



WIPO Arbitration and Mediation Center

ADMINISTRATIVE PANEL DECISION

Mercury Radio Arts, Inc. and Glenn Beck v. Isaac Eiland-Hall

Case No. D2009-1182

1. The Parties

Complainant is Mercury Radio Arts, Inc. and Glenn Beck of New York, New York, United States of America, represented by Cowan, DeBaets, Abrahams & Sheppard, LLP, of the United States of America.

Respondent is Isaac Eiland-Hall of Panama City, Florida, United States of America, represented by Marc J. Randazza, of the United States of America.

2. The Domain Name and Registrar

The disputed domain name <glennbeckrapedandmurderedayounggirlin1990.com> is registered with eNom.

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on September 5, 2009. On September 8, 2009, the Center transmitted by email to eNom a request for registrar verification in connection with the disputed domain name. On September 10, 2009, eNom transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain name which differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to Complainant on September 14, 2009 providing the registrant and contact information disclosed by the Registrar, indicating that the Complaint contained a typographical error in the domain name, and inviting Complainant to submit an amendment to the Complaint. Complainant filed an amended Complaint on September 18, 2009. 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(a) and 4(a), the Center formally notified Respondent of the Complaint, and the proceedings commenced on September 21, 2009. In accordance with the Rules, paragraph 5(a), the due date for Response was October 11, 2009. The Response was filed with the Center on September 28, 2009.

The Center appointed Frederick M. Abbott as the sole panelist in this matter on October 5, 2009. 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.

By email dated October 14, 2009, Complainant transmitted to the Center and Respondent a Supplemental Filing, including a request for consideration by the Panel. The Center duly transmitted the Supplemental Filing and request to the Panel. The Panel thereupon issued its Administrative Panel Procedural Order No. 1 to the parties, stating:

The Panel has received and reviewed the Supplemental Filing transmitted by Complainant to the Center on October 14, 2009. In its Response, Respondent indicated that certain parts of its legal argument are novel in so far as they have not been previously addressed by panel decisions under the Policy. Because Complainant might not have reasonably foreseen the line of argumentation presented by Respondent, the Panel has determined to accept Complainant’s Supplemental Filing.

In order to assure that each party has adequate opportunity to present its case, the Panel invites Respondent to reply to Complainant’s Supplemental Filing. Respondent is requested to transmit any such reply to the Center by e-mail within seven calendar days of the date of this Administrative Order.

Respondent transmitted its Surreply by email to the Center and Complainant on October 21, 2009. The Center duly forwarded that document to the Panel.

4. Factual Background

Complainant principally asserts United States federal common law trademark and service mark rights in the name GLENN BECK based on use in commerce in the United States. Complainant indicates that the individual Glenn Beck initiated a syndicated radio talkshow program in January 2002 (“The Glenn Beck Program”), and that this show is now heard throughout the United States on over 350 stations and on XM Satellite Radio. Complainant also indicates that Glenn Beck is the author of three New York Times best-selling books, two of which have reached the number one ranking. Furthermore, Glenn Beck performs a live stage tour twice each year, attracting over 200,000 fans in nearly 40 different markets. The individual Glenn Beck also appears on a “highly-rated Fox News Network show”. Co-Complainant Mercury Radio Arts, Inc. (“Mercury”), is “Mr. Beck’s fully integrated multi-media production company” responsible for producing or coproducing his various business enterprises. Mercury and Glenn Beck are hereinafter collectively referred to as “Complainant”, except as otherwise expressly indicated.

Complainant indicates and provides evidence that Mercury on January 12, 2007 filed “intent to use” (“ITU”) trademark applications for the term GLENN BECK on the Principal Register of the United States Patent and Trademark Office (“USPTO”), serial number 77081634, in International Classes (“ICs”) 9, 18, 20, 21, 25 and 28, and serial number 77977898, in ICs 16, 35 and 41. The aforesaid ITU applications cover a broad range of goods and services, including, *inter alia*, prerecorded DVDs and CDs, plastic and wooden boxes, cups, ice buckets, “promotional clothing items for a TV and radio personality specializing in social and political commentary”, non-fiction books, on-line ordering services, and on-line information services. The USPTO in each case issued a “notice of allowance”. Complainant has submitted a statement of use in connection with application serial number 77977898. On September 16, 2009, the USPTO advised that this statement was accepted and the GLENN BECK trademark and service mark was allowed for registration. Complainant requested and on September 9, 2009 an extension for filing a statement of use was allowed by the USPTO regarding the remaining ITU application.

