



WIPO Arbitration and Mediation Center

ADMINISTRATIVE PANEL DECISION

**Blue Cross and Blue Shield Association and Trigon Insurance Company, Inc.
d/b/a Trigon Blue Cross Blue Shield v. InterActive Communications, Inc.**

Case No. D2000-0788

1. The Parties

Complainants:

Blue Cross and Blue Shield Association ("BCBSA")
225 North Michigan Avenue
Chicago, Illinois 60601-7680
United States of America

and

Trigon Insurance Company, Inc. ("Trigon Insurance")
d/b/a Trigon Blue Cross Blue Shield
2015 Staples Mill Road
Richmond, Virginia 23230
United States of America

Respondent:

InterActive Communications, Inc.
11903 Lafayette Drive
Silver Spring, Maryland 20902
United States of America

The record reflects several other addresses for the Respondent, apart from that listed above. Those addresses are as follows:

InterActive Communications
118903 Lafayette Drive
Silver Spring, Maryland 20902
United States of America

InterActive Communications, Inc.
1633 Belvedere Blvd.
Silver Spring, Maryland 20902
United States of America

Gregg Ervin
Financial Web
15879 Crabs Branch Way
Rockville, Maryland 20855
United States of America

Mr. Gregg Ervin
11903 Lafayette
Wheaton, Maryland 20902
United States of America

The Panel will assume that one or more of these addresses for the Respondent is correct.

2. The Domain Name(s) and Registrar(s)

Contested Domain Name: trigonbluecrossblueshield.com

Registrar:
Internet Domain Registrars a/k/a Registrars.com
475 Sansome Street, Suite 1730
San Francisco, California 94411
United States of America

3. Procedural History

The Complaint was brought pursuant to the Uniform Domain Name Dispute Resolution Policy ("Policy"), available at <<http://www.icann.org/udrp/udrp-policy-24oct99.htm>>, which was adopted by the Internet Corporation for Assigned Names and Numbers (ICANN) on August 26, 1999, and approved on October 24, 1999, and in accordance with the ICANN Rules for Uniform Domain Name Dispute Resolution Policy ("Rules") as approved on October 24, 1999, as supplemented by the World Intellectual Property Organization (WIPO) Supplemental Rules for Uniform Domain Name Dispute Resolution Policy in effect as of December 1, 1999 (the "Supplemental Rules").

The Complaint was filed by e-mail form on July 14, 2000 and in hard-copy form, with Annexes 1-5, on July 17, 2000 with the WIPO Arbitration and Mediation Center (the "Center") . The Center acknowledged timely receipt of the appropriate payment from the Complainants.

In the Complaint, the Complainants state that on July 13, 2000, their attorneys served a copy of the Complaint, by fax and e-mail, on the Respondent and provided a copy of the Complaint, by e-mail and fax, to the Registrar, Registrars.com.

The Center acknowledged receipt of the Complaint by e-mail dated July 18, 2000 to both the Complainants and the Respondent.

Pursuant to paragraph 4(d) of the Policy, the Complainants selected the Center as the ICANN-approved administrative dispute resolution service provider to administer this

proceeding. Through the Complaint, the Complainants requested a single member panel.

After receiving the complaint, the Center, in accordance with paragraph 5 of the Supplemental Rules, determined that the Complaint fully complied with the formal requirements of the Rules and the Supplemental Rules. In that regard, on July 18, 2000, the Center requested confirmation from Registrars.com of information set forth in the Complaint relative to the domain name; specifically, contact and registrant information for the contested domain name, as well as whether Registrars.com received a copy of the Complaint from the Complainant. The Center also requested Registrars.com to specify: whether the Policy applies to the contested domain name, and the current status of the domain name. On July 19, 2000, Registrars.com provided its response to the Center through which it provided contact information pertinent to the contested domain name from its WHOIS database, confirmed that it is the registrar of the contested domain name, and stated that the contested domain name was then under a "registrar-hold" status pending arbitration. The Registrar did not specify whether the Policy was in effect for this particular domain name. Inasmuch as the registration date of the contested domain name, i.e. January 3, 2000, is subsequent to the effective date of the Policy, i.e., October 24, 1999, the Panel reasonably infers that the contested domain name is governed by the Policy.

