



DECISION

Webster Financial Corporation v. SERV.COM CO., LTD. / Heui-il Kang

Claim Number: FA1909001861084

PARTIES

Complainant is **Webster Financial Corporation** (“Complainant”), represented by **Gail Podolsky** of **Carlton Fields Jordan Burt, P.A.**, Georgia, USA. Respondent is **SERV.COM CO., LTD. / Heui-il Kang** (“Respondent”), Korea.

REGISTRAR AND DISPUTED DOMAIN NAME

The domain name at issue is **<isabank.com>**, registered with eNom, LLC.

PANEL

The undersigned certifies that he has acted independently and impartially and to the best of his knowledge has no known conflict in serving as Panelist in this proceeding.

David L. Kreider as Panelist.

PROCEDURAL HISTORY

Complainant submitted a Complaint to the FORUM electronically on September 6, 2019; the FORUM received payment on September 6, 2019.

On September 9, 2019, eNom, LLC confirmed by e-mail to the FORUM that the **<isabank.com>** domain name is registered with eNom, LLC and that Respondent is the current registrant of the name. eNom, LLC has verified that Respondent is bound by the eNom, LLC 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 September 11, 2019, the FORUM served the Complaint and all Annexes, including a Written Notice of the Complaint, setting a deadline of October 1, 2019 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@isabank.com. Also on September 11, 2019, 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 September 26, 2019.

On October 1, 2019, pursuant to Complainant's request to have the dispute decided by a single-member Panel, the FORUM appointed David L. Kreider as Panelist.

On October 2, 2019, Complainant submitted timely additional written submissions and annexes in accordance with the Policy and the FORUM's Supplemental Rule number 7. The Panel has considered Complainant's additional submissions.

Having reviewed the communications records, the Administrative Panel (the "Panel") finds that the 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

Respondent's <isabank.com> domain name is confusingly similar to Complainant's HSA BANK registered service mark, as it incorporates the HSA BANK mark in the second level domain (albeit with an intentional replacement of the letter "h" for the letter "i"). *See Choice Hotels International, Inc. v. Michele Dinoia a/k/a SZK.com*, FA0406000282792, p. 5 (NAF Jul. 28, 2004) ("Generally, the fact that a domain name incorporates a Complainant's registered mark is sufficient to establish identical or confusing similarity for purposes of the [UDRP] Policy."). Furthermore, the intentional replacement of the letter "h" for the letter "i" and addition of the ".com" suffix does not overcome the confusing similarity of this domain name with Complainant's HSA BANK mark.

Based on the above, Respondent's registration of the <isabank.com> domain name serves only to cause confusion, mistake, or deception among consumers attempting to locate Complainant's website.

Complainant never authorized Respondent to register or use the HSA BANK mark in any manner. Respondent has no rights or legitimate interests in the <isabank.com> domain name under ¶ 4(c) of the UDRP Policy. Complainant is unaware of any evidence that Respondent has ever commonly been known by the name "ISA BANK", "HSA Bank" (or variations thereof) prior to Respondent's

registration of the <isabank.com> domain name. Therefore, Respondent lacks rights or legitimate interests in the domain name.

The <isabank.com> website contains a listing of links which brings the Internet user to websites containing links to Complainant's competitors which offer services in direct competition with those offered by Complainant. Use of a confusingly similar domain name to divert Internet users to a website containing such links is not a *bona fide* offering of goods or services pursuant to UDRP Policy ¶ 4(c)(i). Instead, this demonstrates that Respondent registered and is using the <isabank.com> domain name in bad faith, for the purpose of intentionally attempting to divert, for commercial gain, Internet users to Respondent's website by creating a likelihood of confusion with Complainant's HSA BANK mark as to the source, sponsorship, affiliation, and endorsement of the services offered through links on Respondent's respective websites. *See* UDRP Policy ¶ 4(b)(iii) and ¶ 4(b)(iv); *State Farm Mutual Automobile Insurance Company v. xi wang*, FA1409001579058, pp. 5-6 (NAF October 13, 2014) ("Respondent previously used the <statefarmsusa.com> domain name for a parked webpage that consisted of a variety of different links, some of which were in direct competition with Complainant. . . . the Panel finds that Respondent's previous use of the disputed domain name constitutes bad faith pursuant to Policy ¶ 4(b)(iv).").

