



## **WIPO Arbitration and Mediation Center**

### **ADMINISTRATIVE PANEL DECISION**

**The Guardian Life Insurance Company of America v. James A Watts d/b/a WATTS & Associates**

**Case No. D2006-0137**

#### **1. The Parties**

The Complainant is The Guardian Life Insurance Company of America, New York, New York, United States of America, represented by Winston & Strawn LLP, United States of America.

The Respondent is James A Watts d/b/a WATTS & Associates, Grand Rapids, Michigan, United States of America.

#### **2. The Domain Name and Registrar**

The disputed domain name <retirementguardian.com> is registered with Melbourne IT trading as Internet Names Worldwide.

#### **3. Procedural History**

The Complaint was brought pursuant to the Uniform Domain Name Dispute Resolution Policy (the "Policy"), which was adopted by the Internet Corporation for Assigned Names and Numbers (ICANN) on August 26, 1999, and approved on October 24, 1999, and in accordance with the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules") as approved on October 24, 1999, and by the World Intellectual Property Organization Supplemental Rules for Uniform Domain Name Dispute Resolution Policy in effect as of December 1, 1999, (the "Supplemental Rules").

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") in email form on February 2, 2006, and in hard copy form on February 6, 2006, along with Annexes 1-135.

Pursuant to paragraph 4(d) of the Policy, the Complainant selected the Center as the ICANN approved administrative dispute resolution service provider to administer this proceeding. Through the Complaint, the Complainant requested a single-member

panel.

After receiving the Complaint, the Center, in accordance with paragraph 5 of the Supplemental Rules, determined whether that Complaint fully complied with the formal requirements of the Rules and the Supplemental Rules. In that regard, on February 2, 2006, the Center requested confirmation from the Registrar of information set forth in the Complaint relative to the disputed domain name; specifically, contact and registrant information for that domain name, as well as whether the Registrar received a copy of the Complaint from the Complainant. The Center also requested the Registrar to specify: (a) whether the Policy applies to the disputed domain name, (b) whether the registrant has submitted, in its registration agreement, to the jurisdiction at the location of the principal office of the registrar for court adjudication of disputes concerning or arising from the use of the domain name, (c) the language of the registration agreement, and (d) whether the domain name will remain “locked” during the proceeding.

Subsequently, on February 3, 2006, the Registrar provided its response to the Center through which the Registrar specified name and contact information pertinent to the disputed domain name, to the extent present in its WhoIS database, confirmed that Melbourne IT is the registrar of that name and stated that: the Policy applied to the disputed domain name and the name was then held in a “locked” status pending the resolution of this proceeding, specified that the registration agreement is in English and that the Registrant, through the registration agreement, submitted to jurisdiction, for court adjudication, at the location of the principal office of the Registrar.

The Center verified that the Complaint, together with its amendment, satisfied the formal requirements of the Policy, the Rules, and the Supplemental Rules.

On February 17, 2006, the Center notified the Respondent of the filing of the Complaint, including an indication that the Center was forwarding a complete copy of the Complaint, by courier and email (the latter being without the annexes), to the Respondent. The Complaint and its accompanying documents, and all subsequent communications associated therewith, were provided in the preferred manners and to the addresses as mandated by paragraphs 2(a), 2(b) and 4(a) of the Rules.

Having reviewed the Complaint and all preceding and succeeding correspondence between the Center and the Registrar, in detail, the Panel agrees with the determination of the Center that the Complaint and its handling met the requirements of the Rules and the Supplemental Rules.

The Respondent was then provided with a 20-calendar day period, expiring on March 9, 2006, to file its Response with the Center and serve a copy of the Response on the Complainant.

The Respondent timely filed its Response by email with the Center, which the latter acknowledged through an email letter dated March 8, 2006.

Accordingly, pursuant to the Rules and Supplemental Rules, by email letter dated March 13, 2006, the Center contacted the undersigned, Mr. Peter L. Michaelson, requesting his service as a Sole Panelist for this dispute. Subsequently, on the same day, Mr. Michaelson accepted and returned, by facsimile to the Center, a fully executed Statement of Acceptance and Declaration of Impartiality and Independence. The Center, through an email letter dated March 15, 2006, notified the parties of the appointment of Mr. Michaelson as Sole Panelist.

Based on the deadline set forth in paragraph 15 of the Rules, a decision was to be issued by the Panel to the Center on or before March 29, 2006. However, due to unexpected time conflicts experienced by the Panel – which constituted exceptional circumstances, the Center, upon the Panel’s request, extended the due date to April 14, 2006.

On April 7, 2006, the Complainant, acting in its own volition, filed a Supplemental Filing with the Center.

Through a responding email dated April 8, 2006, to the Center, the Respondent requested a 10-day period to provide its Reply to the Complainant’s Supplemental Filing. The Panel, through Procedural Order No.1 dated April 13, 2006, granted the Respondent’s request and provided the Respondent with a period of time, expiring midnight on April 23, 2006, to file its Reply with the Center and also extended the due date of the decision to April 29, 2006.

On April 22, 2006, the Respondent timely filed its Reply by email with the Center.

