

National Collegiate Athletic Association v. Brown, 72 USPQ2d 1319 (WIPO 2004)

72 USPQ2D 1319
National Collegiate Athletic Association v. Brown
World Intellectual Property Organization

Case No. D2004-0491
Decision August 30, 2004

Headnotes

TRADEMARKS AND UNFAIR TRADE PRACTICES

[1] Infringement; conflicts between marks — Federal constitutional issues (§335.02)

**Infringement; conflicts between marks — Likelihood of confusion — Particular marks —
Confusion likely (§335.0304.03)**

Infringement; conflicts between marks — Willful (§335.11)

Complainant in Internet domain name dispute resolution proceeding has established that respondent engaged in cybersquatting by registering “ncaafootball2005.com” and “ncaafootball2006.com,” since contested domain names are confusingly similar to complainant's “NCAA” trademark and its “ncaafootball.com” domain name, since, in view of social relationship between respondent and prior registrant, conduct of prior registrant should be imputed to respondent in assessing legitimacy of respondent's rights and issues of bad faith use and registration, since record shows that transfer of domain names from prior registrant to respondent was sham transaction, intended to insulate prior registrant's conduct from domain names and cloak use of names in protection of First Amendment by employing them as addresses for respondent's “gripe” site, since primary motivation of both respondent and prior registrant, in registering and using contested domain names, was commercial gain through sale of names, not provision of site for legitimate criticism, since there is no evidence that respondent could not provide gripe site using other domain names, and since respondent therefore has no rights or legitimate interests in contested domain names.

Case History and Disposition

Administrative proceeding pursuant to Uniform Domain Name Dispute Resolution

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Policy of Internet Corporation for Assigned Names and Numbers, in which complainant National Collegiate Athletic Association alleges cybersquatting by respondent Dusty Brown. Panelist directs transfer of disputed domain names to complainant.

Attorneys:

Scott A. Bearby, Indianapolis, Ind., for complainant.

Dozier Internet Law, Ames, Iowa, for respondent.

Opinion Text

Opinion By:

Michaelson, panelist.

1. The Parties

The Complainant is National Collegiate Athletic Association, Indianapolis, Indiana, United States of America, represented by Scott A. Bearby, United States of America.

The Respondent is Dusty Brown, Ames, Iowa, United States of America, represented by Dozier Internet Law, P.C., United States of America.

2. The Domain Names and Registrar

The contested domain names are <ncaafootball2005.com>and <ncaafootball 2006.com> both of which are registered with Go Daddy Software (“Registrar”).

3. Procedural History

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

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) in e-mail form on July 2, 2004, and in hard-copy form on July 5, 2004, along with Annexes A-S and the appropriate payment.

Pursuant to paragraph 4(d) of the Policy, the Complainant selected the Center as the ICANN

approved administrative dispute resolution service provider to administer this proceeding. Through the Complaint, the Complainant requested a single member panel.

After receiving the original Complaint which was directed at only one of the contested domain names, <ncaafootball 2005.com>, the Center, in accordance with paragraph 5 of the Supplemental Rules, determined whether that Complaint fully complied with the formal requirements of the Rules and the Supplemental Rules. In that regard, on July 5, 2004, the Center requested confirmation from the Registrar of information set forth in the Complaint relative to that contested domain name; specifically, contact and registrant information for that domain name, as well as whether the Registrar received a copy of the Complaint from the Complainant. The Center also requested the Registrar to specify: (a) whether the Policy applies to that contested domain name, (b) whether the registrant has submitted, in its registration agreement, to the jurisdiction at the location of the principal office of the registrar for court adjudication of disputes concerning or arising from the use of that domain name, (c) the language of the registration agreement, and (d) whether that domain name will remain "locked" during the proceeding.

