



## NATIONAL ARBITRATION FORUM

### DECISION

Midland National Life Insurance Company v. ItemWire / Edwin Sherman

Claim Number: FA1211001472440

### PARTIES

Complainant is **Midland National Life Insurance Company** (“Complainant”), represented by **Sean Garrison** of **Lewis and Roca LLP**, Arizona, USA.

Respondent is **ItemWire / Edwin Sherman** (“Respondent”), represented by **Zak Muscovitch** of **The Muscovitch Law Firm**, Canada.

### REGISTRAR AND DISPUTED DOMAIN NAME

The domain name at issue is **<midlandinsurance.com>**, registered with **Domain Band, Inc.**

### PANEL

The undersigned certify that they have acted independently and impartially and to the best of their knowledge have no known conflict in serving as Panelists in this proceeding.

Jeffrey M. Samuels, The Honourable Neil Anthony Brown, QC and Hon. Charles K. McCotter, Jr. (Ret.), as Panelists.

### PROCEDURAL HISTORY

Complainant submitted a Complaint to the National Arbitration Forum electronically on November 21, 2012; the National Arbitration Forum received payment on November 21, 2012.

On November 23, 2012, Domain Band, Inc. confirmed by e-mail to the National Arbitration Forum that the <midlandinsurance.com> domain name is registered with Domain Band, Inc. and that Respondent is the current registrant of the name. Domain Band, Inc. has verified that Respondent is bound by the Domain Band, 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 November 27, 2012, the Forum served the Complaint and all Annexes, including a Written Notice of the Complaint, setting a deadline of December 17, 2012 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@midlandinsurance.com. Also on November 27, 2012, 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 17, 2012.

Complainant submitted an Additional Submission on December 21, 2012, which was found to be compliant.

Respondent submitted an Additional Submission on December 26, 2012, which was found to be compliant.

On January 2, 2013, pursuant to Respondent's request to have the dispute decided by a three-member Panel, the National Arbitration Forum appointed as

Panelists Jeffrey M. Samuels, The Honourable Neil Anthony Brown, QC, and Hon. Charles K. McCotter, Jr. (Ret.).

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" 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**

Complainant Midland National Life Insurance Company has been in business for over 100 years and holds more than one million life insurance and annuity policies with assets exceeding \$30 billion. Midland National owns U.S. trademark registrations for its MIDLAND NATIONAL and MIDLAND NATIONAL LIFE marks. See Complaint, Exhibit 3, Ex. A. Midland National also owns a domain name registration for <mnlife.com>, from which it promotes its insurance and annuity products and services.

Complainant asserts that the disputed domain name, <midlandinsurance.com>, which was registered on August 15, 2012, is confusingly similar to its MIDLAND NATIONAL and MIDLAND NATIONAL LIFE marks. It points out that the disputed domain name is nearly identical to the marks, removing only the terms "NATIONAL" and "NATIONAL LIFE," to which Complainant has disclaimed exclusive rights apart from the marks as shown. Complainant also contends that

the addition of the term “insurance” in the disputed domain name increases its confusing nature, insofar as it describes the products and services in connection with which Complainant uses its marks.

Complainant maintains that Respondent has no rights or legitimate interests in the disputed domain name. It notes that Respondent’s former website at [midlandinsurance.com](http://midlandinsurance.com) displayed click-through links to the sites of Complainant’s competitors. See Complaint, Exhibit 4. In addition, the former website had a link to “Midland Life Insurance Co.” but did not link users to Midland National’s [<mnlife.com>](http://mnlife.com) site but to another page on the [<midlandinsurance.com>](http://midlandinsurance.com) website at which more links to Complainant’s competitors (but not to Complainant) were displayed.

Complainant indicates that Respondent changed the content of the disputed website sometime in September or early October 2012. Today, according to Complainant, the Respondent’s [<midlandinsurance.com>](http://midlandinsurance.com) website purports to offer comparison shopping services for auto insurance in Midland, Texas. When a user arrives at the Respondent’s site, the user is prompted to enter their zip code to obtain an insurance quote. After entering one’s zip code, the user is redirected to a “local results” page containing click-through links to the homepages of various insurance companies. Complainant emphasizes that “[r]egardless of the zip code entered, the local results pages returned in response display click-through links to large U.S. insurance companies, not localized results. Because there is no substantive content at the Website other than a homepage with a Zip Code entry box and results pages with click-through links, the Website is merely a pay-per-click site designed to appear otherwise and such use is not 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).”

