

ADMINISTRATIVE PANEL DECISION

Gibson Brands, Inc. v. Domain Administrator, AssuredPartners Inc.
Case No. D2022-2678

1. The Parties

Complainant is Gibson Brands, Inc., United States of America (“United States” or “USA”), represented by Bates & Bates LLC, USA.

Respondent is Domain Administrator, AssuredPartners Inc., USA, represented by The GigaLaw Firm, Douglas M. Isenberg, Attorney at Law, LLC, USA.

2. The Domain Name and Registrar

The disputed domain name <tobias.com> (the “Domain Name”) is registered with MarkMonitor Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on July 21, 2022. On July 22, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On August 2, 2022, the Registrar 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” 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 August 4, 2022. In accordance with the Rules, paragraph 5, the initial due date for Response was August 24, 2022. On August 18, 2022, Complainant submitted an amended Complaint, purportedly to clean up a few typos in the July 21, 2022 Complaint. Upon the mutual agreement of the Parties, the due date for Response was extended to September 17, 2022. The Response was filed with the Center on September 14, 2022.

Complainant submitted an unsolicited filing on September 16, 2022. Respondent sought leave, in the event the Panel were to accept the supplemental filing, to respond to same. The Panel, not needing any further input from Complainant, took no action in response to Respondent’s request.

The Center appointed Robert A. Badgley as the sole panelist in this matter on September 16, 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

The Complaint states: “Complainant Gibson is engaged in the business of developing, manufacturing, and selling musical instruments, including stringed instruments under the famous TOBIAS ® Trademark for over 40 years. Complainant’s Gibson products are offered throughout the world, and Gibson’s name and instruments have gained worldwide and reputation.”

There is no evidence presented to show that Complainant’s TOBIAS mark – as opposed to the GIBSON mark in connection with guitars¹ – enjoys fame, as alleged in the Complaint.

Complainant holds the registered trademark TOBIAS in connection with “stringed musical instruments, namely bass guitars,” registered on March 28, 1995, with the United States Patent and Trademark Office, Reg. No. 1,885,979, with a December 31, 1984 date of first use in commerce.

Respondent AssuredPartners, Inc. is an insurance brokerage firm founded in 2011. According to the Response, Respondent “is the fastest-growing independent insurance agency in the United States.” Respondent operates a website at the domain name <assuredpartners.com>.

In December 2012, Respondent issued a press release stating that it had acquired Tobias Insurance Group (“Tobias IG”), an insurance agency founded in 1973. The press release states:

“AssuredPartners, Inc. has completed a transaction for substantially all of the assets of Tobias Insurance Group, Inc. Tobias Insurance Group, Inc. will continue under its own name and its headquarters in Indianapolis, IN. Tobias is one of the largest independently owned commercial insurance brokerage businesses in the Midwest, serving clients both domestically and internationally, and will continue under the leadership of [...]”.

“Founded in 1973, Tobias offers a comprehensive mix of insurance products and services, including property and casualty, surety, and employee benefits. Tobias works with a wide array of industries, with a strong focus on construction. This acquisition will strategically expand AssuredPartners footprint in the Midwest.”

Another news article, a January 10, 2013 piece in the Indianapolis Business Journal, discussed Respondent’s recent acquisition of Tobias IG, stating in part:

“Tobias Insurance Group Inc., one of Indianapolis’ largest independent insurance brokerages, has merged with Florida-based AssuredPartners Inc. Terms of the deal, announced Thursday, were not disclosed.”

“Tobias will retain its name, and company founder [...] will continue to lead the insurance brokerage that he started in 1973. With [USD] 351 million in premiums written in 2011, Tobias ranks as the area’s eighth-largest independent insurance brokerage, according to the most recent IBJ statistics. The company has 45 employees, who will retain their jobs, [...] said.”

“AssuredPartners has more than 1,700 employees in 63 offices in 20 states, and posts about [USD] 230 million in annual revenue.”

¹ The Panel accepts, even with no evidence in the record, that GIBSON enjoys fame as a trademark in connection with guitars. The Domain Name at issue, however, has nothing to do with the GIBSON mark.

The Domain Name was originally registered, apparently by Tobias IG, on July 28, 1995. Some screenshots annexed to the Response confirm that Tobias IG was the registrant of the Domain Name at least as early as May 17, 2000. Screenshots annexed to the Response show Tobias IG's use of the Domain Name to host a website related to its insurance brokerage business at various moments in time, such as April 29, 2007 and March 18, 2016.

Annexed to the Response is an Affidavit of "SG," executive vice president and chief information officer of Respondent. In the affidavit, SG states that Tobias IG (by then under Respondent's control for several years) transferred ownership of the Domain Name to Respondent on or about December 15, 2017.

SG states further that, apart from Tobias IG's use of the Domain Name for a website, Respondent itself never established a website corresponding to the Domain Name. SG states:

"AssuredPartners has ceased using the Disputed Domain Name in connection with an active website (because AssuredPartners no longer uses the Tobias Insurance brand) but continues to maintain the Disputed Domain Name for email purposes (because some individuals still send emails to addresses that include the Disputed Domain Name, given AssuredPartners's longtime usage of the Disputed Domain Name)."

Also, the online search results provided as an Annex to the Response also show that, when the word "tobias" is searched with the name of the Respondent, the first results are links to the news about the mentioned acquisition.

The Domain Name currently does not resolve to an active website; it resolves to a parking page.

5. Parties' Contentions

A. Complainant

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

B. Respondent

Respondent asserts that it has a legitimate interest in the Domain Name, since it acquired the Domain Name from a company called Tobias Insurance Group, which company Respondent acquired. Respondent denies bad faith registration and use of the Domain Name, and asks the Panel to declare Complainant culpable of Reverse Domain Name Hijacking.