Subsequently, on July 6, 2004, the Registrar provided its response to the Center through which the Registrar specified name and contact information pertinent to the contested domain name <ncaafootball 2005.com>, to the extent present in its WhoIS database, confirmed that GoDaddy.com is the registrar of that domain name, stated that it had not received a copy of the Complaint and that the Policy applied to that domain name, stated that the language of the underlying registration agreement is English and that this domain name was then in a "locked" status. The Registrar also informed the Center that the Registrant of the name, Dusty Brown, through the registration agreement, submitted to the jurisdiction at the location of the principal office of the Registrar for court adjudication of disputes concerning or arising from the use of that contested domain name.

In as much as the name and contact details of the Registrant supplied by the Registrar did not agree with those provided in the original Complaint, the Center issued an

e-mail letter dated July 7, 2004, to the Complainant providing the correct name and contact information for the Registrant and requesting that the Complainant amend its Complaint accordingly.

In response, the Complainant filed an Amended Complaint, which, *inter alia*, corrected the Registrant's contact information and substituted the present Respondent for the original respondent, set forth in the original Complaint, and added the second contested domain name, i.e., <ncaafootball2006.com>. The Complainant filed its Amended Complaint with the Center by e-mail on July 9, 2004, and in hard-copy form on July 12, 2004, together with Annexes A-V.

After receiving the amended Complaint, the Center, on July 12, 2004, and in accordance with paragraph 5 of the Supplemental Rules, requested confirmation from the Registrar of information set forth in the Complaint relative to the second contested domain name <ncaafootball2006.com>; specifically, contact and registrant information for that domain name, as well as whether the Registrar received a copy of the (amended) Complaint from the Complainant. The Center also requested the Registrar to specify: (a) whether the Policy applies to that contested domain name, (b) whether the registrant has submitted, in its registration agreement, to the jurisdiction at the location of the principal office of the registrar for court adjudication of disputes concerning or arising from the use of that domain name, (c) the language of the registration agreement, and (d) whether that domain name will remain "locked" during the proceeding.

Subsequently, on July 12, 2004, the Registrar provided its response to the Center through which the Registrar provided name and contact information pertinent to the contested domain name <ncaafootball 2006.com>, to the extent present in its WhoIS database, confirmed that GoDaddy.com is the registrar of that domain name, stated that it had not received a copy of the (amended) Complaint and that the Policy applied to that domain name, stated that the language of the underlying registration agreement is English and that this particular domain name was then in a "locked" status. The Registrar also informed the Center that the Registrant of the name, Dusty Brown, through the registration agreement, submitted to the jurisdiction at the location of the principal office of the Registrar for court adjudication of disputes concerning or arising from the use of that contested domain name.

Hereinafter, all references to the Complaint, unless specifically noted otherwise, will be to the Amended Complaint.

On July 14, 2004, the Center notified the Respondent of the filing of the Complaint, including an indication that the Center was forwarding a complete copy of the Complaint, by postal mail and e-mail (the latter without the annexes), to the Respondent. Specifically, the Center separately provided its notice along with the Complaint, by e-mail, to the Respondent's domain name registrant, technical, administrative and zone contacts as set forth in the WhoIS record for the contested domain names. In addition and also on July 14, 2004, the Center forwarded a copy of the Complaint (without the annexes) to the Registrar. The Complaint, and its accompanying documents, and all subsequent communications associated therewith were provided in the preferred manners and to the addresses as mandated by paragraphs 2(a), 2(b) and 4(a) of the Rules.

Hence, the notification to the Respondent having occurred on July 14, 2004, under paragraph 4(c) of the Policy, this administrative proceeding is deemed to have commenced on that date.

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

The Respondent was then provided with a 20 calendar day period, expiring on August 3, 2004, to file its Response with the Center and serve a copy of the Response on the Complainant.

The Respondent sent its Response, together with Annex A, to the Center by e-mail on August 4, 2004 Geneva time, but August 3, 2004 at the location of the Respondent, of which the Center acknowledged its receipt by e-mail letter also dated August 4, 2004. Though the Response was

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filed one day late, the Panel, acting in its discretion, has fully considered it.