On July 21, 2000, the Center notified the Respondent of the filing of the Complaint, including providing a complete copy of the Complaint, with an explanatory cover sheet, to the Respondent, by e-mail, facsimile and in hardcopy form by courier (the latter including a copy of the Annexes supplied by the Complainants). The Complaint, and its accompanying documents, and all subsequent communications associated therewith were provided in the preferred manners and transmitted to the addresses as mandated by paragraphs 2(a) and 4(a) of the Rules. In that regard, as reflected by delivery confirmation reports provided by the Center, six separate attempts were made by the Center to send the Complaint and its associated materials by facsimile to the single facsimile number associated with the Respondent as noted in the Complaint and in the confirmation information provided by the Registrar. Only one of these attempts appears to have been partially successful; the others apparently failed. The Center also transmitted identical, hard-copy versions by courier (Express Mail Service available through Swiss Post), with a separate shipment having been sent to each of the five different addresses noted above for the Respondent. Based on delivery reports provided by the Center, all the courier shipments were apparently delivered to the Respondent.

Hence, with the notification to the Respondent having occurred on July 21, 2000, under paragraph 4(c) of the ICANN Policy, this administrative proceeding is deemed to have commenced on July 21, 2000.

Having reviewed the Complaint, its handling and the succeeding correspondence between the Center and the Registrar in detail, 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, including furnishing the Respondent with proper and adequate notice of the Complaint.

The Respondent was then provided with a 20 calendar day period, expiring on August 9, 2000, to file its response with the Center and serve a copy of the response on the Respondent.

As of August 15, 2000, the Center has received no such response from the Respondent. Hence, on that date, the Center so notified the Complainants by e-mail, and the Respondent, by both e-mail and facsimile, that the administrative proceeding would proceed by way of default.

Accordingly, pursuant to the Rules and Supplemental Rules, on August 14, 2000, the Center contacted the undersigned requesting his service as a sole panelist to consider and decide this dispute. On August 15, 2000, the undersigned accepted and returned, by facsimile to the Center, a fully executed Statement of Acceptance and Declaration of Impartiality and Independence. On August 16, 2000, the Center appointed the undersigned as the sole panelist to consider this dispute, and so notified both parties by e-mail. Based on deadline set forth in paragraph 15 of the Rules, a decision is to be issued by the undersigned to the Center on or before August 30, 2000.

This dispute concerns one domain name alone, specifically "trigonbluecrossblueshield.com". The language of this proceeding is English.

4. Factual Background

Inasmuch as the Respondent, InterActive Communications, Inc., has failed to respond to the Complaint, all the facts alleged by the Complainants, BCBSA and Trigon Insurance, will be accepted as true. For convenience of the reader, factual allegations, to the extent needed, from the Complaint are reproduced below.

Complainant BCBSA owns 159 currently valid and subsisting U.S. federal trademark and service mark registrations, 133 of which are for word marks containing either or both of the terms "BLUE CROSS" or "BLUE SHIELD", various design marks, and a family of trade names, trademarks and service marks that contain the term "Blue" (hereinafter simply the "Blue Marks"). Many of the 159 registrations have become incontestable under Section 15 of the Lanham Act.

Trigon Insurance owns a number of federal trademark and service mark registrations for marks that incorporate the term "Trigon" ("Trigon Marks").

The dispute is based on the 159 active US registered marks currently owned by BCBSA and various active registered trademarks currently owned by Trigon Insurance.

Of those marks, the Complainants have submitted, in Annex 3 to the Complaint, ten representative United States trade/service mark registrations, all of which have become incontestable under § 15 of the Lanham Act (15 USC § 1065), to BCBSA and, also in Annex 3 to the Complaint, six representative trade/service mark registrations to Trigon Insurance, all summarized as follows:

A. representative BCBSA marks

1) BLUE-CROSS (block letters)

US registration 554,488 issued February 5, 1952

This service mark was registered for use in connection with: "Distribution of hospital care on a pre-payment financing basis", in international class 36.

This mark claims first use and first use in inter-state commerce on December 31, 1934.

