



WIPO Arbitration and Mediation Center

ADMINISTRATIVE PANEL DECISION

American Funds Distributors, Inc. v. Domain Administration Limited

Case No. D2007-0950

1. The Parties

The Complainant is American Funds Distributors Inc., Los Angeles, California, United States of America, represented by Robins, Kaplan, Miller & Cieresi LLP, United States of America.

The Respondent is Domain Administration Limited, Parnell, Auckland, New Zealand.

2. The Domain Name and Registrar

The disputed domain name <amercanfunds.com> is registered with InnerWise, Inc. d/b/a/ ItsYourDomain.com.

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on June 28, 2007. That Complaint identified the Respondent as Internet REIT, Inc. of Houston, Texas. On June 29, 2007, the Center transmitted by email to InnerWise, Inc. d/b/a ItsYourDomain.com a request for register verification in connection with the domain name at issue. On the same date InnerWise, Inc. d/b/a ItsYourDomain.com transmitted by email to the Center its verification response identifying Domain Administration Limited as the registrant and providing the contact details. On July 4, 2007 the Center notified the Complainant that the registrant of the domain name in issue is Domain Administration Limited, not the Respondent named in the Complaint and requesting the Complainant to file an Amended Complaint to identify the correct registrant. On July 10, 2007 the Amended Complaint was duly filed naming Domain Administration Limited as the Respondent. The Center verified that the amended 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, paragraph 2(a) and 4(a), the Center formally notified the Respondent of the Complaint, and the proceedings commenced on July 12, 2007. In accordance with the Rules, paragraph 5(a), the due date for Response was August 1, 2007. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on August 8, 2007.

The Center appointed David Perkins, Peter L. Michalson and Reinhard Schanda as panelists in this matter on September 12, 2007. The Panel finds that it was properly constituted. Each member of 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.

On August 8, 2007 the Center requested the Registrar, InnerWise, Inc. d/b/a/ ItsYourDomain.com, to confirm that the domain name in issue, which was due to expire on August 22, 2007, would be placed in registration LOCK status until conclusion of this administration proceeding. On August 16, 2007 the Center were advised that InnerWise, Inc. had been purchased by Tucows, Inc. to whom the request should be addressed. Accordingly, on August 21, 2007 the Center made the same request to Tucows. No reply appears to have been received.

4. Factual Background

4.A The Complainant

4.A.1 The Complainant is American Funds Distribution, Inc. a company organised under the laws of the State of California, having its principal place of business in Los Angeles. The Complainant is a wholly owned subsidiary of The Capital Group Companies, Inc.

4.A.2 The Complainant is one of the largest Mutual Fund companies in the United States. The Complainant claims that the AMERICAN FUNDS trademark was first used in commerce in February 1970. Under the AMERICAN FUNDS mark it currently manages 10 of the 25 largest mutual funds [Lipper Performance Report (Reuters) May 3, 2007].

4.A.3 Complainant's AMERICAN FUNDS trademark

4.A.3.1 The Complainant is the registered proprietor of the following U.S. registered trademarks.

Registration No.	Mark	Class	Date of Application/Registration
2,627,929*	AMERICAN FUNDS	36 Financial Services	Application: July 6, 2001 Registered: Oct 1, 2002
1,579,409	THE AMERICAN FUNDS GROUP	36 Mutual Fund Investment Services	Application: April 10, 1989 Registered: Jan 23, 1990
1,582,924	AMERICAN FUNDSLINE	36 Mutual Fund Investment Services	Application: May 22, 1989 Registered: Feb 13, 1990
1,653,879	AMERICAN FUNDS DISTRIBUTORS	36 Mutual Fund Investment Services	Application: March 15, 1990 Registered: Aug 13, 1991

2,441,290	AMERICAN FUNDS INSURANCE SERVICES	36 Mutual Fund Investment Services	Application: May 3, 1999 Registered: April 10, 2001
3,183,222	AMERICAN FUNDS INSTITUTIONAL GROUP	36 Mutual Fund Investment Services	Application: Oct 7, 2005 Registered: Dec 12, 2006

*The Complainant claims that the AMERICAN FUNDS mark [U.S. 2,627,929] was first used in commerce on February 1, 1970.

