none of the three protections for domain name registrants provided in Policy 4(c)(i)-(iii), including that Respondent is making a *bona fide* offering of goods or services, is commonly known by the domain name, and is making a legitimate noncommercial or fair use of the domain name are available to the Respondent.

Respondent's use of the disputed domain name is to operate a website that competes directly with Complainant. It is not a *bona fide* offering of goods or services under the Policy. Respondent is not commonly known as <**cheapautoinsurance.com**> and is not authorized by Complainant to use the mark. Respondent is obtaining commercial gain by diverting consumers to its website which contains a search function for auto insurance information and links to insurance agents. It can be inferred that Respondent is receiving pay-per-click fees from advertisers when users follow the links on the site.

The disputed domain name should be considered as having been registered and used in bad faith. Respondent offered the name for sale to the general public at the site. It was maintained as an inactive domain name and passively held by Respondent. Respondent is cybersquatting by adopting a domain name essentially identical and confusingly similar to Complainant's mark.

B. Respondent

Complainant's claim of a USPTO registered mark provides only *prima facie* evidence of trademark rights. A State registered mark is not even *prima facie* evidence and requires proof of common law trademark rights. That requires presentation of evidence of both use and secondary meaning.

Complainant's own use does not indicate trademark use. The <cheap-auto-insurance.com> site is merely a parking site. All of the services described on the website were provided by third parties. The telephone numbers listed are associated with third party insurance brokers. The links merely redirected users to various third parties. In short, Complainant does not use the mark to provide services. Rather, Complainant uses

its site to merely direct traffic to third parties who perform all of the services. Also, Complainant uses the term “cheap auto insurance” descriptively.

Complainant’s federal registration was based on an Intent to Use application, meaning that Complainant did not claim actual use as of 2006. Following 3 denials, registration was obtained on February 17, 2009 only under Section 2(f). Registration under that section requires only a *prima facie* showing that the mark has been used on a substantially exclusive and continuous basis for the 5 preceding years. USPTO registration creates a *prima facie* presumption that Complainant has satisfied Policy 4(a)(i) which will only succeed if uncontested. If the Respondent puts forward a plausible case contradicting the *prima facie* argument, the panel must decide the issue on the basis of all of the evidence with the Complainant carrying the ultimate burden of proof. By applying under Section 2(f), Complainant admitted that its mark was descriptive. Moreover, Complainant was obligated to disclaim the phrase “auto insurance” apart from the mark. The remaining term “cheap” is merely laudatory and itself incapable of adding registration significance. The evidence is overwhelming that the mark is merely descriptive. Google lists over 32 million web pages using the phrase “cheap auto insurance.”

Complainant provides no evidence of any use of the mark prior to 1999. Until 2006, the use was limited to the <cheap-auto-insurance.com> domain name – which is a simple internet address and not a trademark use. In fact, from 2003-2005, Complainant’s site did not use the term at all. Rather it used “Insure Direct” and “Combined Insurance Group.”

Complainant’s Pennsylvania registration does not satisfy the Policy nor has the Complainant shown common law rights. Common law rights require proof of secondary meaning at the time and place that the infringing use began. The name and business must have become synonymous in the mind of the public. To show secondary meaning, there must be evidence of sales, advertising expenditure and public recognition of the mark. Bald assertions are not sufficient. No evidence of publicity is shown. The only evidence of any promotional activities consists of three classified listings, the first being in the “New Castle Shopper’s Guide” in 1999; the second in an undated listing in the National Inquirer; and the third being a 2007 listing in the yellow pages under Insurance. None of these show trademark use.

Respondent has a right or legitimate interest in the domain name. The burden is on the Complainant to establish its claim – it is not for the Respondent to prove the contrary. Respondent is not required to show a superior right, only that it has “a” legitimate right or interest. Respondent has shown legitimate rights or interests. Respondent has registered and used the disputed domain name in a manner directly related to its descriptive meaning. Respondent did not target Complainant. It did not even know Complainant or the mark existed prior to receipt of the complaint.

