



## NATIONAL ARBITRATION FORUM

### DECISION

State Farm Mutual Automobile Insurance Company v. statefarmc.com c/o Guro-gu  
Claim Number: FA0607000746782

#### PARTIES

Complainant is **State Farm Mutual Automobile Insurance Company** ("Complainant"), represented by **Janice K. Forrest**, of **State Farm Mutual Automobile Insurance Company**, One State Farm Plaza, A-3, Bloomington, IL 61710. Respondent is **statefarmc.com c/o Guro-gu** ("Respondent"), Oryu-dong, Seoul 152100, KR.

#### REGISTRAR AND DISPUTED DOMAIN NAME

The domain name at issue is <**statefarmc.com**>, registered with **Korea Information Certificate Authority, Inc.** d/b/a **DomainCA.com**.

#### 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 July 10, 2006; the National Arbitration Forum received a hard copy of the Complaint on July 11, 2006.

On July 18, 2006, Korea Information Certificate Authority, Inc. d/b/a DomainCA.com confirmed by e-mail to the National Arbitration Forum that the <**statefarmc.com**> domain name is registered with Korea Information Certificate Authority, Inc. d/b/a DomainCA.com and that Respondent is the current registrant of the name. Korea Information Certificate Authority, Inc. d/b/a DomainCA.com has verified that Respondent is bound by the Korea Information Certificate Authority, Inc. d/b/a DomainCA.com 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 July 21, 2006, a Notification of Complaint and Commencement of Administrative Proceeding (the "Commencement Notification"), setting a deadline of August 10, 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@statefarmc.com by e-mail.

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

On August 15, 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:

##### State Farm's Trademark Rights to the Name "State Farm" and "State Farm Insurance"

State Farm is a nationally known company that has been doing business under the name "State Farm" since 1930. In 1999 State Farm opened a Federally Chartered Bank known as State Farm Bank. State Farm engages in business in both the insurance and the financial services industry. State Farm also has established a nationally recognized presence on televised and other media.

State Farm first began using the "State Farm" trademark in 1930 and registered it with the Patent and Trademark Office on June 11, 1996 and registered "State Farm Insurance" on September 11, 1979. State Farm has also registered with the Patent and Trademark Office the following marks that all include the phrase "State Farm":

*State Farm Insurance Companies; the State Farm Insurance 3 oval logo; State Farm Bank; State Farm Federal Savings Bank logo; State Farm Fire and Casualty Co. logo; State Farm Benefit Management Account; State Farm Bayou Classic logo; State Farm Catastrophe Services; State Farm Mutual Funds and statefarm.com.*

In Canada State Farm has registered the State Farm 3 oval logo; State Farm; State Farm Insurance Companies; State Farm Insurance and the State Farm Fire and Casualty Co. logo. In

the European Community the State Farm 3 oval logo is registered. In Mexico the State Farm 3 oval logo, State Farm and State Farm Insurance are registered. The domain name registered by the Respondent incorporates State Farm's registered trademark, "State Farm" and are confusingly similar to State Farm's registered marks.

For over 70 years State Farm has expended substantial time, effort and funds to develop the good will associated with the name "State Farm" as well as to promote and develop its other trademarks. State Farm does not allow unauthorized parties to use its marks as part of their Internet domain names.

#### State Farm on the Internet

State Farm developed its Internet web presence in 1995 using the domain name statefarm.com. At its web site, State Farm offers detailed information relating to a variety of topics that include its insurance and financial service products, consumer information, and information about its independent contractor agents. State Farm has expended substantial time, effort and funds to develop its web site as a primary source of Internet information for the products, services and information provided by State Farm.

#### **Conduct on Part of Respondent**

In April of 2006 it was brought to State Farm's attention that Respondent registered Complainant's trademark "State Farm" as part of the domain name, "statefarmc.com." The domain name sends a person to a web page that contains numerous links for various insurance products and companies, including those in direct competition with State Farm Insurance.

On April 12, 2006 a cease and desist letter was sent by Complainant's Intellectual Property Administrator via email to Respondent at the address at selfx777@naver.com. On May 8, 2006 another cease and desist letter was sent to Respondent; however, no response has been received from Respondent. On June 22, 2006, a cease and desist email was sent, along with a draft arbitration complaint.

