

ADMINISTRATIVE PANEL DECISION

TC Federal Bank v. Privacy service provided by Withheld for Privacy ehf /
John West, US TC Federal, and John Hex
Case No. D2022-1453

1. The Parties

Complainant is TC Federal Bank, United States of America (“United States”), represented by Bryan Cave Leighton Paisner LLP, United States.

Respondent is Privacy service provided by Withheld for Privacy ehf, Iceland / John West, US TC Federal, United States, and John Hex, Nigeria.

2. The Domain Name and Registrar

The disputed domain name <tcbfederal.com> and <tcfederalhub.com> (the “Domain Names”) are registered with NameCheap, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on April 22, 2022. On April 25, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Names. On April 25 and May 3, 2022, the Registrar transmitted by email to the Center its verification responses disclosing registrant and contact information for the Domain Names which differed from the named Respondent and contact information in the Complaint. The Center sent an email to Complainant on May 4, 2022, providing the registrant and contact information for multiple underlying registrants disclosed by the Registrar, and inviting Complainant to either amend the Complaint adding the Registrar-disclosed registrants as the formal Respondent and provide relevant arguments or evidence demonstrating that all the named registrants are, in fact, the same entity and/or that all the Domain Names are under common control or remove one of the Domain Names from the current proceedings and file a separate complaint against it. Complainant filed an amended Complaint on May 7, 2022, including comments on the consolidation.

The Center verified that the Complaint together with the amended Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the “Policy” or “UDRP”), the Rules for Uniform Domain Name Dispute Resolution Policy (the “Rules”), and the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the “Supplemental Rules”).

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified Respondent of the Complaint, and the proceedings commenced on May 9, 2022. In accordance with the Rules, paragraph 5, the due date for Response was May 29, 2022. Respondent did not submit any response. Accordingly, the Center notified Respondent's default on May 30, 2022.

The Center appointed Robert A. Badgley as the sole panelist in this matter on June 9, 2022. The Panel finds that it was properly constituted. The Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Center to ensure compliance with the Rules, paragraph 7.

4. Factual Background

Founded in 1934 as Thomas County Federal Savings and Loan Association, Complainant is a bank located in the state of Georgia, United States. Complainant contends that it has long used "TC" as shorthand for "Thomas County", and that it formally changed its name to "TC Federal Bank" on January 1, 2018.

Complainant holds trademark registrations in the states of Georgia and Florida, including Georgia Reg. No. S-29474 for TC FEDERAL BANK, registered on February 1, 2019, for "banking and financing services", and Florida Reg. No. T1900000139 for TC FEDERAL BANK, registered on February 1, 2019, for "banking and financing services".

Given its longstanding use, Complainant also submits that it owns common law rights in the variations of its TC FEDERAL and TC FEDERAL BANK marks in connection with its banking and financial services. Complainant has invested significant resources in marketing and promoting itself, its services, and its marks. As a result, the relevant consuming public has come to recognize the TC FEDERAL and TC FEDERAL BANK marks as denoting Complainant and its banking and financial services. As of December 31, 2021, Complainant held USD 310 million in savings.

Complainant maintains a commercial website at the domain name <tcfederal.com>, which domain name Complainant has owned since 2012.

The Domain Name <tcfederalhub.com> was registered on May 27, 2021, and the Domain Name <tcbfederal.com> was registered on July 14, 2021. The latter Domain Name resolves to a website which mimics Complainant's website and which, according to Complainant, is used to carry out a fraudulent phishing scheme whereby consumers are invited to provide personal information while logging in to what they believe is Complainant's website. The former Domain Name was also used for this purpose, but it appears that the hosting service has taken down the fake website after being contacted by Complainant.

Neither Respondent named in this case has denied any of the foregoing allegations.

5. Parties' Contentions

A. Complainant

Complainant contends that it has established all three elements required under the Policy for a transfer of the Domain Names.

B. Respondent

Respondent (or Respondents) did not reply to Complainant's contentions.

6. Discussion and Findings

6.1 Consolidation of Dispute

Although the names of the two Domain Name registrants in this case differ (John Hex, US TC Federal and John West), Complainant asserts that the two registrants are probably one and the same person or, at a minimum, they are under common control such that the two Domain Names should be consolidated in this single proceeding. It is apparent that false contact information appears in the Whois database, as John West, US TC Federal's city and state is listed as Texas, Texas. There is no such city. Further, a search of the Texas Secretary of State records conducted by Complainant's counsel indicates there is no legal entity formed or registered to do business in Texas named "US TC Federal." In addition, until one of the websites at issue was taken down by the web hosting service, both websites were identical. Both Domain Names were registered with the same Registrar, and were registered about seven weeks apart.

