



CPR Institute for Dispute Resolution

COMPLAINANT

Luther Burbank Savings
804 Fourth Street
Santa Rosa, CA 85404
Telephone (707) 523-9876
Fax (707) 526-7844
E-mail jbiggs@lbsavings.com

vs.

RESPONDENT

USA Domain Name, Inc.;
Bank of Domain;
Domain Protector;
Domains for All
P.O. Box 1212
New York, NY 10159
Telephone (212) 375-0663
Fax (212) 214-0924
E-mail contact@USUDN.COM
USA8il@AOL.COM
INFO@USUDN.COM

Before Gaynell C. Methvin, Arbitrator

File Number: CPR010106

Date of Commencement: May 21, 2001

Domain Names: LUTHERBURBANKSAVINGS.COM
LUTHERSAVINGS.COM
LUTHERBURBANKSAVINGS.NET
LUTHERSAVINGS.NET

Registrar: Network Solutions

Arbitrator: Gaynell C. Methvin

PROCEDURAL HISTORY

The Complaint was filed with CPR on May 18, 2001. Complainant transmitted a copy of the Complaint to Respondent. After review for administrative compliance, CPR transmitted a copy of the Complaint to Respondent on May 21, 2001, via mail and via e-mail. CPR referred Respondent to CPR's website for information regarding the filing of a response. On May 21, 2001, Respondent transmitted to CPR an e-mail in which Respondent admits that there is no dispute over the ownership of the domain names at issue, but that Respondent has listed Luther Burbank Savings as the owner of the domain names in dispute at their site. Further, Respondent provided directions to Complainant as to how, in its view, the problem could be solved through NSI ("Network Solutions"). Respondent, however, did not offer to take the steps necessary to clarify the problem. On June 13, 2001, CPR appointed the undersigned as Arbitrator pursuant to the Uniform Domain Name Dispute Resolution Policy ("UDRP") and Rules promulgated by the Internet Corporation for Domain Names and Numbers (ICANN). Upon the written submitted record which comprises the Complaint and accompanying exhibits, Respondent's e-mail, the Arbitrator finds as follows:

FINDINGS

Respondent's registered domain names: LUTHERBURBANKSAVINGS.COM; LUTHERSAVINGS.COM; LUTHERBURBANKSAVINGS.NET; and LUTHERSAVINGS.NET, were registered with Network Solutions, date unknown. In registering the names with Network Solutions, 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 is 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: The Complaint alleges the domain names at issue are confusingly similar to Complainant's mark, LUTHER BURBANK SAVINGS and its Internet domain names LUTHERBSAVINGS.COM and LBSAVINGS.COM. It is plain on the faces of the disputed domain names and the mark and Internet domain names of Complainant that they are confusingly similar.

Complainant has rights in the Luther Bank Savings mark and domain names LUTHERBSAVINGS.COM and LBSAVINGS.COM. Complainant certifies that its mark is nationally known as designating the banking services of Luther Bank Savings.

On the basis of this record, the Arbitrator concludes that the registered domain names in dispute are confusingly similar to the Complainant's mark and domain names and Complainant has rights in that mark and such domain names.

RIGHTS AND LEGITIMATE INTERESTS: Complainant alleges that Respondent has no rights or legitimate interests with respect to the domain names at issue. In support for this allegation, Complainant avers that Complainant became aware of Respondent's domain names in December 2000. Complainant avers that its counsel sent a cease and desist letter to Respondent on December 27, 2000 and that Respondent responded by e-mail on December 29, 2000 claiming that the domain names at issue were ordered by Respondent for use of by Luther Burbank's Savings. Complainant alleges that it quickly informed Respondent that this was incorrect by letter dated March 7, 2001. Respondent did not respond to this letter dated March 7, 2001.

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 has not filed a formal response to the Complaint, but sent an e-mail to CPR claiming there was some mistake in the filing of the dispute and that the Respondent had listed Luther Bank Savings as the owner of the domain names at issue and, admitted that there was no dispute over ownership of the domain names and suggested certain steps that Complainant could take through Network Solutions' website to clarify the problem. However, Respondent's e-mail made it clear that it would have a role in approving the requested changes that Respondent suggested Luther Burbank Savings make through Network Solutions. Nothing in this record supports any inference that any of the three illustrative circumstances of UDRP Paragraph 4.(c) exist. It is fair to infer from Respondent's e-mail that it has no evidence to support a finding that it has rights or legitimate interests in the domain names in issue.

On the basis of this record, the Arbitrator concludes that Respondent does not have rights or legitimate interests with respect to the domain names at issue.

BAD FAITH: In support of the contention of Respondent's bad faith registration and use, Complainant avers that (1) the mark of Complainant is known nationally as designating the bank services of Luther Burbank Savings and that it has built up goodwill in its marks over the years leading the mark to be one of its greatest assets; (2) Respondent's use of the domain names is likely to cause confusion, deception or mistake among the public, as it suggests a relationship between the Respondent and Complainant that does not exist which constitutes trademark infringement under federal law; (3) Respondent's use of the domain names is likely to dilute the association between Complainant and its mark; (4) Respondent did not respond to Complainant's counsel's letter of March 7, 2001; (5) Respondent is offering the domain names for lease or sale to any party, has no legitimate interest in the franchise value of Complainant's names and has registered the domain names in bad faith; (6) Respondent's conduct has caused Complainant to be unable to use its own domain names. Implicit in Complainant's averments is that respondent is not using the domain names.

Paragraph 4(a) of the UDRP requires that Complainant establish bad faith with respect both registration and use.

Complaint does not address bad faith use specifically perhaps because of its averments which lead to the undisputed conclusion of non-use by Respondent. It is clear from many other decisions under Paragraph 4 that non-use under the circumstances prevailing here can be tantamount to bad faith registration and use.

Paragraph 4(b) of the UDRP provides that indications of bad faith include, without limitation, (a) registration for the purposes of selling, renting or transferring the domain name to the Complainant for value in excess of Respondent's cost; (b) a pattern of registration in order to prevent Complainant from reflecting the mark in a corresponding domain name; (c) registration for the primary purpose of disrupting the business of a competitor; or (d) an intentional attempt to attract, for commercial gain, Internet users to Respondent's web site by creating a likelihood of confusion with 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.

Complainant's certified averments are entirely plausible. Its inferences are not unreasonable. Respondent admitted that it has no rights in the ownership of the mark and otherwise elected to stand silent. It is fair to accept Complainant's averments and inferences.

Accordingly, on this record, the Arbitrator concludes that Respondent did register and use the domain names in bad faith under Paragraph 4(a)(iii).

CONCLUSION

In light of the findings above that (a) the registered domain names are confusingly similar to Complainant's mark; (b) Respondent does not have rights or legitimate interests with respect to the domain names at issue; and (c) Respondent has registered and used the domain names in bad faith, as that term is defined in the ICANN Policy, I find in favor of the Complainant.

REMEDY

Complainant's request to transfer the domain names to Complainant is GRANTED. The domain names shall be transferred to Complainant Luther Bank Savings.

Signature of Arbitrator

Date

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