Complainant operates a commercial Internet website at “www.glennbeck.com”. On that website Complainant expresses political and other opinions, and offers for sale a variety of products and services, including books, magazines, games, and links to merchandise such as a “survival seed bank”.

According to the Registrar’s verification, Respondent is registrant of the disputed domain name. According to a DomainTools WhoIs database report provided by Complainant, the record of registration of the disputed domain name was created on September 1, 2009.

The disputed domain name directs Internet users to a website that, as of September 4, 2009 (website printout provided by Complainant), the home page of which stated:

GlennBeckRapedAndMurderedAYoungGirlIn1990.com

The Official Website About The Controversy

Did Glenn Beck Rape and Murder a Young Girl in 1990?

Important Information

This site is the official website about the controversy.

We are, however, not the originators. Please see the “The Origin” link on the left to see how it all got started.

The official forum can be found by using the “The Forum” link on the left.

If you wish to contact the site operator, Name Withheld, click the “Email Us” link on the left.

Alternatively, you can call (214) [...] Please note that if we’re not around, and you leave us voicemail, we may post that somewhere (although any identifying information will be removed).

Tip: Check out the bottom of this page for a very important top secret piece

of information.

Notice: This site is parody/satire. We assume Glenn Beck did not rape and murder a young girl in 1990, although we haven't yet seen proof that he didn't. But we think Glenn Beck definitely uses tactics like this to spread lies and misinformation.

There are numerous links to the left of the main text on Respondent's website. As of September 4, 2009. Complainant particularly refers to a link to "www.foxnewsboycott.com", and to the webpages associated with that link. One of those pages includes the following text, by way of illustration:

Anti-Fox News Clothing

FNB Store

Through various partnerships with online retailers, FoxNewsBoycott.com is able to provide a wide selection of books, clothing and stickers related to Fox News and media bias. Show your support for FNB and the anti-Fox News movement. A small percentage of sales goes back to the site.

- Books - Books about Fox News, personalities such as Bill O'Reilly, Sean Hannity, Rush Limbaugh, etc. and media bias.
- Clothing - Humorous parody shirts, sweatshirts, hoodies, hats and more. A great way to make a statement about Fox News.
- Stickers – Bu[m]perstickers and decals to show the world how you feel about Fox News, television, radio and media bias.
- TV-B-Gone - A keychain-sized universal remote control to turn off TVs where Fox News is aired, or use for fun.

Didn't see anything you like? Please consider supporting FoxNewsBoycott.com with a donation. Thank you!

Photographs of T-shirts critical of Fox News (e.g., "Faux News") also appear on the "www.foxnewsboycott.com" website, as do links to books critical of Fox News presenters, and critical "stickers" (e.g., "Fox News Get Off The Air").

A principal feature of Respondent's <glennbeckrapedandmurderedayounggirlin1990.com> website is a forum headed "Assorted Rumours". An illustrative posting reads as follows:

veritas aeternitas: I can't believe evidence as to whether or not Glenn Beck raped a girl in 1990 ... has not come to light! What are the law enforcement agencies doing? Every year hundreds of innocent girls go missing. How many of them have fallen prey to the murdering and raping hands of Glenn Beck? And how many more will have to suffer before we get to the bottom of this? /Never forget: Glenn Beck raped and murdered a girl in 1990 ...

Also at the left of the website pages are links to "Evidence", with link titles such as "Totally Legit Police Report", "Caffeinated Evidence" and "Unreasonable

Evidence”.

As of September 21, 2009, Respondent’s website was seemingly modified to include, *inter alia*, additional references to the “parody” nature of the content. As of that date the website was headed:

DidGlennBeckRapeAndMurderAYoungGirlIn1990.com

The Official Parody Website About The Controversy

Did Glenn Beck Rape and Murder a Young Girl in 1990?

Notice: This website is 100% parody

Following an inserted video link, the text continued:

Welcome

This site exists to try and help examine the vicious rumour that Glenn Beck raped and murdered a young girl in 1990. We don’t claim to know the truth -- only that the rumour floating around saying that Glenn Beck raped and murdered a young girl in 1990 should be discussed. So we’re going to do our part to try and help get to the bottom of this.

