



# CPR Institute for Dispute Resolution

File Number: CPR 0407  
Date of Commencement: November 8, 2004  
Domain Name: capitas.com  
Registrar: Network Solutions, LLC

## COMPLAINANT

Name: Capitas Financial, LLC, a Delaware limited liability company  
Address: 710 Interchange Tower, 600 South Highway 169, Minneapolis, MN 55426  
Attn. Blake Mohr  
Tel: 952-544-0709  
Fax: 952-544-0708  
E-mail: blake.mohr@capitasfinancial.com

vs.

## RESPONDENT

Name: Warren James, Architect  
Address: 251 West 19<sup>th</sup> Street, New York, NY 10011-4043  
Telephone: 212-691-0980  
Fax: 212-691-4141  
E-mail: warrenjames@juno.com

Before Thomas M. Pitegoff, Esq., Arbitrator

## PROCEDURAL HISTORY

The Complaint was filed with CPR Institute for Dispute Resolution (CPR) on November 5, 2004. After review for administrative compliance, CPR served the Complaint on Respondent. Respondent filed a Response on December 9, 2004. On December 10, 2004, CPR appointed me as Arbitrator pursuant to the Uniform Domain Name Dispute Resolution Policy (UDRP) and the Rules for UDRP (the "Rules") promulgated by the Internet Corporation for Domain Names and Numbers (ICANN).

The Response was not filed in within the time period required under the UDRP. On November 10, 2004, Respondent submitted an e-mail to CPR requesting hard copies of all communications because Respondent was unable to open the e-mail attachments, and requesting 30 days to file a Response. Respondent received a hard copy of the Complaint on November 13, 2004, and filed a

Response 26 days later. I accept the late filing in view of my authority under Section 10 (c) of the Rules to extend, in exceptional cases, a period of time fixed by the Rules.

Upon the written submitted record including the Complaint and its attachments and the Response and its attachments, I find as follows:

### **FINDINGS**

Respondent's domain name, CAPITAS.COM, was registered with Network Solutions, LLC, on October 21, 1999. In registering the name with Network Solutions, LLC, an ICANN accredited registrar, Respondent agreed to submit to this forum to resolve any dispute concerning the domain names, pursuant to the UDRP.

The UDRP provides, at Paragraph 4(a), that each of three findings must be made in order for a Complainant to prevail:

- i. Respondent's domain name must be identical or confusingly similar to a trademark or service mark in which complainant has rights; and
- ii. Respondent has no rights or legitimate interests in respect of the domain name; and
- iii. Respondent's domain name has been registered and is being used in bad faith.

### **IDENTITY/CONFUSING SIMILARITY**

UDRP Paragraph 4(a)(i) calls for a finding that Respondent's domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights.

Complainant alleges that the domain name CAPITAS.COM is identical or confusingly similar to Complainant's trademark, CAPITAS, which was registered in the U.S. Patent and Trademark Office December 10, 2002, in International Class 36, for use in conjunction with life insurance brokerage services. Complainant alleges use of the mark since December 2001.

With the exception of the ".com" extension, the domain name CAPITAS.COM is identical to Complainant's registered trademark.

I therefore conclude that the registered domain name is identical or confusingly similar to Complainant's protected mark.

### **RIGHTS AND LEGITIMATE INTERESTS**

Complainant alleges that Respondent has no rights or legitimate interests with respect to the domain name at issue. The basis of this allegation appears to be the fact that Complainant has not

made use of the domain name. Complainant states that Complainant filed its Complaint in order to “protect the image of Complainant’s business in the marketplace as a sophisticated and resource-rich business, which will be undercut if prospective business partners and customers are lead to the Disputed Domain Name webpage, which is an inactive website.”

UDRP Paragraph 4(c) provides that Respondent’s rights or legitimate interests in a domain name may be demonstrated, without limitation, by showing that (a) before notice to Respondent of the dispute, Respondent has used, or made demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services; or (b) Respondent has been commonly known by the domain name; or (c) Respondent is making legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

Respondent states that his family formed a corporation in Puerto Rico in July 1999, called Capitas, Inc., to provide outpatient mental health services in Arecibo, Puerto Rico, expanding upon the services of an existing family business, in operation since 1986, which provided medical and psychological services. Respondent was to be the designer of the graphics and the expanded facilities. Respondent registered the domain name at issue a few months later, on October 21, 1999. Respondent states, further, that Capitas, Inc., has been in operation since then and has grown as a mental health center in Puerto Rico providing psychiatric, medical, psychological and related outpatient services in an integrated fashion to thousands of patients. A prototype of the website was designed but has not yet been linked to the disputed domain name. Respondent states that Respondent has always intended to use the domain name for a website in connection with Capitas, Inc.

Respondent contends that until Respondent received a call from a representative of Complainant sometime in September or October of 2004, Respondent had no knowledge of Complainant or of anyone at Complainant’s company. The purpose of the call was to offer to buy the now disputed domain name for \$10,000. Respondent called back a few days later to decline the offer.

Respondent has shown that, before notice to Respondent of the dispute, Respondent has used, or made demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services. Respondent has also shown that Respondent has been commonly known by the domain name. Moreover, Respondent was formed under and was using a name corresponding to the domain name more than two years before Complainant’s alleged first use of the mark, and Respondent uses the name for services that are entirely different from life insurance brokerage services.

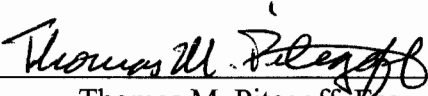
I therefore conclude that Respondent does have rights or legitimate interests with respect to the domain name at issue. Accordingly, there is no need to reach the question of bad faith.

## CONCLUSION

In light of the finding above that Respondent does have rights or legitimate interests with respect to the domain name at issue, I find in favor of Respondent.

## REMEDY

Complainant's request to cancel or transfer the domain name CAPITAS.COM is hereby DENIED.

  
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Thomas M. Pitegoff, Esq.

December 20, 2004  
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Date