4.A.3.2 The Complainant currently has 12 additional trademark applications pending before the U.S. Patent and Trademark Office all of which incorporate the AMERICAN FUNDS mark as the prefix. They are:

Application No.	Mark	Class	Date of Application
78/805,872	AMERICAN FUNDS PORTFOLIO PLANNER	36 Financial Services	February 2, 2002
77/011,994	AMERICAN FUNDS HYPOTHETICALS	36 Financial Services	Oct 2, 2006
77/080,850	AMERICAN FUNDS TARGET DATE RETIREMENT SERIES	36 Financial Services	Jan 11, 2007
77/089,162	AMERICAN FUNDS 2010 TARGET DATE RETIREMENT FUND	36 Financial Services	Jan 23, 2007
77/089,385	AMERICAN FUNDS 2015 TARGET DATE RETIREMENT FUND	36 Financial Services	Jan 23, 2007
77/090,030	AMERICAN FUNDS 2020 TARGET DATE RETIREMENT FUND	36 Financial Services	Jan 24, 2007
77/090,092	AMERICAN FUNDS 2025 TARGET DATE RETIREMENT FUND	36 Financial Services	Jan 24, 2007
77/090,142	AMERICAN FUNDS 2030 TARGET DATE RETIREMENT FUND	36 Financial Services	Jan 24, 2007
77/089,182	AMERICAN FUNDS 2035 TARGET DATE RETIREMENT FUND	36 Financial Services	Jan 23, 2007
77/088,193	AMERICAN FUNDS 2040 TARGET DATE RETIREMENT FUND	36 Financial Services	Jan 23, 2007
77/088,890	AMERICAN FUNDS 2045 TARGET DATE RETIREMENT FUND	36 Financial Services	Jan 23, 2007
77/088,869	AMERICAN FUNDS 2050 TARGET DATE RETIREMENT FUND	36 Financial Services	Jan 23, 2007

4.A.4 Complainant's AMERICAN FUNDS Domain Names

4.A.4.1 Since 1995, Complainant has promoted the sale of its products and services through an Internet website accessible through the domain name <americanfunds.com>. That domain name was first registered in February 3, 1995.

4.A.4.2 Since 1998, Complainant has also promoted the sale of its products and services through an Internet website accessible through the domain name <americanfunds.net>. That domain name was first registered on May 29, 1998. The registrant of those domain names are respectively Capital Research Company and Capital Group Companies.

4.A.4.3 Complainant and its affiliates own a further 29 domain names which all incorporate the AMERICAN FUNDS trademark were registered variously between April 2001 and August 2006.

These comprise:

<americanfunds.biz>
<americanfunds.info>
<americanfunds.mobi>
<americanfunds.org>
<americanfunds.us>
<americanfundsdistributors.com>
<americanfundsdistributors.biz>
<americanfundsdistributors.info>
<americanfundsdistributors.us>
<americanfundsfaxline.com>
<americanfundsfaxline.us>
<americanfundsgroup.biz>
<americanfundsgroup.com>
<americanfundsgroup.info>
<americanfundsgroup.us>
<americanfundsinsuranceseries.com>
<americanfundsinsuranceseries.us>
<americanfundslines.biz>
<americanfundslines.com>
<americanfundslines.info>
<americanfundslines.us>
<americanfundsplandirect.com>
<americanfundsplandirect.us>
<americanfundsretirement.com>
<americanfundsretirement.us>
<americanfundsservicecompany.biz>
<americanfundsservicecompany.com>
<americanfundsservicecompany.info> and
<americanfundsservicecompany.us>.

4.B The Respondent

In the absence of a Response, nothing is known of the Respondent except what is set out below under the Complainant's contentions. It appears that the domain name was

acquired by the Respondent at some date subsequent to June 5, 2007 when the Complainant's WHOIS search showed the registrant as Internet REIT, Inc.

5. Parties' Contentions

5.A Complainant

The Complainant's case is that (1) the domain name is confusingly similar to its AMERICAN FUND trademark, (2) the Respondent has no rights or legitimate interests with respect to that domain name and (3) the domain name was registered and is being used in bad faith.