Complainant adds that Respondent is neither an authorized agent nor a licensee of Midland National Life Insurance Company or its parent company and is not otherwise authorized to use Complainant's marks or to register domain names containing confusingly similar marks; that Respondent is not commonly known by the disputed domain name; that Respondent is not located in Midland, Texas; and that Respondent has no free speech interest in the domain name in issue.

According to Complainant:

No conceivable *bona fide* use of the Domain Name exists when the intended use is a deliberate infringement of another's rights. Given Complainant's use and promotion of the MIDLAND NATIONAL® and MIDLAND NATIONAL LIFE® marks and the reputation of the Marks, coupled with evidence of Respondent's willful disregard of Complainant's rights and the way in which the Domain Name is being used by Respondent, Respondent does not legitimately use the Domain Name. Respondent is trading off Complainant's valuable trademarks to drive consumers to its Website for commercial gain. Such use is not *bona fide* use.

With respect to the issue of "bad faith" registration and use, Complainant contends that, given that Complainant's marks were registered over 80 years ago, Respondent undoubtedly "knew or should have known" of Complainant's use of the MIDLAND NATIONAL and MIDLAND NATIONAL LIFE marks prior to the registration of the disputed domain name. Complainant further emphasizes that none of the sponsored links on the disputed site redirects a consumer to Complainant's site; instead, the links redirect users to third-party sites, all of which compete with Complainant. "Each time a viewer clicks on a sponsored link at Respondent's Website, the Respondent is paid." Moreover, according to Complainant, each redirected user is a potential customer lost. "Respondent's

use of the Website is disruptive to Complainant's business and supports findings of bad faith registration and use of the Domain Name," Complainant asserts.

#### B. Respondent

Respondent first takes aim at Complainant's trademarks, noting that Complainant does not have rights in "Midland Insurance" and that the term "Midland" is commonly used as a trademark by dozens of companies for all manner of goods and services. Respondent indicates that there are at least 535 businesses in Midland, Texas alone that use the geographic descriptor "Midland" in their business name. See Response, Exhibit F. Respondent also faults Complainant for not providing any evidence of the fame or acquired distinctiveness of "Midland Insurance."

Respondent reports that it is the owner of over 200 websites and domain names that include a geographic location and an insurance related term and has never before been accused of cybersquatting. See Response, ¶¶ 20-21. As related by Respondent, typically, a visitor to one of its sites will be asked to enter his/her zip code and then detailed insurance-related ads will be listed, with links to third party sites that offer insurance products within the geographic location of the zip code entered. The ads generated through its sites are not mere pay-per-click ads, Respondent contends. "Rather, they are provided through an agreement with Sure Hits, which provides content to web publishers....Furthermore, the advertisers that appear in the detailed insurance advertiser feed, are companies which have also retained Sure Hits to provide their ads to the public through context specific websites, such as the Respondents."

Respondent next takes the panel through the chronology and history surrounding its acquisition of the disputed domain name. It points out that, long before this dispute, it registered the domain names <odessacarinsurance.com> and <midlandinsurance.com> and then, shortly thereafter, developed sites about car

insurance targeted specifically to users from Odessa, Texas and Midland, Texas, which are only 20 miles apart. In mid-August, 2012, Respondent acquired at auction the expired registrations for the domain names <midlandinsurance.com> and <odessainsurance.com>. Such acquisitions, Respondent explains, “fit perfectly with [its] established business model and previous holdings.” Thereafter, Respondent developed its standard Midland, Texas geo-targeted site for car insurance-related inquiries, although there was a brief gap of time between registration of the disputed domain name and the erection of the site, during which a webhosting company automatically associated a placeholder web page with the domain name. This web page was populated by pay-per-click sites.

Respondent contends it has a legitimate interest in the disputed domain name “because it is a generic, descriptive term referring to ‘insurance’ in Midland.” Respondent also asserts that it has a well-established history of registering geographic + insurance domain names in connection with a genuine and expansive marketing business and that its activities qualify as a *bona fide* offering of goods and services under paragraph 4(c)(1) of the Policy.

Respondent also argues that it “is clearly using the Domain Name not as a trademark, but rather in its commonly understood descriptive sense, and there is no intention to trade off of the goodwill and reputation of the Complainant.”