Why won’t Glenn Beck deny these allegations! We’re not accusing Glenn Beck of raping and murdering a young girl in 1990 - in fact, we think he didn’t! But we can’t help but wonder, since he has failed to deny these horrible allegations. Why won’t he deny that he raped and killed a young girl in 1990?

(Have you looked at the very bottom of this page yet>)

The following statement appears, among others directed to Respondent’s legal situation:

A reminder: I am not making any money off of this site, at all, in any way. I’m paying for everything - the domain, hosting, everything this costs, I’m paying. I’m not even accepting donations!

Following discussion forums constituting the large part of the website, the following appears:

Notice: This site is parody/satire. We assume Glenn Beck did not rape and murder a young girl in 1990, although we haven’t yet seen proof that he didn’t. But we think Glenn Beck definitely uses tactics like this to spread lies and misinformation.

Read the last sentence again. That’s the point. Read it a third time and ignore the name of the site itself, because anyone who believes that we’re trying to actually get people to believe Glenn Beck raped and/or murdered is *whoosh* missing the entire point. So don’t be dumb like a lot of people are. I greatly expanded this text because so many people *read* it, and *still* didn’t understand.

Additional links to the left of the website homepage have been added, including links directed to an explanation of the concept of an Internet “meme”.

As of September 21, 2009, links to “www.foxnewsboycott.com” do not appear on Respondent’s website.

The Registration Agreement in effect between Respondent and eNom subjects Respondent to dispute settlement under the Policy. The Policy requires that domain name registrants submit to a mandatory administrative proceeding conducted by an approved dispute resolution service provider, of which the Center is one, regarding allegations of abusive domain name registration and use (Policy, paragraph 4(a)).

5. Parties’ Contentions

A. Complainant

Complainant alleges that it has rights to the trademark and service mark GLENN BECK in the United States. Complainant argues that the personal name GLENN BECK has acquired secondary meaning among a substantial segment of the U.S. public based upon extensive radio and television appearances, live public performances and promotions by the individual identified by the trademark and service mark. Complainant also indicates that it has filed ITU trademark and service mark applications with the USPTO, that it has received a notice of allowance in each case, and that as to one of the applications a statement of use has been accepted.

Complainant contends that the disputed domain name <glennbeckrapedandmurderedayounggirlin1990.com> is confusingly similar to the GLENN BECK mark. Complainant argues that the addition of terms to a trademark does not preclude a finding of confusing similarity, even if those additional terms are negative (relying on prior determinations under the Policy).

Complainant states that Respondent lacks rights or legitimate interests in the disputed domain name. Complainant argues that Respondent has not been authorized to use its GLENN BECK mark, and that Respondent has not been commonly known as or acquired trademark rights in GLENN BECK. Complainant alleges that Respondent is not engaging in legitimate noncommercial or fair use of its trademark. Complainant states that the disputed domain name does not give Internet users sufficient notice that it resolves to a complaint or protest site. Complainant alleges that because the disputed domain name is plainly defamatory, it weighs against a finding that Respondent has rights or legitimate interests in it.

Complainant argues that the disputed domain name is not protected as a legitimate or noncommercial use of Complainant’s mark as a “parody” because Respondent has not made sufficiently clear that it is intended to convey criticism through a form of comedy (i.e., that it is a “joke”). Complainant states that Respondent has expanded on its “disclaimer” on its website because, even according to Respondent, it appears that many viewers do not appreciate or understand the alleged parody (i.e., it is too much of an inside joke). Complainant argues that Respondent manufactured its parody/criticism defense after the fact, and that it had no such intention when initially registering the disputed domain name.

Complainant alleges that Respondent registered and has used the disputed domain name in bad faith. Complainant argues that the disputed domain name is plainly defamatory, and was adopted with an intention to damage Complainant's reputation, and to tarnish and dilute its trademark. Complainant argues that the disputed domain name does not provide an Internet user with notice that he or she will be directed to a protest site, but will instead likely believe that Respondent's website is intended to provide factual information concerning Complainant. Complainant contends that the enumerated list of bad faith elements in the Policy is not exhaustive, and that conduct such as that engaged in by Respondent has previously been determined to constitute bad faith.

Complainant requests Panel to direct the Registrar to transfer the disputed domain name to Complainant.

