



## DECISION

Webster Financial Corporation v. Domain Manager / Affordable Webhosting, Inc.,  
Advertising

Claim Number: FA1612001705353

### PARTIES

Complainant is **Webster Financial Corporation** (“Complainant”), represented by **Gail Podolsky of Carlton Fields Jordan Burt, P.A.**, Georgia, USA. Respondent is **Domain Manager / Affordable Webhosting, Inc., Advertising** (“Respondent”), represented by **Zak Muscovitch of The Muscovitch Law Firm**, Canada.

### REGISTRAR AND DISPUTED DOMAIN NAME

The domain name at issue is **<hssbank.com>**, registered with **Name.com, Inc.**.

### PANEL

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

Terry F. Peppard as Panelist.

### PROCEDURAL HISTORY

Complainant submitted a Complaint to the FORUM electronically on December 1, 2016; the FORUM received payment on December 1, 2016.

On December 1, 2016, Name.com, Inc. confirmed by e-mail to the FORUM that the **<hssbank.com>** domain name is registered with Name.com, Inc. and that Respondent is the current registrant of the name. Name.com, Inc. has verified

that Respondent is bound by the Name.com, Inc. registration agreement and has thereby agreed to resolve domain disputes brought by third parties in accordance with ICANN's Uniform Domain Name Dispute Resolution Policy (the "Policy").

On December 6, 2016, the FORUM served the Complaint and all Annexes, including a Written Notice of the Complaint, setting a deadline of January 3, 2017 by which Respondent could file a Response to the Complaint, via e-mail to all entities and persons listed on Respondent's registration as technical, administrative, and billing contacts, and to postmaster@hssbank.com. Also on December 6, 2016, the Written Notice of the Complaint, notifying Respondent of the e-mail addresses served and the deadline for a Response, was transmitted to Respondent via post and fax, to all entities and persons listed on Respondent's registration as technical, administrative and billing contacts.

A timely Response was received and determined to be complete on December 29, 2016.

Complainant submitted an Additional Submission under date of January 3, 2017, and Respondent filed an Additional Submission under date of January 5, 2017.

On January 3, 2017, pursuant to Complainant's request to have the dispute decided by a single-member Panel, the FORUM appointed Terry F. Peppard as sole Panelist in this proceeding.

Having reviewed the communications records, the Administrative Panel (the "Panel") finds that the 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" through submission of Electronic and Written Notices, as defined in Rule 1 and Rule 2.

## RELIEF SOUGHT

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

## PARTIES' CONTENTIONS

### A. Complainant

In its Complaint and Additional Submission, Complainant alleges, among other things, that:

Complainant, with \$22 billion in assets, provides business and consumer banking, mortgage, insurance, trust, investment and other financial services.

Complainant has continuously employed the mark HSA BANK in the operation and marketing of its business of offering health savings accounts since December 10, 2003.

Complainant has rights in the HSA BANK service mark by virtue of its registration of the mark with the United States Patent and Trademark Office ("USPTO"), Registry No. 3,161,483, registered October 24, 2006.

Respondent registered the domain name **<hssbank.com>** on December 8, 2002.

The domain name is confusingly similar to Complainant's HSA BANK mark.

Respondent has not been commonly known by the domain name.

Complainant has not authorized Respondent to use the HSA BANK mark.

Respondent fails to provide a *bona fide* offering of goods or services by means of the domain name or a legitimate noncommercial or fair use of it.

The website resolving from the domain name has been used to host links to the websites of competitors of Complainant and currently redirects to an adult entertainment website.

Respondent has no rights to or legitimate interests in the domain name.

Respondent registered the domain name with knowledge of Complainant and its rights in the HSA BANK mark.

The domain name is an instance of typo-squatting.

Respondent registered and uses the domain name in bad faith.

#### B. Respondent

In its Response and Additional Submission, Respondent asserts, *inter alia*, that:

The **<hssbank.com>** domain name is not confusingly similar to the HSA BANK mark because small differences between short acronyms are significant.

Respondent acquired rights in the **<hssbank.com>** domain name senior in time to Complainant's acquisition of rights in the HSA BANK mark in 2006 by registering the domain name on a "first come, first served" basis in 2002.

Respondent's purpose in registering the domain name, which was for speculation in the future value of the domain name, is a legitimate purpose.

Respondent's subsequent use of the domain name cannot retroactively create bad faith as of the time of its registration.

Respondent's use of a privacy service to protect its e-mail security has no bearing on a finding of bad faith in the registration of the domain name.

Respondent, a resident of Israel, did not become aware of the existence of Complainant or its HSA BANK mark until October of 2016, when it received correspondence on this subject from Complainant's legal counsel.

By filing and pursuing its Complaint in this proceeding, Complainant is guilty of reverse domain name hijacking.

## **FINDINGS**

Complainant has failed to demonstrate that Respondent registered the contested <hssbank.com> domain name in bad faith.

## **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."

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 to or legitimate interests in respect of the domain name; and
- (3) the same domain name has been registered and is being used by Respondent in bad faith.

### Identical and/or Confusingly Similar

The parties agree that Complainant has rights in the HSA BANK mark by virtue of its registration of that mark with a national trademark authority, the USPTO. However, Respondent does not agree with Complainant's contention that the <hssbank.com> domain name is confusingly similar to the HSA BANK mark under the standards of Policy ¶ 4(a)(i). For the reasons spelled out below, no further discussion of this head of the Policy is necessary.