Also, Respondent's use of the <isabank.com> domain name is "evidence of bad faith pursuant to [UDRP] Policy ¶ 4(b)(iv) because the domain name provides links to Complainant's competitors and Respondent presumably commercially benefits from the misleading domain name by receiving 'click-through-fees.'" *Associated Newspapers Limited v. Domain Manager*, FA0310000201976, p. 4 (NAF Nov. 19, 2003). *See also Google Inc. v. Aloysius Thevarajah*, FA0911001295342, p. 4 (NAF Dec. 31, 2009) ("[T]he <googleos.org> domain name resolves to a parked website that features hyperlinks to third-parties

unrelated to Complainant. The Panel assumes that Respondent receives click-through fees . . . This use of the disputed domain name constitutes bad faith registration and use under [UDRP] Policy ¶ 4(b)(iv).”).

Respondent’s use of privacy services is additional evidence of bad faith under the Policy. *See Burt’s Bees, Inc. v. Private Registration*, D2011-1808, p. 3 (WIPO Dec. 18, 2011) (“the use of a privacy or identity shield in this case further supports a finding that the Respondent has acted in bad faith. Although privacy shields may be legitimate in some cases, where, as in this case the Disputed Domain Name at issue fully encompasses the Complainant’s reputed mark and has obviously been used to divert Internet users in terms of paragraph 4(b)(iv) of the Policy, then it seems more likely than not that the Respondent is using a privacy shield to mask its true identity in an attempt to facilitate cybersquatting . . .”).

Furthermore, Respondent’s registration of its domain name “in spite of actual or constructive knowledge [of Complainant’s rights in the HSA BANK mark], amount[s] to bad faith registration and use pursuant to [UDRP] Policy ¶4(a)(iii).” *PPG Industries Ohio, Inc. v. PPG Car Paints*, FA0612000874856, p. 6 (NAF Feb. 21, 2007). *See also Digi International Inc. v. DDI Systems*, FA0209000124506, p. 7 (NAF Oct. 24, 2002) (“there is a legal presumption of bad faith, when Respondent reasonably should have been aware of Complainant’s trademarks, actually or constructively.”). Here, Respondent is presumed to have knowledge of Complainant’s registered mark and reputation because Respondent’s domain name <isabank.com> incorporates Complainant’s registered HSA BANK mark in its entirety (albeit by replacing the “h” with an “i”). *See The PNC Financial Services Group Inc. v. Unasi Inc.*, FA0508000535925, p. 6 (NAF Sept. 20, 2005) (“Respondent’s registration of the disputed domain name, which contains confusingly similar versions of Complainant’s PNC, PNCBANK and PNCBANK.COM marks, and Complainant’s registration of its marks with the

USPTO suggest[sic] that Respondent knew of Complainant's rights in the mark when Respondent registered the domain names."). Consequently, Complainant respectfully submits that Respondent has registered and has been using the <isabank.com> domain name in bad faith.

Based on the above, Respondent's domain name registration serves only to cause confusion, mistake or deception among consumers, especially those consumers who are seeking to locate Complainant's website.

B. Respondent

Respondent, resident in South Korea, contends that the Disputed Domain Name <isabank.com> is neither identical nor confusingly similar to Complainant's HSA BANK mark, either in pronunciation or appearance. "ISA", Respondent contends, means "move or moving" in the Korean language.

Respondent planned to develop a "moving service portal website" in Korea and registered the domain "www.isa.co.kr" for this purpose on November 16, 2005. Thereafter, on November 14, 2014, the Respondent registered the Disputed Domain Name <isabank.com>. Respondent asserts that the word "bank" is generic, and that "bank.com" is often used by companies that are not banks, such as in the domains "MaterialBank.com", "NewsBank.com", "DomainBank.com", "NameBank.com", and *cetera*.

The Respondent did not know the identity of the "HSABANK" and "Webster Financial Corporation" and had never visited the "HSABANK.com" website. The Complainant had not registered its mark in Korea and Respondent was unaware of the identity of Complainant.