B. Respondent

Respondent alleges that Complainant has not adequately substantiated its claim of common law trademark rights, that there is insufficient evidence provided of secondary meaning, and that mere fame does not entitle an individual to trademark or service mark rights in their name. Respondent further argues that Complainant filed its ITU application at the USPTO subsequent to registration of the disputed domain name.

Respondent argues that the disputed domain name is not identical or confusingly similar to Complainant's trademark because no reasonable Internet user would conclude that the disputed domain name would direct him or her to a website sourced, sponsored, affiliated or endorsed by Complainant. Respondent alleges that only a "moron in a hurry" could be confused by the disputed domain name.

Respondent contends that it has rights or legitimate interests in the disputed domain name. Respondent argues that the disputed domain name constitutes an Internet "meme" that is a phrase or statement that for some reason (perhaps obscure) acquires a special status among certain Internet users that leads to its continuing use. Respondent provides the following definition: "The term Internet meme is a phrase used to describe a catchphrase or concept that spreads quickly from person to person via the Internet, much like an esoteric inside joke' See Internet For Beginners". [citation omitted] Respondent states that Internet memes often involve famous people, often are unflattering, and that the truth or falsity of the memes are not especially relevant. Respondent indicates that the potentially unfortunate subject of an Internet meme may have done nothing to deserve the attention other than having become famous.

Respondent argues that the disputed domain name is a meme that is based on the technique deriving from a comedy sketch performed by Gilbert Gottfried on a Comedy Central Roast of Bob Saget during which Mr. Gottfried made continuing references to an unflattering rumor concerning Mr. Saget (similar to the one embodied in the disputed domain name), while requesting that those repeating the rumor cease to do so. According to Respondent, Glenn Beck has used a similar technique while interviewing at least one individual on his news broadcast by making an unsupported assertion about his activities, and placing a burden on the interviewee to deny the unsupported assertion. According to Respondent, this technique places the interviewee in a compromised position regardless of underlying facts.

Respondent argues that the disputed domain name is being used legitimately for parody or criticism regardless of whether the Panel approaches the issue using a methodology

more favored by panels deciding cases involving non-U.S. parties, or the methodology favored by panels deciding cases involving U.S. parties.

Using the methodology favored by panels deciding cases involving non-U.S. parties, because the disputed domain name clearly signals that it is not sourced, sponsored or endorsed by Complainant, an Internet user would be aware that the associated website presents parody or criticism.

Using the methodology favored by panels deciding cases involving U.S. parties, Respondent contends that it has rights or legitimate interests in the disputed domain name because it is a meme that is used to parody or criticize Complainant because of his political views, and thus is protected as free speech under the U.S. Constitution. Respondent argues that it is making nominative fair use of Complainant's alleged mark for purposes of criticism, there is no confusion among Internet users as to whether Respondent's website is associated with Complainant, and that Respondent is protected even if its speech results in economic harm to Complainant.

Respondent argues that it did not register and use the disputed domain name in bad faith because it did not have a commercial purpose registering and using the disputed domain name. Respondent states that, in prior determinations under the Policy, links to websites selling items have been found not to preclude a finding of legitimate noncommercial or fair use if the overall intention of the website is to communicate a message.

Respondent argues that Complainant fails to distinguish between trademark tarnishment and free speech. Respondent argues that Complainant's mark is not protected by commercial tarnishment doctrine from speech legitimately conveying a political message.

Respondent requests the Panel to reject Complainant's request to direct the Registrar to transfer the disputed domain name to Complainant.

6. Discussion and Findings

The Policy is addressed to resolving disputes concerning allegations of abusive domain name registration and use. The Panel will confine itself to making determinations necessary to resolve this administrative proceeding.

It is essential to dispute resolution proceedings that fundamental due process requirements be met. Such requirements include that a respondent have notice of proceedings that may substantially affect its rights. The Policy and the Rules establish procedures intended to ensure that respondents are given adequate notice of proceedings commenced against them, and a reasonable opportunity to respond (see, e.g., Rules, paragraph 2(a)).

Respondent has filed detailed responsive pleadings in response to the Complaint and supplementary filing by Complainant. The Panel is satisfied that Respondent had adequate notice of these proceedings and a reasonable opportunity to respond.

