



## NATIONAL ARBITRATION FORUM

### DECISION

State Farm Mutual Automobile Insurance Company v. Dewey MacKay d/b/a PMA  
Media Group  
Claim Number: FA0610000811699

#### 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 **Dewey MacKay d/b/a PMA Media Group** ("Respondent"), 554 E. Technology Way, Orem, UT 84097.

#### REGISTRAR AND DISPUTED DOMAIN NAME

The domain name at issue is <**statefarmcarandhousecare.info**>, registered with **RegisterFly.com, 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 October 2, 2006; the National Arbitration Forum received a hard copy of the Complaint on October 3, 2006.

On October 3, 2006, RegisterFly.com, Inc. confirmed by e-mail to the National Arbitration Forum that the <**statefarmcarandhousecare.info**> domain name is registered with RegisterFly.com, Inc. and that Respondent is the current registrant of the name. RegisterFly.com, Inc. has verified that Respondent is bound by the RegisterFly.com, 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 October 4, 2006, a Notification of Complaint and Commencement of Administrative Proceeding (the "Commencement Notification"), setting a deadline of October 24, 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@statefarmcarandhousecare.info by e-mail.

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

On October 31, 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:

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

##### 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 is 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 July of 2006 it was brought to State Farm's attention that Respondent had registered Complainant's trademark "State Farm" as part of the domain name, "statefarmcareandhousecare.info." The domain name sends a person to a web page that is titled State Farm and appears to be set up as a blogging site. On the page are various links provided by Google that concern blogs and blogging. No legitimate content is presented on the site.

On August 2, 2006 a cease and desist letter was sent by Complainant's Intellectual Property Administrator via certified mail to Respondent which was returned as "unclaimed."

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

Because of State Farm's substantial efforts, the public associates the phrase "State Farm" with the owner of the servicemark "State Farm." The State Farm mark is distinctive and has acquired a secondary meaning. 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 servicemark "State Farm." State Farm did not authorize the Respondent to register the domain name or to use the State Farm trademark for the Respondent's business purposes.

Respondent is not commonly known under the domain name, "statefarmcarandhousecare.info." 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 site.

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).)

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." The Respondent has never traded under the name "State Farm." Respondent has not acquired a trademark or other intellectual property rights in the domain name in question. Moreover, Respondent has not registered the name in question with the Secretary of State in the state in which it does business or filed incorporation papers with respect to the same. This obvious lack of right to use the name in question shows bad faith registration and use.

b) Despite having registered the name "statefarmcarandhousecare.info," 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 "statefarmcarandhousecare.info," giving the impression that interested individuals will receive information regarding State Farm, the fact is individuals are sent to a web page that is titled State Farm and appears to be set up as a blogging site. On the page are various links provided by Google that concern blogs and blogging. No legitimate content is presented on the site. 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 State Farm or professional designation 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.

e) The Respondent registered its domain name, "statefarmcarandhousecare.info" on June 29, 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," "State Farm Insurance" and the long-term use of the domain

name "statefarm.com." The Respondent's registration of the domain name 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 known company providing services in both the insurance and financial services industries. In connection with the provision of these services, Complainant has registered a number of trade and service marks including the STATE FARM mark, which was registered with the United States Patent and Trademark Office ("USPTO") (Reg. No. 1.979,585 issued June 11, 1996).

Respondent registered the <**statefarmcarandhousecare.info**> domain name June 29, 2006. Respondent's disputed domain name currently resolves to a website entitled "state farm" that has several links that concern blogs and blogging.

## **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 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 asserts rights in the STATE FARM mark through registration with the USPTO. The Panel finds Complainant's trademark registration with the USPTO and extensive use of the STATE FARM mark for over seventy years is sufficient to establish rights pursuant to Policy ¶4 (a)(i). *See 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 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.").

Complainant contends Respondent's <statefarmcarandhousecare.info> domain name is confusingly similar to Complainant's mark. Respondent's disputed domain name features Complainant's entire STATE FARM mark and adds the descriptive terms "car," "and," "house," and "care." Additionally, the disputed domain name contains the top-level domain ".info." The additional terms relate to Complainant's insurance business (who insures cars and houses, *inter alia*). The Panel finds the addition of several descriptive terms that relate to Complainant's business, as well as the inclusion of the top-level domain ".info," fails to sufficiently distinguish a domain name from a mark pursuant to Policy ¶4(a)(i). *See Space Imaging LLC v. Brownell*, AF-0298 (eResolution Sept. 22, 2000) (finding confusing similarity where the respondent's domain name combines the complainant's mark with a generic term that has an obvious relationship to the complainant's business); *see also L.L. Bean, Inc. v. ShopStarNetwork*, FA 95404 (Nat. Arb. Forum Sept. 14, 2000) (finding that combining the generic word "shop" with the complainant's registered mark "llbean" does not circumvent the complainant's rights in the mark nor avoid the confusing similarity aspect of the ICANN Policy).

