



NATIONAL

ARBITRATION

FORUM

DECISION

FinPlan, Inc. v The Financial Resource Center
Claim Number: FA0101000096358

PARTIES

Complainant is **FinPlan, Inc.**, Park Ridge, IL, USA ("Complainant") represented by **Robert Beiser, of Michael Best & Friedrich LLC**. Respondent is **G. Bryan Fessenden** **The Financial Resource Center**, Salt Lake City, UT, USA ("Respondent").

REGISTRAR AND DISPUTED DOMAIN NAME

The domain name at issue is "**divorceplanner.com**", registered with **Network Solutions**.

PANEL

The undersigned certifies that she has acted independently and impartially and that to the best of her knowledge, she has no known conflict in serving as a panelist in this proceeding.

Honorable Carolyn Marks Johnson sits as Panelist.

PROCEDURAL HISTORY

Complainant submitted a Complaint to the National Arbitration Forum ("the Forum") electronically on January 4, 2001; the Forum received a hard copy of the Complaint on January 5, 2001.

On January 15, 2001, Network Solutions confirmed by e-mail to the Forum that the domain name "**divorceplanner.com**" is registered with Network Solutions and that the Respondent is the current registrant of the name. Network Solutions has verified that Respondent is bound by the Network Solutions 5.0 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 January 17, 2001, a Notification of Complaint and Commencement of Administrative Proceeding (the "Commencement Notification"), setting a deadline of February 6, 2001 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@divorceplanner.com by e-mail.

A timely response was received and determined to be complete on February 5, 2001.

On February 8, 2001, pursuant to Complainant's request to have the dispute decided by a One Member Panel, the Forum appointed Honorable Carolyn Marks Johnson as Panelist.

RELIEF SOUGHT

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

PARTIES' CONTENTIONS

- A. Complainant urges that Respondent registered its trademark as a domain name and proceeded to do business under that name without legitimate right or interest in the mark. Complainant further urges that Respondent registered and used its mark in bad faith.
- B. Respondent agrees that the domain name in issue is identical to Complainant's mark but urges that Respondent registered and used the mark before it had notice of this complaint and therefore that its efforts cannot be in bad faith. Respondent urges that it has equal right to use the domain name that is identical to Complainant's registered trademark because the trademark protects two generic words.

FINDINGS

Complainant established its ownership of the registered trademark DIVORCE PLANNER with appropriate proof that shows Complainant has been in the business of providing financial planning advice for those in the process of divorcing under that name since 1988. The mark was registered in 1990.

Respondent registered the domain name divorceplanner.com June 9, 1999.

The documents permit the inference that Complainant has made a significant investment in developing software under its registered mark and that the software has been given wide use by lawyers and others who are engaged in financial planning for those in the process of divorcing.

Respondent engages in the same type of enterprise in which Complainant engages but there is no evidence in the record that shows that Respondent has ever been commonly known by Complainant's registered mark.

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) 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.

Identical to and/or Confusingly Similar

It is undisputed by Respondent that the domain name at issue is identical to the registered mark that Complainant owns. Complainant has owned the registered mark DIVORCE PLANNER and has used it continuously since 1988. Respondent concedes Complainant’s assertion that Respondent’s domain name, **divorceplanner.com**, is functionally identical to Complainant’s mark. *See Football Ass’n Ltd. v. UKIP*, D2000-1359 (WIPO Dec. 15, 2000) (finding that domain name "facup.com" is clearly identical to the FA CUP trademark belonging to Complainant); *see also Croatia Airlines v. Kwen Kijong*, AF 0302 (eResolution Sept. 25, 2000) (finding that the domain name "croatiaairlines.com" is identical to the Complainant’s trademark "Croatia Airlines").