Paragraph 4(a) of the Policy sets forth three elements that must be established by a complainant to merit a finding that a respondent has engaged in abusive domain name registration and use, and to obtain relief. These elements are that:

- (i) respondent's 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) respondent's domain name has been registered and is being used in bad faith.

Each of the aforesaid three elements must be proved by a complainant to warrant relief.

A. Identical or Confusingly Similar

Complainant principally asserts federal common law trademark and service mark rights in the personal name GLENN BECK.

In order to establish federal common law trademark or service mark rights in a personal name it is necessary for the party asserting such rights to demonstrate that the personal name has been used to identify goods or services in commerce, and that the public associates the personal name with a good or service provided by the person identified by the name (compare, e.g., *Monty and Pat Roberts, Inc. v. J. Bartell*, WIPO Case No. D2000-0300 and *2001 White Castle Way, Inc. v. Glyn O. Jacobs*, WIPO Case No. D2004-0001, finding such trademark use and association, in contrast to *Planned Parenthood Federation of America, Inc. and Gloria Feldt v. Chris Hoffman*, Case No. D2002-1073, *Charles Rapiet v. Dark Moon Management*, WIPO Case No. D2004-0221, *Fields for Senate v. Toddles Inc.*, WIPO Case No. D2006-1510, finding that the name in question did not acquire common law trademark or service mark status).

Complainant has provided substantial evidence that the personal name GLENN BECK is used in connection with the provision of goods and services, including goods in the form of books and magazines, and services including radio broadcasts and entertainment performances incorporating social and political commentary. Complainant has provided substantial evidence that the public associates the personal name GLENN BECK with goods and services provided by Complainant, including that books authored by Complainant have on two occasions reached the number one ranking on the New York Times best-seller list, and that Complainant's radio and television shows are highly ranked among television viewership, suggesting a significant correlation with Complainant. Respondent has not challenged the validity of Complainant's assertions regarding the strong public association with the GLENN BECK name. Respondent has suggested that Complainant might have provided direct evidence in addition to printouts from Complainant's active Internet website and references to widely publicized book readership and television viewership. In light of the widely available nature of the data explicitly referenced by Complainant, and the substantial evidence from Complainant's website, the Panel considers Complainant to have carried its burden of supporting a determination of secondary meaning in GLENN BECK, at least in relation to radio and television broadcast services and sales of books.

Because the Panel has determined that Complainant has common law rights in the GLENN BECK trademark and service mark, the Panel need not address the significance of Complainant's ITU applications and allowances at the USPTO.

Complainant argues that the disputed domain name, <glennbeckrapedandmurderedayounggirlin1990.com>, is confusingly similar to the GLENN BECK trademark and service mark. Respondent argues that only a “moron in a hurry” would find the disputed domain name and the mark confusingly similar.

In the Panel’s view, confusing similarity between domain names and trademarks may be assessed under the Policy in a manner similar to that used in assessing substantial similarity in trademark infringement actions in U.S. trademark law: that is, the Panel compares the visual impression (sight), sound and meaning of the terms to determine whether Internet users might reasonably be confused so as to associate the disputed domain name with a trademark that identifies and distinguishes a provider of goods and services. A more complete association of a domain name with a good or service often requires Internet users to undertake a second step of “clicking” on a URL (or Internet address) associated with the domain name to determine the identity of the website host. There is a significant possibility for “initial interest confusion” based on the domain name itself that may or may not be dispelled once the Internet user has been directed to the associated website. In the present case, a well-known trademark is directly incorporated in a domain name and additional terms are added. Even a “moron in a hurry” would not likely conclude that Complainant sponsored, endorsed or was affiliated with the website addressed by the disputed domain name. At the same time, the only reason why the typical Internet user would be tempted to visit the website addressed by the disputed domain name is precisely because Complainant’s well-known trademark is directly incorporated in the disputed domain name. Respondent is gaining an advantage in Internet visits based on the use of Complainant’s mark, irrespective of whether Respondent’s use is legitimate.