### Rights or Legitimate Interests

Complainant and Respondent further disagree as to Respondent's claim of rights to or legitimate interests in the <hssbank.com> domain name under Policy ¶ 4(a)(ii). However, in light of the disposition, *infra*, of the question whether Respondent registered the domain name in bad faith, we need not examine this disagreement. *See, for example, Creative Curb v. Edgetec Int'l Pty. Ltd.*, FA 116765 (Nat. Arb. Forum September 20, 2002) (finding that, because a UDRP complainant must prove all three elements set out in Policy ¶ 4(a) in order to obtain relief from an administrative panel, a complainant's failure to prove any one of those elements makes inquiry into the others unnecessary). *See also Hugo Daniel Barbaca Bejinha v. Whois Guard Protected*, FA 836538 (Nat. Arb. Forum December 28, 2006) (declining to inquire into a respondent's rights to or legitimate interests in a domain name or its registration and use of that domain name in bad faith where a UDRP complainant could not satisfy the proof requirements of Policy ¶ 4(a)(i)).

## Registration and Use in Bad Faith

Policy ¶ 4(a)(iii) provides that a UDRP complainant must prove to the satisfaction of an administrative panel both that a respondent registered a contested domain name in bad faith and that it now uses that domain name in bad faith. On the facts before us, it is evident that this dispute turns on the question whether Respondent registered the <hssbank.com> domain name in bad faith. If we conclude that Respondent did not register the domain name in bad faith as that term is understood in Policy ¶ 4(a)(iii), our inquiry ends. *See Creative Curb and Hugo Daniel*, cited above.

The facts determinative of this question are these:

1. Respondent first registered the <hssbank.com> domain name on December 8, 2002, and that registration has remained with Respondent from that time to the present;
2. Complainant has rights in the HSA BANK service mark by reason of its registration of the mark with the United States Patent and Trademark Office (Registry No. 3,161,483, registered October 24, 2006, on an application filed December 8, 2003, with a first use in commerce dating from December 10, 2003); and
3. Complainant does not rely upon a claim of pre-existing common law rights in its HSA BANK mark.

These facts permit no other conclusion than that Respondent could not have registered the <hssbank.com> domain name in bad faith. Respondent registered the domain name a full year before Complainant introduced the claimed mark to commerce. Respondent therefore could not have entertained bad faith intentions respecting the HSA BANK mark because it could not have contemplated Complainant's then non-existent rights in it either at the moment the domain

name was registered or at any point in the succeeding year. *See, for example, Telecom Italia S.p.A. v. NetGears LLC*, FA 944807 (Nat. Arb. Forum May 16, 2007) (finding that a respondent could not have registered a disputed domain name in bad faith where that respondent registered the domain name before a UDRP complainant began using the mark relied upon in its complaint). *See also Telecom Italia S.p.A. v. NetGears LLC*, FA 944807 (Nat. Arb. Forum May 16, 2007) (finding that a respondent could not have registered or used a disputed domain name in bad faith where that respondent registered the domain name before a UDRP complainant began using its mark).

This has long been the consensus judgment of UDRP panelists. *See Interep Nat'l Radio Sales, Inc. v. Internet Domain Names, Inc.*, D2000-0174 (WIPO May 26, 2000) (finding no bad faith where a respondent registered a disputed domain name before a UDRP complainant's first use of its mark); *and see Open Sys. Computing AS v. degli Alessandri*, D2000-1393 (WIPO December 11, 2000) (finding no bad faith where a respondent registered a domain name before the filing of an application for registration of a trademark and commencement of its use in commerce by a UDRP complainant); *further see Aspen Grove, Inc. v. Aspen Grove*, D2001-0798 (WIPO October 5, 2001) (finding it "impossible" for a respondent to have registered a disputed domain name in bad faith where a UDRP complainant did not exist at the time of a respondent's domain name registration).

The Panel therefore finds that Complainant has failed to show that Respondent registered the contested <hssbank.com> domain name in bad faith as provided in Policy ¶ 4(a)(iii).



## Reverse Domain Name Hijacking

Respondent has requested of this Panel a finding of reverse domain name hijacking as to Complainant's conduct in bringing and pursuing its claim in this proceeding. In order to justify this request, Respondent must establish not only that Complainant's Complaint has no merit, but that Complainant has proceeded under the UDRP in bad faith. *See NetDepositVerkaik v. Crownonlinemedia.com*, D2001-1502 (WIPO March 19, 2002):

*To establish reverse domain name hijacking, Respondent must show knowledge on the part of the Complainant of the Respondent's right or legitimate interest in the Domain Name and evidence of harassment or similar conduct by the Complainant in the face of such knowledge.*

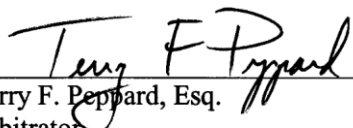
Because Complainant has demonstrated in the record that it has rights in the HSA BANK mark, and because Complainant has advanced facially plausible arguments in support of its Complaint, we decline to find that Complainant has engaged in reverse domain name hijacking in instituting and prosecuting this proceeding. *See Gallup, Inc. v. PC+s.p.r.l.*, FA 190461 (Nat. Arb. Forum December 2, 2003) (finding no reverse domain name hijacking where a UDRP complainant prevailed on the identical-or-confusingly-similar prong of the Policy). *See also ECG European City Guide v. Woodell*, FA 183897 (Nat. Arb. Forum October 14, 2003):

*Although the Panel has found that Complainant failed to satisfy its burden under the Policy, the Panel cannot conclude on that basis alone, that Complainant acted in bad faith.*

## DECISION

Complainant having failed to establish one of the elements required to be proven under the ICANN Policy, the Panel concludes that the relief requested must be, and it is hereby, **DENIED**.

Accordingly, it is Ordered that the <hssbank.com> domain name **REMAIN WITH** Respondent.

  
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Terry F. Peppard, Esq.  
Arbitrator

Terry F. Peppard, Panelist

Dated: January 6, 2017