



NATIONAL ARBITRATION FORUM

DECISION

IMT Services Corp. v. Texas International Property Associates-NA NA
Claim Number: FA0904001259913

PARTIES

Complainant is **IMT Services Corp.** (“Complainant”), represented by **Fritz L. Schweitzer III**, of **St. Onge Steward Johnston & Reens LLC**, Connecticut, USA. Respondent is **Texas International Property Associates-NA NA** (“Respondent”), represented by **JanPaul Guzman**, of **Rothstein Rosenfeldt Adler**, Florida, USA.

REGISTRAR AND DISPUTED DOMAIN NAME

The domain name at issue is <**insurancemytrip.com**>, registered with **Compana Llc**.

PANEL

The undersigned certifies that he has acted independently and impartially and to the best of his knowledge has no known conflict in serving as Panelist in this proceeding.

Petter Rindforth as Panelist.

PROCEDURAL HISTORY

Complainant submitted a Complaint to the National Arbitration Forum electronically on April 28, 2009; the National Arbitration Forum received a hard copy of the Complaint on April 29, 2009.

On April 30, 2009, Compana Llc confirmed by e-mail to the National Arbitration Forum that the <**insurancemytrip.com**> domain name is registered with Compana Llc and that the Respondent is the current registrant of the name. Compana Llc has verified that Respondent is bound by the Compana Llc 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 May 5, 2009, a Notification of Complaint and Commencement of Administrative Proceeding (the “Commencement Notification”), setting a deadline of May 26, 2009 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@insurancemytrip.com by e-mail.

A timely Response was received and determined to be complete on May 26, 2009.

On June 1, 2009, pursuant to Complainant's request to have the dispute decided by a single-member Panel, the National Arbitration Forum appointed Petter Rindforth as Panelist.

RELIEF SOUGHT

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

PARTIES' CONTENTIONS

A. Complainant

The Complainant is the owner of U.S. Trademark Registration No. 2,866,245 (registered on July 27, 2004, with a stated first use in commerce of June 1, 2000) for the mark INSUREMYTRIP.COM & Design for use in connection with insurance comparison services, insurance brokerage services, and insurance agency services, in the field in travel insurance, in International Class 36 (Exhibit A of the Complaint). Complainant is also the owner of U.S. Trademark Registration No. 3,007,162 (registered on October 18, 2005, with a stated first use in commerce of June 1, 2000) for the mark INSURE MY TRIP for use in connection with insurance comparison services, insurance brokerage services, and insurance agency services, in the field in travel insurance, in International Class 36 (Exhibit B of the Complaint).

The Complainant further holds registrations for other trademarks in Class 36, containing the words "INSURE MY". Complainant asserts that, due to substantial and exclusive use of the marks for approximately 9 years, the same have become well-known and famous in the fields of travel insurance services (copies of articles submitted as Exhibit E of the Complaint). In addition, the Complainant has used the domain name <insuremytrip.com> for over 8 years in connection with its travel insurance services.

Complainant accuse the Respondent to be a known cybersquatter which engages in a pattern of registering domain names which incorporate the trademarks of others, parking them on click-through sites for commercial gain, promising to transfer the domain names to the trademark owners when they complain, and then failing to do so for as long as possible, in order to maximize its illegitimate revenues. Complainant argues that Respondent has registered and used the disputed domain name to divert Internet users to websites which offer travel insurance related services that compete with Respondent's services. Complainant has repeatedly attempted to resolve the matter by notifying Respondent of Complainant's rights in and to the trademarks and seeking a transfer of the domain name to the Complainant (copies of correspondence provided as Exhibit F of the Complaint).

According to the Complainant, <insurancemytrip.com> is confusingly similar to Complainant's trademarks as it incorporates all elements of the marks, specifically "INSUR*MYTRIP". Complainant refers to two other UDRP cases, wherein Respondent was found to have used the same tactic.