2) Blue Cross Plan (stylized)

US registration 554,492 issued February 5, 1952

This service mark was registered for use in connection with: "Distribution of hospital care on a pre-payment financing basis" in international class 36. This mark claims first use and first use in inter-state commerce on December 31, 1934.

3) Cross pattern (lined for the color blue)

US registration 554,817 issued February 12, 1952

This service mark was registered for use in connection with: "Distribution of hospital care on a pre-payment financing basis" in international class 36. This mark claims first use and first use in inter-state commerce on December 31, 1934.

4) BLUE CROSS (block letters)

US registration 1,293,244 issued September 4, 1984

This service mark was registered for use in connection with: "Prepaid Financing and administration of dental and related health care services" in international class 36. This mark claims first use and first use in inter-state commerce on December 31, 1968.

5) BLUE CROSS (block letters)

US registration 1,420,888 issued December 16, 1986

This trademark was registered for use in connection with: "AM/FM stereo receivers with headphones, cassette tape players with headphones, calculators and thermometers", all in international class 9. This mark claims first use and first use in inter-state commerce on July 3, 1984.

6) BLUE SHIELD (block letters)

US registration 557,037 issued April 1, 1952

This collective service mark was registered for use in connection with: "Furnishing medical care on a pre-payment basis", in international class 42. This mark claims first use on September 23, 1939 and in inter-state commerce on April 30, 1940.

7) BLUE SHIELD (block letters)

US registration 557,040 issued April 1, 1952

This collective service mark was registered for use in connection with: "Underwriting the expense of medical care", in international class 36. This mark claims first use on September 23, 1939 and first use in inter-state commerce on April 30, 1940.

- 8) shield pattern (lined for the color blue)

US registration 562,430 issued July 29, 1952

This service mark was registered for use in connection with: "Underwriting, on a pre-payment basis, the expense to the patient of medical care and underwriting the doctor's expense in furnishing medical care", all in international class 36. This mark claims first use and first use in inter-state commerce on September 5, 1949.

- 9) BLUE SHIELD (block letters)

US registration 1,319,824 issued February 12, 1985

This collective service mark was registered for use in connection with: "Prepaid financing and administration of dental and related health care services", in international class 36. This mark claims first use and first use in inter-state commerce on June 1, 1969.

- 10) BLUE SHIELD (block letters)

US registration 1,420,889 issued December 16, 1986

This trademark was registered for use in connection with: "AM/FM stereo receivers with headphones, cassette tape players with headphones, calculators", all in international class 9. This mark claims first use and first use in inter-state commerce on July 3, 1984.

- B) representative Trigon Insurance marks

- 1) TRIGON (block letters)

US registration 1,890,672 issued April 18, 1995

This service mark was registered for use in connection with: "Health and life insurance underwriting services; administration of health insurance claims for others; services associated with health insurance claims processing system and health claims data analysis; administration of self-insured workers compensation programs; and financial investment in the field of securities and mutual fund services", all in international class 36. This mark claims first use on June 30, 1994 and first use in inter-state commerce on July 1, 1994.

- 2) TRIGON (block letters)

US registration 1,894,605 issued May 16, 1995

This trademark was registered for use in connection with: "Newsletter dealing with health", in international class 16. This mark claims first use and first use in inter-state commerce on September 30, 1994.

3) TRIGON (block letters)

US registration 2,005,350 issued October 1, 1996

This service mark was registered for use in connection with:

"Market research services; health care cost and utilization review services; cost containment programs relating to prescription drug insurance benefits", all in international class 35; and

"Consulting services for businesses concerning pre-mature birth and pre-natal care for employees; behavioral risk rating health screening services and providing custom employee health and wellness programs; providing counseling services for employees and their families regarding physical, psychological, family and related matters; and health care services, namely, evaluating health risk factors and promoting public awareness in the field of health care; health care offered through health maintenance organizations", all in international class 42.

This mark claims first use and first use in inter-state commerce for the services in classes 35 on August 1, 1994, and for the services in class 42 on October 1, 1994.

4) TRIGON ONLINE (block letters)

US registration 2,090,876 issued August 26, 1997

This service mark was registered for use in connection with: "Providing information regarding health insurance via an on-line global computer network", in international class 36. This mark claims first use and first use in inter-state commerce on May 16, 1996.

