Decision for dispute CAC-UDRP-100979

Case number	**CAC-UDRP-100979**
Time of filing	**2015-07-16 10:44:07**
Domain names	**pimafcu.com**

Case administrator

Name	**Lada Válková (Case admin)**

Complainant

Organization	**Pima Federal Credit Union**

Complainant representative

Organization	**RODENBAUGH LAW**

Respondent

Organization	**Whois Privacy Corp.**

OTHER LEGAL PROCEEDINGS

The Panel is not aware of pending or decided legal proceedings which relate to the disputed domain name.

IDENTIFICATION OF RIGHTS

The Complainant is the holder of various registrations and/or applications for trademarks, comprising the wording “PIMA FEDERAL CREDIT UNION”, including the US trademark registration 4126547 for the combined mark “PIMA FEDERAL CREDIT UNION”, first used on 1 April 2011 and registered on 10 April 2012 in class 36 and the US trademark registration 86664542 for the word mark “PIMA FEDERAL CREDIT UNION”, first used in commerce May 1981 and registered on 22 June 2015 in class 36.

FACTUAL BACKGROUND

The Complainant, Pima Federal Credit Union (“Pima”) is a not-for-profit financial cooperative that was founded by a group of teachers in 1951. Pima currently serves 52,000 members throughout Pima County and surrounding areas. Pima has numerous branches in Pima County, Arizona and also maintains an online presence at the website associated with the <pimafcu.org> domain name of which it is the holder since 18 April 1997.

The disputed domain name “pimafcu.com” was created on 18 April 1997 and is registered by Respondent. The disputed domain name has been used as a parking page containing pay-per-click advertisements. The disputed domain name is listed for sale at US$7,250. The disputed domain name has allegedly been used to redirect to web pages which opened a pop-up

window with a security warning.

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

COMPLAINANT:
The Complainant considers the disputed domain name to be confusingly similar to trademarks and service marks in which it claims to have rights. The Complainant further claims that the Respondent has no rights or legitimate interests in respect of the disputed domain name. According to the Complainant, the Respondent has not used the disputed domain names in connection with a legitimate use. Also, according to the Complainant, the Respondent has not been commonly known by the disputed domain name.

Finally, the Complainant considers that the domain name was registered and being used in bad faith.

RESPONDENT:

No administratively compliant Response has been filed.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the Domain Name is identical or confusingly similar to a trademark or service mark in which the complainant has rights (within the meaning of paragraph 4(a)(i)of the Policy).

NO RIGHTS OR LEGITIMATE INTERESTS

The Complainant has, to the satisfaction of the Panel, shown the Respondent to have no rights or legitimate interests in respect of the Domain Name (within the meaning of paragraph 4(a)(ii)of the Policy).

BAD FAITH

The Complainant has, to the satisfaction of the Panel, shown the Domain Name has been registered and is being used in bad faith (within the meaning of paragraph 4(a)(iii)of the Policy).

PROCEDURAL FACTORS

At the time of the commencement of this proceeding, the owner of the record of the disputed domain name was Whois Privacy Corp. Once notified of the complaint, Registrar disclosed another owner for the disputed domain name Ryan G Foo (organization PPA Media Services). The Complainant preferred not to change the Respondent’s name in the complaint based on the arguments of CAC decision No. 100221.In that respect the Panel finds the CAC followed the correct procedure in accordance with the Policy and the Rules and accepts the request of the Complainant that the complaint proceeds against WHOIS Privacy Corp.

Accordingly, the Panel is satisfied that all procedural requirements under UDRP were met and there is no other reason why it would be inappropriate to provide a decision.

PRINCIPAL REASONS FOR THE DECISION

Paragraph 15 of the Rules provides that the Panel is to decide the complaint on the basis of the statements and documents submitted in accordance with the Policy, the Rules and any rules and principles of law that it deems applicable.

The onus is on the Complainant to make out its case and it is apparent, both from the terms of the Policy and the decisions of past UDRP panels, that the Complainant must show that all three elements set out in Paragraph 4 (a) of the Policy have been established before any order can be made to transfer a domain name. As the proceedings are civil, the standard of proof is the balance of probabilities.

Thus for the Complainant to succeed it must prove, within the meaning of Paragraph 4(a) of the Policy and on the balance of probabilities that:

1. The domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and
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.

The Panel has therefore dealt with each of these requirements in turn.

Confusing similarity of the Domain Name with existing rights

The Complainant must first establish that there is a trademark or service mark in which it has rights. Since Complainant is the holder of the PIMA FEDERAL CREDIT UNION trademarks, which are used in connection with its business, it is established that there is a trademark in which Complainant has rights.

The Panel considers the disputed domain name <pimafcu.com> to be confusingly similar to the PIMA FEDERAL CREDIT UNION trademarks. The Panel is of the opinion the disputed domain name contains the most distinctive element of the Complainant's trademark and adds the letters 'fcu', which can be seen as an acronym for 'federeal credit union'. According to the Panel, these differences are not sufficient to escape the finding that the Domain Name is confusingly similar to the Complainant's trademarks.

Furthermore, it should be noted that the disputed domain name had been registered before the Complainant acquired trademark rights. However, this does not prevent a finding of identity or confusing similarity under the UDRP for the UDRP makes no specific reference to the date on which the holder of the trademark or service mark acquired rights.

