



NATIONAL ARBITRATION FORUM

DECISION

The Prudential Insurance Company of America v. Expired Domains Inc. c/o Billing
Department
Claim Number: FA0611000839816

PARTIES

Complainant is **The Prudential Insurance Company of America** ("Complainant"), represented by **Sue J. Nam**, of **The Prudential Insurance Company of America**, 751 Broad Street, 21st Floor, Mail Stop NJ-01-21-05, Newark, NJ 07102-3777. Respondent is **Expired Domains Inc c/o Billing Department** ("Respondent"), 15 Surrey Ln, New York, NY 12020.

REGISTRAR AND DISPUTED DOMAIN NAME

The domain name at issue is <**prudentialillinois.com**>, registered with **Estdomains, 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 November 10, 2006; the National Arbitration Forum received a hard copy of the Complaint on November 10, 2006.

On November 21, 2006, Estdomains, Inc. confirmed by e-mail to the National Arbitration Forum that the <**prudentialillinois.com**> domain name is registered with Estdomains, Inc. and that Respondent is the current registrant of the name. Estdomains, Inc. has verified that Respondent is bound by the Estdomains, 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 November 22, 2006, a Notification of Complaint and Commencement of Administrative Proceeding (the "Commencement Notification"), setting a deadline of December 12, 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@prudentialillinois.com by e-mail.

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

On December 19, 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:

A. The Prudential Insurance Company of America

1. For over 130 years, The Prudential Insurance Company of America ("Prudential") has used its well-known PRUDENTIAL name and mark in connection with a wide variety of insurance, securities, investment, financial and real estate services throughout the United States and the world.

2. The PRUDENTIAL trademark is the subject of trademark registrations in over 50 countries, including the United States. In the United States, Prudential owns over 100 U.S. trademark registrations for its PRUDENTIAL and PRUDENTIAL combination marks. Most of these U.S. registrations are incontestable pursuant to 15 U.S.C. Sec. 1065.

3. Prudential spends more than \$90 million annually for advertising and promotion of its brand. Prudential's name and marks have been prominently displayed on outdoor signs, letterhead, invoices, direct mail advertising, telephone directory advertising, billboards, television, and radio advertising and periodicals throughout the United States.

4. In addition, Prudential promotes its services and its name and mark on the Internet. Prudential and its affiliated companies operate numerous web sites, which incorporate the famous PRUDENTIAL mark in domain names, including www.prudential.com, www.prudentialproperties.com, www.prudentialhomefinder.com,

www.prudentialfirstchoice.com, www.prudentialonerealty.com, www.prudentialgeorgia.com, www.prudentialcarolina.com, www.prudentialct.com, www.prudentialutah.com, www.prudentialcal.com, www.prudentialcalbayarea.com, www.prudentialclarksville.com, www.prudentialmetrowide.com, www.prudentialpropertiesunlimited.com, www.prudentialpropertiesplus.com, www.prudentialmissoulaproperties.com and www.prudentialpartners.com.

5. Prudential has achieved a tremendous amount of goodwill as a result of its long and continuous use of its well-known PRUDENTIAL mark. As a result of the foregoing, consumers and the trade have come to associate the PRUDENTIAL mark exclusively with Prudential and its affiliated companies. Prudential's PRUDENTIAL mark is recognized by millions of people around the world as a symbol of financial strength, quality, and trust.

B. Respondent Expired Domains, Inc. c/o Billing Department

5. Respondent Expired Domains, Inc. c/o Billing Department is identified in the Whois records as the registrant of the domain name at issue "prudentialillinois.com" (the "Domain Name"), and its listed address is 15 Surrey Ln, New York, New York 12020. Respondent's telephone number is listed as 518-884-3223.

6. Respondent is not affiliated with Prudential, and has not been licensed or otherwise authorized to use the PRUDENTIAL name and mark.

7. On or about October 6, 2006, Prudential learned that Respondent registered the Domain Name and is using the Domain Name for a website providing links to the websites of competing real estate brokerage services, informational and commercial links unrelated to Prudential or its services, and links to pornographic and sexually explicit material. On October 10, 2006, Prudential transmitted a cease and desist letter to Respondent by email to the address identified in the Domain Name's registration records.

