



NATIONAL ARBITRATION FORUM

DECISION

AmeriServ Financial, Inc. v. Michele Dinoia d/b/a SZK.com
Claim Number: FA0603000661368

PARTIES

Complainant is **AmeriServ Financial Inc.** (“Complainant”), represented by **Robert A Diaz**, of **Eckert Seamans Cherin & Mellott, LLC**, 600 Grant Street, 44th Floor, Pittsburgh, PA 15219. Respondent is **Michele Dinoia d/b/a SZK.com** (“Respondent”), Via Trilussa 11, Pineto, TE 64025, Italy.

REGISTRAR AND DISPUTED DOMAIN NAME

The domain name at issue is <**ameriserv.com**>, registered with **Onlinenic, Inc.**

PANEL

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

Houston Putnam Lowry, Chartered Arbitrator, as Panelist.

PROCEDURAL HISTORY

Complainant submitted a Complaint to the National Arbitration Forum electronically on March 16, 2006; the National Arbitration Forum received a hard copy of the Complaint on March 24, 2006.

On Mar 17, 2006, Onlinenic, Inc. confirmed by e-mail to the National Arbitration Forum that the <**ameriserv.com**> domain name is registered with Onlinenic, Inc. and that Respondent is the current registrant of the name. Onlinenic, Inc. has verified that Respondent is bound by the Onlinenic, Inc. 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 March 24, 2006, a Notification of Complaint and Commencement of Administrative Proceeding (the "Commencement Notification"), setting a deadline of April 13, 2006 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@ameriserv.com by e-mail.

Having received no response from Respondent, the National Arbitration Forum transmitted to the parties a Notification of Respondent Default.

On April 20, 2006, pursuant to Complainant's request to have the dispute decided by a single-member Panel, the National Arbitration Forum appointed Houston Putnam Lowry, Chartered Arbitrator, as Panelist.

Having reviewed the communications records, the Administrative Panel (the "Panel") finds that the National Arbitration Forum has discharged its responsibility under Paragraph 2(a) of the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules") "to employ reasonably available means calculated to achieve actual notice to Respondent." Therefore, the Panel may issue its decision based on the documents submitted and in accordance with the ICANN Policy, ICANN Rules, the National Arbitration Forum's Supplemental Rules and any rules and principles of law that the Panel deems applicable, without the benefit of any response from Respondent.

RELIEF SOUGHT

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

PARTIES' CONTENTIONS

A. Complainant makes the following assertions:

Trademark/Service Mark Information: The following United States Trademarks are owned by the Complainant.

1. **AMERISERV**: U.S. Trademark Registration No. 2,795,956.

Description of the goods: banking services; corporate, institutional and personal trust services; financial planning and portfolio management; brokerage in the fields of bonds, insurance, annuities and mutual funds; mortgage banking, lending and brokerage services; estate administration services; title insurance services; maintaining mortgage escrow accounts and credit life reinsurance services.

2. **AMERISERV PREMIER EQUITY DISCIPLINE**: U.S. Trademark Registration No. 3,052,636.

Description of the goods: Investment advisory services

3. **AMERISERV FINANCIAL**: U.S. Trademark Registration No. 2,751,280

Description of the goods: Banking services; Corporate, institutional and personal trust services; Financial planning and portfolio management; Brokerage in the fields of bonds, insurance, annuities and mutual funds; Mortgage banking, lending and brokerage services; Estate administration services; Title insurance services; Maintaining mortgage escrow accounts; and Credit life reinsurance services.

4. **AMERISERV PREFERRED**: U.S. Trademark Registration No. 2,760,191

Description of the goods: Banking services; Corporate, institutional and personal trust services; Financial planning and portfolio management; Brokerage in the fields of

bonds, insurance, annuities and mutual funds; Mortgage banking, lending and brokerage services; Estate planning and trust management.

5. **AMERISERV TRUST & FINANCIAL SERVICES:** U. S. Trademark Registration No. 2,748,573

Description of the goods: Corporate, institutional and personal trust services; Financial planning and portfolio management; and Estate administration services.

6. **AMERISERV FINANCIAL:** U. S. Trademark Registration No. 2,751,279

Description of the goods: Banking services; corporate, institutional and personal trust services; financial planning and portfolio management; brokerage in the fields of bonds, insurance, annuities and mutual funds; mortgage banking, lending and brokerage services; estate administration services; title insurance services; maintaining mortgage escrow accounts; and credit life reinsurance services.