Owing to further time conflicts experienced by the Panel now caused by the timing of the Supplemental Filing and the Reply – which constituted exceptional circumstances, the Center, upon the Panel’s request, extended the due date to May 12, 2006.

This dispute concerns one domain name, specifically <retirementguardian.com>.

The language of this proceeding is English.

#### **4. Factual Background**

The Panel understands the zeal of the Complainant’s counsel in fully advocating the Complainant’s position and “leaving no stone unturned” in the Complaint. Nevertheless, one can not escape the fact that the Complaint is undeniably a case study in sheer prolixity not to mention absolute weight -- with its 135 separate annexes of which many present what is, at best, simply cumulative evidence and span hundreds, if not nearly a thousand, pages and form a solid stack of paper some 3 1/2”-4” thick which could probably break all, but heavy duty, postage scales.

Candidly, ICANN panels, including this one, do not welcome voluminous filings. Such filings invariably consume considerable time and effort to examine -- both of which, at least for this Panel and presumably many other panelists, come at quite a premium. Consequently, this Panel advises not just the Complainant’s counsel here, but all counsel, to exercise proper discretion to file relatively compact submissions, with only what counsel believes to be, in instances where multiple pieces of evidence exist for a given allegation, a small sample of the best representative pieces of all those available. All counsel must resist the urge -- that urge being amply demonstrated here -- to err on the side of simply throwing in, as annexes, “everything and the kitchen sink” so that counsel could be seemingly spared the concern that (s)he might otherwise omit some item of evidence which (s)he thinks is, in all likelihood, unnecessary but which a panel just might, by the slightest probability, consider useful, let alone dispositive. It should come as no surprise that if counsel views an item as probably cumulative and unnecessary, then a panel will too.

The underlying facts in this dispute are rather simple and can be readily distilled from

the parties' submissions, and are as follows.

A copy of the WhoIS registration records for the disputed domain name appears in Annex 1 to the Complaint. As indicated on these records, the Respondent registered the disputed domain name on February 24, 2005.

#### **A. Complainant's GUARDIAN Marks**

The Complainant owns over 30 United States trademark registrations for its marks that contain the term "GUARDIAN", either by itself or with other terms -- most in block letter, and with and without an accompanying logo (collectively the GUARDIAN Marks) and on which this dispute is based. The Complainant has provided, in Annex 107 to the Complaint, hard-copy printouts of the registration certificates of all these marks. A small sampling of the Complainant's United States registrations is as follows:

- (a) THE GUARDIAN (stylized letters with logo)  
United States registration 1,436,668; registered: April 14, 1987  
filed: January 17, 1986

This mark was registered for use in connection with "underwriting group and individual life and health insurance; brokerage services for mutual funds, annuities, and pension plans" in international class 36. The registration states that first use and first use in commerce of this mark in conjunction with these services commenced as of October 14, 1985 and October 30, 1985, respectively.

- (b) GUARDIAN (block letters)  
United States registration 1,637,817; registered: March 12, 1991  
filed: April 24, 1990

This mark was registered for use in connection with "annuity and annuity administration services" in international class 36. The registration states that both first use and first use in commerce of this mark in conjunction with these services commenced as of December 31, 1918.

- (c) GUARDIAN (block letters)  
United States registration 1,637,818; registered: March 12, 1991  
filed: April 24, 1990

This mark was registered for use in connection with "insurance services, namely group health insurance underwriting services" in international class 36. The registration states that both first use and first use in commerce of this mark in conjunction with these services commenced as of December 31, 1957.

- (d) GUARDIAN (block letters)  
United States registration 1,641,534; registered: April 16, 1991  
filed: April 24, 1990

This mark was registered for use in connection with "insurance services, namely individual life insurance underwriting services" in international class 36. The registration states that both first use and first use in commerce of this mark in conjunction with these services commenced as of December 31, 1918.

Each of these registrations, as with many of the Complainant's other federally

registered trademarks, has become incontestible under section 15 of the Lanham Act (15 U.S.C. § 1065).

## **B. The Complainant**

The Complainant is one of the oldest and largest mutual insurance companies in the United States. Since 1918, it has offered a wide variety of insurance and financial services nationwide under its GUARDIAN Marks and its full corporate name, The Guardian Life Insurance Company of America. As indicated in the Complainant's <guardianlife.com> web site (from which hard-copy printouts of various web pages appear in Annex 3 to the Complaint), the Complainant is a mutual insurance company with total assets, including those of its subsidiaries, in excess of \$39 billion. Furthermore, the Complainant is a Fortune 500 company which has issued dividends to its policyholders for 145 consecutive years.

The Complainant is licensed to sell insurance in all fifty states of the US and receives life and health insurance premium income from residents of all these states and has continuously done so since at least 1952. Copies of the Complainant's representative promotional materials, for various years since 1918 regarding its offerings of insurance and financial services appear in Annexes 4-54 to the Complaint, and regarding its retirement and financial planning services appear in Annexes 55-104 to the Complaint. The Complainant has been named as one of the most admired life and health insurance companies by Forbes magazine.