8. To date, no response has been received from Respondent to Complainant's cease and desist email. The email was not returned as undeliverable.

9. Further review of the website on October 26, 2006 revealed continuing misuse of the Domain Name. Respondent appears to no longer post adult content on the first page of the website located at the Domain Name but rather conceals such content behind links with titles like "Prudential Real Estate Affiliates." On these secondary links, Respondent has set up a box with the heading of "Popular Topics," which provides links to more sexually explicit content.

10. Registrant's misuse of the Domain Name for a website with links to competing real estate brokerage services, various commercial and informational services unrelated to Prudential and pornographic and sexually explicit material irreparably harms Prudential by creating consumer confusion and by tarnishing Prudential's famous mark.

Grounds For Complaint

11. To obtain relief under the Policy, a complainant must show: (1) the domain name is identical to or confusingly similar to the trademark of the complainant; (2) the respondent has no rights or legitimate interests in or to the domain name; and (3) the respondent registered and is using the domain name in bad faith. *See* ICANN Policy ¶4(a). Prudential has shown all of these requisite factors and thus merits the immediate transfer of the Domain Name.

12. With respect to the first ICANN factor, the Domain Name directly incorporates Prudential's PRUDENTIAL mark in conjunction with the geographic name for the state of "Illinois." The addition of a geographic term does not render the domain name distinguishable from Prudential's mark. *See Net2phone Inc, v. Netcall SAGL*, D2000-0666 (WIPO Sept. 26, 2000) (finding that the respondent's registration of the domain name "net2phone-europe.com" is confusingly similar to the complainant's mark; "the combination of a geographic term with the mark does not prevent a domain name from being found confusingly similar."); *see also VeriSign, Inc. v. Tandon*, D2000-1216 (WIPO Nov. 16, 2000) (finding confusing similarity between the complainant's VERISIGN mark and the "verisignindia.com" and "verisignindia.net" domain names where the respondent added the word "India" to the complainant's mark); *see also JVC Americas Corp. v. Macafee*, CPR006 (CPR Nov. 10, 2000) (finding that the domain name registered by the respondent, "jvc-america.com," is substantially similar to, and nearly identical to the complainant's JVC mark). Accordingly, Prudential has satisfied the first element of the ICANN test.

13. The second element of the ICANN test also is met because Respondent has no rights or legitimate commercial interest in the Domain Name and has no legitimate interest with respect to the PRUDENTIAL mark, which is the subject of numerous trademark registrations owned by Prudential throughout the world. Respondent is not commonly known by the domain name. *See Gallup Inc. v. Amish Country Store*, FA 96209 (Nat. Arb. Forum Jan. 23, 2001) (finding that the respondent does not have rights in domain name because the respondent is not known by the mark). In addition, Respondent is not a licensee of the PRUDENTIAL mark or in anyway authorized to use the PRUDENTIAL mark. *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 the complainant to use the trademarked name); *State Farm Mut. Auto. Ins. Co. v. LaFaive*, FA 95407 (Nat. Arb. Forum Sept 27, 2000) (finding that "unauthorized providing of information and services under a mark owned by a third party cannot be said to be the bona fide offering of goods or services"). By using Prudential's famous PRUDENTIAL mark, Respondent clearly is attempting to divert Internet users to, among other links, pornographic websites for its own commercial gain. Such use is neither a bona fide offering of goods or services nor a legitimate noncommercial, or fair, use of the Domain Name. *See National Football League Prop., Inc., et al. v. One Sex Entm't. Co.*, D2000-0118 (WIPO Apr. 17, 2000) (finding that the respondent has no rights or

legitimate interests in the domain names "chargergirls.com" and "chargergirls.net" where the respondent linked these domain names to its pornographic website); *Brown & Bigelow, Inc. v. Rodela*, FA 96466 (Nat. Arb. Forum Mar. 5, 2001) (finding that infringing on another's well known mark to provide a link to a pornographic site is not a legitimate or fair use); *MatchNet plc v. MAC Trading*, D2000-0205 (WIPO May 11, 2000) (finding that it is not a bona fide offering of goods or services to use a domain name for commercial gain by attracting Internet users to third party sites offering sexually explicit and pornographic material).