Respondent maintains that the disputed domain name was not registered in bad faith as the evidence indicates that such registration was consistent with its well-established business practice. The domain name is not being used in bad faith, according to Respondent, because it is being used in connection with a site dedicated to providing car insurance quotes to residents of Midland, Texas; it never received a dime as a result of the webhost’s actions; and its use of the domain name “was perfectly acceptable” since it made use of the ordinary

common meaning of “Midland Insurance,” that is, insurance for or relating to residents of Midland, Texas.

Finally, Respondent accuses Complainant of reverse domain name hijacking. Respondent asserts that Complainant had knowledge of Respondent’s unassailable right or legitimate interest in the disputed domain name as it was well aware that Respondent had a network of similar geographic + insurance domain names and sites, yet failed to disclose such information to this Panel and proceeded to file its Complaint.

### C. Additional Submissions

In its Additional Submission, Complainant asserts that the fact that Midland is a city in Texas is not relevant to the issue of confusing similarity. Complainant also labels as “misguided” Respondent’s attempt to avoid a finding of confusing similarity by contending that Complainant only offers life insurance while Respondent’s site only relates to auto insurance. Complainant notes that Respondent’s site has links to life insurance companies and that auto and life insurance are complementary products.

Complainant further contends that Respondent’s evidence on the issue of legitimate use is not relevant because Respondent is not located in Midland and that the “local results” page on the disputed site displays links to the sites of the largest insurance companies in the U.S. and not to local, i.e., Midland, insurance companies.

Respondent attempts to distinguish itself from a pay-per-click website but the inherent purpose of Respondent’s Website is identical to that of a pay-per-click site. The only difference is Respondent has cleverly designed its site to give a personalized and legitimate look and feel by requiring entry of a zip code before

displaying sponsored links disguised as local results, as opposed to displaying sponsored links on the homepage like a traditional pay-per-click site.

On the issue of “bad faith” registration and use, Complainant contends that the content at the disputed website was under Respondent’s control from the instant it acquired such registration; indicates that Respondent hired a Whois privacy service in order to shield its identity as the registrant of the disputed domain name but did not hire such a privacy service for the <odessainsurance.com> domain name; and notes that Respondent paid 12 times more for the <midlandinsurance.com> domain name than it did for the <odessainsurance.com> name.

Complainant further argues that if Respondent intended to use the domain name in issue as a geographic indicator, “one would expect to find that the businesses listed and hyperlinked on the website were businesses specifically located in the geographic area. But that is not the case. Instead, Respondent has posted hyperlinks to competitors of Complainant located throughout the country.”

In sum, Complainant asserts, Respondent’s actions fall within paragraph 4(b)(iv) of the Policy.

Responding to Respondent’s claim of reverse domain name hijacking, Complainant first asserts that, since it has proven all three elements under the Policy, such claim need not even be addressed. Complainant goes on to assert, however, that, at the time its counsel visited the sites allegedly owned by Respondent, counsel was not aware of the identity of the registrant.

In its Additional Submission, Respondent first notes that there is no authority in the Policy for additional submissions, although it does acknowledge that the National Arbitration Forum has adopted supplemental rules, under which

additional submissions may be considered by the panel. In any event, Respondent continues, Complainant's additional submission "does nothing to avoid the inescapable issue which this case boils down to, namely; `whether it is likely that the Respondent specifically targeted the disputed Domain Name *because* of the Complainant's trademarks, or alternatively, whether it is likely that the Respondent merely acquired the Domain Name *because* of his well-established business of using geographic + insurance descriptive domain names, and has since used it in good faith'." (emphasis in original)

Respondent disputes Complainant's assertion that no local results are displayed when a visitor enters a zip code on <midlandinsurance.com>. Respondent points out that auto insurance advertisers bid by state and visitors enter their zip codes, which indicate the state in which they reside. "Local results are indeed returned because only companies that provide auto insurance coverage for that state are displayed." (emphasis in original) According to Respondent, the midlandinsurance.com site was optimized exclusively for residents of Midland, Texas and contains information about auto insurance which is specific to Texas.

Respondent also indicates that it never hired a privacy service (*see* Additional Submission, Exhibit 1, consisting of sworn declaration of Respondent Edwin Sherman) and notes that similar domains sell for a wide range of prices.

Finally, in connection with its claim of reverse domain name hijacking, Respondent reiterates its claim that Complainant knew that Respondent owned the domain name in dispute and also owned other similar geo-specific sites.