5.A.1 Confusingly Similar

5.A.1.1 In the light of its AMERICAN FUNDS registered trademarks, its longstanding use since 1970 of the AMERICAN FUNDS mark, its registration and use of trademarks incorporating the AMERICAN FUNDS mark, its registration and use of AMERICAN FUNDS as a domain name and the substantial commercial success promoting funds and services under the AMERICAN FUNDS mark, the Complainant asserts that the AMERICAN FUNDS mark "has become famous throughout the world".

5.A.1.2 The domain name in issue <amercanfunds.com> is identical to the AMERICAN FUNDS mark but for the letter "i". This does not, as Complainant says, avoid confusing similarity. In that respect, the Complainant cites a number of cases decided under the Policy where confusingly similarity has been found in directly comparable cases. For example:

Domain name	Complainant's Trademark	WIPO Case
<washingtonmutual.com>	WASHINGTON MUTUAL	D2003 – 0283
<newbergerberman.com>	NEUBERGER BERMAN	D2000 – 0323
<bitannica.com> <britannca.com> <bitannica.com>	BRITANNICA BRITANNICA BRITANNICA	D2000 – 0330
<encyclopediabrittanica.com>	ENCYCLOPAEDIA BRITANNICA	D2000 – 0330

5.A.2 Rights or Legitimate Interests

5.A.2.1 The domain name in issue was first registered on August 22, 2000 some 30 years after first use by the Complainant of its AMERICAN FUNDS mark or more than 10 years after Complainant had obtained U.S. registered trademarks for 3 of its marks which incorporate AMERICAN FUNDS: [see para 4.A.3.1 above.] Further, the Respondent did not acquire the domain name until June 2007, some 37 years after Complainant's first use, 17 years after registration by Complainant of it's THE AMERICAN FUNDS GROUP: AMERICAN FUNDSLINe and AMERICAN FUNDS DISTRIBUTORS marks or 5 years after Complainant obtained a U.S. trademark registration for AMERICAN FUNDS simpliciter.

5.A.2.2 Additionally, the first registration of the domain name in issue was 5 years after the Complainant's registration and use of the domain name <americanfunds.com> and 3 years after Complainant's registration and use of its domain name <americanfunds.net>: [see, para 4.A.4 above.]

5.A.2.3 The domain name in issue resolves to a web page, which displays hyperlinks to various categories of sponsored websites including "Mutual Funds", "Financial Advisor" and "Financial Planning". Activating each of those links takes the user to competitors of the Complainant in each of those aspects of financial services. For example, the Mutual Funds link is to Amerprise and T. Rowe Price, the Financial Advisor link is to Jarvis Capital Group and the Financial Planning link again goes to Amerprise and T. Rowe Price and also to TD Ameritrade.

5.A.2.4 Complainant's case is that this use by the Respondent of the domain name in issue is an improper use of the AMERICAN FUNDS trademark and amounts to what is known as typosquatting. This constitutes using a confusingly similar name with the intention of diverting users searching for information regarding the Complainant's goods and services to web pages maintained by its competitors. The Complainant cites cases decided under the Policy where such conduct has been held not to constitute a legitimate non-commercial or fair use of the domain name.

5.A.2.5 Consequently, the Complainant says that the Respondent cannot bring itself into any of the circumstances set out in paragraph 4(c) of the Policy which demonstrate rights and legitimate interests in the domain name.

5.A.3 Registered or Used in Bad Faith

5.A.3.1 As to registration, the Complainant points to its 30 years of prior use of the AMERICAN FUNDS trademark and its U.S. registered trademark which also antedate creation of the domain name in issue. In the circumstances, the original registrant and also the Respondent had actual or, at least, constructive notice of the Complainant's rights in that trademark.

5.A.3.2 As to use in bad faith, the Complainant points to the typosquatting activities outlined in paragraph 5.A.2 above and cites cases decided under the Policy where such activity has been held to amount to bad faith use.