While life insurance services originally formed the cornerstone of the Complainant's retirement and financial planning services, the Complainant, since 1971, has offered a wide range of equity products to assist its clients and policyholders in the accumulation, management, preservation and disposition of their financial assets.

In 2004, the Complainant paid out more than \$5.8 billion in benefits to policy beneficiaries, policyholders, doctors, hospitals and other care providers, and issued US \$538 million in policy dividends and received total insurance premium income of nearly US \$5.5 billion. Currently, the Complainant insures the lives of more than 6 million individuals in the US. Also, more than 1.25 million US employees are covered by the Complainant's GUARDIAN group insurance policies.

The Complainant has extensively used its GUARDIAN Marks through their placement on millions of publications which the Complainant distributed to the trade and consumers in connection with its sale of insurance and financial services, including insurance cards, prospectuses, annual reports, brochures, promotional materials, directories, forms, stationery, applications, manuals, sales tools; and through communications to the Complainant's field sales force, the trade, policyholders and the public at large. In 1991 alone, the Complainant published and distributed approximately 21 billion pieces of promotional literature.

The Complainant has also established a presence on the Internet, through its websites at <guardianlife.com> and <guardianinvestor.com>.

## **C. The Respondent**

The Respondent is an established independent Certified Financial Planner Practitioner who offers financial advice and retirement planning services to Senior and Baby Boomer-age clientele and has been doing so (as indicated by copies of salient State of Michigan Business Registration Certificates that appear in Annex 2 to the Response)

under the names “Senior Financial Services” since 1996, and “WATTS & ASSOCIATES” since 2001. The Respondent is legally licensed to sell securities and insurance in the states of Michigan and New York. He is a registered Investment Advisor representative for US Allianz Securities, Inc, a NASD registered Broker/Dealer located in Minneapolis, MN and is authorized to provide fee-based financial advisory services.

On June 18, 2005, the Respondent filed a US trademark application (serial no. 78/536,634) seeking to federally register the mark RETIREMENT GUARDIAN for use in conjunction with “financial planning and wealth management for retirement”. The Respondent claims that he commenced use of this mark (both in commerce and interstate commerce) on February 23, 2005. A copy of the entry in the USPTO database for this application appears in Annex 110 to the Complaint.

The Respondent maintains a web site through which the disputed domain name resolves. At least as of May 27, 2005, the Respondent promoted his specific financial planning and retirement services through that site and under the name “Watts & Associates” (a hard-copy printout of the home page of that site at it then existed appears in Annex 111 to the Complaint). Sometime thereafter, and at least as of January 24, 2006, the Respondent changed that page to merely provide his contact information (a copy of the page as it then existed appears in Annex 112). Currently, the Respondent’s website indicates that it is “under construction”.

#### **D. Interactions between the parties**

On June 15, 2005, the Complainant’s counsel sent the Respondent a cease and desist letter (a copy of which appears in Annex 113 to the Complaint), through which the Complainant, *inter alia*, advised the Respondent of Complainant’s rights in its GUARDIAN Marks and demanded transfer of the disputed domain name.

On June 29, 2005, the Respondent called the Complainant’s counsel. Though some dispute exists as to what actually transpired, according to the Complainant, the Respondent stated that the RETIREMENT GUARDIAN mark had no particular value to him because he had only recently commenced use of the mark and then the Respondent asked counsel whether the Complainant would be willing to pay for the transfer of the name. Counsel asked the Respondent how much money he was seeking. The Respondent apparently remarked that he would consider an appropriate number and so advised counsel.

On July 27, 2005, the Complainant’s counsel, having heard nothing further from the Respondent, sent a follow-up letter to the Respondent (a copy of which appears in Annex No. 114 to the Complaint).

On July 29, 2005, counsel for the Respondent sent a letter (a copy of which appears in Annex 115 to the Complaint) to the Complainant’s counsel, stating that the Respondent did not intend to cease use of the RETIREMENT GUARDIAN mark or to transfer the name. In that letter, counsel for the Respondent suggested that the Respondent would not settle the matter and transfer the domain name unless \$ 50,000 was paid; the letter stating in pertinent part:

“It is our understanding, however, that during an initial telephone discussion, you had asked Mr. Watts what price he would charge to sell the domain name to your client. Again, I want to emphasize that my client did not register the domain name to sell it. He has not offered to sell it, and wants nothing more

than to continue to use the domain name in peace. That being said, Mr. Watt is realistic enough to recognize that your client possesses the ability to wage litigation or quasi-litigation activities that are beyond his resources. Perhaps you meant to inquire what amount my client would require in order to settle this dispute with such a settlement involving payment to my client and transfer of the domain name to your client. If that is the case, my client would not be interested in settling except upon the payment of \$ 50,000.”

The Complainant’s counsel responded by a letter dated August 4, 2005 (a copy of which appears in Annex 116 to the Complaint) through which the Complainant’s counsel stated that the Respondent’s demand for \$50,000 for transfer of the name amounted to cybersquatting, particularly in light of the Respondent’s filing of his trademark application after having received notice of the Complainant’s rights in its GUARDIAN Marks.