The Complainant states that Respondent has no rights or legitimate interests in respect of the disputed domain name, as Respondent is not authorized by Complainant to use the marks in a domain name, is not commonly known by the domain name and is not using the same for a bona fide offering of goods or services or for a legitimate noncommercial or fair use.

Finally, Complainant states that Respondent registered and is using <**insurancemytrip.com**> in bad faith. In this respect, the Complainant refers to that Respondent is using the domain name to provide links to Complainant's competitors for Respondent's presumed commercial benefit, that Respondent has repeatedly been found to violate the Policy by registering and using domain names in bad faith (herewith referring to a large number of previous cases rendered against the Respondent), and that Respondent had actual and/or constructive notice of Complainant's rights before the registration of the disputed domain name.

B. Respondent

Respondent agrees to the relief requested by the Complainant and declares that it will, upon order of the Panel, transfer the domain name at issue. Respondent states that this agreement is not an admission of the three elements of 4(a) of the Policy but rather an offer of a "unliteral consent to transfer".

Respondent, referring to some previous UDRP decisions, argues that as Respondent has agreed to the transfer, judicial economy dictates that the Panel should simply proceed to its decision as there is no dispute between the parties and no need for a decision on the merits. Respondent requests, should the Panel decide that analysis is required, to be given the opportunity to prepare a more formal Response.

FINDINGS

The Complainant is the owner of valid U.S. Trademark Registrations for INSUREMYTRIP.COM (registered July 27, 2004), INSURE MY TRIP (registered October 18, 2005), and others consisting of the part "INSURE MY". Both INSUREMYTRIP.COM and INSURE MY TRIP have been used in commerce for insurance related services since June 1, 2000.

Respondent seems to have registered the disputed domain name on March 19, 2005. Respondent has used <**insurancemytrip.com**> to provide links to insurance service related sites.

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."

Respondent suggest the Panel not make the traditional analysis, but to proceed immediately to a decision granting the request for transfer as Respondent has so accepted.

This Panel may, under certain circumstances, have granted the request for immediate transfer without any analysis, for example if the Respondent had shown that the domain name had been registered in his name but without its / his knowledge, or the registration was made out of an excusable mistake. This is not the case in this dispute.

Respondent further request to be given the opportunity to prepare a more formal Response, should the Panel decide that analysis is required. However, Respondent has already been given the full opportunity to file a formal Response, but has chosen to only deal with the issue of immediate transfer.

The Panel finds that the “consent-to-transfer” approach is but one way for presumed cybersquatters to avoid adverse findings against them. *See Graebel Van Lines, Inc. v. Tex. Int’l Prop. Assocs.*, FA 1195954 (Nat. Arb. Forum July 17, 2008) (“Respondent has admitted in his response to the complaint of Complainant that it is ready to offer the transfer without inviting the decision of the Panel in accordance with the Policy. However, in the facts of this case, the Panel is of the view that the transfer of the disputed domain name deserves to be along with the findings in accordance with the Policy”). *See also Imperial Chemical Indus. PLC v. RareNames* (WIPO Case No. D2006-0124) (“Of course, where the respondent stipulates that the domain name be transferred without contest, the complainant can withdraw the complaint and finalise the acquisition of the domain name. But otherwise, the panel should consider the matters raised before it and proceed to carry out its function in making a determination according to the Policy”).

In summary: The Panel will proceed to decide the case on the merits, and Respondents request for additional filing of a “formal” response is denied.

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) 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.

Identical and/or Confusingly Similar

Complainant has established rights in the INSUREMYTRIP.COM trademark in the U.S. through Registration No. 2,866,245 (registered on July 27, 2004) as well as in the INSURE MY TRIP trademark in the U.S. through Registration No 3,007,162 (first used in commerce on June 1, 2000; application filed on August 9, 2004; registered on October 18, 2005). *See Trip Network Inc. v. Alvierra*, FA 914943 (Nat. Arb. Forum Mar. 27, 2007) (finding that the complainant’s federal trademark registrations for the CHEAPTICKETS and CHEAPTICKETS.COM marks were adequate to establish its

rights in the mark pursuant to Policy ¶ 4(a)(i); *see also Innomed Techs., Inc. v. DRP Servs.*, FA 221171 (Nat. Arb. Forum Feb. 18, 2004) (“Registration of the NASAL-AIRE mark with the USPTO establishes Complainant’s rights in the mark.”).