14. The third element of the ICANN test, namely that the Domain Name has been registered in bad faith and is being used in bad faith, is also satisfied here. Given the general fame of the PRUDENTIAL mark and the explicit references to Prudential's businesses, such as Prudential Real Estate Affiliates, in Registrant's website, there can be no doubt that Respondent was well aware of Prudential's exclusive rights to its mark when it registered the Domain Name. *See The Prudential Insurance Company of America v. Prudential Mortgage Loans*, FA 103880 (Nat. Arb. Forum March 20, 2002) ("The famous nature of Complainant's mark and Respondent's actual knowledge of Complainant's mark raises the inference that Respondent acted in bad faith in registering [a domain name incorporating the PRUDENTIAL mark]"). There also can be no doubt that Respondent, by using the domain name, is intentionally attempting to attract, for commercial gain, Internet users to its website, by creating a likelihood of confusion with Complainant's mark as to the source, sponsorship, affiliation or endorsement of the website and services. Given the fame of the Prudential marks, especially in the real estate business that is the subject of a substantial portion of Respondent's website, a reasonable Internet user cannot but be led to believe that there is a connection between Prudential and Respondent. *See Sony Kabushiki Kaisha v. Inja, Kil*, D 2000-1409 (WIPO Dec. 9, 2000) (finding bad faith 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"); *The Prudential Insurance Company of America v. Prudential Mortgage Loans, supra* (based on fame of Prudential's mark and the overlap in the parties' services, holding that "reasonable Internet user cannot help but to be led to believe that there is a connection between Complainant and Respondent"). Respondent's deliberate use of the goodwill of Prudential's name and mark to create traffic to pornographic websites also constitutes bad faith. *See, e.g., Safway Steel Products, Inc. v. Café Au Lai*, FA 94631 (Nat. Arb. Forum May 27, 2000) (finding bad faith where respondent attempted to attract Internet users to pornographic site by using the domain name "safway.net"); *Youtv, Inc. v. Alemдар*, FA 94243 (Nat. Arb. Forum Apr. 25, 2000) (finding bad faith where the respondent attracted users to his website for commercial gain and linked his website to pornographic websites); *CCA Indus., Inc. v. Dailey*, D2000-0148 (WIPO Apr. 26, 2000) (finding that "association with a pornographic web site can itself constitute bad faith").

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

FINDINGS

Complainant, The Prudential Insurance Co of America, is one of the world's largest financial services companies. Complainant has continuously and extensively used the PRUDENTIAL mark for over 130 years in connection with insurance, securities, investment, financial and real estate services throughout the world. Complainant also operates numerous websites, including one at the <prudential.com> domain name.

Complainant owns over one hundred trademark registrations for the PRUDENTIAL mark with the United States Patent and Trademark Office ("USPTO") (including Reg. No. 693,628 issued February 23, 1960).

Respondent registered the <prudentialillinois.com> domain name on January 15, 2005 and the disputed domain name resolves to a website featuring links to Complainant's competitors in the financial services industry, as well as links to sexually explicit content.

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

Due to Complainant's more than one hundred trademark registrations for the PRUDENTIAL mark, the Panel concludes Complainant has sufficiently demonstrated its

rights in the mark pursuant to Policy ¶4(a)(i). See *ESPN, Inc. v. MySportCenter.com*, FA 95326 (Nat. Arb. Forum Sept. 5, 2000) (concluding that the complainant demonstrated its rights in the SPORTSCENTER mark through its valid trademark registrations with the USPTO and similar offices around the world); see also *Am. Int'l Group, Inc. v. Morris*, FA 569033 (Nat. Arb. Forum Dec. 6, 2005) (“Complainant has established rights in the AIG mark through registration of the mark with several trademark authorities throughout the world, including the United States Patent and Trademark office (‘USPTO’)...”).