Accordingly, pursuant to the Rules and Supplemental Rules, by e-mail letter dated August 11, 2004,

the Center contacted the undersigned, Mr. Peter L. Michaelson, Esq., requesting his service as a sole panelist for this dispute. Later that day, Mr. Michaelson accepted and returned, by facsimile to the Center and, to ensure compliance with paragraph 7 of the Rules, a fully executed Statement of Acceptance and Declaration of Impartiality and Independence. The Center, through an e-mail letter dated August 12, 2004, notified the parties of the appointment of Mr. Michaelson as Sole Panelist.

Based on the deadline set forth in paragraph 15 of the Rules, a decision was to be issued by the Panel to the Center on or before August 26, 2004.

This dispute concerns two domain names, specifically <ncaafotball2005.com> and <ncaafotball2006.com>.

The language of this proceeding is English.

Due to unavoidable circumstances, the Panel, on August 24, 2004, extended the due date for its decision to September 2, 2004.

4. Factual Background

A copy of the WhoIS registration records, as of July 7, 2004, for the contested domain names <ncaafotball 2005.com> and <ncaafotball2006. com> respectively appears in Annexes T and U, to the Complaint. As indicated on these records, the <ncaafotball2005.com> was originally registered on July 15, 2003, to Kaldenberg Domain Brokerage (KDB) and subsequently transferred to the Respondent on May 20, 2004, with the registration for this name expiring on July 15, 2004. The <ncaafotball2006.com> name was registered on July 16, 2003, with the registration for that name expiring on July 16, 2005.

A. The Complainant's NCAA Marks

The Complainant owns numerous United States trademark registrations for the mark "NCAA" and has provided, for a representative sampling of these marks and in Annex C to the Complaint, a hard-copy printout of each of the corresponding registration certificates or records from the Trademark Electronic Search System (TESS) maintained by the US Patent and Trademark Office

(PTO) and accessible over the Internet. The pertinent details for a few of these marks are as follows:

1. NCAA (block letter)

US registration 976,117;
registered January 1, 1974
last renewed: June 14, 2003

This mark was registered for use in connection with: "Association services - namely, promoting and encouraging physical fitness programs, amateur sports participation and athletic programs at the college level; providing counseling in the field of college and intercollegiate athletic administration; establishing rules for radio broadcasting and telecasting of amateur sporting events; formulating guidelines for the provision of financial aid to student-athletes; and disseminating information with reference to physical education, collegiate sports and athletic activities" in international class 42. This mark claims first use and first use in inter-state commerce dates of December 31, 1911.

2. NCAA (block letter)

US registration 1,508,377;
registered October 11, 1988
sections 8 and 15 affidavit filed

This mark was registered for use in connection with: "Sporting goods - namely, basketballs, volleyballs, soccer balls, water polo balls, softballs, baseballs and footballs" in international class 28. This mark claims first use and first use in inter-state commerce dates of January 13, 1984.

3. NCAA (stylized)

US registration 2,333,735;
registered March 21, 2000

This mark was registered for use in connection with: "Clothing, namely, T-shirts, polo shirts, rugby shirts, golf shirts, sweatshirts and sweatpants, sweaters, jackets, coats, socks, caps and hats" in international class 25; "Radio and television broadcasting of football contests and events at the college level" in international class 38; "Entertainment services, namely, football contests and events at the college level, for rendering live football games, football exhibitions and other football events, all at the college

level, and the production and distribution of radio and television broadcasts of football contests and events at the college level for others” in international class 41; and “Association services, namely, promoting the interest of colleges and universities through participation in football contests and events at the college level, and supervising and sanctioning of football contests and events at the college level” in international class 42. This mark claims first use and first use in inter-state commerce dates in classes 25, 38, 41 and 42 of September 1, 1999.

B. The Parties’ Activities

The Complainant, The National Collegiate Athletic Association (NCAA), founded in 1905, is an association of colleges and universities governing intercollegiate athletics in the United States. The NCAA has been and is using the marks NCAA and NCAA FOOTBALL in connection with amateur intercollegiate football contests. The NCAA mark has been in use since 1910 in connection with the Association and since 1921 in connection with annual national championships.