Subsequently, on September 1, 2005, the Respondent’s counsel responded by letter (a copy of which appears in Annex 117 to the Complaint) stating that the Respondent refused to cease using the term RETIRMENT GUARDIAN, and argued that the Complainant, rather the Respondent, first raised the issue of securing payment for the name.

Shortly thereafter, the Respondent, by letter dated September 6, 2005 (a copy of which appears in Annex 118 to the Complaint), responded to the Complainant’s counsel’s letter of August 4, 2005, through which the Respondent raised various points, among which: (a) he denied he was cybersquatting; (b) he denied that he made mention of any monetary offer or solicited an offer during his June 29th telephone discussion with Complainant’s counsel when it was that counsel who initially asked “How much do you want for the domain?”, (c) he filed to federally register his “RETIREMENT GUARDIAN” mark in response to his belief that “certain unscrupulous companies and individuals would covet and actually attempt to steal my work product”; and (d) the disputed domain name, through its inclusion of the term “RETIREMENT” and in light of the generic nature of the term “GUARDIAN” was not confusingly similar to the Complainant’s GUARDIAN Marks. The Respondent also expressed his motivation in creating the disputed domain name:

“I legally own and created the mark and domain in the utmost good faith with the legitimate purpose of differentiating my services in the highly competitive financial services industry. There was no other motive or intent. It certainly was not developed with your client in mind as you claim. It perfectly describes and conveys what I am trying to accomplish in my financial planning service. It’s design is a descriptive word combination of the target market that I serve (Retirement) and the conservative, protective nature of advice my firm offers to differentiate itself, Guardian(ship).”

The Respondent expressed his view that his mark RETIREMENT GUARDIAN “has tremendous marketing appeal and the potential to impact the growth of my practice,” and that mark will “differentiat[e] [his] services in the highly competitive financial services industry.” Further, the Respondent noted that both he and the Complainant have totally different roles in the financial services marketplace, as he is an independent financial planner, while the Complainant is primarily an “underwriter, manufacturer and wholesale distributor of life insurance products and related services.”

Then, on September 7, 2005, the Complainant’s counsel sent a letter (a copy of which

appears in Annex 119 to the Complaint) to the Respondent's counsel. The former, among other things, reiterated her belief that demand for \$ 50,000 constituted cybersquatting. Thereafter, by letter dated September 8, 2005 (a copy of which appears in Annex 120 to the Complaint), the Respondent's counsel indicated that his firm no longer represented the Respondent and that he would forward Complainant's September 7, 2005 letter to the Respondent.

Since the September 8th letter, the Complainant's counsel has heard nothing further from the Respondent.

## **5. Parties' Contentions**

### **A. Complainant**

#### **(i) Identical or Confusingly Similar**

The Complainant contends that the disputed domain name is confusingly similar to the Complainant's GUARDIAN Marks.

First, the Complainant contends that the dominant portion of the name is the term "GUARDIAN" and adding the generic term "RETIREMENT" to that term to form the name is insufficient to distinguish the name from the Complainant's GUARDIAN Marks and hence dispel user confusion. Furthermore, as the term "RETIREMENT" is not only descriptive, as the Respondent concedes of the Respondent's own services, it is also descriptive of the Complainant's services and thus enhances the likelihood that user confusion will occur.

The Complainant also contends that the Respondent's use of the disputed domain name is designed to cause confusion and to deceive Internet users into mistakenly believing that the Respondent and his services are sponsored, authorized or in some manner related to the Complainant -- when, in actuality, they are not.

Further, the Complainant contends that the Respondent, in selecting and using the disputed domain name is capitalizing on the Complainant's goodwill and intended to profit, and may have already done so, by virtue of that name incorporating the Complainant's GUARDIAN Marks.

Hence, the Complainant believes that it has satisfied the confusing similarity/identity requirement in paragraph 4(a)(i) of the Policy.

#### **(ii) Rights or Legitimate Interests**

The Complainant contends that, for several reasons, the Respondent has no rights or legitimate interests in the disputed domain name pursuant to paragraph 4(a)(ii) of the Policy.

First, the Complainant contends that the Respondent does not offer, promote or sell retirement planning services either under the mark GUARDIAN or any other mark.

Further, the Respondent's claimed first use date of February 23, 2005, is only some four months before the Complainant's counsel initially contacted the Respondent on June 15, 2005. However, the Complainant's use and registration of its GUARDIAN Marks preceded the Respondent's February 23, 2005 first use date by some 87 years.

Also, the Complainant states that the Respondent is not related to, licensed by, or affiliated with Complainant, nor is the Respondent licensed or authorized in any way by the Complainant to use any of the GUARDIAN Marks.

In addition and to the Complainant's knowledge, the Respondent has never been known and, by virtue of the Complainant's registered marks, can never be known by the term RETIREMENT GUARDIAN.

Lastly, the Complainant contends that since the Respondent has apparently ceased all use of the mark RETIREMENT GUARDIAN, this confirms the absence of any rights or legitimate interest the Respondent might have had in the disputed domain name. As such, the Respondent's use of that name does not constitute a *bona fide* offering of goods or services pursuant to paragraph 4(c)(i) or a legitimate or fair use pursuant to paragraph 4(c)(iii) of the Policy.

