

ADMINISTRATIVE PANEL DECISION

Comerica Bank v. Whois Privacy Shield Services / Jacob Tanner Case No. D2014-1454

1. The Parties

The Complainant is Comerica Bank of Dallas, Texas, United States of America, represented by Bodman PLC, United States of America.

The Respondent is Whois Privacy Shield Services of Mission Viejo, California, United States of America / Jacob Tanner of Clay, New York, United States of America.

2. The Domain Name and Registrar

The disputed domain name <bankofthehills.com> is registered with Ignitela, LLC (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on August 22, 2014. On August 25, 2014, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On August 25, 2014, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain name which differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to the Complainant on August 26, 2014 providing the registrant and contact information disclosed by the Registrar and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed an amendment to the Complaint on August 28, 2014.

The Center verified that the Complaint together with the amendment to the Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the "Policy"), the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules"), and the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the "Supplemental Rules").

In accordance with the Rules, paragraphs 2(a) and 4(a), the Center formally notified the Respondent of the Complaint, and the proceedings commenced on September 5, 2014. In accordance with the Rules, paragraph 5(a), the due date for Response was September 25, 2014. The Respondent did not submit any response. Accordingly, on September 26, 2014, the Center notified the parties of the Respondent's default.

The Center appointed Peter L. Michaelson as the sole panelist in this matter on October 2, 2014. The Panel finds that it was properly constituted. The Panel has submitted the Statement of Acceptance and

Declaration of Impartiality and Independence, as required by the Center to ensure compliance with the Rules, paragraph 7.

4. Factual Background

As reflected in the registration record for the disputed domain name in the Registrar's Whois database (a copy of that record appears in Annex 1 to the Complaint), the disputed domain name was created on May 21, 2014 and is set to expire on May 21, 2015.

A. Complainant's BANK OF THE HILLS Marks

As indicated in the Complaint, the Complainant owns two United States trademark registrations for marks that, in one instance, solely contains the phrase BANK OF THE HILLS and, in the other instance, includes that phrase as a formative with other words, in a stylized form, and a design element. The Complainant has provided, in Annexes 6 and 7 to the Complaint, copies of its registration certificates. Pertinent details of a few of these registrations are as follows:

1. BANK OF THE HILLS (block letters)
United States registration no.: 2,259,919
registered as of: July 6, 1999; filed: August 14, 1997

This mark is registered for use in connection with: "financial services" in international class 36. The registration indicates that both first use of the mark in conjunction with these services and first use in commerce commenced as of April 9, 1998.

2. BANK OF THE HILLS A division of Comerica Bank (stylized with design)
United States registration no.: 4,173,010
registered as of: July 10, 2012; filed: September 1, 2011

This mark is registered for use in connection with: "banking services" in international class 36. The registration indicates that both first use of the mark in conjunction with these services and first use in commerce commenced as of November 1, 2011.

B. The Parties

The Complainant is a financial services company headquartered in Dallas, Texas with approximately USD 65.4 billion in assets as of December 31, 2013 (see copy of a printout appearing in Annex 4 to the Complaint). The Complainant has bank locations in Arizona, California, Florida, Michigan and Texas, with select businesses operating in several other states, as well as in Canada and Mexico (see printout of a page from the Complainant's website appearing in Annex 5 to the Complaint).

The Complainant invests considerable sums every year to promote its products and services identified by its marks.

The Complainant was the registrant for the disputed domain name through at least January 20, 2012 (see copies of archived webpages appearing in Annex 8 to the Complaint). Apparently, unbeknownst to the Complainant, its registration for the disputed domain name expired and was not renewed. The Respondent subsequently registered the disputed domain name on May 21, 2014.

When the Complainant attempted to direct its customers to what the Complainant thought to be its website at "www.bankofthehills.com", in actuality, such direction, as a result of the Respondent having registered the disputed domain name, actually diverted those customers to the Respondent's website instead. The Respondent's website contains what appears to be a blog with four posts, three of which include click-through links to other companies and where one of those click-through links directs users to a website of a distributor of new and used automated teller machine (ATM) equipment (see copies of printouts provided in

Annex 10 to the Complaint). Furthermore, one of blog posts is titled "Gay Beaches", with the other three are titled "Cheap Apartments Benidorm", "How Could You Decrease the price of Utilizing Your Credit Card Overseas?" and "Why Are Right Men Infringing Gay Bars?". Of these latter three blog posts, the first and second respectively contain a video showing a man reviewing his travels in Israel, and a man withdrawing money from an ATM in the United States.

5. Parties' Contentions

A. Complainant

(i) Identical or Confusingly Similar

The Complainant contends that the disputed domain name is identical to the Complainant's mark BANK OF THE HILLS simply because the name incorporates that mark in its entirety, while the ".com" generic Top-Level Domain (gTLD) is ignored for the purposes of assessing identity or confusing similarity.

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, for any of several reasons, that the Respondent has no rights or legitimate interests in the disputed domain name pursuant to paragraph 4(a)(ii) of the Policy.

The Complainant has not licensed the Respondent or otherwise permitted the Respondent to use the Complainant's marks or the disputed domain name.

Before any notice to the Respondent of the dispute, there was no evidence of the Respondent's use of, or demonstrable preparations to use, the disputed domain name or a name corresponding to the disputed domain name in connection with a *bona fide* offering of goods or services. In that regard, the disputed domain name resolves to a blog which includes a total of four posts, three of which provide click-through links to other companies.

Further, there is no evidence that the Respondent either has been commonly known by the disputed domain name or is making a legitimate noncommercial or fair use of the disputed domain name, without intent for commercial gain to misleadingly divert consumers or tarnish the Complainant's marks.