Accordingly, the Complainant has made out the first of the three elements that it must establish.

No legitimate rights

Under paragraph 4(a)(ii) of the Policy, the Complainant has the burden of establishing that respondent has no rights or legitimate interests in respect of the domain names.

It is established case law that it is sufficient for the Complainant to make a prima facie showing that Respondent has no right or legitimate interest in the Domain Name in order to shift the burden of proof to the Respondent. (See: Champion Innovations, Ltd. V. Udo Dussling (45FHH), WIPO case No. D2005-1094 (championinnovation.com); Croatia Airlines d.d. v. Modern Empire Internet Ltd., WIPO case No. D2003-0455 (croatiaairlines.com); Belupo d.d. v. WACHEM d.o.o., WIPO case No. 2004-0110 (belupo.com).)

The Panel finds that Respondent has not been commonly known by the Domain Name and that the Respondent has not acquired trademark or service mark rights. Respondent's use and registration of the disputed domain name was not authorized by Complainant. There are no indications that a connection between Complainant and Respondent existed.

Moreover, the Panel is of the opinion that Respondent is not making a legitimate non-commercial or fair use of the Domain Name. In fact, Respondent has been using the domain name to resolve to a parking page, containing sponsored links to competitors of Complainant. Respondent has also been using the domain name to resolve to a webpage allegedly offering online banking services. See Région Rhône-Alpes v. Registration Private, Domains by Proxy, LLC / Edmunds Gaidis, WIPO Case No. D2014-1942.

These verified allegations are sufficient to make out a prima facie case and shift the burden of proof to Respondent. In the absence of a rebuttal by Respondent and based on the case file, the Panel considers that the second requirement of

Paragraph 4(a) of the Policy is, therefore, satisfied (See CAC Case No. 100707, Mount Gay Distilleries Limited v. shan gai gong zuo shi; WIPO Case No. D2007-0368, Teva Pharmaceutical USA, Inc. v. US Online Pharmacies; WIPO Case No. D2003-0796, Grupo Televisa, S.A., Televisa, S.A. de C.V., Estrategia Televisa, S.A. de C.V., Videoserpel, Ltd. v. Party Night Inc., a/k/a Peter Carrington).

Bad faith

Complainant must prove on the balance of probabilities that the disputed domain name was registered in bad faith and that it is being used in bad faith (See e.g. Telstra Corporation Limited v. Nuclear Marshmallow, WIPO Case No. D2000-0003; Control Techniques Limited v. Lektronix Ltd, WIPO Case No. D2006 1052).

Policy Paragraph 4(b) provides a non-exclusive list of factors, any one of which may demonstrate bad faith registration and use, namely:

(i) circumstances indicating that the domain name is registered or acquired primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the Complainant or to a competitor of the Complainant, for valuable consideration in excess of documented out-of-pocket costs directly related to the domain name (Policy Paragraph 4(b)(i));
(ii) the registration of a domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that Respondent has engaged in a pattern of such conduct (Policy Paragraph 4(b)(ii));
(iii) the registration of a domain name primarily for the purpose of disrupting the business of a competitor (Policy Paragraph 4(b)(iii)); and
(iv) the use of a domain name for intentionally attempting to attract, for commercial gain, Internet users to a 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 Respondent’s web site or location or of a product or service on Respondent’s web site or location (Policy Paragraph 4(b)(iv)).

According to the Panel, the awareness of a respondent of the complainant and/or the complainant’s trademark rights at the time of registration can evidence bad faith (See BellSouth Intellectual Property Corporation v. Serena, Axel, WIPO Case No. D2006-0007, where it was held that the respondent acted in bad faith when registering the disputed domain name, because widespread and long-standing advertising and marketing of goods and services under the trademarks in question, the inclusion of the entire trademark in the domain name, and the similarity of products implied by addition of telecommunications services suffix (“voip”) suggested knowledge of the complainant’s rights in the trademarks).

In the present case, the disputed domain name has been registered a couple of hours after the Complainant registered its <pimafcu.org> domain name. At the time, Complainant was already using its “PIMA FEDERAL CREDIT UNION” trademark. Respondent has subsequently been using the disputed domain name to promote competitors and to offer competing services. On the balance of probabilities, it can therefore be concluded that the Respondent was aware of the Complainant’s business and related trademarks.

Moreover, the Respondent is offering the disputed domain name for sale for valuable consideration in excess of documented out-of-pocket costs. The Respondent has also been using the disputed domain name for offering competing services, which created a likelihood of confusion with the Complainant’s mark as to the source, sponsorship, affiliation, or endorsement of Respondent’s web site and services. In addition, the Respondent did not respond to the allegations made by the Complainant. According to the Panel, this is indicative of the Respondent’s bad faith.

Finally, the fact that the Respondent used a WHOIS privacy service constitutes additional evidence of the Respondent’s bad faith (See CAC Case No. 100849, ArcelorMittal S.A. v. david trapp).

Considering the above, the Panel finds that the Complainant has made out the three elements that it must establish.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

AND THE DISPUTED DOMAIN NAME(S) IS (ARE) TO BE

1. **PIMAFCU.COM**: Transferred

PANELLISTS

Name	**Flip Petillion**

DATE OF PANEL DECISION 2015-08-20

Publish the Decision