When confronted with domain names incorporating well-known marks appended with additional pejorative terms, panelists assessing confusing similarity under the Policy typically prefer to assess the legitimacy of the registration under the criteria of rights or legitimate interests, or bad faith, rather than under the criterion of confusing similarity. This allows panelists to assess the way the domain name is used in connection with the website addressed by it, rather than looking only to an alphanumeric string. (There have been some past panel decisions that reflect a different perspective on this issue, in which panels have found that adding a pejorative term such as “sucks” may insulate a domain name from a finding of confusing similarity. This is presently said to be a minority view under the Policy.¹)

To further elaborate on this perspective, the Panel refers to *TPI Holdings, Inc. v. AFX Communications a/k/a AFX*, WIPO Case No. D2000-1472, involving the domain name <autotradersucks.com>, among others. In that proceeding, a competitor of a well-known Internet-based automobile trading enterprise registered and used a “sucks”-formative domain name solely for the purpose of directing Internet users to a competing Internet location. This Panel said:

The disputed domain name <autotradersucks.com> appends the word “sucks” to Complainant’s “AUTO TRADER” mark. In an earlier administrative proceeding, this sole panelist determined that a domain name comprised of a trademark and the pejorative term “sucks” may be

¹ See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Section 1.3 “Is a domain name consisting of a trademark and a negative term confusingly similar to the complainant’s trademark? (‘sucks cases’)”, Panel visit of October 29, 2009.

confusingly similar to the subject trademark depending on the specific context in which the “sucks”-formative domain name is used (*Wal-Mart Stores, Inc. v. Walsucks and Walmarket Puerto Rico*, Case No. D2000-0477, decided July 20, 2000). The Panel affirms this view.... When an Internet user enters a trademark into [a] search engine and a “sucks”-formative domain name is returned as a search result, that user is likely to proceed to the site so identified because of interest or puzzlement created by association of the trademark and the pejorative term. The operator of the website identified by the “sucks”-formative domain name will have accomplished the objective of diverting the Internet user seeking the trademark holder’s website. Bad faith adoption of a trademark, including in a “sucks”-formative domain name, increases the likelihood of a finding of confusing similarity.

As discussed in this sole panelist’s earlier determination, a finding that a “sucks”-formative domain name is confusingly similar to a trademark does not automatically flow from a *per se* rule that “sucks”-formative domain names are confusingly similar to trademarks. The issue is context-specific. This is consistent with the holding in *Bally Total Fitness v. Faber*, 29 F. Supp. 2d 1161 (C.D. Cal. 1998), in which the court said that a “sucks”-formative domain name “would not necessarily” constitute trademark infringement as a “matter of law” (*id.*, at 1165). This Panel agrees. “Sucks”-formative domain names are not necessarily confusingly similar to trademarks, nor are they necessarily immunized from confusing similarity.

In the instant proceeding, the term “sucks” is appended to Complainant’s mark to form <autotradersucks.com>. The resulting domain name is used to divert Internet traffic to a commercial website that directly competes in Complainant’s channel of commerce. Complainant’s mark has been intentionally adopted, and the term “sucks” has been appended to cause consumer interest and confusion in an on-line location not associated with Complainant. Respondent’s objective in adopting the disputed domain name falls squarely within the list of bad faith criteria established in paragraph 4(b) of the Policy. The Panel finds that the disputed domain name <autotradersucks.com> is confusingly similar to Complainant’s “AUTO TRADER” mark within the meaning of paragraph 4(a)(i) of the Policy. [footnote omitted]

In the instant proceeding, Respondent has intentionally used the well-known trademark and service mark of Complainant in an “inflammatory” domain name in order to attract Internet users to its website. Based on the reasoning explained above, the Panel determines that the disputed domain name is confusingly similar to Complainant’s mark for purposes of the Policy. This does not resolve matters in favor of Complainant. It does, however, require that the question of abusive domain name registration and use be assessed under additional elements of the Policy.

B. Rights or Legitimate Interests

The second element of a claim of abusive domain name registration and use is that the respondent has no rights or legitimate interests in respect of the domain name (Policy, paragraph 4(a)(ii)). The Policy enumerates several ways in which a respondent may demonstrate rights or legitimate interests:

Any of the following circumstances, in particular but without limitation, if found by the [p]anel to be proved based on its evaluation of all evidence presented, shall demonstrate your rights or legitimate interests to the domain name for purposes of [p]aragraph 4(a)(ii):

- (i) before any notice to you 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 (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 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.
(Policy, paragraph 4(c))

Complainant has set forth a *prima facie* argument that Respondent lacks rights or legitimate interests in the disputed domain name.

Respondent has not argued that it used the disputed domain name in connection with a *bona fide* offering goods or services prior to notice of a dispute, or that it has been commonly known by the disputed domain name.