5.A.3.3 Further, the Complainant asserts a pattern of conduct by the Respondent evidenced by 6 decisions under the Policy where the Respondent had registered and used domain names containing slight misspellings of Complainant's trademark to direct users to advertisements and commercial websites, which conduct was held to constitute bad faith registration and use. For example:

Domain name	Complainant's Trademark	Case under the Policy
<voguetyres.com>	VOGUE TYRES	FA 9122A
<tolbrothers.com>	TOLL BROTHERS	FA 856389
<diner-club.com>	DINERS CLUB	FA 853706
<nationwide.com>	NATION WIDE	WIPO Case No. D2006-1490
<compasbank.com>	COMPASS BANK	WIPO Case No. D2006-1259

<bunomatic.com>	BUNN-O-MATIC	FA785539
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5.A.3.4 The Complainant also cites 4 decisions under the Policy where the Respondent was held to have acted in bad faith by registering domain names that were identical or confusingly similar to the complainant’s trademark, namely:

Domain name	Complainant’s Trademark	Case under the Policy
<icebergclothing.com>	ICEBERG	WIPO Case No. D2007-0093
<thomsoneducation.com>	THOMASON EDUCATION	FA 843555
<hibbettssports.com>	HIBBETT and HIBBETT SPORTS	WIPO Case No. D2006-1147
<americandiabetesassociation.com>	AMERICAN DIABETES ASSOCIATION	WIPO Case No. D2006-0921

5.B Respondent

As noted, no Response was filed.

6. Discussion and Findings

6.1 The Policy paragraph 4(a) provides that the Complainant must prove *each* of the following in order to succeed in an administrative proceeding:

- that the Respondent’s domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and
- that the Respondent has no rights or legitimate interests in respect of the domain name; and
- that the domain name has been registered *and* is being used in bad faith.

6.2 The Policy paragraph 4(c) sets out circumstances which, in particular but without limitation, if found by the Panel to be proved shall demonstrate the Respondent’s rights or legitimate interests in the domain name in issue.

6.3 The Policy paragraph 4(b) sets out circumstances which, again in particular but without limitation, if found by the Panel to be present shall be evidence of the registration and use of a domain name in bad faith.

6.4 As stated, the circumstances set out in paragraphs 4b and 4c of the Policy are not exclusionary. They are *without limitation*. That is, the Policy expressly recognises that *other* circumstances can be evidence relevant the requirements of paragraphs 4(a)(ii) and (iii) of the Policy.

6.5 Identical or Confusingly Similar

Omitting the letter “i” in the domain name in issue is insufficient to avoid a finding of confusing similarity with a well established prior mark identical in all other respects to such domain name. Furthermore, visually and phonetically AMERICAN FUNDS and <amercafunds....> are to all intents and purposes the same. Accordingly, the Complainant meets the requirements of paragraph 4(a)(i) of the Policy.

6.6 Rights or Legitimate Interest

On the uncontested evidence provided by the Complainant, it is clear that the Respondent cannot bring itself within any of the circumstances set out in paragraph 4(c) of the Policy. Typosquatting of that type is well recognised as neither a *bona fide* offering of goods and services [para 4(c)(i) of the Policy] nor a legitimate non-commercial or fair use [para 4(c)(iii) of the Policy]. Nor is there any evidence that the Respondent could bring itself within paragraph 4(c)(ii) of the Policy: the Respondent is a known typosquatter under the name Domain Administration Ltd. The Respondent is clearly not commonly known by the domain name in issue. Accordingly, the Complainant also meets the requirement of paragraph 4(a)(ii) of the Policy.

6.7 Registered and Used in Bad Faith

6.7.1 If the original registrant did not have actual knowledge of the Complainant's AMERICAN FUNDS trademark, then the extensive prior use of that name and the fact that it comprises the dominant part of several U.S. registered trademarks provided constructive knowledge of the Complainant's trademark rights in AMERICAN FUNDS. By the time the Respondent acquired the domain name in issue, the Complainant's trademark rights in AMERICAN FUNDS were still more established. Accordingly, the Complainant satisfies the first limb of paragraph 4(a)(iii) of the Policy, namely registration in bad faith.

6.7.2 As to the second limb, use in bad faith is manifest both from the typosquatting to which this domain name has been put and from the pattern of conduct with the trademarks of other parties: paragraphs 5.A.3.3 and 4 above. On the uncontested evidence in the Complainant, the Respondent's use of the domain's name plainly falls fair and square within the circumstances set out in paragraph 4(b)(iv) of the Policy.

7. Decision

For all the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the domain name <americanfunds.com> be transferred to the Complainant.

David Perkins
Presiding Panelist

Peter L. Michaelson
Panelist

Reinhard Schanda
Panelist

Dated: September 26, 2007