



## NATIONAL ARBITRATION FORUM

### DECISION

Piper Jaffray & Co. v. Total Net Solutions  
Claim Number: FA0801001128866

#### PARTIES

Complainant is **Piper Jaffray & Co.** ("Complainant"), represented by **Jodi A. DeSchane**, of **Faegre & Benson, LLP**, Minnesota, USA. Respondent is **Total Net Solutions** ("Respondent"), Victoria, AU.

#### REGISTRAR AND DISPUTED DOMAIN NAME

The domain name at issue is <**piperjaffrey.com**>, registered with **Moniker Online Services, 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 January 10, 2008; the National Arbitration Forum received a hard copy of the Complaint on January 11, 2008.

On January 14, 2008, Moniker Online Services, Inc. confirmed by e-mail to the National Arbitration Forum that the <**piperjaffrey.com**> domain name is registered with Moniker Online Services, Inc. and that Respondent is the current registrant of the name. Moniker Online Services, Inc. has verified that Respondent is bound by the Moniker Online Services, 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 January 18, 2008, a Notification of Complaint and Commencement of Administrative Proceeding (the "Commencement Notification"), setting a deadline of February 7, 2008 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@piperjaffrey.com by e-mail.

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

On February 14, 2008, 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:

##### **Complainant's Trademark Rights and Factual Background**

1. Founded over a century ago by H.C. Piper Sr. and C.P. Jaffray, Piper Jaffray & Co. has evolved as a leading financial services company.
2. For over one hundred years Complainant has been at the leading edge of financial services. Complainant prides itself delivering superior financial solutions for its clients by listening carefully, daring to innovate and adopting marketplace trends.
3. Complainant, as an investment bank and institutional securities firm, delivers a full selection of financial products including merger and acquisition advising and financing, cash management services, corporate and venture services, corporate debt origination, directed trade execution, fairness opinions, financial advising and restructuring, loan participation and portfolio analysis. Complainant delivers powerful competitive advantage to its clients by providing the highest quality of guidance and service.
4. Over the last hundred years Complainant has extensively used the PIPER JAFFRAY mark or a variety of other marks incorporating the words PIPER JAFFRAY in connection with its financial products and services. Complainant holds several United States Trademark Registrations for the words PIPER JAFFRAY. In particular, Complainant is the owner of United State Trademark Registration Numbers 2,098,959 and 2,889,370, both for use in connection with financial management and related services.

5. Complainant has 27 U.S. offices and 2 International offices with headquarters in Minneapolis, Minnesota and locations in Arizona, California, Colorado, Illinois, Idaho, Iowa, Kansas, Massachusetts, Montana, Nebraska, New York, North Carolina, Oregon, Texas, Wisconsin, London and Hong Kong.

6. Complainant also operates a promotional and informational web site at [piperjaffray.com](http://piperjaffray.com). The web site is accessible to consumers throughout the world.

7. Complainant's commercial undertakings have developed a reputation for high-quality and integrity. This well-deserved and hard-earned reputation is reflected in the substantial and valuable body of goodwill symbolized by the well-known PIPER JAFFRAY mark.

8. The PIPER JAFFRAY mark is a financial icon that has for many years been extensively used and advertised. As a result of, among other things, Complainant's continuous and extensive promotion, the PIPER JAFFRAY mark enjoys a high degree of recognition with consumers in the United States as a premier financial management and investment company.

9. In fact, in light of the distinctiveness of the mark, the duration and extent of the use of the mark in connection with financial services, the duration and extent of advertising and publicity of the mark, and the high degree of recognition of the mark, the PIPER JAFFRAY mark is a famous mark as defined in 15 U.S.C. § 1125(c).

10. The PIPER JAFFRAY mark is of great and incalculable value to Complainant. Complainant closely controls the use and reproduction of the PIPER JAFFRAY mark to ensure that all of Complainant's current and potential clients can rely upon the mark as a symbol of superior quality and integrity.