Respondent’s domain name registration <**insurancemytrip.com**> differs from Complainant’s mark INSURE MY TRIP in three ways: (1) the first term “INSURE” has been changed to the variant “INSURANCE;” (2) the spaces between the words have been removed; and (3) the generic top-level domain (gTLD) “.com” has been added. The Panel finds that replacing a term in a mark with another that shares a dominant element with that term will not sufficiently distinguish a domain name from a mark for the purposes of Policy ¶ 4(a)(i), nor will removing the spaces from between the terms of a mark. *See Modern Props, Inc. v. Wallis*, FA 152458 (Nat. Arb. Forum June 2, 2003) (“Notwithstanding the analysis by Respondent, ‘modprops’ is a contraction or shorthand for ‘Modern Props.’ ‘Mod’ connotes [sic] ‘modern’ regardless of any other dictionary meanings, so the names are substantially similar in meaning.”); *see also Bama Rags, Inc. v. Zuccarini*, FA 94380 (Nat. Arb. Forum May 8, 2000) (finding that <davemathewsband.com> is a common misspelling of the DAVE MATTHEWS BAND mark and therefore confusingly similar).

Furthermore, the addition of the generic top-level domain “.com” is insufficient to distinguish the domain name from Complainant’s mark INSURE MY TRIP but, on the contrary, even increase the similarity with Complainant’s mark INSUREMYTRIP.COM.

Accordingly, the Panel finds that the disputed domain name is confusingly similar to Complainant’s INSUREMYTRIP.COM and INSURE MY TRIP (used and filed before the registration of Respondent’s domain name) trademarks. Policy ¶ 4(a)(i) has been satisfied.

Rights or Legitimate Interests

Complainant’s assertion that Respondent lacks rights or legitimate interests in the disputed domain name establishes a *prima facie* case under the Policy.

Once a *prima facie* case has been established, the burden shifts to Respondent to demonstrate that it does have rights or legitimate interests pursuant to Policy ¶ 4(c). *See Do The Hustle, LLC v. Tropic Web*, D2000-0624 (WIPO Aug. 21, 2000) (holding that, where the complainant has asserted that the respondent has no rights or legitimate interests with respect to the domain name, it is incumbent on the respondent to come forward with concrete evidence rebutting this assertion because this information is “uniquely within the knowledge and control of the respondent.”); *see also G.D. Searle v. Martin Mktg.*, FA 118277 (Nat. Arb. Forum Oct. 1, 2002) (“Because Complainant’s Submission constitutes a *prima facie* case under the Policy, the burden effectively shifts to Respondent. Respondent’s failure to respond means that Respondent has not presented any circumstances that would promote its rights or legitimate interests in the subject domain name under Policy ¶ 4(a)(ii).”).

Respondent has not established in any way that it is known by the domain name at issue. *See Broadcom Corp. v. Intellifone Corp.*, FA 96356 (Nat. Arb. Forum Feb. 5, 2001) (finding no rights or legitimate interests because the respondent is not commonly known by the disputed domain name or using the domain name in connection with a legitimate or fair use); *see also Wells Fargo & Co. v. Onlyne Corp. Services11, Inc.*, FA 198969 (Nat. Arb. Forum Nov. 17, 2003) (“Given the WHOIS contact information for the disputed domain [name], one can infer that Respondent, Onlyne Corporate Services11, is not commonly known by the name ‘welsfargo’ in any derivation.”).