Complainant waited over 16 years from its claimed first use to file this complaint. Xedoc has openly used the domain name and has spent valuable time and resources developing

affiliate relationships for use in connection with the domain name and in acquiring numerous other insurance related domain names. Complainant is charged with policing its own asserted marks and thus knew or should have known of the existence of the domain name.

Complainant is a practiced domainer and actively registers domain names for use in PPC, holding approximately 236 other insurance related domain names that are either parked as PPC pages or used to drive traffic to its PPC sites.

Respondent did not register the domain name primarily to disrupt a Competitor nor to divert traffic from Complainant. It was registered because of its inherently descriptive nature and has been used in connection with the obvious and widely used meaning of the phrase.

There is no evidence of bad faith. Mere assertions of bad faith are not sufficient. Any *prima facie* presumption of bad faith vanishes upon Respondent's presentation of a plausible reason for registration. The disputed domain name was registered prior to any trademark; the phrase is inherently descriptive; the three words are generic and are commonly used to describe low-cost insurance; there is wide-spread public use as a descriptive term; Complainant uses the term descriptively; and, Complainant waited over 16 years to assert any claim.

A prior offer of sale is not bad faith. An inactive domain can be evidence of bad faith but only in the absence of any other factors showing actual use or preparations for use. Xedoc's actual use is shown by actual images of the site being used in a manner consistent with its descriptive meaning.

In conclusion, Complainant has no trademark sufficient for the Policy and even if it did, Xedoc has a legitimate interest and neither registered nor used the domain name in bad faith.

Respondent claims Complainant has engaged in Reverse Domain Name Hijacking. Complainant has acted in bad faith. It has not shown an absence of legitimate interest and bad faith registration and use by Respondent.

C. Additional Submissions

Complainant submitted a timely Additional Submission which was considered by the Panel. Respondent submitted an Additional Submission which was received in hard copy subsequent to the Response deadline and was considered by the Forum not to be in compliance with ICANN Rule 5. Respondent also submitted an Amended Additional Submission for which there is no provision in the Rules. Because neither of Respondent's Additional Submissions affected the decision of the panel, they were not considered.

Complainant's Additional Submission states that Complainant is a full service national insurance agency holding licenses in 46 states and having written nearly \$300 million

dollars in policy premiums since 1993. Complainant claims a vested interest in protecting its valuable brand and registered service mark. It says that Respondent ignores Complainant's common-law and federal rights in the mark.

Complainant says it has satisfied the elements of the Policy by showing the mark to be confusingly similar to its trademarks; that Respondent has no rights or legitimate interest in the disputed domain name; and that the disputed domain name was registered in bad faith.

Complainant also says that Respondent's claim of Reverse Domain Name Hijacking is an attempt to divert the attention of the panel away from the considerations under ICANN Rules and Policy.

With respect to Respondent claim of laches, Complainant says that ICANN Rules and Policies do not apply to the Doctrine of Laches.

Although much of the material in Complainant's Additional Submission merely reiterates arguments made in Complainant's initial submission, the Panel has considered the Additional Submission to the extent that it addresses matters that could not reasonably have been included in the prior submission.

FINDINGS

The first finding of this Panel relates to the voluminous submissions in this case. The physical weight of the submissions exceeds 26 pounds! The supplemental filings basically duplicated and amplified prior arguments, and in so doing provided little real value to us. Counsel could have and should have been far more succinct and direct than they were. *See WWF-World Wide Fund for Nature v. Moniker Online Services LLC*, D2006-0975 (WIPO Nov. 1, 2006) (noting that submission of an "overkill" of documentation is oppressive for the provider and the panel, and suggesting that voluminous submissions by a complainant may be indicative that the dispute is not susceptible to adjudication under the Policy).

The Panel having reached a unanimous decision that Complainant is not entitled to the relief requested, only those findings relevant to the Decision will be discussed.

The Panel finds that this case distills to a rather simple analysis. Complainant states that it has a registered trademark and common law rights in the mark CHEAP AUTO INSURANCE. The registered trademark was registered based on Section 2(f) which presumes distinctiveness after 5 years of continuous use.

