

ADMINISTRATIVE PANEL DECISION

Bankwell Financial Group, Inc. v. Whois Privacy Protection Service, Inc. /
Domain Manager, Affordable Webhosting, Inc., Advertising
Case No. D2015-1664

1. The Parties

The Complainant is Bankwell Financial Group, Inc. of New Canaan, Connecticut, United States of America.

The Respondent is Domain Manager, Affordable Webhosting, Inc., Advertising of Manzanita, Oregon, United States of America.

2. The Domain Name and Registrar

The disputed domain name <bankwell.com> (the “Disputed Domain Name”) is registered with Name.com LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on September 18, 2015. On September 21, 2015, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On September 22, 2015, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Disputed Domain Name which differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to the Complainant on September 29, 2015, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed an amended Complaint on October 6, 2015.

The Center verified that the Complaint together with the amended Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the “Policy” or “UDRP”), the Rules for Uniform Domain Name Dispute Resolution Policy (the “Rules”), and the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the “Supplemental Rules”).

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on October 6, 2015. In accordance with the Rules, paragraph 5, the due date for Response was October 26, 2015. The Response was filed with the Center on October 23, 2015.

The Center appointed Peter Dernbach as the sole panelist in this matter on October 30, 2015. The Panel finds that it was properly constituted. The Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Center to ensure compliance with the Rules, paragraph 7.

4. Factual Background

The Complainant is a consumer and commercial banking and lending institution. It underwent a name change in 2013, after a merger of three local banks, from "Bank of New Canaan" to "Bankwell", as well as its holding company, from "BNC Financial Group" to "Bankwell Financial Group".

The Complainant has produced registration information for the following trademarks in the United States:

1. BANKWELL: Registration No. 4,419,856 in class 36 on October 15, 2013
2. BANK SMART. BANK LOCAL. BANKWELL: Registration No. 4,523,071 in class 36 on April 29, 2014

According to the Whois data, the Disputed Domain Name <bankwell.com> was registered by the Respondent on April 16, 2003, updated on April 9, 2015, and will expire on April 16, 2017.

The Respondent changed its registration record in April 2015 so that the publicly disclosed Whois data reflected a privacy protection service, and changed it back again in September 2015.

5. Parties' Contentions

A. Complainant

The Complainant requests the Disputed Domain Name be transferred to the Complainant based on the following grounds:

(i) The Disputed Domain Name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights.

The Disputed Domain Name <bankwell.com> is identical to the Complainant's BANKWELL trademark and confusingly similar to the BANKWELL mark.

(ii) The Respondent has no rights or legitimate interests in respect of the Disputed Domain Name.

The Disputed Domain Name does not comprise the legal name of the Respondent, nor is the Respondent commonly known by the Disputed Domain Name. The Complainant has not authorized, licensed or otherwise permitted the Respondent to use the BANKWELL trademark.

The Respondent did not, prior to notice of this dispute, use the Disputed Domain Name in connection with a *bona fide* offering of goods or services, or make a legitimate noncommercial or fair use of the Disputed Domain Name. The website to which the Disputed Domain Name resolves provides hyperlinks to the websites of the Complainant's competitors or to other third party websites that provide advertisements for links to the Complainant's competitors.

(iii) The Disputed Domain Name was registered and is being used in bad faith.

The Respondent acquired the Disputed Domain Name sometime between February 9, 2015 and April 14, 2015, and purchased privacy services after the Complainant had established its name and website under the BANKWELL trademark.

In addition, a renewal or transfer of a registration may, in some circumstances, be treated as a “new registration” thereby reaffirming the representation and warranty. Sometime after April 14, 2015, and after removing its name from the registration by putting a privacy protection proxy in place, the Respondent began using the Disputed Domain Name in bad faith, by modifying the related links and hyperlinks from non-bank related links and hyperlinks to the links and hyperlinks of the Complainant’s competitors and/or competitive services. Such activities occurred subsequent to the Complainant’s established rights in the BANKWELL trademark. Consumers looking for the Complainant are faced with links to numerous third-party websites that advertise and sell competing consumer and commercial banking products and services.

Due to the fact that the Disputed Domain Name is identical to the Complainant’s BANKWELL trademark and that the Respondent purchased the proxy services from Whois Privacy Protection Service, Inc. just prior to modifying the content on the website to which the Disputed Domain Name resolves to include hyperlinks to direct competitors of the Complainant, it can be inferred that the Respondent had actual knowledge of the Complainant’s rights in its BANKWELL trademark.

As of September 22, 2015, four days after the filing of the original Complaint, the Respondent changed its Whois status to accurately reflect its ownership of the Disputed Domain Name. It further removed all content that had been associated with the Disputed Domain Name, where it now resolves to the home page of the Registrar.

B. Respondent

(i) The Disputed Domain Name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights.

The Respondent acknowledges that the Complainant has rights in the BANKWELL mark, and that the Disputed Domain Name is identical or confusingly similar to the Complainant’s BANKWELL trademark. The Respondent argues, though, that the Respondent’s rights in the Disputed Domain Name predate the Complainant’s rights in the BANKWELL trademark by over ten years, discussed further below.