#### **Respondent Has No Legitimate Interest in the Domain Name**

Because of State Farm's substantial efforts, the public associates the phrase "State Farm" and "State Farm Insurance" with the owner of the servicemarks "State Farm" and "State Farm Insurance." The State Farm marks are distinctive and have acquired secondary meanings. The domain name at issue is confusingly similar to State Farm's servicemark that it has been using since 1930 and to State Farm's other registered marks. Moreover, the domain name is confusingly similar to products, services or information that State Farm offers generally to the public as well as on its web sites. Consumers who discover this domain name are likely to be confused as to Respondent's affiliation with, sponsorship by or connection to State Farm.

Respondent has no right or legitimate interest in the disputed domain name. The Respondent is not associated with, affiliated with or sponsored by State Farm, the owner of the servicemarks "State Farm" and "State Farm Insurance." State Farm did not authorize the

Respondent to register the domain name or to use the State Farm trademarks for the Respondent's business purposes.

Respondent is not commonly known under the domain name, "statefarmc.com." It is believed that the Respondent has never been known by or performed business under the domain name at issue. The Respondent does not possess independent intellectual property rights in the name. In addition, State Farm does not have a contractual arrangement with Respondent that would allow him to offer services under the State Farm name.

State Farm believes that the Respondent registered the name to create the impression of association with State Farm, its agents, products, sponsorships, and services; to trade off the good will associated with the State Farm name; and/or to create initial interest confusion for individuals looking for information about State Farm.

### **Respondent Has Acted in Bad Faith**

It is clear that the name registered by Respondent is confusingly similar to State Farm's trademarks. Indeed, the name includes one of State Farm's registered marks "State Farm." This domain is clearly intended to attract individuals seeking information on State Farm and create customer confusion as to the source or sponsorship of the sites, especially since they are offering insurance information.

State Farm has filed numerous complaints relating to its domain names under the ICANN Uniform Dispute Resolution Process. The arbitrators have consistently found that the use of State Farm's trademarks in a domain name, whether or not additional language, characters or hyphens are added to the State Farm name, is confusingly similar to State Farm's trademarks and that such registrations have been done in bad faith. (See *State Farm Mut. Auto. Ins. Co. v. Advisory Services, Inc.*, FA94662 (Nat. Arb. Forum June 8, 2000); *State Farm Mut. Auto. Ins. Co. v. Bulldog, Inc.*, FA94427 (Nat. Arb. Forum, May 27, 2000); *State Farm Mut. Auto. Ins. Co. v. I & B*, FA94719 (Nat. Arb. Forum June 8, 2000); *State Farm Mut. Auto. Ins. Co. v. JIT Consulting*, FA94335 (Nat. Arb. Forum April 24, 2000); *State Farm Mut. Auto. Ins. Co. v. Life en Theos*, FA94663 (Nat. Arb. Forum June 1, 2000); *State Farm Mut. Auto. Ins. Co. v. Try Harder & Company*, FA94730 (Nat. Arb. Forum June 15, 2000); *State Farm Mut. Auto. Ins. Co. v. J & B, Inc.*, FA94802 (Nat. Arb. Forum June 13, 2000); *State Farm Mut. Auto. Ins. Co. v. Richard Pierce*, FA94808 (Nat. Arb. Forum June 6, 2000), *State Farm Mut. Auto. Ins. Co. v. HPR*, FA94829 (Nat. Arb. Forum June 22, 2000.) (Decisions can be viewed at [www.icann.org](http://www.icann.org)) As in the cases above, Respondent has no legitimate claim in the domain name at issue. In addition, the facts in evidence demonstrate that Respondent has registered and is using the name in bad faith.