7. **AMERISERV TRUST & FINANCIAL SERVICES CO.:** U.S. Trademark Registration No. 2,816,933

Description of the goods: Corporate, institutional and personal trust services; Financial planning and portfolio management; Estate administration services; and mutual fund services, namely, establishing mutual funds for others.

8. **AMERISERV TRUST & FINANCIAL SERVICES CO.:** U.S. Trademark Registration No. 2,816,932

Description of the goods: Corporate, institutional and personal trust services; Financial planning and portfolio management; Estate administration services; and mutual fund services, namely, establishing mutual funds for others.

9. **AMERISERV ASSOCIATES:** U.S. Trademark Registration No. 2,762,366

Description for the goods: Portfolio and investment consulting services.

10. **AMERISERV LEASING:** U.S. Trademark Registration No. 2,719,868

Description for the goods: Lease purchase financing; and Lease processing services for others.

11. **AMERISERV FINANCIAL SERVICES:** U. S. Trademark Registration No. 2,652,600

Description for the goods: Investment consulting; Brokerage in the fields of mutual funds, annuities and insurance; and Title insurance services.

12. **AMERISERV ASSOCIATES:** U. S. Trademark Registration No. 2,730,051

Description for the goods: Portfolio and investment consulting services.

13. **AMERISERV LEASING:** U. S. Trademark Registration No. 2,722,190

Description for the goods: Lease purchase financing; and Lease processing services for others.

14. **AMERISERV FINANCIAL SERVICES:** U.S. Trademark Registration No. 2,647,009

Description for the goods: Investment consulting; Brokerage in the fields of mutual funds, annuities and insurance; and Title insurance services.

15. **AMERISERV TRUST & FINANCIAL SERVICES:** U.S. Trademark Registration No. 2,666,902

Description for the goods: Corporate, institutional and personal trust services; Financial planning and portfolio management; and Estate administration services.

16. **AMERISERV FINANCIAL:** U.S. Trademark Registration No. 2,643,670

Description for the goods: Banking services; corporate, institutional and personal trust services; financial planning and portfolio management; financial brokerage in the fields of bonds, insurance, annuities and mutual funds; mortgage banking, lending and brokerage services; estate administration services; title insurance services; maintaining mortgage escrow accounts; credit life reinsurance services.

FACTUAL AND LEGAL GROUNDS

This Complaint is based on the following factual and legal grounds:

[a.] Pursuant to ICANN Rule 3(b)(ix)(1), the Complainant asserts that the Respondent's <ameriserv.com> domain name is **identical** to Complainant's AMERISERV trademark which has acquired goodwill as a result of Complainant's expenditure of time, money, and resources.

Moreover, the Respondent's <ameriserv.com> domain name is **confusingly similar** to the following trademarks which have also acquired goodwill as a result of Complainant's efforts because the Respondent's <ameriserv.com> domain name incorporates the word "ameriserv": AMERISERV PREMIER EQUITY DISCIPLINES; AMERISERV FINANCIAL; AMERISERV PREFERRED; AMERISERV TRUST & FINANCIAL SERVICES; AMERISERV TRUST & FINANCIAL SERVICES CO.; AMERISERV ASSOCIATES; AMERISERV LEASING; and AMERISERV FINANCIAL SERVICES

[b.] Pursuant to ICANN Rule 3(b)(ix)(2), the Complainant asserts that it has not licensed or otherwise permitted the Respondent to use any of its marks or apply for or use any domain name incorporating its mark.

Furthermore, Complainant asserts that the Respondent commercially benefits from the misleading domain name by redirecting unsuspecting Internet users to various third party commercial websites.

[c.] Pursuant to ICANN Rule 3(b)(ix)(3), the Complainant asserts that the Respondent has registered and used the <ameriserv.com> domain name in bad faith because the Respondent has a long history of registering domain names that are identical or confusingly similar to marks legitimately owned by trademark or service mark holders throughout the world. See *Geoffrey Inc. v. Dinoia*, FA 104089 (Nat. Arb. Forum Feb. 25, 2002) (transferring Respondent's registration of the <kidsrus.com> domain name to Complainant); see also *Venator Group Regail Inc. v. Dinoia*, FA 101506 (Nat. Arb. Forum Dec. 10, 2001); see also *Anheuser-Busch, Inc. v. Dinoia*, FA 114465 (Nat. Arb. Forum July 15, 2002) (involving Respondent's registration of the <anheuserbusch.com> domain name); see also *Alcoa Inc. v. Dinoia*, FA 227654 (Nat. Arb. Forum March 3, 2004).

