



WIPO Arbitration and Mediation Center

ADMINISTRATIVE PANEL DECISION

American Funds Distributors Inc. v. Texas International Property Associates

Case No. D2007-0994

1. The Parties

Complainant is American Funds Distributors Inc., Los Angeles, California, United States of America, represented by Robins, Kaplan, Miller & Ciresi LLP, United States of America.

Respondent is Texas International Property Associates, Dallas, Texas, United States of America, represented by Shrull Altman LLP, United States of America.

2. The Domain Name and Registrar

The disputed domain name <americanfnds.com> (the “Domain Name”) is registered with Compana LLC.

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on July 6, 2007. On July 12, 2007, the Center transmitted by email to Compana LLC a request for registrar verification in connection with the domain name at issue. On July 18, 2007, Compana LLC 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”), 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(a) and 4(a), the Center formally notified Respondent of the Complaint, and the proceedings commenced on July 20, 2007. In accordance with the Rules, paragraph 5(a), the due date for Response was August 9, 2007. The Response was filed with the Center on August 10, 2007.

The Center appointed Maxim H. Waldbaum, Peter L. Michaelson and David E. Sorkin as

panelists in this matter on August 24, 2007. The Panel finds that it was properly constituted. Each member of 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.

On August 30, 2007, Complainant filed a supplemental filing to the Complaint.

4. Factual Background

The Domain Name was registered with Compana LLC on December 10, 2004.

Complainant registered the service mark AMERICAN FUNDS (the “Mark”) in the United States of America on October 1, 2002, and first used the Mark in connection with the provision of a variety of financial services in 1970. Complainant is one of the largest mutual fund companies and operates many mutual funds under the Mark. Since 1995, Complainant has promoted its services through an Internet website at the domain name <americanfunds.com>, which was registered by an affiliate of Complainant on February 3, 1995. Complainant and its affiliates also own at least thirty other domain names that incorporate the Mark and predate the registration of the Domain Name by Respondent.

Respondent is the registrant of thousands of domain names, which consist of electronically registered generic words or typos of generic terms.

5. Parties’ Contentions

A. Complainant

Complainant argues that the Domain Name is confusingly similar to the Mark because it merely represents a misspelling of the Mark, varying from the correct spelling by only one letter. “A slight difference in spelling between a trademark and a domain name does not reduce the confusing similarity.” *Washington Mutual, Inc. v. Phayze Inc., Peter Carrington and Party Night, Inc.*, WIPO Case No. 2003-0283.

Complainant argues that Respondent has no rights or legitimate interests in the Domain Name. First, Complainant contends that the Domain Name was registered thirty-four years after Complainant first used the Mark in commerce, fourteen years after Complainant first registered a trademark incorporating AMERICAN FUNDS, and more than three years after Complainant registered the Mark. Further, Respondent is not known by the Domain Name. Respondent is not making a legitimate non-commercial or fair use of the Domain Name, because the associated website redirects Internet users to a landing page which displays a variety of hyperlinks with names that incorporate Complainant’s marks, including “American Funds Money Market” and “American Funds Growth Funds”. When Internet users activate these hyperlinks, they are directed to web pages that display links to websites maintained by investment companies that compete directly with Complainant.

Complainant contends that Respondent’s behavior is not a legitimate business under the Policy, as it constitutes “typosquatting”, through the intentional diversion, for commercial gain, of Internet users searching for information regarding Complainant’s goods and services to Respondent’s unrelated web pages.

Complainant contends that Respondent's "typosquatting" is itself evidence of bad faith. Further, given the well-known status of Complainant's numerous marks containing of AMERICAN FUNDS and the fact that they were registered with the USPTO before Respondent registered the Domain Name, Respondent had at least constructive knowledge of Complainant's marks. Respondent's bad faith is further demonstrated by its improper and infringing use of the correctly spelled Mark on the landing page associated with the Domain Name. This is evidence of Respondent's bad faith intention to trade upon Complainant's goodwill in the Mark and confuse Internet users as to the source, sponsorship, or affiliation of Respondent's website.

Complainant also points to several prior UDRP proceedings in which panels ordered various disputed domain names of Respondent, that were identical or confusingly similar to various marks, transferred to complainants.

B. Respondent

Respondent contends that the Domain Name "calls into mind an entirely different or distinct meaning rather than the alleged mark . . .". The Domain Name is a combination of a descriptive adjective, "American", and the characters "fnds". The characters "fnds" constitute a widely used acronym, as evidenced by a search for the characters using Google results in 232,000 hits, including "Fox News Derangement Syndrome", "Focal neurological deficits". Respondent admits that "fnds" can be a typographical error or informal abbreviation in relation to several words, including "finds", "founds", "friends", or "foundations". Because of the wide range of possible legitimate meanings carried by "fnds", it cannot be said to be confusingly similar to Complainant's Mark when used in connection with "American". Respondent further argues that this is evidence of widespread usage of "fnds" in manners unrelated to the Mark, and therefore the Mark cannot protect usage of the Domain Name.

Respondent contends that it has rights and a legitimate interest in the Domain Name. Respondent claims that it offers a "legitimate business of targeted online advertising searches that are legal everywhere in the world and are actually undertaken in connection with industry leaders Google and Yahoo". Respondent contends that the links on its landing site are "provided pursuant to Yahoo or Google's terms and are triggered by search requests entered by computer users", over which it has no control. Respondent claims that the Domain Name is intended to advertise to persons looking for "American" and "fnds".