In accordance with 15 U.S.C. §1125(d) Respondent's registration of the disputed domain name was in bad faith in that:

a) Respondent has never been known by the name "State Farm" or "State Farm Insurance." The Respondent has never traded under the name "State Farm" or "State Farm

Insurance." Respondent has not acquired a trademark or other intellectual property rights in the domain name in question. This obvious lack of right to use the name in question shows bad faith registration and use.

b) Despite having registered the name "statefarmc.com" Respondent is not authorized to sell products, engage in sponsorships or services for or on behalf of State Farm Mutual Automobile Insurance Company, its affiliates or subsidiaries and is not an independent contractor agent of State Farm. Registering a domain name for products and services that it does not have authority to offer shows that the Respondent has acted in bad faith.

c) While the Respondent registered the domain name "statefarmc.com," giving the impression that interested individuals will receive information regarding State Farm; the fact is individuals are sent to a webpage that contains numerous links that pertain to insurance, including various insurance companies in direct competition with State Farm Insurance. The use of a trademark to generate business in other fashions reflects that the Respondent has acted in bad faith.

d) The Respondent is not using, nor are there any demonstrable preparations to use the domain name in connection with a bona fide offering of goods or services. As of the date of this complaint, there was no legitimate content associated with the names and no demonstrable indication that legitimate content would be forthcoming. Even if Respondent did put insurance company information on its web site, their content along with their proposed domain name, would be in direct conflict with information State Farm already provides and would cause confusion to potential customers. Failure to resolve the domain name to legitimate web site content indicates that the Respondent has no legitimate reason for having registered the name and demonstrates that it has registered and is using the name in bad faith.

f) Respondent's use of the "statefarmc.com" domain name constitute typosquatting and is evidence of bad faith registration and use pursuant to Policy ¶4(a)(iii). *See Nat'l Ass'n of Prof'l Baseball Leagues, Inc. 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"); *Nat'l Geographic Soc. v. Stoneybrook Inv.*, FA 96263 (Nat. Arb. Forum Jan. 11, 2001) finding that the domain name <nationalgeographics.com> was confusingly similar to Complainant's "National Geographic" mark; *see also Kelson Physician Partners, Inc. v. Mason*, CPR003 (CPR 2000); *EBAY, Inc. v. MEODesigns*, D2000-1368 (WIPO Dec. 15, 2000).

g) The Respondent registered its domain name, "statefarmc.com" on March 30, 2006. State Farm registered its domain name "statefarm.com" on May 24, 1995. The Respondent knew or should have known of Complainant's long-term use of the trademark "State Farm," and the long-term use of the domain name "statefarm.com." The Respondent's registration of these domain names by the Respondent was intended to be in bad faith.

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

## FINDINGS

Complainant, State Farm Mutual Automobile Insurance Company, is a nationally leading provider of insurance and financial services in the United States. In connection with the provision of these services, Complainant has registered a number of trade and service marks including the STATE FARM mark, which has been registered with the United States Patent and Trademark Office (“USPTO”) (Reg. No. 1,979,585 issued June 11, 1996).

Respondent registered the <statefarmc.com> domain name on March 30, 2006. Respondent’s domain name resolves to a website that features links to various competing and non-competing commercial links.

## 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.”).

The first question is what language the UDRP proceedings should occur in. According to ICANN Rule 11, “the language of the administrative panel proceeding shall be the language of the Registration Agreement.” The National Arbitration Forum asked the Korea Information Certificate Authority, Inc. d/b/a DomainCA.com whether the Respondent used the registration agreement in English or Korean (registration agreements in both languages appear on their web site). After a second request, the Korea Information Certificate Authority, Inc. responded “[W]e select Korean language for the dispute resolution.” The problem is the registrar does not have the power to select the language of the proceeding. Since the registrar elected to have registration agreements in English (as well as Korean), this Panel finds Respondent used the English registration agreement since there is no evidence to the contrary. Therefore, the proceeding may take place in English.

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**

Respondent has submitted evidence sufficient to establish Complainant's rights in the STATE FARM mark through registration with USPTO. *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.").