In addition, Complainant asserts that Respondent’s domain name is confusingly similar to its well-established mark because a reasonable Internet user would assume the domain name at issue is somehow affiliated with Complainant’s mark. *See Treeforms, Inc. v. Cayne Indus. Sales Corp.*, FA 95856 (Nat. Arb. Forum Dec. 18, 2000) (finding that confusion would result when Internet users, intending to access Complainant’s web site, think that an affiliation of some sort exists between Complainant and Respondent, when in fact, no such relationship would exist).

Respondent admits its domain name is identical to and/or confusingly similar to Complainant's mark; however, Respondent argues that since its domain name is comprised of generically linked terms, which are descriptive and have not been shown to have any secondary meaning it can make this use of Complainant's mark. There is some authority for Respondent's position. *See SOCCERPLEX, INC. v. NBA Inc.*, FA 94361 (Nat. Arb. Forum May 25, 2000) (finding that the Complainant failed to show that it should be granted exclusive use of the domain name "SOCCERZONE.COM", as it contains two generic terms and is not exclusively associated with its business.). That authority is not persuasive here where Respondent seeks to engage in the same kind of business that Complainant engages in under a duly registered trademark. If this were permitted, anyone could unilaterally negate the purpose and system of having registered trademarks that are protected at law.

The Panel finds that the domain name at issue here is identical to Complainant's registered mark. *Policy ¶ 4(a)(i)*.

Rights or Legitimate Interests

Complainant has established ownership of the registered trademark that is identical to the domain name at issue in this case. Complainant contends that Respondent has no rights or legitimate interests in respect to the domain name at issue because Complainant maintains exclusive right to use the mark on financial planning software as well as Divorce Plan software and related services that are currently also being offered by Respondent. *See Clerical Med. Inv. Group Ltd. v. Clericalmedical.com*, D2000-1228 (WIPO Nov. 28, 2000) (finding that under certain circumstances the mere assertion by Complainant that Respondent has no right or legitimate interest is sufficient to shift the burden of proof to the Respondent to demonstrate that such a right or legitimate interest does exist).

It should be further noted that Respondent claims that Complainant's mark combines two generic words and that for that reason Respondent can make use of the generic two words to create a domain name that is used to engage in the same type of enterprise. In other arenas, what Respondent proposes is often described as trademark infringement. Respondent knowingly was making use of Complainant's registered trademark identity without showing any association with Complainant that would give Respondent the right to do so.

Respondent also asserts that prior to notification of this dispute, its domain name was in constant use for the purpose of offering bona fide divorce planning services and that such circumstances have been held to give Respondent's rights in the domain names at issue. There is some authority for this position. *See IG Index PLC v Index Trade*, D2000-1124 (WIPO Oct. 16, 2000) (finding that Respondent has rights in the domain name because Respondent's claimed use of the domain name is a "plausible explanation" to which the Panelist must give weight); *see also Western Hay Co. v. Forester*, FA 93466 (Nat. Arb.

Forum, Mar. 3, 3000) (finding that the Respondent was using the domain names for a legitimate purpose). Even giving Respondent's claims full weight and credibility as a plausible explanation for using Complainant's registered trademark, such plausible explanation does not excuse unilateral assumption of the right to do the same business another person is doing under a duly registered trademark. To hold otherwise, would be a mockery of the reasons that Congress created that orderly system of regulating businesses.

Accordingly, the Panel finds that Complainant has established rights in the trademark that is identical to the domain name at issue here and that Respondent did not obtain rights or legitimate interests in the mark simply by using it in another business forum. *Policy ¶ 4(a)(ii)*.

Registration and Use in Bad Faith

Complainant alleges that Respondent registered the domain name at issue to intentionally attract Internet users to its web site by creating a likelihood of confusion with Complainant's well-established mark as to the sponsorship, affiliation and endorsement of its domain name. *See Drs. Foster & Smith, Inc. v Jaspreet Lalli*, FA 95284 (Nat. Arb. Forum Aug. 21, 2000) (finding bad faith where Respondent directed Internet users seeking Complainant's site to its web site [and that] consequently Respondent has violated Policy ¶4(b)(iv) by attracting Internet users to its web site, for commercial gain, by creating a likelihood of confusion with the Complainant's mark).