Respondent principally argues that it is using Complainant's mark in the disputed domain name to parody the political interviewing and commenting style of Complainant. Respondent argues that is engaged in nominative fair use of Complainant's mark, and that its political parody is protected as free speech under the U.S. Constitution.

Respondent states that Complainant engages in an interviewing and commentary style that involves making an allegation that even Complainant may stipulate is not true, then asking why the interviewee or subject of the commentary refuses to deny the allegation. In Respondent's view, Complainant's methodology places the subject of the allegation in an unfavorable light virtually regardless of the response (or lack of response).

In the present context, the disputed domain name contains a statement that Respondent concedes on its website is untrue (or at least that there are no known facts to support it). Respondent then demands to know, and Respondent's forum participants demand to know, why Complainant refuses to deny the untrue allegation set out in the disputed domain name.

As Complainant has pointed out, the full effect of Respondent's domain name parody is unlikely to be ascertained by the "average Internet user" (i.e., not party to the "inside joke") without the second step of visiting Respondent's website. The disputed domain name standing alone (i.e., without the second step of visiting Respondent's website) itself is undoubtedly unflattering, pejorative and inflammatory (presumably Respondent's intent). Whether it is "defamatory" is likely to be a difficult question, and in any event one more suited to resolution by a court than in an administrative proceeding under the Policy. Respondent's

Supreme Court reference to *Hustler Magazine, Inc. v. Falwell*, 485 U.S. 46 108 S. Ct. 876 (1988) provides some guidance on that issue:

Of course, this does not mean that any speech about a public figure is immune from sanction in the form of damages. Since *New York Times Co. v. Sullivan*, 376 U.S. 254, 84 S.Ct. 710, 11 L.Ed.2d 686 (1964), we have consistently ruled that a public figure may hold a speaker liable for the damage to reputation caused by publication of a defamatory falsehood, but only if the statement was made “with knowledge that it was false or with reckless disregard of whether it was false or not.” *Id.*, 376 U.S., at 279-280, 84 S.Ct., at 726. False statements of fact are particularly valueless; they interfere with the truth-seeking function of the marketplace of ideas, and they cause damage to an individual’s reputation that cannot easily be repaired by counterspeech, however persuasive or effective. See *Gertz*, 418 U.S., at 340, 344, n. 9, 94 S.Ct., at 3007, 3009, n. 9. But even though falsehoods have little value in and of themselves, they are “nevertheless inevitable in free debate,” *id.*, at 340, 94 S.Ct., at 3007, and a rule that would impose strict liability on a publisher for false factual assertions would have an undoubted “chilling” effect on speech relating to public figures that does have constitutional value. “Freedoms of expression require ‘breathing space.’” *Philadelphia Newspapers, Inc. v. Hepps*, 475 U.S. 767, 772, 106 S.Ct. 1558, 1561, 89 L.Ed.2d 783 (1986) (quoting *New York Times*, *supra*, 376 U.S., at 272, 84 S.Ct., at 721). This breathing space is provided by a constitutional rule that allows public figures to recover for libel or defamation only when they can prove both that the statement was false and that the statement was made with the requisite level of culpability.

Generally speaking the law does not regard the intent to inflict emotional distress as one which should receive much solicitude, and it is quite understandable that most if not all jurisdictions have chosen to make it civilly culpable where the conduct in question is sufficiently “outrageous.” But in the world of debate about public affairs, many things done with motives that are less than admirable are protected by the First Amendment. In *Garrison v. Louisiana*, 379 U.S. 64, 85 S.Ct. 209, 13 L.Ed.2d 125 (1964), we held that even when a speaker or writer is motivated by hatred or ill will his expression was protected by the First Amendment:

“Debate on public issues will not be uninhibited if the speaker must run the risk that it will be proved in court that he spoke out of hatred; even if he did speak **881 out of hatred, utterances honestly believed contribute to the free interchange of ideas and the ascertainment of truth.” *Id.*, at 73, 85 S.Ct. at 215.

Thus while such a bad motive may be deemed controlling for purposes of tort liability in other areas of the law, we think the First Amendment prohibits such a result in the area of public debate about public figures.

Were we to hold otherwise, there can be little doubt that political cartoonists and satirists would be subjected to damages awards without any showing that their work falsely defamed its subject.