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

### **Rights or Legitimate Interests**

Complainant contends Respondent lacks rights or legitimate interests in the <statefarmcarandhousecare.info> 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 it does possess rights or legitimate interests in the disputed domain name. *See Compagnie Generale des Matieres Nucleaires v. Greenpeace Int'l*, D2001-0376 (WIPO May 14, 2001) ("Proving that the Respondent has no rights or legitimate interests in respect of the Domain Name requires the Complainant to prove a negative. For the purposes of this sub paragraph, however, it is sufficient for the Complainant to show a *prima facie* case and the burden of proof is then shifted on to the shoulders of Respondent. In those circumstances, the common approach is for respondents to seek to bring themselves within one of the examples of paragraph 4(c) or put forward some other reason why they can fairly be said to have a relevant right or legitimate interests in respect of the domain name in question."); *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”).

Over time, respondents have sent up a variety “form” web sites on domain names in an attempt to show the domain is being used. This has included links to search engines to give dynamic content, static and dynamic parking pages, family gathering places, and commission-generating website links (essentially static referral pages). Such uses are not a *bona fide* offering of goods or services. It is easy to set up a web site to create a blog with no content (as was done in this case). Without content that has any meaning (in this case, there is apparently no content at all, much less content with meaning), it appears the blog is just being used as a subterfuge to show a *bona fide* use. With all due respect, this Panel will not be so easily misled.

Complainant asserts Respondent is using the disputed domain name to resolve to a website that is unrelated to the Complainant’s business. 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 ¶4(c)(iii). *See Bank of Am. Corp. v. Nw. Free Cmty. Access*, FA 180704 (Nat. Arb. Forum Sept. 30, 2003) (“Respondent’s demonstrated intent to divert Internet users seeking Complainant’s website to a website of Respondent and for Respondent’s benefit is not a bona fide offering of goods or services under Policy ¶4(c)(i) and it is not a legitimate noncommercial or fair use under Policy ¶4(c)(iii).”); *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).”).

Respondent is neither commonly known by the <**statefarmcarandhousecare.info**> domain name nor authorized to register a domain name 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 Gallup, Inc. v. Amish Country Store*, FA 96209 (Nat. Arb. Forum Jan. 23, 2001) (finding that the respondent does not have rights in a domain name when the respondent is not known by the mark); *see also G.D. Searle & Co. v. Cimock*, FA 126829 (Nat. Arb. Forum Nov. 13, 2003) (“Due to the fame of Complainant’s mark there must be strong evidence that Respondent is commonly known by the disputed domain name in order to find that Respondent has rights or legitimate interests in the disputed domain name pursuant to Policy ¶4(c)(ii). However, there is no evidence on record, and Respondent has not come forward with any proof to establish that it is commonly known as CELEBREXX or <celebrexx.com>.”).

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

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

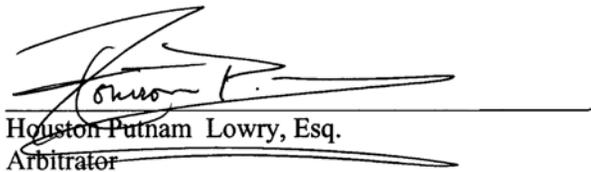
Respondent is using the <statefarmcarandhousecare.info> domain name to operate a website that is unrelated to Complainant's business. The Panel finds Respondent's use is likely to cause confusion with Complainant's business and evinces bad faith pursuant to Policy ¶4(b)(iv). The Panel further infers Respondent's use suggests the registration of the disputed domain name is for the commercial gain of Respondent. *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). *See G.D. Searle & Co. v. Celebrex 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) because the respondent was using the confusingly similar domain name to attract Internet users to its commercial website); *see also State Farm Mut. Auto. Ins. Co. v. Northway*, FA 95464 (Nat. Arb. Forum Oct. 11, 2000) (finding that the respondent registered the domain name <statefarmnews.com> in bad faith because the respondent intended to use the complainant's marks to attract the public to the web site without permission from the complainant).

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 <statefarmcarandhousecare.info> domain name be **TRANSFERRED** from Respondent to Complainant.



Houston Putnam Lowry, Esq.  
Arbitrator

Houston Putnam Lowry, Chartered Arbitrator, Panelist  
Dated: November 14, 2006