The NCAA owns and operates a website pertaining to its association activities located at “www.ncaa.org.” The NCAA also owns a website pertaining to intercollegiate football located at “ncaafootball.com” with content at this site being mirrored as “www.ncaafootball.net.” Both of these “football-formative” domains are operated by NCAA Football USA, Inc., an authorized licensee of the NCAA, on behalf of and pursuant to agreement with the NCAA. Copies of screen captures from these websites, along with the WhoIS information pertaining to each site, appear in Annexes D-I to the Complaint.

The NCAA maintains Corporate Champion and Corporate Partner Programs with CBS and several of America’s top corporations. These corporations, including Coca-Cola, General Motors, Cingular, Kraft and The Hartford, support the NCAA’s youth program by providing funding, personnel and expertise to benefit intercollegiate athletics in return for sponsorship and licensing agreements with NCAA championships and rights to use the NCAA Marks.

The Complainant has licensed and/or sub-licensed the NCAA and Football Pennant marks (including

Registration 2,333,735), to NCAA Football USA, Inc. (NFUSA), Host Communications, Inc. (Host), and Electronic Arts, Inc. (EA) for the purpose of exploiting those marks on various goods and services in various media including over the Internet.

EA's "EA Sports" division produces an interactive, intercollegiate football video game simulation for use on home-console entertainment systems such as Microsoft's XBOX, Sony's Playstation II and Nintendo's Game Cube called "NCAA Football 2005" (as indicated in the hard-copy printout of EA Sports home page appearing in Annex L to the Complaint). As indicated in the WhoIS printout appearing in Annex M to the Complaint, EA owns the domain <ncaafotball2004.com>, which it used in connection with its last season's video game product, "NCAA Football 2004."

Neither Kaldenberg Domain Brokerage (KDB) nor Respondent Dusty Brown is either a Corporate Partner of the NCAA or is licensed to use any of the NCAA Marks in any form.

Mr. Brian Kaldenberg is a student at Iowa State University (an NCAA school) doing business as Kaldenberg Domain Brokerage. The primary business purpose of KDB is to register domains for the purpose of selling them to third parties at a price significantly higher than KDB's costs of registration. Respondent Dusty Brown is also a student at Iowa State University and is an acquaintance of Brian Kaldenberg. In that regard, Complainant provided a printout of several pages (appearing in Annex V to the Complaint) from Mr. Kaldenberg's personal web page, located at "www.briankaldenberg.com," which on one page depicts a picture of Dusty Brown along with the caption, "Here is a picture of Dusty Brown...he isn't sober." The Respondent has neither an interest in nor any no role at KDB.

On July 15, 2003, KDB registered the domain name <ncaafotball2005.com>.

As early as May 07, 2004, the domain name <ncaafotball2005.com> resolved to a webpage (a copy of which appears in Annex J to the Complaint), the heading of which reads:

"ncaafotball2005.com This domain is for sale! More details..."

When a user clicked on linked text, “More details...,” that user was re-directed to a page located on the “www.sedo.com” servers which read, in pertinent part and as reflected in a hard-copy printout in Annex K to the Complaint:

“ncaafootball2005.com is for sale:

Details of the Offer

Offer comprises: Domain Name ncaafootball2005.com without content

Description: a good one.

Make Offer

The domain is for sale by its owner.

If you would like to buy the domain name, please make your offer below:

Price: 10,000 \$US

Your Offer: _____ \$US

Make Offer”

On May 10, 2004, counsel for the Complainant’s licensees, Host and NFUSA, sent Mr. Kaldenberg, then owner of the contested domain name <ncaafootball 2005.com>, by e-mail and certified mail, a letter (a copy of which appears in Annex N to the Complaint) demanding that Mr. Kaldenberg transfer that domain name to the Complainant. On the same day and as evident in Annex O to the Complaint. Mr. Kaldenberg responded, via e-mail, through which he referred counsel to his attorney. Subsequently, on that same day, counsel sent essentially the same letter (as evidenced in Annex P) to that attorney.