The Complainant also asserts that the Respondent is using the <ameriserv.com> domain name to intentionally attract for commercial gain, Internet users to its website, by creating a likelihood of confusion with the Complainant as to the source, sponsorship, affiliation and/or endorsement of its website.

B. Respondent failed to submit a Response in this proceeding.

FINDINGS

Complainant, Ameriserv Financial, Inc., provides customers with various financial services including banking services, investment services, trust services, and mortgage lending services. Complainant has registered numerous marks in connection with the provision of these services, particularly the AMERISERV mark that has been registered with the United States Patent and Trademark Office ("USPTO") (Reg. No. 2,795,956 issued December 16, 2003, filed February 12, 2001).

Respondent registered the <ameriserv.com> domain name on August 3, 2003. Respondent's domain name resolves to a website that features links to various competing and non-competing commercial websites.

DISCUSSION

Paragraph 15(a) of 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."

In view of Respondent's failure to submit a response, the Panel shall decide this administrative proceeding on the basis of Complainant's undisputed representations pursuant to paragraphs 5(e), 14(a) and 15(a) of the Rules and draw such inferences it considers appropriate pursuant to paragraph 14(b) of the Rules. The Panel is entitled to accept all reasonable allegations and inferences set forth in the Complaint as true unless the evidence is clearly contradictory. See *Vertical Solutions Mgmt., Inc. v. webnet-marketing, inc.*, FA 95095 (Nat. Arb. Forum July 31, 2000) (holding that the respondent's failure to respond allows all reasonable inferences of fact in the allegations

of the complaint to be deemed true); *see also Talk City, Inc. v. Robertson*, D2000-0009 (WIPO Feb. 29, 2000) (“In the absence of a response, it is appropriate to accept as true all allegations of the Complaint.”).

Paragraph 4(a) of the Policy requires that 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 Respondent is identical or confusingly similar to a trademark or service mark in which Complainant has rights; and
- (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 and/or Confusingly Similar

Complainant has established rights in the AMERISERV mark through registration with the USPTO. Moreover, Complainant’s rights date back to the time of filing of the trademark application, which occurred on February 12, 2001. Respondent registered the <ameriserv.com> domain name on August 3, 2003. Consequently, Complainant’s rights in the AMERISERV mark predate the registration of the disputed domain name. *See Men’s Wearhouse, Inc. v. Wick*, FA 117861 (Nat. Arb. Forum Sept. 16, 2002) (“Under U.S. trademark law, registered marks hold a presumption that they are inherently distinctive [or] have acquired secondary meaning”); *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.”); *see also Thompson v. Zimmer*, FA 190625 (Nat. Arb. Forum Oct. 27, 2003) (“As Complainant’s trademark application was subsequently approved by the U.S. Patent and Trademark Office, the relevant date for showing ‘rights’ in the mark for the purposes of Policy ¶4(a)(i) dates back to Complainant’s filing date.”).

Complainant contends Respondent’s <ameriserv.com> domain name is identical to Complainant’s mark. Respondent’s disputed domain name features Complainant’s entire AMERISERV mark and adds the generic top-level domain (“gTLD”) “.com.” The Panel finds the addition of a gTLD is irrelevant when determining whether a domain name is identical to a mark pursuant to Policy ¶4(a)(i). *See Pomellato S.p.A v. Tonetti*, D2000-0493 (WIPO July 7, 2000) (finding <pomellato.com> identical to the complainant’s mark because the generic top-level domain (gTLD) “.com” after the name POMELLATO is not relevant); *see also Rollerblade, Inc. v. McCrady*, D2000-0429 (WIPO June 25, 2000) (finding that the top level of the domain name such as “.net” or “.com” does not affect the domain name for the purpose of determining whether it is identical or confusingly similar).

The Panel finds Policy ¶4(a)(i) satisfied.