11. Upon information and belief, the domain name **<piperjaffrey.com>** was registered and is being used by Respondent to redirect Internet users to a site purporting to be "Your Finance Resource" with related categories such as "Investing" and "Stock Broker," among others. When an Internet user clicks on the related categories, sponsored links to third party web sites are displayed, many of which are competitors of Complainant.

12. After discovery of the use of the domain name **<piperjaffrey.com>**, Complainant sent a cease and desist letter to the registrant of record at the time, Digi Real Estate Foundation.

13. Sometime thereafter, the registration of **<piperjaffrey.com>** was transferred to Moniker Privacy Services. On October 31, 2007, Complainant sent a letter to Moniker Privacy Services advising that the use of the domain name **<piperjaffrey.com>** violated Complainant's rights and requested that Moniker Privacy

Services cease and desist from providing private registration service for the domain name, cease and desist all use of Complainant's trademarks, and transfer the domain name <**piperjaffrey.com**> to Complainant. Complainant also sent a follow up letter on December 18, 2007.

14. Moniker Privacy Service did not respond to Complainant's letter, and Complaint originally filed this complaint naming Moniker Privacy Service as Respondent. After filing this complaint, Moniker Privacy Service changed the Whois information for the domain name <**piperjaffrey.com**> to Total Net Solutions, therefore, Complainant files this Amended Complaint.

### **Similarity of the Domain Name to Complainant's Trademarks**

15. The domain name <**piperjaffrey.com**> appropriates Complainant's PIPER JAFFRAY mark. The variations between Complainant's mark and the domain name is minor. Respondent's domain name contains the word "Piper" with a common misspelling of "Jaffray"; it has merely replaced the second "a" in "Jaffray" with an "e." It is well established that the misspelling of famous marks does not create a distinct mark or defeat a claim of confusing similarity. See, *Victoria's Secret et al. v. Zuccarini*, FA 95762 (Nat. Arb. Forum Nov. 18, 2000) (finding that misspelling words and adding letters on to words does not create a distinct mark but is nevertheless confusingly similar with the Complainant's marks); see also *Hewlett-Packard Co. v. Zuccarini*, FA 94454 (Nat. Arb. Forum May 30, 2000) (finding the domain name hewlitpackard.com to be identical or confusingly similar to Complainant's HEWLETT-PACKARD mark).

16. Given that <**piperjaffrey.com**> is nearly identical to the famous PIPER JAFFRAY mark, the domain name is confusingly similar to Complainant's mark under ICANN Policy ¶4(a)(i).

### **Absence of Trademark Rights in Respondent**

17. Upon information and belief, Respondent has no trademark or intellectual property rights in the domain name <**piperjaffrey.com**>. Upon information and belief, Respondent is not commonly known as <**piperjaffrey.com**>. In fact, as evident by the Whois record, Respondent is known as "Total Net Solutions." See, *Gallup, Inc. v. Amish Country Store*, FA 96209 (Nat. Arb. Forum Jan. 23, 2001) (finding that Respondent does not have rights in the domain name when Respondent is not known by the mark).

18. In addition, Respondent is not, and has never been, a licensee of Complainant. See, *Compagnie de Saint Gobain v. Com-Union Corp.*, D2000-0020 (WIPO Mar. 14, 2000) (finding no rights or legitimate interests where Respondent was not commonly known by the mark and never applied for a license or permission from Complainant to use the trademarked name).

19. Respondent is not using the domain name in connection with the *bona fide* offering of goods and services. When an Internet user inputs the domain name <**piperjaffrey.com**>, the user is immediately transferred to a search portal offering information and links to financial resources and Complainant's competitors. Misdirecting consumers through the use of Complainant's mark does not qualify as a bona fide offering of goods and services under ICANN Policy ¶ 4(c)(i). *Ticketmaster Corp. v. DiscoverNet, Inc.*, D2001-0252 (WIPO Apr. 9, 2001) (finding no rights or legitimate interests where Respondent generated commercial gain by intentionally and misleadingly diverting users away from Complainant's site to a competing web site); *Vapor Blast Mfg. Co. v. R & S Tech., Inc.*, FA 96577 (Nat. Arb. Forum Feb. 27, 2001) (finding that Respondent's commercial use of the domain name to confuse and divert Internet traffic is not a legitimate use of the domain name).