### **(iii) Registered and Used in Bad Faith**

The Complainant contends that the Respondent has registered and is now using the disputed domain name in bad faith under paragraph 4(a)(iii) of the Policy.

First, the Complainant contends that the Respondent's request for payment of \$ 50,000 as consideration for transferring the domain name, and which far exceeds his out-of-pocket costs of registration, constitutes strong evidence of bad faith in and of itself.

Further, the Complainant contends that the Respondent registered that name to opportunistically exploit the confusion as to source, sponsorship, affiliation or endorsement that would likely arise through use of a name that incorporated the Complainant's mark GUARDIAN and, by doing so, intentionally attract Internet users to his site for his own commercial gain.

Moreover, given Complainant's size, as a Fortune 500 company with assets of approximately \$ 39 billion, its notoriety in the insurance industry and particularly for a wide range of insurance products, and its age -- over 87 years, it is inconceivable that the Respondent did not know of the Complainant and its GUARDIAN Marks when the Respondent registered the disputed domain name. Hence, the likelihood that the Respondent would combine the Complainant's mark GUARDIAN and the word descriptive word "retirement" without any prior knowledge of the Complainant is essentially nil.

Therefore, the Complainant contends that the Respondent's knowing registration of the name which includes a well-known third-party mark, is also evidence itself of bad faith registration and use.

## **B. Respondent**

### **(i) Identical or Confusingly Similar**

For various reasons, the Respondent disputes the Complainant's contention that the disputed domain name is confusingly similar to the Complainant's GUARDIAN Marks. Those reasons are principally as follows.

First, the Respondent contends that both parties to the disputes are significantly

different from each other and perform different roles in the marketplace. Specifically, the Respondent states: “The Complainant is primarily a Life Insurance Company selling whole life insurance and related products. The majority of its history, patents and fame are the direct result of the manufacturer, distribution and underwriting of individual and group life insurance products to the general public. They derive their revenues from commissions and have a seller/buyer relationship with their customers. Their main role in the marketplace is to sell products and make a profit.” [emphasis removed from original] In contrast, the Respondent is a registered Investment Advisor Representative and Certified Financial Planner serving the seniors market and baby boomers, who earns his income primarily from fees -- which apparently the Complainant does not.

Second, the Respondent contends that no confusion is likely simply because: (a) he does not represent that he is connected, representing or affiliated with the Complainant, and (b) Internet users who seek the Complainant’s web site but reach that of the Respondent would immediately realize that the Respondent has nothing to do with the Complainant. Further, no evidence of any such confusion has yet to be presented.

Third, the disputed domain name is one word which sufficiently distinguishes it from two- or other multi-word marks of the Complainant which contain the word “GUARDIAN”. Moreover, the Complainant has never used the mark “Retirement Guardian” or apparently expressed any interest in doing so -- as the record is replete with any corresponding proof. Furthermore, the Complainant has registered its GUARDIAN marks in conjunction with underwriting annuity plans -- which is a service the Respondent does not provide.

Lastly, the Respondent provided copies, in Annexes 23-32 of the Response, of hard-copy printouts of home pages of illustrative web sites that collectively evidence third-party use of the term “GUARDIAN” in their corresponding domain names.

#### **(ii) Rights or Legitimate Interests**

The Respondent contends that, for various reasons -- the principal reasons set forth below, he has a legitimate interest in the disputed domain name.

First, the Respondent states that he has undertaken appropriate due diligence for the term “retirementguardian”, including a world-wide search of domain name registrations and of federally pending and registered marks accessible through the USPTO web site, and, as a result, determined that the term was apparently free for the Respondent to register as his domain name. The Respondent, also being a broker/dealer for ALLIANZ Life of Germany, submitted his proposed advertising, including use of the term “retirementguardian” to US Allianz Securities for its approval, and thereafter in fact received their approval (as indicated in Annexes 13 and 14 to the Response).

The Respondent states that he filed his federal trademark application, which is presently pending, in order to “protect his work product against infringers”. The Respondent acknowledged that the application was filed after he received the initial correspondence from the Complainant’s counsel and maintains “it was prudent to do so after being threatened by a high price[d] New York Law firm”.

Also, the Respondent states that his website is currently under construction, as it has been revised several times as the Respondent continued to refine his brand. Furthermore, the Respondent states that US ALLIANZ has modified and updated its advertising policy in regard to public websites for its registered representatives and, in

connection with doing so, has required the Respondent to use an approved website vendor. The Respondent's website vendor is not an approved vendor; thus, the Respondent is currently awaiting the Panel's decision before establishing the latest version of his website.

Moreover, the Respondent registered the name on February 24, 2005, with the sole intent of establishing a brand and website through which the Respondent could market his financial services to the public in the State of Michigan. Subsequently, throughout the months of March, April and May during the spring of 2005, the Respondent published a web page under that domain name through which he offered various financial services and provided personal information on his background and credentials. The first contact between the Respondent and the Complainant's counsel occurred on June 12, 2005 -- several months after the Respondent began his marketing efforts under the name. This shows that the Respondent made demonstrable preparations to use the disputed domain name prior to any contact he had with the Complainant regarding the present dispute.