## FINDINGS

The Panel finds that the disputed domain name is confusingly similar to trademarks in which Complainant has rights; that Respondent has rights or

legitimate interests in the disputed domain name; and that the domain name was not registered and is not being used 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 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

The Panel finds that the disputed domain name is confusingly similar to the MIDLAND NATIONAL and MIDLAND NATIONAL LIFE trademarks. The test for this element of the Policy is how the objective bystander would view a comparison between the domain name and the trademarks.

The domain name and the marks each share the term "Midland," which, as used by Complainant in connection with insurance services, is distinctive and protectable. To the extent the domain name and marks differ, such differences relate to descriptive or generic matter and do not dispel a finding of confusing similarity. Moreover, the use of the term "insurance" in the disputed domain name heightens the confusing similarity, at least with respect to the MIDLAND

NATIONAL LIFE mark, insofar as such mark suggests its use in connection with insurance products and services. *See AOL LLC v. AIM Profiles*, FA 964479 (Nat. Arb. Forum May 20, 2007) (finding that the respondent failed to differentiate the <aimprofiles.com> domain name from the complainant's AIM mark by merely adding the term "profiles"); *see also Tesco Pers. Fin. Ltd. v. Domain Mgmt. Servs.*, FA 877982 (Nat. Arb. Forum Feb. 13, 2007) (holding that "the Domain Name is confusingly similar to Complainant's 'TESCO PERSONAL FINANCE' mark in that it merely omits the descriptive term 'personal.'"); *see also Isleworth Land Co. v. Lost in Space, SA*, FA 117330 (Nat. Arb. Forum Sept. 27, 2002) ("[I]t is a well established principle that generic top-level domains are irrelevant when conducting a Policy ¶ 4(a)(i) analysis.").

The evidence further indicates that Complainant, through its ownership of U.S. trademark registrations and long use of its marks, has rights in MIDLAND NATIONAL and MIDLAND NATIONAL LIFE.

### **Rights or Legitimate Interests**

The Panel concludes that Complainant has not sustained its burden of proving that Respondent has no rights or legitimate interests in the disputed domain name. The Panel is persuaded that Respondent is using the domain name in connection with a *bona fide* offering of goods and services and is making a fair use of the domain name.

The evidence indicates that Respondent owns over 200 insurance-related domain names that incorporate a geographic location. Thus, its registration of <midlandinsurance.com> appears consistent with past business practices. Moreover, the disputed domain name is used in connection with a site directed at residents of Midland, Texas, insofar as residents of Midland are directed to auto insurance companies that can *offer* policies within the State of Texas. The fact

that Respondent is not *located* in Midland or that the local results page does not refer to insurance companies *located* in Midland does not render such use illegitimate. Indeed, the Panel finds that such use constitutes a fair use under the Policy. While Complainant owns rights in the MIDLAND NATIONAL and MIDLAND NATIONAL LIFE marks, such rights do not preclude Respondent from using the term “Midland” in its domain name in connection with a site directed at residents of the city of Midland, Texas.

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

The Panel further concludes that the disputed domain name was not registered and is not being used in bad faith. The Complainant’s reliance on Respondent’s alleged use of a privacy service and the fact that the disputed domain name fetched more at auction than some other domain name does not convince the Panel that the domain name was registered in bad faith. Nor does the fact that Respondent presumably earns income from its pay-per-click site.

Upon review of all the evidence, the Panel finds that Respondent’s registration of the disputed domain was merely part and parcel of its long-standing business practices and was not motivated by an attempt to trade on Complainant’s marks.

### **Reverse Domain Name Hijacking**

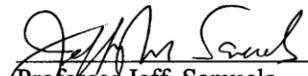
The Panel declines to declare this a case of reverse domain name hijacking, concluding that the Complaint was not brought in bad faith and does not constitute an abuse of the administrative proceeding under paragraph 15(e) of the Rules. *See ECG European City Guide v. Woodell*, FA 183897 (Nat. Arb. Forum Oct. 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”). In other words, simply because a

complainant does not prevail does not mean that it brought the Complaint in bad faith. After taking all of the evidence into account, the Panel takes the view that Complainant was entitled to take steps to protect its trademarks by filing the Complaint.

## DECISION

Having failed to establish all three elements required under the ICANN Policy, the Panel concludes that relief shall be **DENIED**.

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

  
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Professor Jeff Samuels  
Arbitrator

Jeffrey M. Samuels, Honourable Neil Anthony Brown, Q.C., and  
Hon. Charles K. McCotter, Jr. (Ret.)  
Panelists

Dated: January 11, 2013