5) TRIGON PROFESSIONAL FORUM (block letters)

US registration 2,332,056 issued March 21, 2000

This trademark was registered for use in connection with: "Newsletter for healthcare providers about the managed care industry", in international class 16. This mark claims first use and first use in inter-state commerce on October 1, 1997.

6) TRIGON PROFESSIONAL FORUM ONLINE (block letters)

US registration 2,335,392 issued March 28, 2000

This service mark was registered for use in connection with:

"Disseminating information about the managed care industry to health care providers on a global computer network", in international class 42. This mark claims first use and first use in inter-state commerce on September 14, 1998.

As discussed below, the Panel finds that, for all intents and purposes, the various representative word mark (block letter) registrations for the marks "TRIGON", "BLUE CROSS" and "BLUE SHIELD", when concatenated, are identical to the formative in the contested domain name, namely "trigonbluecrossblueshield", and as such provide an adequate basis for the findings herein. Inasmuch as each of the other representative marks owned by Complainants BCBSA and Trigon Insurance differs from a portion of the contested domain name, the Panel finds each of those latter marks to be of lessened importance and hence unnecessary to address the issues raised by the Complainants. Hence, for the sake of simplicity, the Panel will simply ignore each of these other marks. Consequently, all references hereinafter to the Complainants' "marks" will simply and collectively refer to their word mark registrations.

Complainant BCBSA is an association of 47 independently operated, local Blue Cross and Blue Shield member plans, which are licensed by BCBSA to provide prepaid healthcare and health insurance services. BCBSA and its independent member plans render services under the Blue Marks. BCBSA and its predecessors in interest and/or its licensees have been using certain of the Blue Marks since 1938; the earliest incontestable BCBSA United States service mark registration was issued in 1952.

Further, Complainant BCBSA has extensively used, advertised and promoted the Blue Marks throughout the United States in connection with an affiliation involving BCBSA, its Member Plans and licensees, and their services. In that regard, BCBSA has expended many millions of dollars in establishing this affiliation so that the general public recognizes the Blue Marks as identifying BCBSA, its Member Plans and licensees, and the services these plans render.

Well prior to the Respondent committing any acts which are the subject of this dispute, and by virtue of the Complainant BCBSA's widespread use, promotion and recognition of the Blue Marks, these marks, by virtue of the goodwill they have achieved over time and to the extent that they represent BCBSA, its Member Plans and their services, have become "famous". In that regard, the Panel takes note of §§ 43(c)(1), (c)(2) and (d)(1)(A)(II), and 45 of the Lanham Act (15 U.S.C. §§1125(c)(1), (c)(2), (d)(1)(A)(II) and 1127) which, in whole or part, are directed to "famous" marks.

Since July 1994, Trigon Insurance and its predecessor, Blue Cross and Blue Shield of Virginia, have been doing business as Trigon Blue Cross Blue Shield. Trigon Insurance is a Member Plan and licensee of Complainant BCBSA and is authorized to use the Blue Marks.

Trigon Insurance has also been using the domain name "trigon.com" since December 21, 1995. On or about May 8, 2000, Trigon Insurance registered the domain names "trigonbluecrossblueshield.net" and "trigonbluecrossblueshield.org".

On or about January 3, 2000, Respondent, through its administrative, technical and billing contact, Gregg Ervin, registered the domain name

"trigonbluecrossblueshield.com". The Respondent is not affiliated with BCBSA, Trigon Insurance, any other Member Plan or their services, nor is it licensed to use either the Blue Marks or the Trigon Marks.

On or about February 14, 2000, Mr. Gregg Ervin of the Respondent contacted, via an e-mail (a copy of which was supplied in Annex 4 to the Complaint), Mr. Tom Snead at Complainant Trigon Insurance, through which the Respondent attempted to sell the contested domain name to that Complainant. As of February 16, 2000, no web site then existed that resolved to the contested domain name as evidenced by a declaration of Mr. Rudy M. Reyes ("Reyes declaration"), a copy of which is supplied in Annex 5 to the Complaint.