The Respondent contends that all the actions he has taken thus far constitute a "serious business plan" which evidences the Respondent's legitimate interest in the disputed domain name.

### **(iii) Registered and Used in Bad Faith**

Contrary to the Complainant's view, the Respondent contends that he did not register or use the disputed domain name in bad faith. His principal allegations are as follows:

First, the Respondent states that he did not register the name with any intention to sell it to the Complainant or disrupt its business and no proof or evidence has been provided by the Complainant to show otherwise. Furthermore, the Respondent has no history or pattern of such conduct, and the Complainant does not own the mark RETIREMENTGUARDIAN and offers no proof that it does.

Second, and contrary to the Complainant's view, the Respondent states that the Complainant has provided no evidence that shows that the Respondent has made any attempt to lure or redirect customers for commercial gain to the Respondent's website using the Complainant's various marks.

Lastly, the Respondent contends that any offer to sell the domain name was not made by him but rather by the Complainant's counsel when, during a June 29, 2005 telephone call, she asked the Respondent "how much do you want for the domain?". The Respondent merely set forth an amount of \$ 50,000 to "avoid lengthy and costly litigation".

### **C. Additional Submissions**

The Panel has reviewed and considered the Supplemental Filing filed by the Complainant and the Respondent's Reply thereto.

Specifically, the Complainant, through its Supplemental Filing, notes that, on September 12, 2005, it had filed a letter of protest with the US PTO in the Respondent's then pending US trademark application to register the term "RETIREMENT GUARDIAN" citing, *inter alia*, the Complainant's GUARDIAN Marks. On March 23, 2006, the USPTO granted the letter of protest as supporting a refusal of registration. Subsequently, on March 27, 2006, as noted by the Complainant

in its submission, the USPTO issued an office action in the Complainant's pending application refusing registration based on the GUARDIAN Marks.

The Respondent, in his Reply, argues that the Panel should disregard the Supplemental Filing because: (a) from a procedural standpoint, the Panel did not request it under paragraph 12 of the Rules, and (b) independent of that reason and from a substantive standpoint, issues of trademark registrability are not within the jurisdiction of a UDRP panel to decide.

## 6. Discussion and Findings

### A. Complainant's Supplemental Filing & Respondent's Reply

Issues regarding registrability and validity of federal trademark registrations lie well outside the purview of a UDRP panel -- as significant deference must be accorded to determinations made by the USPTO. See, e.g., this Panel's prior rulings, though with respect to post-registration challenges to trademark validity, in: *Sound Unseen, Ltd.; Apple Bottoms, LLC; and Cornell Haynes p/k/a "Nelly" v. Patrick Vanderhorst*, WIPO Case No. D2005-0636 (August 18, 2005); *Register.com, Inc. v. Wolfgang Reile a/k/a RWG Internet and Marketing Rightway Gate Inc, et. al.*, National Arbitration Forum Case No. FA208576 (January 27, 2004); *United States Office of Personnel Mgmt. v. MS Tech. Inc.*, National Arbitration Forum Case No. FA 198898 (December 9, 2003); and *Lake at Las Vegas Joint Venture v. Principal Equiti, Inc.*, WIPO Case No. D2002-0758 (October 4, 2002). Fortunately, the Panel need not even reach this principle here.

Specifically, while the Complainant points, in its Supplemental Filing, to the recent actions of the USPTO as effectively questioning the ultimate registrability of the Respondent's mark, it is not the Respondent's mark that forms the basis of an analysis under paragraph 4(a)(i) of the Policy but rather the Complainant's marks. In that regard, this paragraph states, in pertinent part:

“You are required to submit to a mandatory administrative proceeding in the event that a third party (a “complainant”) asserts ... that  
(i) your domain name is identical or confusingly similar to a trademark or service mark in which *the complainant has rights*” [emphasis added].

Hence, the essence of this dispute does not concern the Respondent's mark or its fate before the USPTO -- all of which are irrelevant to the present proceeding, but rather assessing the Respondent's disputed domain name against the Complainant's marks. Those marks stand as they are: registered with many being incontestable.

Consequently, the Complainant's Supplemental Filing, being directed to the Respondent's mark, is misguided. Given the irrelevance of the matters it raises, the Panel has not considered that filing any further.

### B. Identical or Confusingly Similar

The Panel finds that confusion is likely to arise as a result of the Respondent's use of the disputed domain name.

The disputed domain name is formed of a generic term, specifically “retirement”, prepended to the Complainant's mark “GUARDIAN” to form the term “retirementguardian” and with “.com” gTLD appended to that term though the addition

of any gTLD is completely ignored in assessing identity/similarity under paragraph 4(a)(i) of the Policy.