At least as early as May 17, 2004, KDB “removed” the content, as described above, previously located at “www.ncaafootball2005.com” and simply re-directed all Internet traffic from that domain to Mr. Kaldenberg’s “personal” webpage located at “www.briankaldenberg.com” (a copy of the home page for that site appears in Annex Q to the Complaint). On May 20, 2004, counsel for Host and NFUSA wrote a letter (a copy of which appears in Annex R to the Complaint) to KDB’s attorney to inform him of that change in the use of that name and site content. KDB’s attorney failed

to respond to either the May 10th or May 20th letter.

On May 20, 2004, and as indicated in the WhoIS record provided in Annex T to the Complaint, KDB transferred the contested domain name <ncaafotball2005.com> to the Respondent, Dusty Brown.

As early as May 25, 2004, the Respondent altered the content located at “www.ncaafotball2005.com.” As of that date, that domain name resolved to an “NCAA Football 2005 Gripe Site.” The text of the site reads, in pertinent part and as seen in the hard-copy print-out appearing in Annex S to the Complaint:

“Welcome to NcaaFootball.Com.

The NCAA is proud to present all fans with the most *worthless season of football in 2005*. They added another game to their disgusting collection of BCS Bowls. They rejected the return of some of the best athletes to their former teams.

And they still havn’t [sic] got Instant Replay!”(emphasis in original).

When, counsel for Host and NFUSA telephoned KDB’s attorney on May 25, 2004. That attorney refused to substantively discuss the matter with anyone other than the NCAA.

The Respondent also owns the contested domain name <ncaafotball2006.com>. This domain was registered on July 16, 1003, one day after Mr. Kaldenberg registered the contested domain name <ncaafotball2005.com>. As of July 9, 2004, the domain name <ncaafotball2006.com> re-directed Internet users to the same gripe site to which <ncaafotball2005.com>also then resolved.

5. Parties’ Contentions

A. Complainant

i. Similarity

The Complainant contends that the contested domain names are confusingly similar to the Complainant’s NCAA Marks.

Specifically, the Complainant states each contested domain name consists of the Complainant's NCAA mark plus the generic term "football" and the generic calendar year "2005" or "2006" which, taken collectively, is ostensibly insufficiently distinctive from the Complainant's mark to dispel user confusion.

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

ii. Legitimacy

The Complainant contends that the Respondent has no rights or legitimate interests in either of the contested domain names pursuant to paragraph 4(a)(ii) of the Policy.

Specifically, the Complainant states that neither KDB nor the Respondent are either corporate partners or authorized licensees of the Complainant NCAA.

iii. Bad Faith

The Complainant contends that, for various reasons, the Respondent has registered and is now using the contested domain names in bad faith.

Specifically, as evidence of its bad faith, the Respondent:

- (a) through its use of the contested domain names, intentionally attempted to attract, for financial gain, Internet users to Respondent's website by creating a likelihood of confusion as to the source, sponsorship, affiliation or endorsement of that website with and/or by the NCAA, its authorized licensees and corporate partners, such as EA;
- (b) refused to respond in writing to communications sent by counsel for the Complainant's authorized licensees; and

(c) registered and is using more than one version of the “ncaafootball” domain names, namely, <ncaafootball2005.com> and <ncaafootball2006.com>, hence demonstrating a pattern of conduct that Respondent and Respondent’s associate, Brian Kaldenberg, are in the business of registering multiple versions of domains containing third-party trademarks with the intent of selling those domain names back to the trademark owners at prices far beyond the Respondent’s out of pocket cost to register those domain names.

Further, the Complainant alleges that bad faith is shown inasmuch as Mr. Kaldenberg registered one of the contested domain names, <ncaafootball2005.com>, for the purpose of selling it to the Complainant or a third party with no legitimate rights or interests in the NCAA Marks for a minimum price of \$10,000 USD—a price far greater than the Respondent’s out-of-pocket costs to register and transfer the domain name and one at which Mr. Kaldenberg would profit from the sale.