(ii) The Respondent has no rights or legitimate interests in respect of the Disputed Domain Name.

The Disputed Domain Name was registered by the Respondent on April 12, 2003, when the Complainant did not exist and had not adopted BANKWELL as a brand. Throughout the period from 2003 to 2014, the Disputed Domain Name was owned and registered to the Respondent, and not to any “prior owner” as alleged by the Complainant.

A press release dated September 9, 2013 announced that “three local Connecticut banks were merging into one”, and were rebranding to be called “Bankwell”. The Complainant subsequently obtained a registered trademark in October, 2013, with a date of first use of June 27, 2013.

The Respondent’s rights and interests in the Disputed Domain Name pre-existed the Complainant’s own purported rights and interests by over ten years. At the time that the Disputed Domain Name was registered on April 16, 2003, the Complainant itself did not have rights or legitimate interests in BANKWELL. In fact, the Complainant did not exist or adopt the brand until 2013.

Upon registration of the Disputed Domain Name, the only person who had any rights or legitimate interests in the Disputed Domain Name was the Respondent, and although those rights may have subsequently been somewhat curtailed by the coming into existence of a trademark in connection with certain services, the Respondent’s original rights and legitimate interests in the Disputed Domain Name were never extinguished.

(iii) The Disputed Domain Name has been registered and is being used in bad faith.

The Respondent argues that it is a factual impossibility for the Disputed Domain Name to have been

registered in bad faith for the simple reason that the Disputed Domain Name was registered before the Complainant, or its brand, existed (*Aspen Grove, Inc. v. Aspen Grove*, WIPO Case No. D2001-0798). The WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Second Edition (“WIPO Overview 2.0”) states at paragraph 3.1: “Generally speaking...when a domain name is registered by the respondent before the complainant’s relied-upon trademark right is shown to have been first established...the registration of the domain name would not have been in bad faith because the registrant could not have contemplated the Complainant’s then non-existent right.”

With regard to use of the Disputed Domain Name, the Respondent has been consistently using the Disputed Domain Name for pay-per-click advertising since at least 2006. The Disputed Domain Name contains the word, “bank”, and as such the parking platform’s algorithm likely automatically selected what it considered to be subject-matter related links. At no time to-date, did the Respondent ever set or manipulate the content of the ads. The Respondent’s use of BANKWELL in association with banking is actually senior to the Complainant’s use of its trademark, and therefore the Respondent’s use of the Disputed Domain Name should not be held to be in bad faith.

The Respondent’s use of privacy protection for the Disputed Domain Name on April 14, 2015 does not constitute a “re-registration”. Where an unbroken chain of underlying ownership by a single person is established, a change in the recorded Whois details will not be considered a new registration for the purposes of the UDRP (*Angelica Fuentes Téllez v. Domains by Proxy, LLC / Angela Brink*, WIPO Case No. D2014-1860).

The use of privacy services in general is not objectionable. This approach is also supported by the WIPO Overview 2.0 at paragraph 3.9, wherein it is stated that the use of a privacy or proxy registration service is not in and of itself an indication of bad faith. It is only when a respondent uses a privacy service primarily in order to hinder legal proceedings, that the use of a privacy service may be an argument supporting an allegation of bad faith. In the present case, there was no effort to hide or hinder legal proceedings, nor any correlation with the Disputed Domain Name’s use, as aforesaid.

Upon service of the UDRP proceeding, the Respondent of course disabled the Disputed Domain Name’s associated website, as the Respondent was surprised by the existence of the Complainant’s trademark and did not wish to infringe upon it. This does not support a conclusion that either the registration or use of the Disputed Domain Name was in bad faith.

There is no evidence whatsoever that the Respondent intentionally used the Disputed Domain Name to target the Complainant, and there is no evidence whatsoever that it intentionally changed its use of the Disputed Domain Name to take advantage of the Complainant. It is indisputable that the Respondent’s use for banking related ads pre-existed the Complainant’s trademark. There is no evidence whatsoever of the Respondent becoming aware of Complainant’s trademark in 2013.

6. Discussion and Findings

A. Identical or Confusingly Similar

Paragraph 4(a)(i) of the Policy provides that “[a domain-name holder] is required to submit to a mandatory administrative proceeding in the event that [a complainant] asserts to the applicable [administrative-dispute-resolution service provider], in compliance with the Rules of Procedure, that (i) [the disputed domain name] is identical or confusingly similar to a trademark or service mark in which the complainant has rights[.]”

The Complainant has established that it is the owner of the BANKWELL trademark in the United States.

The Disputed Domain Name, <bankwell.com>, incorporates the BANKWELL trademark in its entirety, with the addition of the generic Top-Level Domain (gTLD) “.com”. The addition of the gTLD “.com” cannot distinguish the Disputed Domain Name from the Complainant’s BANKWELL trademark. The only distinctive

part of the Disputed Domain Name is “bankwell”, which is identical to the trademark in which the Complainant has rights.

Therefore, the Panel concludes that the Disputed Domain Name is confusingly similar to the Complainant’s BANKWELL trademark. The condition of paragraph 4(a)(i) of the Policy has been fulfilled.