Rights or Legitimate Interests

Complainant has alleged Respondent does not have rights or legitimate interests in the <ameriserv.com> domain name. Once Complainant makes a *prima facie* case in support of its allegations, the burden shifts to Respondent to show rights or legitimate interests. Due to Respondent's failure to respond to the Complaint, the Panel infers Respondent does not have rights or legitimate interests in the disputed domain name. *See G.D. Searle v. Martin Mktg.*, FA 118277 (Nat. Arb. Forum Oct. 1, 2002) (holding that, where the complainant has asserted that respondent does not have rights or legitimate interests with respect to the domain name, it is incumbent on 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 Clerical Med. Inv. Group Ltd. v. Clericalmedical.com*, D2000-1228 (WIPO Nov. 28, 2000) (finding that, under certain circumstances, the mere assertion by the complainant that the respondent does not have rights or legitimate interests is sufficient to shift the burden of proof to the respondent to demonstrate that such a right or legitimate interest does exist); *see also Broadcom Corp. v. Ibecom PLC*, FA 361190 (Nat. Arb. Forum Dec. 22, 2004) ("Respondent's failure to respond to the Complaint functions as an implicit admission that [Respondent] lacks rights and legitimate interests in the disputed domain name. It also allows the Panel to accept all reasonable allegations set forth...as true."). However, the Panel chooses to analyze whether the evidence supports rights or legitimate interests.

Complainant contends Respondent's domain name resolves to a website that features links to various competing and non-competing commercial websites from which Respondent presumably receives referral fees. The Panel finds Respondent's use of the infringing domain name that includes Complainant's AMERISERV mark in its entirety for Respondent's own commercial gain is neither a *bona fide* offering of goods or services pursuant to Policy ¶4(c)(i) nor a legitimate non-commercial or fair use pursuant to Policy ¶4(c)(iii). *See WeddingChannel.com Inc. v. Vasiliev*, FA 156716 (Nat. Arb. Forum June 12, 2003) (finding that the respondent's use of the disputed domain name to redirect Internet users to websites unrelated to the complainant's mark, websites where the respondent presumably receives a referral fee for each misdirected Internet user, was not a *bona fide* offering of goods or services as contemplated by the Policy); *see also Golden Bear Int'l, Inc. v. Kangdeock-ho*, FA 190644 (Nat. Arb. Forum Oct. 17, 2003) ("Respondent's use of a domain name confusingly similar to Complainant's mark to divert Internet users to websites unrelated to Complainant's business does not represent a bona fide offering of goods or services under Policy ¶4(c)(i) or a legitimate noncommercial or fair use under Policy ¶4(c)(iii).").

Complainant contends Respondent is neither commonly known by the disputed domain name nor authorized to register domain names featuring Complainant's mark. The Panel finds there is no evidence that Respondent is commonly known by the <ameriserv.com> domain name for purposes of establishing rights or legitimate interests under Policy ¶4(c)(ii). *See Charles Jourdan Holding AG v. AAIM*, D2000-0403 (WIPO June 27, 2000) (finding no rights or legitimate interests where (1) the respondent is not a licensee of the complainant; (2) the complainant's prior rights in the domain name precede the respondent's registration; (3) the respondent is not commonly known by the domain

name in question); *see also Compagnie de Saint Gobain v. Com-Union Corp.*, D2000-0020 (WIPO Mar. 14, 2000) (finding no rights or legitimate interest where the respondent was not commonly known by the mark and never applied for a license or permission from the complainant to use the trademarked name).

The Panel finds Policy ¶4(a)(ii) satisfied.

Registration and Use in Bad Faith


Complainant contends Respondent's use of the <ameriserv.com> domain name for purposes of operating a website that features links to various competing and non-competing commercial websites through which Respondent presumably receives referral fees is evidence of bad faith. The Panel finds that such use of Complainant's mark is likely to cause confusion as to Complainant's sponsorship of and affiliation with Respondent's website. As a result, Respondent's intent to deceive Internet users for commercial gain is evidence of bad faith registration and use pursuant to Policy ¶4(b)(iv). *See G.D. Searle & Co. v. Celebrix Drugstore*, FA 123933 (Nat. Arb. Forum Nov. 21, 2002) (finding that the respondent registered and used the domain name in bad faith pursuant to Policy ¶4(b)(iv) where the respondent was using the confusingly similar domain name to attract Internet users to its commercial website); *see also Associated Newspapers Ltd. v. Domain Manager*, FA 201976 (Nat. Arb. Forum Nov. 19, 2003) ("Respondent's prior use of the <mailonsunday.com> domain name is evidence of bad faith pursuant to Policy ¶4(b)(iv) because the domain name provided links to Complainant's competitors and Respondent presumably commercially benefited from the misleading domain name by receiving 'click-through-fees.'").

The Panel finds Policy ¶4(a)(iii) satisfied.

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 <ameriserv.com> domain name be **TRANSFERRED** from Respondent to Complainant.


Houston Putnam Lowry, Esq.
Arbitrator

Houston Putnam Lowry, Chartered Arbitrator, Panelist
Dated: May 4, 2006