Respondent maintains a website at the <**insurancemytrip.com**> domain name that features links to third-party websites offering services in competition with Complainant’s business. Complainant contends that Respondent commercially benefits from these links by collecting “click-through” fees from the third-party websites. The Panel finds that this use of the disputed domain name is neither a *bona fide* offering of goods or services under Policy ¶ 4(c)(i) nor a legitimate noncommercial or fair use under Policy ¶ 4(c)(iii). *See Wells Fargo & Co. v. Lin Shun Shing*, FA 205699 (Nat. Arb. Forum Dec. 8, 2003) (finding that using a domain name to direct Internet traffic to a website featuring pop-up advertisements and links to various third-party websites is neither a *bona fide* offering of goods or services under Policy ¶ 4(c)(i) nor a legitimate noncommercial or fair use under Policy ¶ 4(c)(iii) because the registrant presumably receives compensation for each misdirected Internet user).

The Panel concludes that the Respondent has no rights or legitimate interests in the Domain Name, and finds for Complainant under Policy ¶ 4(a)(ii).

Registration and Use in Bad Faith

Complainant asserts that Respondent has a pattern of registering and using domain names containing others’ trademarks, which has resulted in Respondent being the subject of multiple UDRP proceedings wherein many panels have concluded that Respondent registered and used domain names in bad faith. *See, e.g., Xojet Inc. v. Tex. Int’l Prop. Assocs.*, FA 1105705 (Nat. Arb. Forum, Dec. 24, 2007); *Endurance Specialty Holdings Ltd. v. Tex. Int’l Prop. Assocs. – NA NA*, FA 1103617 (Nat. Arb. Forum, Dec. 27, 2007).

The Panel finds that this pattern evidences Respondent’s bad faith registration and use of the <**insurancemytrip.com**> domain name pursuant to Policy ¶ 4(b)(ii). *See Westcoast Contempo Fashions Ltd. v. Manila Indus., Inc.*, FA 814312 (Nat. Arb. Forum Nov. 29, 2006) (finding bad faith registration and use pursuant to Policy ¶ 4(b)(ii) where the respondent had been subject to numerous UDRP proceedings where panels ordered the transfer of disputed domain names containing the trademarks of the complainants); *see also Armstrong Holdings, Inc. v. JAZ Assocs.*, FA 95234 (Nat. Arb. Forum Aug. 17, 2000) (finding that the respondent violated Policy ¶ 4(b)(ii) by registering multiple domain names that infringe upon others’ famous and registered trademarks).

Complainant contends that Respondent has been diverting Internet customers seeking Complainant's website to Respondent's website that resolves from the disputed domain name and competes with Complainant for business. Complainant also contends that Respondent intentionally disrupts Complainant's business by its diversionary tactics. The Panel finds that this behavior is evidence of Respondent's registration and use in bad faith pursuant to Policy ¶ 4(b)(iii). *See Persohn v. Lim*, FA 874447 (Nat. Arb. Forum Feb. 19, 2007) (finding bad faith registration and use pursuant to Policy ¶ 4(b)(iii) where a respondent used the disputed domain name to operate a commercial search engine with links to the complainant's competitors).

A further evidence of bad faith is Respondent's presumed commercially gain from the diversion through the click-through fees Respondent receives from the third-party websites. *See AltaVista Co. v. Krotov*, D2000-1091 (WIPO Oct. 25, 2000) (finding bad faith under Policy ¶ 4(b)(iv) where the respondent's domain name resolved to a website that offered links to third-party websites that offered services similar to the complainant's services and merely took advantage of Internet user mistakes).

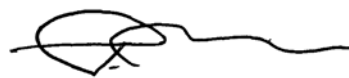
The fact that Respondent has registered a domain name that is confusingly similar with at least two of Complainant's earlier trademarks, and then used the said domain name for competing services is clearly not just a coincidence.

The Panel concludes that Respondent registered and has been using the disputed domain name in bad faith.

DECISION

Having established all three elements required under the ICANN Policy, the Panel concludes that relief shall be **GRANTED**.

Accordingly, it is Ordered that the <**insurancemytrip.com**> domain name be **TRANSFERRED** from Respondent to Complainant.



Petter Rindforth, Esq.
Arbitrator

Petter Rindforth, Panelist
Dated: June 15, 2009

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