Respondent is using the disputed domain name, which is identical to the mark of Complainant, as an address of a website that provides auto insurance through carriers which compete with Complainant. Use of the domain name in this fashion apparently began well before Complainant became aware of the Respondent's website in 2009. The Panel finds that the Respondent is using the words that form the name in their commonly understood meaning in connection with services it offers through its website, i.e. "cheap

auto insurance” meaning relatively inexpensive auto insurance as compared to other sources. The words are not being used in a trademark sense but rather in their commonly understood descriptive sense. Such use is not designed to trade off the good will and reputation of anyone else.

The Panel finds that paragraph 4(c)(i) of the policy applies in that Respondent was making a *bona fide* offering of services prior to the date when Respondent became aware of the dispute. Therefore, the Panel finds that Respondent has rights and legitimate interests in the name.

Since the Complainant has not established a lack of rights and legitimate interests in the Respondent, it has failed to establish each of the three elements of the Policy as required. Therefore, the Panel does not need to consider the other elements.

The Panel also finds that there is no Reverse Domain Name Hijacking.

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.

Rights or Legitimate Interests

The Panel finds that Complainant has not established a *prima facie* case in support of its arguments that Respondent lacks rights and legitimate interests under Policy ¶ 4(a)(ii). See *Terminal Supply, Inc. v. HI-LINE ELECTRIC*, FA 746752 (Nat. Arb. Forum Aug. 24, 2006) (holding that the complainant did not satisfactorily meet its burden and as a result found that the respondent had rights and legitimate interests in the domain name under UDRP ¶ 4(a)(ii)); see also *Workshop Way, Inc. v. Harnage*, FA 739879 (Nat. Arb. Forum Aug. 9, 2006) (finding that the respondent overcame the complainant’s burden by showing it was making a *bona fide* offering of goods or services at the disputed domain name).

Respondent asserts that its website content relates to the descriptive phrase that comprises the <**cheapautoinsurance.com**> domain name. Respondent further asserts that its use of

the disputed domain name for a pay-per-click site is a *bona fide* offering of goods and services. The Panel agrees and finds that Respondent has used the disputed domain name in connection with a *bona fide* offering of goods or services pursuant to Policy ¶ 4(c)(i) or a legitimate fair use pursuant to Policy ¶ 4(c)(iii). *See Eastbay Corp. v. VerandaGlobal.com, Inc.*, FA 105983 (Nat. Arb. Forum May 20, 2002) (finding that the respondent's use of the disputed domain name, which was comprised of generic terms, as a portal to a commercial website featuring various advertisements and links constituted a *bona fide* offering of goods or services pursuant to Policy ¶ 4(c)(i)); *see also Advanced Drivers Educ. Prods. & Training, Inc. v. MDNH, Inc.*, FA 567039 (Nat. Arb. Forum Nov. 10, 2005) (finding that the disputed domain name was not used in the trademark sense, but was "a descriptor of the site's intended content or theme," and therefore that complainant failed to prove that Respondent lacked any rights or legitimate interests in the disputed domain name). The Panel recognizes that Complainant may have a tenable trademark claim against Respondent based upon Respondent's use of the disputed domain name, notwithstanding Respondent's intention to use the term in its descriptive sense; but at most this is a legitimate trademark dispute not susceptible to adjudication under the Policy. *See Vail Corp. v. Resort Destination Marketing*, FA 1106470 (Nat. Arb. Forum Jan. 2, 2008).

Reverse Domain Name Hijacking

Although the Panel has found that the Complainant has failed to satisfy its burden under the Policy, the Panel does not conclude that the Complainant acted in bad faith in bringing its Complaint. Hence, the Panel rejects Respondent's request to find Reverse Domain Name Hijacking. *See ECG European City Guide v. Woodell*, FA 183897 (Nat. Arb. Forum Oct. 14, 2003) ("Although the Panel has found that Complainant failed to satisfy its burden under the Policy, the Panel cannot conclude on that basis alone, that Complainant acted in bad faith).

DECISION

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

Daniel B. Banks, Jr., Panel Chair
Professor David E. Sorkin, Panelist
Peter L. Michaelson, Panelist

Dated: June 26, 2009

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