Complainant contends Respondent's <statefarmc.com> domain name is confusingly similar to Complainant's mark. Respondent's disputed domain name features Complainant's entire STATE FARM marks and adds the letter "c" along with the generic top-level domain ("gTLD") ".com." The Panel finds neither the addition of letters nor the addition of gTLD's negate a finding of confusing similarity between a domain name and a mark pursuant to Policy ¶4(a)(i). *See Victoria's Secret v. Zuccarini*, FA 95762 (Nat. Arb. Forum Nov. 18, 2000) (finding that, by misspelling words and adding letters to words, a respondent does not create a distinct mark but nevertheless renders the domain name confusingly similar to the complainant's marks); *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 contends Respondent lacks all rights or legitimate interests in the <statefarmc.com> domain name. In instances where Complainant has made a *prima facie* case under Policy ¶4(a)(ii), the burden shifts to Respondent to set forth concrete evidence that it does possess rights or legitimate interests in the disputed domain name. *See 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").

Complainant contends Respondent is using its disputed domain name to resolve to a website that features links to various competing and non-competing commercial websites from which Respondent presumably receives referral fees. The web site also contains a notation “this web site may be for sale.” The Panel finds Respondent’s use is neither a *bona fide* offering of goods or services pursuant to Policy ¶4(c)(i) nor a legitimate noncommercial or fair use pursuant to Policy ¶(c)(iii). *See Computer Doctor Franchise Sys., Inc. v. Computer Doctor*, FA 95396 (Nat. Arb. Forum Sept. 8, 2000) (finding that the respondent’s website, which is blank but for links to other websites, is not a legitimate use of the domain names); *see also TM Acquisition Corp. v. Sign Guards*, FA 132439 (Nat. Arb. Forum Dec. 31, 2002) (finding that the respondent’s diversionary use of the complainant’s marks to send Internet users to a website which displayed a series of links, some of which linked to the complainant’s competitors, was not a *bona fide* offering of goods or services).

Complainant contends Respondent is neither commonly known by the <statefarmc.com> domain name nor authorized to register domain names featuring Complainant’s STATE FARM mark in any way. In the absence of evidence suggesting otherwise, the Panel finds Respondent has not established rights or legitimate interests in accordance with Policy ¶4(c)(ii). *See 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); *see also 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).

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

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

Complainant contends Respondent is using the <statefarmc.com> domain name to operate websites that provide Internet users with links to various competing insurance and financial services websites. The Panel finds Respondent’s use constitutes a disruption of Complainant’s business and evinces bad faith pursuant to Policy ¶4(b)(iii). *See 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)); *see also EBAY, Inc. v. MEODesigns*, D2000-1368 (Dec. 15, 2000) (finding that the respondent registered and used the domain name <ebay.com> in bad faith where the respondent has used the domain name to promote competing auction sites).

Respondent’s use will likely cause confusion as to Complainant’s sponsorship of and affiliation with the resulting websites. The Panel finds such use of a domain name for

Respondent's own commercial gain is additional evidence of Respondent's bad faith registration and use pursuant to Policy ¶4(b)(iv). *See Perot Sys. Corp. v. Perot.net*, FA 95312 (Nat. Arb. Forum Aug. 29, 2000) (finding bad faith where the domain name in question is obviously connected with the complainant's well-known marks, thus creating a likelihood of confusion strictly for commercial gain); *see also Anne of Green Gable Licensing Auth., Inc. v. Internetworks*, AF-0109 (eResolution June 12, 2000) (finding that the respondent violated Policy ¶4(b)(iv) because the respondent admittedly used the complainant's well-known mark to attract users to the respondent's website).

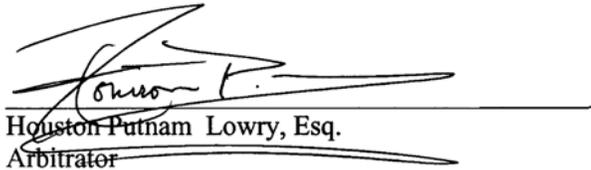
Respondent's bad faith is further evidenced by the phrase "this web site may be for sale." It is a common subterfuge to use such language to give the registrant room to deny the domain is for sale, while attracting buyers. The Panel's vision will not be clouded by such a subterfuge.

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



Houston Putnam Lowry, Esq.  
Arbitrator

Houston Putnam Lowry, Chartered Arbitrator, Panelist  
Dated: August 29, 2006