Respondent calls the Complaint a "parasitic interference in the free exchange of information and opportunity" and asserts its right to use a combination of descriptive or generic terms in a domain name. Respondent asserts that the advertising revenues generated by the Domain Name constitute a legitimate interest, and the generic nature of the Domain Name's constitutive elements evidences Respondent's good faith.

Respondent argues that should the Panel find the Domain Name to be confusingly similar to the Mark, Respondent's usage of the Domain Name constitutes a fair use, and is concordant with the policies of free competition and free use of language.

Finally, Respondent urges the Panel to eschew consideration of Respondent's recent UDRP defeats.

6. Discussion and Findings

There are two preliminary issues to resolve prior to deciding the merits of the case: (i) whether to consider the late-filed Response and (ii) whether to consider the supplemental filing to the Complaint.

The Response was due on August 9, 2007, but was not filed until August 10, 2007. Some UDRP decisions have advocated a strict adherence to the deadlines. See *e.g.* *1099 Pro, Inc. v. Convey Compliance Systems, Inc.*, WIPO Case No. D2003-0033. However, here, as the Response was filed only one day late, before a notice of default was even issued, in the interests of fairness and in accordance with paragraph 10(b) of the Rules, the Panel has considered the Response.

With respect to the supplemental filing to the Complaint, the Policy provides for supplementary filings only at the discretion of the Panel. The Panel is of the view that a supplemental filing should only be allowed in exceptional circumstances, for instance where a response raises facts that a complainant could not have been expected to address in the complaint. In the circumstances, the Panel does not believe exceptional circumstances exist and accordingly the Panel does not take the supplemental filing into consideration in reaching its decision.

For Complainant to succeed, it must prove each of the three elements referred to in paragraph 4(a) of the Policy:

- i. the Disputed Domain Name is identical or confusingly similar to a trade mark or service mark in which the Complainant has rights;
- ii. the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name; and
- iii. the Disputed Domain Name has been registered and is being used in bad faith.

A. Identical or Confusingly Similar

Complainant has provided sufficient evidence of its proprietary rights to the Mark through its USPTO registrations. Through its use of the Mark in an active website, Complainant has provided “conclusive evidence [of] Complainant’s exclusive rights in the mark for the goods and services listed in the registrations, and displayed on the Internet. As a result, the validity of Complainant’s rights may not be challenged on the grounds that the mark is merely descriptive.” *The Sportsman’s Guide, Inc. v. Modern Limited, Cayman Islands*, WIPO Case No. D2003-0305. There is nothing to indicate AMERICAN FUNDS is a generic term for goods or services provided by Complainant.

Thus, as the Domain Name differs from the Mark by the omission of only one letter, and is both phonetically and visually similar, the Panel finds that the Domain Name is confusingly similar to Complainant’s Mark. See *Encyclopaedia Britannica, Inc. v. John Zuccarini and The Cupcake Patrol a/k/a Country Walk a/k/a Cupcake Party*, WIPO Case No. D2000-0330. The Panel, therefore, finds that Complainant has satisfied the requirement of paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

The Panel finds that Complainant has established that Respondent has no rights or

legitimate interests in the Domain Name. Respondent does not dispute the fact that it is not commonly known by the Domain Name and concedes that it is making a commercial use of the Domain Name. Respondent's arguments that "fnds" can be an abbreviation or misspelling of words other than "funds" is unconvincing, and in any case, misses the point. By Respondent's own admission, the hyperlinks on the landing site associated with the Domain Name that contain AMERICAN FUNDS are generated based upon search terms provided by Internet users. If this is taken to be true, then it shows that most Internet users who arrive at the landing site were actually looking for a website associated with Complainant. In any case, it is clear that Respondent's behavior constitutes "typosquatting", by associating a domain name that is a close misspelling of Complainant's Mark with a commercial pay-per-click website, and does not constitute a legitimate business under the Policy. See e.g. *PHE, Inc. v. Chris Calnek*, WIPO Case No. D2006-1612; *ESPN, Inc. v. XC2*, WIPO Case No. D2005-0444; *JELD-WEN, Inc. v. Texas International Property Associates*, NAF Case No. FA 882053. For these reasons, the Panel finds that Respondent has no rights or legitimate interests in the Domain Name, and that Complainant has satisfied paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

Despite Respondent's protests to the contrary, it cannot be said that as "American" and "Funds" are generic or descriptive terms, the combination of the first term with a misspelling of the second term must necessarily prove good faith. On the contrary, where a Domain Name constitutes a common misspelling of a protected mark, "typosquatting" has often been held to be "inherently parasitic and of itself evidence of bad faith". *National Association of Professional Baseball Leagues, Inc., d/b/a Minor League Baseball v. John Zuccarini*, WIPO Case No. D2002-1011 (involving a misspelling of "league" in <minorleaguebaseball.com>); *Lexar Media, Inc. v. Michael Huang*, WIPO Case No. D2004-1039; *Identigene, Inc. v. Genetest Laboratories*, WIPO Case No. D2000-1100. For these reasons, the Panel finds that Complainant has satisfied paragraph 4(a)(iii) of the Policy.

7. Decision

For all the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the Domain Name, <americanfnds.com> be transferred to Complainant.

Maxim H. Waldbaum
Presiding Panelist

Peter L. Michaelson
Panelist

David E. Sorkin
Panelist

Dated: September 7, 2007