20. Respondent is also not making any legitimate noncommercial or fair use of the domain name <**piperjaffrey.com**>. Upon information and belief, Respondent receives commercial gain by featuring "sponsored" links on its search portal. However, even if Respondent did not receive financial gain from its use of <**piperjaffrey.com**>, Respondent is not making any legitimate noncommercial or fair use of the domain name. See, *Alta Vista v. Krotov*, D2000-1091 (WIPO Oct. 25, 2000) (finding that using the domain name to direct user to other, unconnected web sites does not constitute a legitimate interest in the domain name); *Big Dog Holdings, Inc. v. Day*, FA 93554 (Nat. Arb. Forum Mar. 9, 2000) (finding no legitimate use when Respondent was diverting consumers to its own web site by using Complainant's trademarks). See also, *Am. Online, Inc. v. Tencent Comm. Corp.*, FA 93668 (Nat. Arb. Forum Mar. 21, 2000) (finding that use of Complainant's mark "as a portal to suck surfers into a site sponsored by Respondent hardly seems legitimate.")

21. Under these circumstances, Respondent lacks any valid rights or legitimate interests in the domain name under ICANN Policy ¶ 4(a)(ii).

### **Bad Faith Registration and Use of Domain Name**

22. At the time Respondent registered the domain name <**piperjaffrey.com**>, the PIPER JAFFRAY mark was sufficiently distinctive or famous to give constructive notice to Respondent that the registration of <**piperjaffrey.com**> would violate Complainant's rights. Complainant's federal trademark registrations for the PIPER JAFFRAY mark put Respondent on notice of Complainant's rights in the marks. See *Samsonite Corp. v. Colony Holding*, FA 94313 (Nat. Arb. Forum April 17, 2000) (evidence of bad faith includes actual or constructive knowledge of commonly known mark at time of registration); *Sony Kabushiki Kaisha v. Inja, Kil*, D2000-1409 (WIPO Dec. 9, 2000) (finding that bad faith registration and use where it is "inconceivable that the respondent could make any active use of the disputed domain names without creating a false impression of association with the Complainant").

23. Complainant has not authorized or had control over Respondent's use of the domain name <**piperjaffrey.com**> or any activities associated with the domain name.

24. Respondent's use of the <**piperjaffrey.com**> domain name to direct users to a search portal with links to third parties is evidence of bad faith. See, *ESPN, Inc. v. Ballerini*, FA 95410 (Nat. Arb. Forum Sept. 15, 2000) (finding bad faith when the web site in dispute was linked by the respondent to a second web site, from which second web site the respondent presumably received a portion of advertising revenue because of his direction of Internet traffic to that site).

25. Respondent's use of a domain name that incorporates Complainant's mark to direct users to Respondent's web site is likely to cause confusion or cause the public to mistakenly believe that Complainant in some way authorized, sponsored, approved or endorsed Respondent's activities related to the domain name <**piperjaffrey.com**> or that Complainant is in some way affiliated with Respondent's activities. "Internet users searching for a company's web site often assume, as a rule of thumb, that the domain name of a particular company will be the company name or trademark followed by '.com.'" *Entrepreneur Media, Inc. v. Smith*, 279 F.3d 1135, 1146 (9<sup>th</sup> Cir. 2002).

26. Respondent is also engaged in typosquatting. Respondent registered a common misspelling of Complainant's famous PIPER JAFFRAY mark to divert Internet traffic to a website for commercial gain. Typosquatting is recognized as evidence of bad faith use and registration under ICANN Policy § 4(b)(iv). See, *Nat'l Ass'n of Prof'l Baseball Leagues v. Zuccarini*, D2002-1011 (WIPO Jan. 21, 2003) ("Typosquatting is the intentional misspelling of words with intent to intercept and siphon off traffic from its intended destination, by preying on Internauts who make common typing errors. Typosquatting is inherently parasitic and of itself evidence of bad faith.").