We conclude that public figures and public officials may not recover for the tort of intentional infliction of emotional distress by reason of publications

such as the one here at issue without showing in addition that the publication contains a false statement of fact which was made with “actual malice,” i.e., with knowledge that the statement was false or with reckless disregard as to whether or not it was true. This is not merely a “blind application” of the New York Times standard, see *Time, Inc. v. Hill*, 385 U.S. 374, 390, 87 S.Ct. 534, 543, 17 L.Ed.2d 456 (1967), it reflects our considered judgment that such a standard is necessary to give adequate “breathing space” to the freedoms protected by the First Amendment.

*57 Here it is clear that respondent Falwell is a “public figure” for purposes of First Amendment law. [footnote omitted] The jury found against respondent on his libel claim when it decided that the *Hustler* ad parody could not “reasonably be understood as describing actual facts about [respondent] or actual events in which [he] participated.” App. to Pet. for Cert. C1. The Court of Appeals interpreted the jury’s finding to be that the **883 ad parody “was not reasonably believable,” 797 F.2d, at 1278, and in accordance with our custom we accept this finding. Respondent is thus relegated to his claim for damages awarded by the jury for the intentional infliction of emotional distress by “outrageous” conduct. But for reasons heretofore stated this claim cannot, consistently with the First Amendment, form a basis for the award of damages when the conduct in question is the publication of a caricature such as the ad parody involved here.

Respondent has conceded that it knows the statement embodied in the disputed domain name is false. In the *Hustler Magazine* case referred to by Respondent, a jury determined that the reader of a magazine advertisement could not have reasonably concluded that it described an actual series of events (i.e., known to be false), highly unflattering to the subject though they may have been. In the present context, this Panel considers that if Internet users view the disputed domain name *in combination* with a visit to Respondent’s website, the “total effect” is that of political commentary by Respondent, capable of protection as political speech by the First Amendment under the *Hustler Magazine* standard. Respondent appears to the Panel to be engaged in a parody of the style or methodology that Respondent appears genuinely to believe is employed by Complainant in the provision of political commentary, and for that reason Respondent can be said to be making a political statement. This constitutes a legitimate non-commercial use of Complainant’s mark under the Policy. It equally appears that Respondent is making nominative fair use of Complainant’s mark in the sense of using it to identify a well-known public figure (in a manner that does not use more of the mark than is necessary and does not create confusion as to Complainant’s sponsorship of Respondent’s activities). In making such findings, the Panel makes no assumptions as to the potentially defamatory nature of any of the content on Respondent’s website, which is beyond the scope of the present Policy proceeding.

It can be and has been argued by Complainant that the disputed domain name should be assessed “standing alone” because at least some Internet viewers will only have that first impression (i.e., they will not click through). However, this case involves a form of speech arguably strongly protected under the First Amendment of the U.S. Constitution. This Panel is very reluctant to reject Respondent’s claim of legitimate noncommercial and fair use on the distinction between viewing of the disputed domain name itself and clicking through to Respondent’s website. On the same basis by which the Panel has determined the

disputed domain name is confusingly similar to Complainant's trademark - that is, Internet users viewing the disputed domain name will be curious and motivated to visit the website - the Panel also considers that Respondent's speech should be assessed as a whole, both by reference to the disputed domain name and the content of Respondent's website (i.e., on the assumption the preponderance of Internet users will indeed click through).

The Panel determines that Respondent has in the present circumstances established that it is engaged in legitimate noncommercial or fair use of Complainant's mark in the disputed domain name. While there is some evidence that at some stage third-party vendors of goods and services critical of Complainant may have earned some income on sales of T-shirts and bumper stickers embodying political slogans based on click-throughs from Respondent's website, the Panel does not believe this is sufficient "commercial activity" to change the balance of interests already addressed.

Because Complainant necessarily fails to prove that Respondent's conduct runs afoul of all three elements required for adverse determination under the Policy, the Panel need not further address the elements of bad faith registration and use.

The Panel notes, however, that the combination of political speech engaged in by Respondent and the substantial lack of commercial intent makes it unlikely to this Panel that Complainant would have succeeded in demonstrating bad faith registration and use (see, e.g., *Sutherland Institute v. Continuative LLC*, WIPO Case No. D2009-0693).

7. Decision

For all the foregoing reasons, the Complaint is denied.

Frederick M. Abbott
Sole Panelist

Dated: October 29, 2009