Further, Complainant asserts that it has built up extensive good will in connection with its mark, from which Respondent, who is in the same business as Complainant, can benefit by utilizing the domain name at issue. *See Pavillion Agency, Inc. v. Greenhouse Agency Ltd.*, D2000-1221 (WIPO Dec. 4, 2000) (finding that the "domain names are so obviously connected with the Complainants that the use or registration by anyone other than Complainants suggests 'opportunistic bad faith'."); *see also Sony Kabushiki Kaisha v. Inja, Kil*, D2000-1409 (WIPO Dec. 9, 2000) (finding that bad faith registration and use where it is "inconceivable that the respondent could make any active use of the disputed domain names without creating a false impression of association with the Complainant").

Respondent alleges Complainant has not shown it registered and used the domain name at issue in bad faith. There is support for the proposition that mere holding of a domain name that frustrates the efforts of another is not bad faith. *See Goldmasters Precious Metals v. Gold Masters srl*, FA 95246 (Nat. Arb. Forum Aug. 21, 2000) (finding no bad faith even though Respondent's ownership and purported use of the domain name frustrates Complainant's efforts where the record does not indicate any purpose or intent on the part of the Respondent to prevent Complainant from reflecting its mark in a corresponding domain name, to disrupt the business of a competitor, or to intentionally attract the customers of Complainant to Respondent's site by creating a likelihood of confusion); *see also Lumena s-ka zo.o. v. Express Ventures LTD*, FA 94375 (Nat. Arb. Forum May 11, 2000) (finding no bad faith where the domain name involves a generic

term, and there is no direct evidence that Respondent registered the domain name with the intent of capitalizing on Complainant's trademark interest).

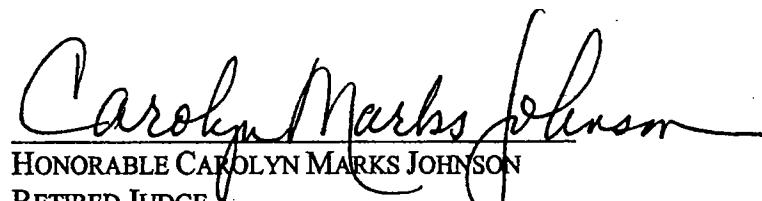
Moreover, Respondent also asserts that Complainant had ample opportunity to register the domain name for itself using its registered mark and that Complainant's inaction in relation to the domain name indicates Complainant's intent to reverse domain-hijack Respondent's domain name. Respondent also alleged that this dispute was brought for the sole purpose of harassing Respondent.

The Panel is not persuaded by these arguments. One who knows about the registered mark that belongs to another—and it can be presumed that Respondent knew about Complainant's mark here—and one who engages in the same operations in the same arena as another and using that other entity's registered trademark, does not do so without some intent to encroach upon that other entity's mark and business. Proper use of the Internet and domain names does not include using another's mark to draw business away from that entity. Looking at the entirety of the proof offered, as the Panel must, it is reasonable for the Panel to draw the inference here that Respondent registered this domain name to attract away those looking for the services that Complainant had been offering under its registered trademark for almost a score of years.

Accordingly, the Panel finds that Respondent registered and used the domain name that utilized Complainant's mark to provide the same services provided by Complainant in bad faith *Policy ¶ 4(a)(iii)*.

DECISION

The Panel finds that Complainant is entitled to the requested relief. It is therefore, ORDERED that the domain name "divorceplanner.com" be transferred from Respondent to Complainant.



CAROLYN MARKS JOHNSON
HONORABLE CAROLYN MARKS JOHNSON
RETIRED JUDGE
ARBITRATOR

Dated: February 19, 2001

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