27. As even further evidence of bad faith, Respondent has failed to respond to the cease and desist letters from Complainant. See, *Cigna Corp. v. JIT Consulting*, AF-00174 (eResolution, June 6, 2000) (finding that failure to respond to cease-and-desist letters amounts to an "admission-by-silence" and is evidence of both registration and use in bad faith). See also, *Seiko Epson Corporation et al v JIT Consulting*, FA 95476 (Nat. Arb. Forum, Oct. 20, 2000) (finding that Respondent's provision of inaccurate contact information and his failure to answer numerous cease and desist letter is evidence of bad faith)

28. In light of these circumstances, Respondent has registered and used the domain name <**piperjaffrey.com**> in bad faith under ICANN Policy ¶ 4(a)(iii).

29. Respondent's bad faith registration and use of the domain name <**piperjaffrey.com**> meets the standards for transfer of the domain name to Complainant under the Anticybersquatting Consumer Protection Act of 1999, 15 U.S.C.A. § 1125(d)(1)(A).

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

## **FINDINGS**

Complainant, Piper Jaffray & Co., is an investment bank and institutional securities firm that offers financial products and services to its clients. Complainant first registered the PIPER JAFFRAY mark with the United States Patent and Trademark Office (“USPTO”) on September 23, 1997 (Reg. No. 2,098,959). Complainant uses the PIPER JAFFRAY mark to advertise and promote its financial management products and services.

Respondent registered the <**piperjaffrey.com**> domain name on August 22, 2000. The disputed domain name resolves to a website which offers links to third party websites that offer products and services that directly compete with Complainant.

## **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 registered the PIPER JAFFRAY mark with the USPTO. The Panel finds Complainant's registration of its mark with the USPTO is sufficient to establish rights in

the mark pursuant to Policy ¶4(a)(i). See *Expedia, Inc. v. Inertia 3D*, FA 1118154 (Nat. Arb. Forum Jan. 18, 2008) (“...Complainant asserts rights in the mark through its registration of the mark with the United States Patent and Trademark Office. This registration sufficiently establishes Complainant’s rights in the mark pursuant to Policy ¶4(a)(i).”); see also *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.”).

The Panel finds Respondent’s <**piperjaffrey.com**> domain name is confusingly similar to Complainant’s PIPER JAFFRAY mark pursuant to Policy ¶4(a)(i). The disputed domain name fully incorporates Complainant’s mark with the substitution of the letter “e” for the letter “a” in JAFFRAY. Additionally, the generic top-level domain “.com” is considered irrelevant in evaluating whether a disputed domain name is confusingly similar to Complainant’s mark. See *Belkin Components v. Gallant*, FA 97075 (Nat. Arb. Forum May 29, 2001) (finding the <belken.com> domain name confusingly similar to the complainant’s BELKIN mark because the name merely replaced the letter “i” in the complainant’s mark with the letter “e”); see also *Reuters Ltd. v. Global Net 2000, Inc.*, D2000-0441 (WIPO July 13, 2000) (finding that a domain name which differs by only one letter from a trademark has a greater tendency to be confusingly similar to the trademark where the trademark is highly distinctive); see also *Nev. State Bank v. Modern Ltd. – Cayman Web Dev.*, FA 204063 (Nat. Arb. Forum Dec. 6, 2003) (“It has been established that the addition of a generic top-level domain is irrelevant when considering whether a domain name is identical or confusingly similar under the Policy.”).

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 disputed domain name. After Complainant presents a *prima facie* case in support of its allegations, the burden shifts to Respondent to establish that it does have rights or legitimate interests in the disputed domain name pursuant to Policy ¶4(a)(ii). The Panel finds Complainant has established a *prima facie* case to support its allegations. Respondent has failed to submit a response to the Complaint. The Panel assumes Respondent does not have rights or legitimate interests in the disputed domain name.

The Panel will, however, examine the record to determine whether Respondent has rights or legitimate interests in the disputed domain name pursuant to Policy ¶4(c). See *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).”); see also *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”).