B. Rights or Legitimate Interests

Paragraph 4(a)(ii) of the Policy provides that “[a domain-name holder] is required to submit to a mandatory administrative proceeding in the event that [a complainant] asserts to the applicable [administrative-dispute-resolution service provider], in compliance with the Rules of Procedure, that [...] (ii) [the respondent has] no rights or legitimate interests in respect of the [disputed] domain name[.]”

Paragraph 4(c) of the Policy sets out the following several circumstances “[which], in particular but without limitation, if found by the Panel, shall demonstrate [the respondent’s] rights or legitimate interests to the [disputed] domain name for the purposes of Paragraph 4(a)(ii) [of the Policy]:

- (i) before any notice to [the respondent] of the dispute, [the respondent’s] use of, or demonstrable preparations to use, the [disputed] domain name or a name corresponding to the [disputed] domain name in connection with a *bona fide* offering of goods or services; or
- (ii) [the respondent] (as an individual, business, or other organization) [has] been commonly known by the [disputed] domain name, even if [the respondent has] acquired no trademark or service mark rights; or
- (iii) [the respondent is] making a legitimate noncommercial or fair use of the disputed domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.”

The Complainant has shown that the Respondent is not in any way related to the Complainant’s business, is not one of its distributors and the Respondent does not carry out any activity for the Complainant nor does it have any business with it. There is also no evidence showing that the Respondent is commonly known by the Disputed Domain Name, and not is it authorized to use the BANKWELL trademark.

The Respondent has shown that it registered the Disputed Domain Name in 2003, some ten years prior to the Complainant’s trademark registration.

The Panel notes that the system of domain name registration is generally a “first-come, first-served system.” Absent pre-existing rights which may be used to revoke a registration, the first person in time to register a domain name would normally be entitled to use the domain name for any legitimate purpose it wishes (*Inbay Limited v. Ronald Tse dba Neosparx International*, WIPO Case No. D2014-0096).

In the instant case, the Respondent adopted the Disputed Domain Name prior to the Complainant’s obtaining rights or interests in the BANKWELL trademark. The Respondent proceeded to use the Disputed Domain Name for advertising, including for banking which appears to be a reasonable use considering the composition of the Disputed Domain Name.

However, the Panel notes that the website to which the Disputed Domain Name resolves did provide, at some point in time after the Complainant had registered its BANKWELL trademark, hyperlinks to the websites of the Complainant’s competitors or to other, third party websites.

Be that as it may, in view of the Panel’s findings below, the Panel need not make a finding under paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

Paragraph 4(a)(iii) of the Policy provides that “[a domain-name holder] is required to submit to a mandatory administrative proceeding in the event that [a complainant] asserts to the applicable [administrative-dispute-resolution service provider], in compliance with the Rules of Procedure, that [...] (iii) [the respondent’s] domain name has been registered and is being used in bad faith.”

Paragraph 4(b) of the Policy explicitly states, in relevant part, that “the following circumstances, in particular but without limitation, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith:

(iv) by using the domain name, [the respondent has] intentionally attempted to attract, for commercial gain, Internet users to [the respondent’s] web site or other on-line location, by creating a likelihood of confusion with the complainant’s mark as to the source, sponsorship, affiliation, or endorsement of [the respondent’s] web site or location or of a product or service on [the respondent’s] web site or location.”

There is authority supporting the view that a trademark that did not exist at the time the disputed domain name was registered cannot serve as the basis for a claim under the Policy, since it is impossible for the domain name to have been registered in bad faith.

The Complaint argues that the Respondent’s change of registration information, as shown in the Whois database, after April 14, 2014 constitutes a new registration, and thus can be considered a registration in bad faith as it occurred after the registration of the Complainant’s trademark. However, it is established that where an unbroken chain of underlying ownership by a single person is established, a change in the recorded Whois details will not be considered a new registration for the purposes of the UDRP (*Angelica Fuentes Téllez v. Domains by Proxy, LLC / Angela Brink, supra*).

Generally speaking, although a trademark can form a basis for a UDRP action under the first element irrespective of its date, when a domain name is registered by the respondent before the complainant’s relied-upon trademark right is shown to have been first established (whether on a registered or unregistered basis), the registration of the domain name would not have been in bad faith because the registrant could not have contemplated the complainant’s then non-existent right (paragraph 3.1 of WIPO Overview 2.0).

The Disputed Domain Name was registered in 2003, long before the Complainant, or its brand, existed (*Aspen Grove, Inc. v. Aspen Grove, supra*), and the Complainant has failed to establish that the Disputed Domain Name was registered in bad faith.

As the Policy requires that the Disputed Domain Name be registered and used in bad faith, and the Complainant has failed to show that the Disputed Domain Name was registered in bad faith, the Panel concludes that the conditions of paragraph 4(a)(iii) of the Policy have not been satisfied and does not need to address the allegations regarding the use of the Disputed Domain Name.

7. Decision

For the foregoing reasons, and in accordance with paragraphs 4(a) of the Policy and 15 of the Rules, the Complaint is denied.

Peter Dernbach

Sole Panelist

Date: November 13, 2015