Respondent has wholly incorporated Complainant’s PRUDENTIAL mark in the <**prudentialillinois.com**> domain name and simply added the geographic identifier “illinois.” The simple addition of a geographic identifier to a registered mark in a domain name is not a distinguishable difference. Consequently, the Panel finds the <**prudentialillinois.com**> domain name to be confusingly similar to the PRUDENTIAL mark according to Policy ¶4(a)(i). See *CMGI, Inc. v. Reyes*, D2000-0572 (WIPO Aug. 8, 2000) (finding that the domain name <cmgiasia.com> is confusingly similar to the complainant’s CMGI mark); see also *JVC Americas Corp. v. Macafee*, CPR007 (CPR Nov. 10, 2000) (finding that the domain name registered by the respondent, <jvc-america.com>, is substantially similar to, and nearly identical to the complainant’s JVC mark).

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

Rights or Legitimate Interests

Complainant claims Respondent lacks rights and legitimate interests in the <**prudentialillinois.com**> domain name. Complainant must first make a *prima facie* case in support of its allegations, and then the burden shifts to Respondent to show it has rights or legitimate interests pursuant to Policy ¶4(a)(ii). See *Document Tech., Inc. v. Int'l Elec. Commc'ns Inc.*, D2000-0270 (WIPO June 6, 2000) (“Although Paragraph 4(a) of the Policy requires that the Complainant prove the presence of this element (along with the other two), once a Complainant makes out a *prima facie* showing, the burden of production on this factor shifts to the Respondent to rebut the showing by providing concrete evidence that it has rights to or legitimate interests in the Domain Name.”); see also *AOL LLC v. Gerberg*, FA 780200 (Nat. Arb. Forum Sept. 25, 2006) (“Complainant must first make a *prima facie* showing that Respondent does not have rights or legitimate interest in the subject domain names, which burden is light. If Complainant satisfies its burden, then the burden shifts to Respondent to show that it does have rights or legitimate interests in the subject domain names.”).

Respondent’s failure to answer the Complaint raises a presumption Respondent has no rights or legitimate interests in the <**prudentialillinois.com**> domain name. See *Am. Online, Inc. v. AOL Int'l*, D2000-0654 (WIPO Aug. 21, 2000) (finding no rights or legitimate interests where the respondent fails to respond); see also *BIC Deutschland GmbH & Co. KG v. Tweed*, D2000-0418 (WIPO June 20, 2000) (“By not submitting a response, Respondent has failed to invoke any circumstance which could demonstrate,

pursuant to ¶4(c) of the Policy, any rights or legitimate interests in the domain name”). Out of an abundance of caution, the Panel will now examine the record to determine if Respondent has rights or legitimate interests under Policy ¶4(c).

Respondent registered the domain name under the name “Expired Domains Inc. c/o Billing Department,” and there is no other evidence in the record suggesting that Respondent is commonly known by the <**prudentialillinois.com**> domain name. Thus, Respondent has not established rights or legitimate interests in the <**prudentialillinois.com**> domain name pursuant to Policy ¶4(c)(ii). *See M. Shanken Commc’ns v. WORLDTRAVELERSONLINE.COM*, FA 740335 (Nat. Arb. Forum Aug. 3, 2006) (finding that the respondent was not commonly known by the <cigaraficionada.com> domain name under Policy ¶4(c)(ii) based on the WHOIS information and other evidence in the record); *see also Coppertown Drive-Thru Systems, LLC v. Snowden*, FA 715089 (Nat. Arb. Forum July 17, 2006) (concluding that the respondent was not commonly known by the <coppertown.com> domain name where there was no evidence in the record, including the WHOIS information, suggesting that the respondent was commonly known by the disputed domain name).