Respondent avers that his website received only 646 visitors in the last 12 months and total revenue from traffic was only 0.29 Euro. Respondent "parked"

<isabank.com> at Sedo.com, because they provide free parking pages and it is very convenient in managing the domain name. Respondent never contacted Complainant and never offered to sell the Disputed Domain Name to Complainant.

Respondent asserts that he registered the Disputed Domain Name in good faith; that <isabank.com> has nothing to do with health care services and was not registered for the purpose of disrupting Complainant's business; and that Complainant's present UDRP action "is a reverse hijacking to rob(sic) 'isabank.com'."

FINDINGS

Complainant has rights in the HSA BANK service mark through registration of the mark with the United States Patent and Trademark Office for use with banking services (Reg. No 3161483, registered October 24, 2006).

Complainant has also established unregistered or common law trademark rights in HSA BANK, in that, at least as early as December 10, 2003, Complainant, through its licensee, Webster Bank, National Association, and its predecessor entity, State Bank of Howards Grove, has exclusively, continuously and on a widespread basis used and promoted the HSA BANK mark in commerce.

Respondent registered the Disputed Domain Name on November 4, 2014.

Complainant's Exhibit 6, a screenshot of a Domain Tools web page, reflects that the Disputed Domain Name <isabank.com> was listed for sale on the Internet for USD 11,494.00. Complainant's Exhibit 8, a screenshot of the website to which the Disputed Domain Name <isabank.com> resolves, displays banners reading: "Buy this domain" for EUR 10,000.00, and "Related links" headed "LOANS",

“BANK LOANS”, “FINANCE LOANS”, “FINANCIAL LOANS”, “BANKS”, among others, linking to competitors of Complainant.

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

Complainant asserts that Respondent's <isabank.com> domain name is confusingly similar to Complainant's HSA BANK registered service mark, as it incorporates the HSA BANK mark in the second level domain, albeit with an intentional misspelling, replacement of the letter "h" for the letter "i". The Panel finds the Disputed Domain Name and Complainant's mark confusingly similar. *See Webster Financial Corporation v. Zhong Wan / Wanzhongmedia*, FA1611001704956 (FORUM January 9, 2017) (finding the domain name "HASABANK.COM" confusingly similar to Complainant's HSA BANK mark because it incorporates a misspelling of the mark, minus the space, along with the gTLD ".com.")

Complainant has thus satisfied the first element that it must establish, Policy Paragraph 4(a)(i).

Rights or Legitimate Interests

Complainant never authorized Respondent to register or use the HSA BANK mark in any manner. Complainant, having thus established *prima facie* that Respondent lacks rights and legitimate interests in the disputed domain name under Policy ¶ 4(a)(ii), the burden shifts to Respondent to show it does have rights or legitimate interests in the Disputed Domain Name. *See Advanced International Marketing Corporation v. AA-1 Corp*, FA 780200 (FORUM Nov. 2, 2011) (finding that a complainant must offer some evidence to make its *prima facie* case and satisfy Policy ¶ 4(a)(ii)).

Respondent does not allege that it is commonly known by the Disputed Domain Name under Policy ¶ 4(c)(ii), nor does Respondent assert authorization to use Complainant's mark. Furthermore, Respondent's bare allegation that it "planned to develop a moving service portal website in Korea and registered the domain 'www.isa.co.kr' for this purpose on November 16, 2005", consists of nothing more than a screenshot of the "ISA.CO.KR" website showing the banner "Coming Soon!" It must be noted, moreover, that "ISA.CO.KR" is not the Disputed Domain Name, but another domain registered by Respondent in Korea that incorporated the letters "ISA", which is alleged by Respondent to be a word meaning "move, or moving" in the Korean language.

Respondent has used the Disputed Domain Name to resolve to a website containing links to competitors of Complainant and offering the Domain Name for public sale, and not in any *bona fide* offering of goods or services or legitimate non-commercial or fair use under Policy ¶¶ 4(c)(i) or (iii). The Panel finds that Respondent lacks any rights or legitimate interests in the Disputed Domain

Name. *See Ripple Labs Inc. v. NGYEN NGOC PHUONG THAO*, FA 1741737 (FORUM Aug. 21, 2017).