6. Discussion and Findings

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

- (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 trademark TOBIAS through registration demonstrated in the record. The Panel also concludes that the Domain Name is identical to that mark.

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

B. Rights or Legitimate Interests

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 clearly has rights or legitimate interests in the Domain Name. Respondent, an insurance broker, acquired Tobias Insurance Group in 2012, and Tobias IG had been trading under the mark TOBIAS for many years. The TOBIAS mark continued to be used by Respondent for several years until Respondent decided to discontinue the TOBIAS brand. Because of some legacy customers accustomed to communicating with Respondent via an email address using the Domain Name, Respondent continues to use the Domain Name for that limited purpose to this day. This is manifestly a legitimate use of the Domain Name, and Complainant should have better than to argue otherwise.

Moreover, Respondent, through its Tobias IG subsidiary or division, was commonly known by the Domain Name for several years.

Complainant has not established Policy paragraph 4(a)(ii).

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy provides that the following circumstances, "in particular but without limitation," are evidence of the registration and use of the 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 there is no evidence that Respondent registered or used the Domain Name in bad faith under the Policy. The Panel incorporates its discussion above in the "Rights or Legitimate Interests" section.

This Domain Name obviously was not acquired by Respondent in bad faith. By December 15, 2017, when Tobias IG transferred the Domain Name to Respondent, the latter firm had owned the former firm for several years, and the Domain Name had operated as it had for years prior to Respondent's acquisition of Tobias IG, namely, as a legitimate commercial website offering insurance brokerage services. Whether Respondent actually took a formal assignment of any TOBIAS trademark from Tobias IG – a point Complainant tries to raise in its unsolicited supplemental filing – does not alter the question of bad faith here.

Complainant does not seem to dispute the legitimacy of Tobias IG's ownership and use of the Domain Name, but it argues that Respondent's ownership and use of the Domain Name after Tobias IG transferred it was somehow bad faith. This makes little sense. Respondent acquired Tobias IG in 2012, and for a time allowed its Tobias IG subsidiary or division (the precise corporate structure following the 2012 acquisition is not altogether clear from the record, but it matters not for these purposes) to carry on trading under the TOBIAS mark and using the Domain Name toward that end. If Tobias IG's ownership and use of the Domain Name is legitimate, then it is difficult to understand how that ownership and use by the parent firm can somehow become illegitimate, or bad faith.

Complainant has not established Policy paragraph 4(a)(iii).

D. Reverse Domain Name Hijacking

The Panel agrees with Complainant that this Complaint never should have been brought. Moreover, once Respondent's position became clear from the Response, Complainant should have sought to settle or withdraw the Complaint. Instead, Complainant doubled down with irrelevant arguments. Complainant, represented by counsel with experience in UDRP cases, has committed Reverse Domain Name Hijacking ("RDNH").

First, Complainant asserts, with absolutely no proof, that its TOBIAS mark is "famous." That sort of bald assertion is, in this case, an overreach, and it undermines Complainant's credibility from the outset.

Second, the Panel agrees with Respondent that it would have been very easy for Complainant to acquire an understanding of why Respondent registered the Domain Name. Respondent AssuredPartners, Inc. is listed in the Whois database as the registrant of the Domain Name. As Respondent points out, a simple Google search of "AssuredPartners" and "Tobias" would have yielded articles discussing the fact that Respondent is an insurance brokerage firm that had acquired another such firm, trading as Tobias Insurance Group, a decade before the Complaint in this proceeding was launched.² Such knowledge presumably would have put Complainant on ample notice that Respondent may well have a legitimate claim to the Domain Name. A panel may find RDNH where a complaint was doomed to failure and a modicum of due diligence by a complainant would have made this clear before the complaint is filed. See *Mountain Top (Denmark) ApS v. Contact Privacy Inc. Customer 0133416460 / Name Redacted*, *Mountaintop Idea Studio*, WIPO Case No. [D2020-1577](#).

Because Complainant, represented by counsel acquainted with the UDRP process, apparently made no effort at all to research the potential *bona fides* of Respondent, Complainant launched a misbegotten

² The Panel's own Google search for "tobias" did not bring up Complainant on the first page, but that page did mention "Tobias Funeral Homes" in Dayton, Ohio.

Complaint, and aggravated matters by making unreasonable arguments, such as the argument (in the unsolicited supplemental filing) that using the Domain Name for email only (and no website) is not a “use” of the Domain Name, and that “it is not possible to conceive of any plausible actual or contemplated active use of the domain name ... by the Respondent that would not be illegitimate.”

Third, and perhaps most importantly in this case, it should have been clear to Complainant and its counsel, once they read the Response and annexes, that this case would not succeed. At that time, Complainant should have thought about withdrawing the Complaint. Instead, Complainant doubled-down in its unsolicited supplemental filing. In that submission, Complainant fails to address any of the critical points raised by Respondent, and instead offers flimsy and inessential arguments, such as the argument that Respondent is somehow in bad faith because it apparently did not have an assigned trademark from its own subsidiary, or that using a domain name for email only and not as a website is not a “use” of the Domain Name.

Taking Complainant’s conduct in its totality, the Panel does not hesitate to declare that Complainant has abused the UDRP process in this case.

7. Decision

For the foregoing reasons, the Complaint is denied. Complainant has committed Reverse Domain Name Hijacking.

/Robert A. Badgley/

Robert A. Badgley

Sole Panelist

Date: September 29, 2022