Respondent is using the disputed domain name to display links to websites for Complainant’s competitors. Respondent presumably receives a click-through fee for displaying these links and advertisements. The Panel finds this diversionary use is not a use in connection with a *bona fide* offering of goods pursuant to Policy ¶4(c)(i), or a legitimate noncommercial or fair use pursuant to Policy ¶4(c)(iii). *See Ameritrade Holdings Corp. v. Polanski*, FA 102715 (Nat. Arb. Forum Jan. 11, 2002) (finding that the respondent’s use of the disputed domain name to redirect Internet users to a financial services website, which competed with the complainant, was not a *bona fide* offering of goods or services); *see also Coryn Group, Inc. v. Media Insight*, FA 198959 (Nat. Arb. Forum Dec. 5, 2003) (finding that the respondent was not using the domain names for a *bona fide* offering of goods or services nor a legitimate noncommercial or fair use because the respondent used the names to divert Internet users to a website that offered services that competed with those offered by the complainant under its marks).

In addition, the Panel finds Respondent has not established rights or legitimate interests in the disputed domain name pursuant to Policy ¶4(c)(ii) because there is no evidence Respondent is commonly known by <**piperjaffrey.com**> domain name. The record and WHOIS information provide no evidence Respondent was commonly known by the disputed domain name and Complainant did not authorize Respondent to use their PIPER JAFFRAY mark. *See Michael Smith Custom Clothiers, Inc. v. Custom Shirt Shop*, FA 1109402 (Nat. Arb. Forum Jan. 4, 2008) (“ . . . other ICANN panels have held, and this Panel agrees, that in order to have rights or legitimate interests under the “commonly known” provision of the Policy a respondent must be commonly known by the domain name prior to registration of the domain name in issue.”); *see also Tercent Inc. v. Lee Yi*, FA 139720 (Nat. Arb. Forum Feb. 10, 2003) (stating “nothing in Respondent’s WHOIS information implies that Respondent is ‘commonly known by’ the disputed domain name” as one factor in determining that Policy ¶4(c)(ii) does not apply).

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

### **Registration and Use in Bad Faith**

Respondent’s disputed domain name resolves to a website which displays links to the websites of Complainant’s competitors. The Panel finds such use constitutes disruption and is evidence of registration and use in bad faith pursuant to Policy ¶4(b)(iii). *See H-D Michigan Inc. v. Buell d/b/a Pre-owned Harleys*, FA 1106640 (Nat. Arb. Forum Jan. 2, 2008) (“The disputed domain names resolve to websites that list links to competitors of Complainant, evidence that Respondent intends to disrupt Complainant’s business, a further indication of bad faith pursuant to Policy ¶4(b)(iii).”); *see also Puckett, Individually v. Miller*, D2000-0297 (WIPO June 12, 2000) (finding that the respondent

has diverted business from the complainant to a competitor's website in violation of Policy ¶4(b)(iii).

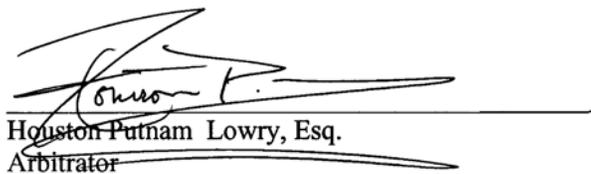
In addition, Respondent is using the confusingly similar <**piperjaffrey.com**> domain name to operate a website containing links to the websites of Complainant's competitors. Respondent presumably receives click-through fees for displaying these links on the website that resolves from the disputed domain name. The Panel finds this is an attempt by Respondent to profit from the goodwill associated with Complainant's PIPER JAFFRAY mark, and constitutes registration and use in bad faith pursuant to Policy ¶4(b)(iv). *See 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.'"); *see also Drs. Foster & Smith, Inc. v. Lalli*, FA 95284 (Nat. Arb. Forum Aug. 21, 2000) (finding bad faith where the respondent directed Internet users seeking the complainant's site to its own website for commercial gain).

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



Houston Putnam Lowry, Esq.  
Arbitrator

Houston Putnam Lowry, Chartered Arbitrator, Panelist  
Dated: February 28, 2008

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**NATIONAL ARBITRATION FORUM**