It is now very well-established in UDRP precedent, including numerous decisions previously rendered by this Panel, that minor variations, such as adding short letter or number groups or even generic or highly descriptive words to a mark, are each insufficient in and of itself, when used in forming a domain name that results from modifying the mark, to confer requisite and sufficient distinctiveness to that name to avoid user confusion. “Retirement” is certainly such a generic or highly descriptive, word, with, in fact, the Respondent here conceding the latter. See, e.g., *The Cheesecake Factory Inc. and The Cheesecake Factory Assets Co., LLC v. Say Cheesecake* WIPO Case No. D2005-0766 (September 12, 2005); *Napster, Inc. v. Giovanni Vinscani*, WIPO Case No. D2005-0531 (July 19, 2005); *Caesars Entertainment, Inc. v. Nova Internet Inc*, WIPO Case No. D2005-0411 (June 22, 2005); *Lockheed Martin Corporation v. The Skunkworx Custom Cycle*, WIPO Case No. D2004-0824 (January 18, 2005); *Lockheed Martin Corporation v. Deborah Teramani*, WIPO Case No. D2004-0836 (December 1, 2004) and *National Collegiate Athletic Association v. Dusty Brown*, WIPO Case No. D2004-0491 (August 30, 2004). This result follows from a simple comparison of the disputed domain name against the Complainant’s marks.

Such confusion, should it occur, would undoubtedly cause Internet users intending to access the Complainant’s web site, but who were to reach the Respondent’s site resolvable through the disputed domain name to think that an affiliation of some sort exists between the Complainant and the Respondent or its third-party transferee, when, in fact, no such relationship would exist at all. See, also, e.g., *Cheesecake Factory, Napster, Caesars Entertainment, Lockheed v. Skunkworx, and Lockheed v. Teramani, all cited supra; Register.com, Inc. v. Wolfgang Reile a/k/a RWG Internet et al*, FA208576 (National Arbitration Forum, January 27, 2004); *Caesars World, Inc. and Park Place Entertainment Corporation v. Japan Nippon*, WIPO Case No. D2003-0615 (September 30, 2003); *Leiner Health Services Corp. v. ESJ Nutritional Products*, FA 173362 (National Arbitration Forum, September 16, 2003); *American Family Life Assurance Company of Columbus v. defaultdata.com aka Brian Wick*, FA 123896 (National Arbitration Forum, October 14, 2002); *AT&T Corp. v. Roman Abreu d/b/a Smartalk Wireless*, WIPO Case No. D2002-0605 (September 11, 2002); *L.F.P., Inc. v. B and J Properties*, FA 109697 (National Arbitration Forum, May 30, 2002); *Peter Frampton v. Frampton Enterprises, Inc.*, WIPO Case No. D2002-0141 (April 17, 2002); *Spence-Chapin Services to Families and Children v. Stanley Wynman*, FA 100492 (National Arbitration Forum, December 10, 2001); *Meijer, Inc. v. Porksandwich Web Services*, FA 97186 (National Arbitration Forum, July 6, 2001); *MPL Communications, Limited et al v. IWebAddress.com*, FA 97092 (National Arbitration Forum, June 4, 2001); *American Home Products Corporation v. Ben Malgioglio*, WIPO Case No. D2000-1602 (February 19, 2001); *Surface Protection Industries, Inc. v. The Webposters a/k/a Mark’s Paint Store, Inc.*, WIPO Case No. D2000-1613 (February 5, 2001); *Dollar Financial Group, Inc. v. VQM NET*, FA 96101 (National Arbitration Forum, January 25, 2001); *eBAY Inc. v. G L Liadis Computing, Ltd. and John L. Liadis d/b/a G L Liadis Computing Ltd.*, WIPO Case No. D2000-1463 (January 10, 2001); *Treeforms, Inc. v. Cayne Industrial Sales Corp.*, FA 95856 (National Arbitration Forum, December 18, 2000); See also *Pep Boys Manny, Moe and Jack of CA v. E-Commerce Today, Ltd.*, AF-0145 (eResolution, May 3, 2000).

Therefore, the Panel finds that the disputed domain name sufficiently resembles the Complainant’s GUARDIAN Marks as to cause confusion; hence, the Complainant has

shown sufficient similarity between the disputed domain name, and the Complainant's marks under paragraph 4(a)(i) of the Policy.

### **C. Rights or Legitimate Interests**

The Panel believes that not only has the Respondent not provided any basis that would legitimize any claim it has to the disputed domain name, but also it is extremely unlikely that the Respondent could ever make such a claim.

The simple reason is that the disputed domain name contains the Complainant's mark "GUARDIAN" under which the Complainant provides its services and has continuously so provided those services since 1918 – which is well prior, by some 87 years, to the date (February 24, 2005) on which the Respondent has registered the name. Moreover, the considerable reputation and long-term recognition which the Complainant had developed in its GUARDIAN Marks substantially prior to February 2005, in the financial industry, particularly annuity and pension services -- which are indeed financial tools for those planning their future retirement, as well as the extensive name recognition and goodwill the Complainant had developed in its own corporate name during that time leads this Panel to believe that the Respondent, who provided retirement advisory services though perhaps not the identical services as does the Complainant but nonetheless in the same overall industry, was very likely to have been well aware of the Complainant's services, its reputation and its marks all prior to having registered the disputed domain name.

