

ADMINISTRATIVE PANEL DECISION

Marathon Savings Bank v. Domain Manager, Affordable Webhosting, Inc.,
Advertising

Case No. D2017-1841

1. The Parties

Complainant is Marathon Savings Bank of Wausau, Wisconsin, United States of America, represented by Quarles & Brady LLP, United States of America.

Respondent is Domain Manager, Affordable Webhosting, Inc., Advertising, of Manzanita, Oregon, United States of America (“United States”), represented by Muscovitch Law P.C., Canada.

2. The Domain Name and Registrar

The disputed domain name <marathonbank.com> is registered with Name.com, Inc. (Name.com LLC) (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on September 21, 2017. On September 22, 2017, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On September 25, 2017, the Registrar transmitted by email to the Center its verification response confirming that Respondent is listed as the registrant and providing the contact details.

The Center verified that the 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 Respondent of the Complaint, and the proceedings commenced on October 4, 2017. In accordance with the Rules, paragraph 5, the due date for Response was October 24, 2017. The Response was filed with the Center on October 24, 2017.

The Center appointed Lawrence K. Nodine as the sole panelist in this matter on November 7, 2017. 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

Complainant offers banking services under the name Marathon Savings Bank. Complainant was established in Marathon County, Wisconsin, United States, in 1902 as Marathon Savings and Loan Association and in 1993 changed its name to Marathon Savings Bank. Complainant currently offers its services through its bank locations in Wisconsin and online through its website "www.marathonsavingsbank.com", which was registered in 1999.

Respondent is "in the business of registering ... 'brand-able' names, particularly for the banking industry", Response, paragraph 43. On January 21, 2004, Respondent registered the disputed domain name <marathonbank.com>. Using a third party, on June 27, 2017, Complainant attempted to purchase the disputed domain name from Respondent for USD 5,000. Respondent counteroffered for USD 375,000.

5. Parties' Contentions

A. Complainant

Complainant asserts common law rights in Marathon Savings Bank through its continuous use of the name in commerce since 1993. Complainant argues that Respondent did not have rights to the name because Complainant had been using the name in commerce for more than a decade before Respondent registered the disputed domain in 2004. According to Complainant, the disputed domain name is confusingly similar to Complainant's name as the dominant portion of the name ("Marathon" and "Bank") is incorporated in the disputed domain name. Furthermore, Complainant maintains that Respondent does not have rights or legitimate interests in the disputed domain name because Respondent is misleading consumers by attracting them using a disputed domain name nearly identical to Complainant's name and collecting revenue by featuring sponsored links on its search engine. Complainant also points to the fact that the disputed domain name is listed for sale.

In support of its contention of bad faith registration and use, Complainant argues that Respondent registered the disputed domain name with the intent of creating a parked page with sponsored links to take advantage of Internet users seeking Complainant's services and that Respondent has used the disputed domain name to disrupt Complainant's business by preventing Complainant from using that domain name for its services. Moreover, Complainant points to Respondent's demand of USD 375,000 in exchange for the disputed domain name.

B. Respondent

Respondent maintains that the name Marathon Savings Bank is merely descriptive and that Complainant has failed to establish its common law rights to the name. According to Respondent, "several federally regulated Marathon-named banks . . . co-existed with Complainant" at the time Respondent registered the disputed domain name (Response, paragraph 15). Respondent argues that because Complainant has failed to prove its rights to the name Marathon Savings Bank, it cannot establish that the disputed domain name is confusingly similar to Complainant's trademark or that Respondent lacked rights or a legitimate interest in the disputed domain name. Moreover, Respondent asserts that it was not aware of Complainant at any point before the Complaint was filed and that Complainant has failed to prove that its name was known outside the Wisconsin area such that Respondent was likely to have known of Complainant at the time it registered the disputed domain name. Thus, Respondent argues, Complainant cannot show bad faith registration.

6. Discussion and Findings

A. Identical or Confusingly Similar

Complainant offers evidence that the name Marathon Savings Bank is used in commerce and has sufficiently shown acquired distinctiveness for present purposes. For example, Complainant provides three print ads (from 1996, 1997, and 2002) featuring the services of the Marathon Savings Bank and shows that it maintains an on-line presence through its website “www.marathonsavingsbank.com” and also that, as of 2017, it is the “only active FDIC insured bank in the United States using the name ‘Marathon’” (Complaint, paragraph 12.1.2). While the evidence is not robust, it is enough to find that Complainant has common law rights in Marathon Savings Bank sufficient to confer standing under the first element.

The disputed domain name is confusingly similar to Complainant’s common law mark because it incorporates “Marathon”, the dominant term in the mark. The omission of the term “Savings” does not prevent a finding of confusing similarity, especially given the inclusion of the term “bank” in the disputed domain name.

Accordingly, the Panel finds that Complainant has satisfied paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

Because Complainant fails to satisfy the third element of the Policy, the Panel does not address the second element.

C. Registered and Used in Bad Faith

Complainant has not proved by a preponderance of evidence that Respondent registered the disputed domain name in bad faith. There is no basis to infer that Respondent had knowledge of Complainant’s rights when it registered the disputed domain name in 2004. Neither is there any basis to conclude that Respondent probably knew of Complainant’s rights when it registered in 2004. While Complainant provides print ads from 1996, 1997, and 2002, these ads appear to be in local circulars and there is nothing to indicate that the reach of the circulars extended beyond the local area in Wisconsin. Although Complainant shows that it registered its domain name in 1999, there is nothing to show when Complainant’s created a website particularly so as to show it would be known in a wider sense. Thus, there is nothing in the record from which the Panel may infer “Respondent’s knowledge and bad faith disregard of Complainant’s rights” *Thirty & Co. v. Jake Marcum, Marcum Creative, LLC*, WIPO Case No. D2016-1212.

Accordingly, Complainant has not satisfied paragraph 4(a)(iii) of the Policy.

7. Decision

For the foregoing reasons, the Complaint is denied.

Respondent argues that this is an instance of reverse domain name hijacking. The Panel is not persuaded.

Lawrence K. Nodine

Sole Panelist

Date: November 20, 2017