Complainant BCBSA, through its attorney at the time, Mr. Rudolph Reyes, and specifically through a cease and desist letter dated February 18, 2000 (a copy of which has been submitted as part of the Reyes declaration), wrote the Respondent, specifically Mr. Ervin, to advise the latter that BCBSA is the owner of incontestable federal registrations for the marks, BLUE CROSS and BLUE SHIELD. Through this letter, BCBSA further informed Respondent that its use of the domain name "trigonbluecrossblueshield.com" was confusingly similar to the BLUE CROSS and BLUE SHIELD marks and that Respondent's use of that particular domain name was likely to cause confusion among the public as it implied that a relationship existed between Respondent and BCBSA and/or Trigon Insurance. Through this letter, BCBSA requested that Respondent discontinue its use of these marks and the domain name by March 1, 2000.

On or about February 23, 2000, Respondent wrote to BCBSA stating that it had purchased the domain name trigonbluecrossblueshield.com to provide, through a web site it intended to establish, "unbiased reviews of the products and services of Trigon," and that for US \$15,145, it would "assign" the registration to BCBSA. (See Keyes declaration)

On or about March 23, 2000, BCBSA offered to reimburse Respondent US \$70 for its registration fee for the contested domain name. Respondent countered that it had put "a lot of work into the site and that it had hoped to 'attract visitors' to the site by using the name 'trigonbluecrossblueshield.com,' but that it would consider BCBSA's offer of reimbursement for the registration fee". (See Keyes declaration)

On or about March 31, 2000, Respondent contacted BCBSA saying that having a less desirable or less known domain name than the contested domain name would increase the Respondent's marketing costs, whereas if Respondent continued to use "trigonbluecrossblueshield.com," its marketing costs would be reduced, since that domain name in and of itself would generate traffic to the Respondent's site.

Respondent informed BCBSA that the Respondent was willing to compromise, i.e. moderate its offer, but that \$70 was not enough, but for US \$2,000 the Respondent would relinquish the contested domain name to Complainant BCBSA. (See Keyes declaration)

On or about April 11, 2000, BCBSA rejected Respondent's demand of \$2,000 for the domain name "trigonbluecrossblueshield.com," and reiterated its offer to reimburse Respondent \$70 for his registration fee. Respondent rejected BCBSA's offer and informed BCBSA that BCBSA would have to bring suit against Respondent, and that it would cost more than \$2,000 to do so.

Thus far, the Respondent has not transferred the contested domain name to the Complainant.

As of the date of the Complaint, i.e. July 13, 2000, the Respondent has not established a web site or other on-line presence that resolved to the contested domain name.

5. Parties' Contentions

A. Complainants

The Complainants contend that:

- (a) the domain name in question is identical or confusingly similar, to their registered trademarks;
 - (b) the Respondent has no rights or legitimate interests in the domain name in contention; and
 - (c) the Respondent has registered and is using this domain name in bad faith.
- (a) similarity

As to similarity of the contested domain name to its registered trade/service marks, the Complainants have provided copies, as noted above, of their various US trade/service mark registrations.

In view of those registered marks, the Complainants contend that the contested domain name is confusingly similar to the marks of BCBSA and identical to the business name of Trigon Insurance.

- (b) illegitimate use

First, the Complainants state that the Respondent is not affiliated with, nor has it been licensed or permitted to use, BCBSA's or Trigon's Marks or any domain name incorporating those marks. Respondent has not registered nor used the contested domain name as a trademark, nor has it ever been known by the name "trigonbluecrossblueshield.com."

Furthermore, the Complainants contend that the Respondent's stated purpose in using the contested domain name, i.e. to allegedly provide "unbiased reviews of the products and services of Trigon", is merely a pretext to negotiate for its sale. In that regard, the Complainants note that the Respondent's allegations that it

spent \$15,145 to set up its Web site using said domain name are unsubstantiated. Second, the Complainants point to the e-mail contact sent by the Respondent to the Complainant, as discussed above, on February 23, 2000 and occurring less than six weeks after the Respondent registered the contested domain name, through which the Respondent initially offered to sell that domain name to Trigon Insurance, and also, point to the Respondent's actions, less than 10 days later, in having priced the sale of the contested domain name at \$15,145.