Neither Respondent (if indeed there be two different persons here) has come forward in this proceeding to assert that he is not the same person as the other Respondent, or to assert that he is not under common control with the other Respondent. In these circumstances, the Panel finds it appropriate to credit Complainant's plausible assertion that both named registrants are probably under common control, and therefore disposing of both Domain Names in a single consolidated proceeding is warranted here.

6.2 Merits of Dispute

Paragraph 4(a) of the Policy lists the three elements which Complainant must satisfy with respect to each of the Domain Names:

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

A. Identical or Confusingly Similar

The Panel concludes that Complainant has rights in the common law trademarks TC FEDERAL and TC FEDERAL BANK through many years of use demonstrated in the record. Further, because the Panel finds that Respondent targeted Complainant here, it follows logically that Respondent himself believes that TC FEDERAL or TC FEDERAL BANK serves as a source identifier for Complainant's goods and services.

The Panel also concludes that the Domain Names are confusingly similar to the above-mentioned marks. The only difference between the TC FEDERAL BANK mark and the Domain Names is the omission of the descriptive word "bank" in both Domain Names, plus the additional letter "b" in one Domain Name and the additional word "hub" in the other. The "TC FEDERAL" portion of this trademark is clearly recognizable in both Domain Names. Further, the Domain Names also incorporate Complainant's TC FEDERAL trademark in its entirety.

Complainant has established Policy paragraph 4(a)(i).

B. Rights or Legitimate Interests

For each of the Domain Names pursuant to paragraph 4(c) of the Policy, Respondent may establish its rights or legitimate interests in the Domain Name, among other circumstances, by showing any of the following elements:

- (i) before any notice to you [Respondent] of the dispute, your use of, or demonstrable preparations to use, the Domain Name or a name corresponding to the Domain Name in connection with a *bona fide* offering of goods or services; or
- (ii) you [Respondent] (as an individual, business, or other organization) have been commonly known by the Domain Name, even if you have acquired no trademark or service mark rights; or
- (iii) you [Respondent] are making a legitimate noncommercial or fair use of the Domain Name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

The Panel concludes that Respondent lacks rights or legitimate interests in respect of the Domain Names. Respondent has not come forward in this proceeding to dispute the serious and plausible allegations raised in the Complaint. The undisputed record in this case is that Respondent used the Domain Names to set up a website identical to Complainant's website and then use that site to apparently induce unwitting customers to provide their personal information to Respondent. Trying to perpetrate a classic "phishing" scheme is manifestly not the source of a right or legitimate interest in the Domain Names.

Further, Respondent John West appears to be associated with an organization, "US TC Federal". According to Complainant, there is no legal entity formed or registered to do business in Texas (where Respondent John West is located) named "US TC Federal". The Panel finds under circumstances of this case that Respondent's choice of "US TC Federal" as his organization name further evidences his intention to pass off as Complainant for potential phishing scheme.

The Panel concludes that Complainant has established Policy paragraph 4(a)(ii).

C. Registered and Used in Bad Faith

For each of the Domain Names, paragraph 4(b) of the Policy provides that the following circumstances, "in particular but without limitation", are evidence of the registration and use of each Domain Name in "bad faith":

- (i) circumstances indicating that Respondent has registered or has acquired the Domain Name primarily for the purpose of selling, renting, or otherwise transferring the Domain Name registration to Complainant who is the owner of the trademark or service mark or to a competitor of that Complainant, for valuable consideration in excess of its documented out of pocket costs directly related to the Domain Name; or
- (ii) that Respondent has registered the Domain Name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that Respondent has engaged in a pattern of such conduct; or
- (iii) that Respondent has registered the Domain Name primarily for the purpose of disrupting the business of a competitor; or
- (iv) that by using the Domain Name, Respondent has intentionally attempted to attract, for commercial gain, Internet users to Respondent's website or other online location, by creating a likelihood of confusion with Complainant's mark as to the source, sponsorship, affiliation, or endorsement of Respondent's website or location or of a product or service on Respondent's website or location.

The Panel concludes that Respondent has registered and used the Domain Names in bad faith. The Panel incorporates its discussion above in the "Rights or Legitimate Interests" section. The undisputed record here demonstrates that Respondent clearly registered these Domain Names with Complainant's trademark in mind, and that Respondent's motive was most likely to carry out a phishing scam through the website which

fraudulently impersonated Complainant's own site. Such misconduct clearly constitutes bad faith registration and use within the meaning of the above-quoted Policy paragraph 4(b)(iv).

Complainant has established Policy paragraph 4(a)(iii).

7. Decision

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

/Robert A. Badgley/

Robert A. Badgley

Sole Panelist

Date: June 23, 2022