Respondent’s <**prudentialillinois.com**> domain name, which is confusingly similar to Complainant’s PRUDENTIAL mark, resolves to a commercial website providing links to websites offering financial services that compete with Complainant’s own services under the PRUDENTIAL mark and various websites offering sexual services. In *Ameritrade Holdings Corp. v. Polanski*, FA 102715 (Nat. Arb. Forum Jan. 11, 2002), the respondent was using a domain name confusingly similar to the complainant’s AMERITRADE mark to divert Internet users to a competing financial services website. The panel concluded that redirecting Internet users to a competing website could not be deemed a *bona fide* offering of goods or services pursuant to Policy ¶4(c)(i), and that such use for Respondent’s own commercial gain could not be a legitimate noncommercial or fair use pursuant to Policy ¶4(c)(iii). *Id.* Because Respondent is also using the disputed domain name to redirect Internet users to a competing website, Respondent’s use of the disputed domain name does not constitute a *bona fide* offering of goods or services under Policy ¶4(c)(i) or a legitimate noncommercial fair use pursuant to Policy ¶4(c)(iii). *See The Royal Bank of Scot. Grp plc et. Al. v. Demand Domains*, FA 714952 (Nat. Arb. Forum Aug. 2, 2006) (finding that the operation of a commercial web directory displaying various links to third-party websites was not a use in connection with a *bona fide* offering of goods or services pursuant to Policy ¶4(c)(i) or a legitimate noncommercial or fair use pursuant to Policy ¶4(c)(iii), as the respondent presumably earned “click-through” fees for each consumer it redirected to other websites). Directing users to websites offering sexual services (at least in the context of the facts of this case) does not constitute a *bona fide* offering of services.

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

Registration and Use in Bad Faith

Respondent is using the <**prudentialillinois.com**> domain name, which includes Complainant's entire PRUDENTIAL mark, to divert Internet users seeking Complainant's services to competing websites through Respondent's pay-per-click website. Respondent likely generates revenue for each consumer it diverts to these websites. Therefore, Respondent is taking advantage of the confusing similarity between the <**prudentialillinois.com**> domain name and Complainant's PRUDENTIAL mark, and profiting from the goodwill associated with the mark. Use of the disputed domain name for this purpose suggests bad faith registration and use under Policy ¶4(b)(iv). *See Allianz of Am. Corp. v. Bond*, FA 680624 (Nat. Arb. Forum June 2, 2006) (finding bad faith registration and use under Policy ¶4(b)(iv) where the respondent was diverting Internet users searching for the complainant to its own website and likely profiting from click-through fees); *see also Red Hat, Inc. v. Haecke*, FA 726010 (Nat. Arb. Forum July 24, 2006) (finding that the respondent engaged in bad faith registration and use pursuant to Policy ¶4(b)(iv) by using the disputed domain names to operate a commercial search engine with links to the products of the complainant and to complainant's competitors, as well as by diverting Internet users to several other domain names).

Respondent registered and used the domain name in order to disrupt Complainant's business, as Respondent is using the <**prudentialillinois.com**> domain name to maintain a website with links to Complainant's competitors in the financial industry. In *Disney Enters., Inc. v. Noel*, FA 198805 (Nat. Arb. Forum Nov. 11, 2003), the panel found the respondent had registered and used the <euro-disney.com> domain name in bad faith pursuant to Policy ¶4(b)(iii) because it resolved to a website promoting a competing theme park. Respondent's use of the disputed domain name to operate a website that prominently displays Complainant's PRUDENTIAL mark provides evidence it registered the domain name primarily to disrupt Complainant's business in violation of Policy ¶4(b)(iii). *See Lubbock Radio Paging v. Venture Tele-Messaging*, FA 96102 (Nat. Arb. Forum Dec. 23, 2000) (concluding that domain names were registered and used in bad faith where the respondent and the complainant were in the same line of business in the same market area).

Respondent's claim it "empower[s] individuals, organizations and businesses by providing unique up-to-date information. Our dedicated team of professionals strives to gather the most relevant content for our users." does not make sense in context with the domain name. Clearly the web site is a cybernetic net that casts itself on the internet (with the help of search engines) to gather "fish" to generate "click through" revenue. Respondent's failure to honestly describe its business suggests Respondent did not register the domain name in good faith, does not use the domain name in good faith and is not making a *bona fide* offering of goods and services.

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

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



Houston Putnam Lowry, Esq.
Arbitrator

Houston Putnam Lowry, Chartered Arbitrator, Panelist
Dated: January 2, 2007

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