Lastly, the Respondent does not own and cannot lawfully obtain any right in the Complainant's marks or any words or phrases that incorporate or are confusingly similar to either of those marks.

(iii) Registered and Used in Bad Faith

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

Specifically, the Respondent, in spite of having known of the Complainant and its well-known mark BANK OF THE HILLS, intentionally registered the disputed domain name. In that regard, the Complainant's mark existed for more than 15 years prior to the date (May 21, 2014) the Respondent registered the disputed domain name, thus reflecting bad faith registration.

Further, the Respondent's use of the disputed domain name, which is comprised of the Complainant's trademark, to derive small but regular revenue through click-through links posted to the website to which the disputed domain name resolves constitutes bad faith use. In addition, bad faith use is also shown by the Respondent using the disputed domain name to intentionally divert web traffic, destined to the Complainant's

website, to the Respondent's site instead and, by so doing, intentionally disrupting the Complainant's business, deceiving its customers and trading off the Complainant's goodwill by creating an unauthorized association between the Respondent and the Complainant's marks.

B. Respondent

In view of the lack of a Response filed by the Respondent as required under paragraph 5 of the Rules, this proceeding has proceeded by way of default. Hence, under paragraphs 5(e), 14(a) and 15(a) of the Rules, the Panel is directed to decide this administrative proceeding on the basis of the Complainant's undisputed factual representations.

6. Discussion and Findings

A. Identical or Confusingly Similar

The Panel finds that the disputed domain name is identical to the Complainant's mark BANK OF THE HILLS. From simply comparing the disputed domain name to the mark, no doubt exists that the name is identical to the mark. The only difference between the two is the addition of the generic top-level domain ".com" to the mark to form the disputed domain name, with that addition being generally irrelevant in assessing confusing similarity or identity under paragraph 4(a)(i) of the Policy and thus typically ignored.

Thus, the Panel finds that the disputed domain name is identical to the Complainant's mark BANK OF THE HILLS. Hence, the Complainant has satisfied its burden under paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

Based on the evidence of record here, the Panel finds that no basis exists which would appear to legitimize a claim of rights or legitimate interests by the Respondent to the disputed domain name under paragraph 4(c) of the Policy.

First, the Complainant never authorized the Respondent to utilize the mark BANK OF THE HILLS nor does the Complainant apparently have any relationship or association whatsoever with the Respondent. Furthermore, given the exclusive trademark rights that reside in the Complainant and have resided since April 1998 – some 15 years prior to the date on which the Respondent registered the disputed domain name, the Respondent could not legitimately acquire any public association between itself and the mark BANK OF THE HILLS or even any mark similar thereto, at least for the services which the Complainant provides under its marks.

Second, there is absolutely no evidence of record that the Respondent has ever been commonly known by the disputed domain name or more generally the mark BANK OF THE HILLS, let alone in conjunction with the banking and financial services for which the Complainant uses its marks. Nor could the Respondent likely ever become commonly known by either the disputed domain name or the mark without infringing on the exclusive trademark rights of the Complainant. Hence, the Respondent does not fall within paragraph 4(c)(ii) of the Policy.

Lastly, as the Respondent likely receives some pecuniary benefit through the sponsored third-party links on his website by misleadingly diverting consumers who seek the Complainant's website, this use does not constitute a legitimate noncommercial or fair use within the ambit of paragraph 4(c)(iii) of the Policy.

As such, based on the evidence presently before the Panel, the Respondent does not fall within any of paragraphs 4(c)(i)-(iii) of the Policy. Also, there is simply no evidence that the Respondent has acquired, through any other means, any rights or legitimate interests in the disputed domain name.

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

C. Registered and Used in Bad Faith

The Panel finds that the Respondent's actions, with respect to the disputed domain name, constitute bad faith registration and use.

Paragraph 4(b) of the Policy illustrates non-exhaustive circumstances, if found by the Panel, as evidence of registration and use of a domain name in bad faith, including:

“(iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your web site or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of your web site or location or of a product or service on your web site or location.”

For reasons unknown, the Complainant's registration of the disputed domain name lapsed in 2012. For some time, the Complainant had used the disputed domain name in conjunction with its website and, without realizing its own registration had lapsed, continued to direct interested Internet users (presumably including both potential and existing customers) to what it thought was its website only to realize at some point, after the Respondent registered the disputed domain name and posted content to its site, that the Respondent was diverting those users to the Respondent's website instead. The Respondent's site contained a blog which, itself, had entries, one of which included click-through links to a third-party ATM equipment supplier. While such equipment is complementary to the Complainant's business (as consumer banking institutions which have physical branches routinely provide ATM systems for their customers' use), nevertheless it is reasonable for the Panel to infer – particularly in the absence of any Response – that Internet users seeing, through the Respondent's website, an advertisement from that supplier and for that equipment would likely think that some relationship, whether it be in terms of source, sponsorship, affiliation or endorsement, existed between that supplier and the Complainant, when, in fact, no such relationship existed at all, thus engendering confusion. The Respondent's incentive in deliberately causing confusion, as it did, was exacerbated by its prospect of earning click-through revenue from that supplier each time an Internet user clicked on the corresponding link. Further, the Respondent would receive additional click-through revenue through other third-party links on its blog entries. Thus, the Respondent used the disputed domain name to intentionally attract Internet users to its site by trading off the Complainant's reputation and goodwill in order to create confusion with the Complainant's mark for the Respondent's own pecuniary gain.

Given the present facts and circumstances, the Panel views the Respondent's conduct as constituting bad faith registration and use under paragraph 4(b)(iv) of the Policy.

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 <bankofthehills.com> is ordered to be transferred to the Complainant.

Peter L. Michaelson

Sole Panelist

Date: October 10, 2014