Furthermore, the Complainant has never authorized the Respondent to utilize any of its GUARDIAN Marks or any mark confusingly similar thereto in conjunction with the specific or even similar services which the Complainant provides under its marks, nor does the Complainant have any relationship or association whatsoever with the Respondent.

Hence, any use to which the Respondent were to put the mark "GUARDIAN" or one confusingly similar thereto, in connection with the pension and annuity services provided by the Complainant or even similar services, encompassing financial-based retirement planning services, would directly violate the exclusive trademark rights now residing in the Complainant. See, e.g., *Cheesecake Factory, Napster and Caesars Entertainment, cited supra*; *Pelmorex Communications Inc. v. weathernetwork*, WIPO Case No. D2004-0898 (December 18, 2004); *Sybase, Inc. v. Analytical Systems*, WIPO Case No. D2004-0360 (June 24, 2004); *Caesars World, Inc. and Park Place Entertainment Corporation v. Japan Nippon*, WIPO Case No. D2003-0615 (September 30, 2003); *Leiner Health Services Corp., AT&T Corp., and MPL Communications* FA 97086 and FA 97092, all cited *supra*; *Am. Online, Inc. v. Fu*, WIPO Case No. D2000-1374 (December 11, 2000); and *Treeforms, Inc.*, cited *supra*. Consequently, the Respondent could not legally acquire any public association between it and the mark "GUARDIAN" and hence could never be commonly known or recognized by that mark and thus could never fall within paragraph 4(c)(ii) of the Policy.

Thus, the Panel finds that the Respondent has no rights or legitimate interests in the disputed domain name within paragraph 4(a)(ii) of the Policy.

### **D. Registered and Used in Bad Faith**

The Panel believes that the Respondent's actions constitute bad faith registration and use of the disputed domain name.

As discussed in the preceding section, the Panel believes – and it strains belief to think otherwise – that the Respondent was not aware of the Complainant’s mark “GUARDIAN” when the Respondent registered the disputed domain name on February 24, 2005, and particularly the considerable reputation which that mark had attained as a result of the Complainant’s commercial activities starting some 87 years earlier.

In fact, this Panel believes, and hence is not persuaded by the Respondent’s arguments to the contrary, that the Respondent not only knew of the Complainant’s prior and ongoing activities but also intentionally chose the disputed domain name due to its inclusion of the Complainant’s mark “GUARDIAN” in order to trade off the Complainant’s reputation. By so doing, it is clear to this Panel that the Respondent, in selecting the disputed domain name that substantially mirrored the Complainant’s mark, sought to leverage the Complainant’s reputation by having intended to either use that name to either divert users, seeking the Complainant’s site, to the Respondent’s site instead, whenever the Respondent’s site were to become operational, and/or to derive some other benefit by implying in the minds of those users that a relationship or affiliation of some sort existed between it and the Complainant – when no such relationship or affiliation then existed in actuality. Such conduct violates paragraph 4(b)(iv) of the Policy.

Furthermore, although the parties vigorously dispute whether the Complainant or the Respondent is said to have technically “made the first offer”, the end result is the same. It is irrelevant to this Panel whether the Respondent was predisposed by the Complainant to make a monetary demand, here being US \$ 50,000, to transfer the disputed domain name, hence possibly viewing the Complainant as having made the offer by “inducing” the Respondent to actually suggest a specific monetary amount; or whether the Respondent simply made that demand on his own volition in response to the Complainant’s question as to how much money he wanted. In either case, the Respondent requested US \$ 50,000. Absent outright coercion, fraud or other untoward act by the Complainant in extracting an offer from the Respondent -- acts which the present record certainly do not support, then how the Respondent arrived at making that demand is immaterial. The Panel does not see the application of paragraph 4(b)(i) of the Policy as turning on either navigating the subtleties of contract law in divining which party actually made an offer, or scrutinizing the facts to assess where the suggestion first arose of such an offer. In fact, this paragraph makes no such distinctions by merely requiring:

*“you have registered or you have acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark ... for valuable consideration in excess of your documented out-of-pocket costs directly related to the domain name”.*

The Respondent ultimately made such a demand, US \$ 50,000, having a value which clearly exceeded his registration costs. That much is known. That much is certain. This conduct violates paragraph 4(b)(i) of the Policy.

Hence, the Panel views the Respondent’s actions as constituting bad faith registration and use in violation of paragraph 4(a)(iii) of the Policy, and specifically under both paragraphs 4(b)(i) and 4(b)(iii) of the Policy.

Thus, the Panel concludes that the Complainant has provided sufficient proof of its

allegations to establish a case under paragraph 4(a) of the Policy upon which the relief it now seeks can be granted.

**7. Decision**

Accordingly, under paragraphs 4(i) of the Policy and 15 of the Rules, the Panel now grants the relief sought by the Complainant.

The disputed domain name, <retirementguardian.com>, is ordered transferred to the Complainant.

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Peter L. Michaelson  
Sole Panelist

Dated: May 12, 2006