The Complainants further contend that even if the Respondent spent \$15,145 to set up a web site to provide "unbiased reviews of the products and services of Trigon," the Respondent may not use BCBSA's or Trigon's Marks to do so. Any such use would not be legitimate under the Policy. In that regard, the Complainants state that the Respondent, where it to use the Complainant's marks to market the Respondent's own services, would misleadingly divert consumers of the Complainants. Furthermore, the Complainants contend that the Respondent cannot use the Complainants' marks for its own commercial gain. Here, the Complainants point to the Respondent's own admission, whereby the Respondent specifically expressed an intention to reduce its own marketing costs through use of the Complainant's marks.

Hence, the Complainants conclude that the Respondent cannot claim any right to or legitimate interest in the domain name.

(c) bad faith

The Complainants contend that the Respondent registered the contested domain name primarily for the purpose of renting, selling or otherwise transferring the domain name registration to the Complainant or a competitor thereof for payment above and beyond the costs incurred by the Respondent in securing its domain name registration.

To support this contention, the Complainants point to:

- (i) the Respondent having offered the contested domain name for sale to Trigon Insurance less than six weeks after registering it, for \$15,145, an amount which exceeds any out-of-pocket costs that Respondent may have incurred directly related to registering the domain name;
- (ii) the Respondent's last demand of \$2,000, in exchange for transfer of the contested domain name to the Complainant Trigon Insurance, made on the basis that "it would be in BCBSA's best interest to do so since it would cost more than \$2,000 to file suit against Respondent";
- (iii) the Respondent not having established a web site or other on-line presence at the contested domain name, which, in the Complainants' mind, indicate that the Respondent's true intent was never to establish a web site, but rather to negotiate for the sale of the contested domain name; and
- (iv) even if the Respondent had intended to establish a web site, the Respondent, by its own admission, registered the contested domain name to reduce its marketing costs by taking advantage of Complainants' well

known marks to attract visitors to the Respondent's site, thus creating a likelihood of confusion with the Complainants' marks.

Consequently, the Complainants conclude that the Respondents actions evidence registration and use of the domain name in bad faith.

B. Respondent

To date, the Respondent has not filed any response to the Complaint.

6. Discussion and Findings

In view of the lack of any response filed by the Respondent, InterActive Communications, Inc., this proceeding has proceeded by way of default. Hence, in the absence of any refuting evidence, all the facts and allegations submitted by the Complainants, BCBSA and Trigon Insurance, are accepted as true.

Apart from judging this proceeding through mere default of the Respondent, the Panel makes the following specific findings:

A. Similarity

The domain name in question is formed of a concatenation of the marks owned by the Complainants, specifically "TRIGON", "BLUE CROSS" and "BLUE SHIELD".

No doubt exists whatsoever that the contested domain name is clearly sufficiently similar to these marks as to cause a likelihood of confusion to arise between the relevant consumers of the Complainants and those who were to view a web site provided by the Respondent and accessed through the contested domain name -- when and if the Respondent, or any third-party not affiliated with the Complainants to which the Respondent were to transfer that domain name, were to start using the domain name in conjunction with goods or services similar to those of the Complainants. Such confusion, should it occur, would undoubtedly cause consumers to think that a relationship, affiliation or sponsorship of some sort exists between either or both of the Complainants and the Respondent or its third-party transferee, when, in fact, no such relationship, affiliation, sponsorship or the like would exist at all.

The differences between the contested domain name and the Complainants' marks when concatenated, being the deletion of spaces between the words "BLUE" and "CROSS", and "BLUE" and "SHIELD" (as the words appear in the Complainant BCBSA's block letter registrations), along with appending of a top-level domain (.com) are so de minimis as to be utterly inadequate to preclude any such confusion from occurring.

As such, the Panel finds that sufficient similarity exists under paragraph 4(a)(i) of the Policy.