Complainant has satisfied the second element set out in Policy Paragraph 4(a)(ii).

Registration and Use in Bad Faith

Respondent purports to be a consulting agency that assists companies in acquiring Chinese hygiene licenses for cosmetics and trademarks and conducts online business consulting in Korea and China. Respondent claims that it did not register or use the <isabank.com> domain name in bad faith, as the incorporated term “isa,” means “move, or moving” in the Korean language and Respondent planned to develop a moving service portal website in Korea.

Respondent further argues that the incorporation of the word “BANK” is purely generic and relates to its business plan to use the Disputed Domain Name. As is noted above, however, Respondent’s assertions are unsupported by evidence. Additionally, the incorporation of the generic term “BANK” within the Disputed Domain Name provides no support to Respondent’s argument that it planned to establish a moving service portal website. The Panel fails to see any logical connection. Complainant correctly observes in its Supplemental Materials, moreover, that Respondent has submitted no evidence whatsoever of any positive action being undertaken by the Respondent in relation to the domain name, thus demonstrating Respondent’s bad faith.

It is generally accepted by UDRP panels that the owner of a parked domain name is ultimately responsible for how its domain name is used, regardless whether it exerts actual control over the content appearing at the parking site. *See State Farm Mut. Auto. Ins. Co. v. Pompilio*, FA 1092410 (FORUM Nov. 20,

2007) (“As a rule, the owner of a parked domain name does not control the content appearing at the parking site. Nevertheless, it is ultimately [the] respondent who is responsible for how its domain name is used.”); *see also Park ‘N Fly Service Corporation v Kevin Lanzillo*, FA 1554365 (FORUM May 13, 2014) (holding that it is ultimately “the Registrant responsible for the content of the material appearing on the webpage associated with the domain name in [a] dispute”).

Complainant has produced evidence that Respondent’s website contained links directing visitors to Complainant’s competitor banks and financial institutions. Furthermore, Respondent’s website and parking site offered the Disputed Domain Name for public sale at a high price. Finally, Complainant has established that Respondent utilized a privacy service to shield his identity as the Registrant of the Disputed Domain Name. Assessing these factors and circumstances in their totality and weighing the same against the Respondent’s unsubstantiated and wholly unconvincing assertions, this Panel has no difficulty finding by a preponderance of the evidence that the Respondent registered and used the Disputed Domain Name in bad faith.

The Panel accepts Complainant’s argument that Respondent’s use of “ISA” is a classic case of “typosquatting” for Internet users attempting to reach Complainant’s website, as the “i” is only two keys away from the “h” on a standard QWERTY keyboard. Numerous FORUM panels have ordered the transfer of domain names that are one letter off from Complainant’s HSA BANK mark. *See, e.g., Webster Financial Corporation v. mo ban lin shi / Cheng Du Xi Wei Shu Ma Ke Ji You Xian Gong Si*, FA1606001680509 (NAF Aug. 11, 2016) (ordering the transfer of <hsabamk.com> to Complainant); *Webster Financial Corporation v. ICS Inc / Ics Inc*, FA1506001622500 (NAF July 26, 2015) (ordering the transfer of <hsabnk.com> to Complainant); *Webster Financial Corporation v. Zhong Wan / Wanzhongmedia*, FA1611001704956 (NAF Jan. 9,

2017) (ordering the transfer of <hasabank.com> to Complainant); *Webster Financial Corporation v. fang teng*, FA1805001785981 (NAF June 7, 2018) (ordering the transfer of <hsaank.com> to Complainant); *Webster Financial Corporation v. Li Jin Liang*, FA1808001801762 (NAF Sept. 13, 2018) (ordering the transfer of <hsabanl.com> to Complainant).

Complainant has satisfied the third element that it must establish, Policy Paragraph 4(a)(iii).

DECISION

Having established all three elements required under the ICANN Policy, the Panel concludes that relief shall be **GRANTED**.

Accordingly, it is Ordered that the <**isabank.com**> domain name be **TRANSFERRED** from Respondent to Complainant.

David L. Kreider, Panelist

Dated: October 3, 2019