In fact, for the reasons set forth below with respect to Illegitimacy and Bad Faith, given the conduct of the Respondent, InterActive Communications, Inc., as

evidenced by its intended purpose of posting a web site, specifically through use of the contested domain name, targeted at the Complainants' customers, its offer for sale of the contested domain name to the Complainants far in excess of its costs of registration (which, in the absence of any credible evidence to the contrary, the Panel accepts the Complainant's offer of \$ 70.00 as accurately reflecting those costs) and its repeated refusal to sell the domain name for a sum equal to those costs, the Panel concludes that:

- (i) the Respondent intentionally chose the contested domain name for its high and nearly identical degree of similarity with the marks under which the Complainants undertake their business, and
- (ii) the Respondent, through its expressed intention of trading on the goodwill inherent in the Complainants' registered marks, would utilize the contested domain name to attract, for commercial gain, Internet users to its own web site by creating a likelihood of confusion with those registered marks as to source, sponsorship, affiliation or endorsement of its web site or of a product or service at that site.

B. Illegitimacy

Based on the evidence submitted by the Complainants, the Panel makes the following findings regarding illegitimacy.

The Respondent has failed to provide any basis, under paragraph 4(c) of the Policy, that would legitimize any claim it might have to the contested domain name in connection with any goods or services which it intends to provide, i.e. its web site offering through which it purports to provide "unbiased reviews of the products and services of Trigon."

Specifically, the Panel finds that the Respondent has not established any web site or other on-line service that uses or has made any demonstrable preparations to use the contested domain name in connection with a bona fide offering of goods or services, and particularly such a use that would not likely cause consumer confusion with the services offered under the Complainants' marks. The Respondent has not shown that its purported use would in any way constitute "fair use".

The Panel finds that any unauthorized use to which the Respondent were to put any of the Complainants' registered marks in connection with the services listed in any of the registrations -- which the Respondent clearly states it intends to do -- would directly violate the exclusive trademark rights now residing in the Complainants, and would clearly cause confusion as to origin of the relevant purchasers of Complainant's services and dilute the goodwill which the Complainants has acquired by virtue of the extensive and continuous use, since at least 1940, of their marks.

The Panel believes that if the Respondent truly intends to exercise its Constitutionally guaranteed right of expression to provide critical reviews of the Complainant's services, it could clearly do so without diluting the marks of the Complainants and specifically without using a domain name that would likely infringe and dilute those marks. The Panel sees no reason why the Respondent should be free to dilute the Complainants' famous marks and cause injury to the

Complainants through use of the contested domain name that incorporates those very marks, when the Respondent can be clearly restrained, under the Lanham Act provisions cited hereinbelow, from using those marks themselves in such a manner. In the Panels' mind, the fact that the contested domain name is a concatenation of those marks is of no consequence and is insufficient to enable the Respondent from escaping legal liability for their unauthorized and potentially injurious use.

Furthermore, the Panel finds that it is extremely unlikely that the Respondent can even make a legitimate claim on the contested domain name. The simple reason is that the three marks, which form the basis of the contested domain name, incorporates the famous marks of the Complainant BCBSA -- which also form basic portions of the name of that Complainant, as well as the name of Trigon Insurance, and neither of the Complainants has any relationship whatsoever with the Respondent.

In light of the above findings, the Panel is unpersuaded that the Respondent has any legitimate rights in the contested domain name, whether commercial or non-commercial.

Thus, the Panel concludes that any use of the contested domain name by the Respondent is illegitimate within paragraph 4(a)(ii) of the Policy.

C. Bad Faith

Based on its federal trade/service mark registrations, the Complainants have acquired exclusive rights to use their registered marks in conjunction with the goods and services listed in its various registrations, of which a small representative sampling was provided.

Furthermore, each of the Complainants' registered marks, "Blue Cross", "Blue Shield" and "Trigon" is highly distinctive and not descriptive of any goods or services with which that mark is registered. Moreover, each of the "Blue Cross" and "Blue Shield" marks has been and is being advertised and promoted extensively, and used nationally, with this use dating back several decades to at least as early as the mid-1930's for the former mark and to 1940 for the latter mark, and continuing to date. There is nothing in the record before this Panel that indicates that either of these "Blue" marks is anything other than widely known among the consuming public, on a nationwide basis, in conjunction with the services for which these marks have been and are exclusively used by the Complainants and their licensees.

It is clear to the Panel that the marks "Blue Cross" and "Blue Shield" have acquired fame when assessed against the criteria set forth in §43(c)(1) of the Lanham Act (15 USC § 1125(c)(1)); namely,

- (A) the degree of inherent or acquired distinctiveness of the mark;
- (B) the duration and extent of use of the mark in connection with the goods or services with which the mark is used;
- (C) the duration and extent of advertising and publicity of the mark;

- (D) the geographical extent of the trading area in which the mark is used;
- (E) the channels of trade for the goods or services with which the mark is used;
- (F) the degree of recognition of the mark in the trading areas and channels of trade of the mark's owners and the person against whom the injunction is sought;
- (G) the nature and extent of the use of the same or similar marks by third parties; and
- (H) the existence of a registration under the Act of March 3, 1881, or the Act of February 20, 1905, or on the principal register.

It is also clear to this Panel, from the express admissions of the Respondent, that it willfully intends, were it to retain the contested domain name and in spite of a total lack of authorization from either of the Complainants, to trade on the Complainants BCBSA reputation and cause dilution of the "Blue Cross" and "Blue Shield" marks with concomitant injury to Complainant BCBSA. As such, this intention, were it to manifest itself into actual conduct, would constitute actionable trademark infringement under §43(c)(2) of the Lanham Act, subjecting the Respondent to various remedies set forth in §35(a) of the Lanham Act (15 USC § 1117(a)) as well as destruction of any infringing articles under §36 of the Lanham Act (15 USC § 1118). Clearly, this Panel finds those remedies would clearly encompass, under §35(a) of the Lanham Act, an injunction terminating operation of the Respondent's purported web site.

Furthermore, it is eminently clear to the Panel, that the Respondent, rather than to legitimize the use of the contested domain name, has as its express purpose to:

- (a) sell the contested domain name to the Complainant for an amount in excess of the costs of its registration, or to a third-party unrelated to the Complainant;
- (b) prevent the Complainant, as lawful owner of the registered trademarks "BLUE CROSS", "BLUE SHIELD" and "TRIGON", from reflecting its trademark in a corresponding domain name (here being "trigonbluecrossblueshield.com"), and/or
- (c) use the contested domain name to intentionally attract, for commercial gain, Internet users to the Respondent's site or other on-line location by creating a likelihood of confusion with the Complainant's mark as to source, sponsorship, affiliation or endorsement of the goods and services provided by the Complainant.

The Panel finds that the repeated refusal of the Respondent to transfer the contested domain name, which it has yet to use in a bona fide offering of goods or services, to the Complainants for an amount equal to its costs of registration directly exemplify the very conduct which the United States Congress in enacting the Anticybersquatting provisions of the Lanham Act sought to outlaw and ICANN in approving the Policy now seeks to remedy (see §§43(d)(1)(A) and (B)

(15 USC §§ 1125(d)(1)(A) and (B)) of the Lanham Act, and paragraph 4 of the Policy).

The Panel believes that bad faith under both the Policy as well as the Lanham Act is not proportional to, measured by or even excused by the quanta of the payment demanded that exceeds the costs of registration. As long as the amount demanded amounts to financial gain, that in and of itself suffices. Such offers, particularly when repeated as here, lay bare the inherent untoward character and underlying motivation of the domain name holder's acts.

The Panel infers, based on a lack of any response from the Respondent, that the Respondent has no reasonable grounds to believe that any use which it has or will make of contested domain name constitutes fair or otherwise lawful use.

Hence, the Panel finds that the Respondent's actions clearly evince bad faith under the Anti-Cybersquatting provisions of the §§43(d)(1)(A) and (B)(i) and (ii) of the Lanham Act (15 USC § 1125(d)(1)(A) with various factors indicative of 'bad faith' given in 15 USC § 1125(d)(1)(B)(i) though limited by (B)(ii) , and under paragraphs 4(a)(iii) and (b) of the Policy.

Thus, the Panel concludes that the Complainants, apart from default of the Respondent, have provided sufficient proof of their allegations to establish a case under paragraph 4(a) of the Policy upon which the relief they now seek can be granted.

7. Decision

In accordance with paragraph 4(i) of the Policy and paragraph 15 of the Rules, the relief sought by the Complainant is hereby granted. The domain name is ordered transferred to the Complainants. The Center is authorized to publish this entire decision in its discretion on a publicly accessible web site.

Peter L. Michaelson
Panelist

Dated: August 28, 2000