Additionally, bad faith use is shown by a series of actions that the Respondent and/or Mr. Kaldenberg committed only after they had been notified by the Complainant of its NCAA Marks.

In essence, the Complainant asserts that these actions, which ultimately culminated in the Respondent using these names to resolve to a purported gripe site, were actually a subterfuge to shield these names, as a purported vehicle through which the Respondent exercised its rights to free speech under the First Amendment to the US Constitution, from being transferred under the Policy. In that regard and to that end, the Complainant points to the following actions taken by the Respondent and/or Mr. Kaldenberg:

- (a) altered the content located at the contested domain name <ncaafootball 2005.com>, after being contacted by counsel for the NCAA’s authorized licensees in order to re-direct Internet traffic to Mr. Kaldenberg’s personal webpage in an effort to remove the “commercial” component from its use;
- (b) subsequently altered the content located at that contested domain name, also in response following a letter from counsel for the NCAA’s authorized licensees, to resolve to a purported gripe site in an effort to afford itself First Amendment protection for its use; and
- (c) in an attempt to destroy the Complainant’s ability to prove a nexus between the registrant’s bad faith use and registration of the domain names at issue, Mr. Kaldenberg transferred that domain name to the Respondent around the same time as that domain name started resolving to the “gripe site,” an

action which was done specifically in response to the Complainant's reasserted concerns regarding activities surrounding that name.

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Through these actions, the Complainant contends that Mr. Kaldenberg was merely trying to shift liability away from himself.

Therefore, the Complainant concludes that the Respondent's conduct constitutes bad faith registration and use under paragraph 4(a)(iii) of the Policy.

B. Respondent

i. Similarity

The Respondent did not address, let alone dispute, the issue as to whether either of the contested domain names were confusingly similar to the Complainant's NCAA Marks.

ii. Legitimacy

The Respondent contends that he has rights and legitimate interests in both of the contested domain names.

Specifically, the Respondent states that he purchased the domain names, for a fair price and in a *bona fide* transaction, for the sole purpose of expressing his opinion and providing a forum for fairly criticizing the practices and policies of the Complainant. Five days after doing so, the Respondent launched the "www.ncaafootball2005.com" gripe site to which both names resolve. The Respondent contends that under the rights of free speech, as set forth in the First Amendment to the US Constitution, he is permitted to use the contested domain names in this fashion.

iii. Bad Faith

The Respondent also contends that he did not register and use either of the contested domain names in bad faith.

First, the Respondent states that he did not possess the domain names until May 20, 2004, and is not responsible for, nor has any knowledge about any of the actions of or conduct taken in conjunction with those names by their previous owner (KDB). Moreover, that owner, KDB, is not the current registrant of the names; the Respondent is. The Respondent states that he is not an agent, employee or affiliate of KDB.

Second, the Respondent states that he did not offer for sale, or in any way attempt to sell the contested domain names and has no intention of doing so.

Further, he contends that “the use of the domain name as a gripe site is not a use in bad faith and is a right of free speech guaranteed under the First Amendment of the United States Constitution.” In that regard, the Respondent states that the sole purpose of his site is for legitimately criticizing the Complainant’s football and the many controversial policies and actions it has taken, and hence is not for any commercial benefit. As to the latter, the Respondent states that his website contains no advertising and generates no revenue. Moreover, the Respondent states “This entire proceeding is simply an effort by the Complainant to stifle free speech, attack the very foundation of democracy, and continue with its unfair actions that have resulted in fervent opposition to its policies.”

Additionally, the Respondent contends that it has not intentionally attempted to attract, for financial gain, Internet users to his website by creating a likelihood of confusion as to the source, sponsorship, affiliation or endorsement of his site with of the Complainant, its authorized licensees or corporate partners.

Lastly, the Respondent asserts that its act of registering both contested domain names does not demonstrate bad faith. Specifically, the Respondent states that “he is in the business of registering domains containing third-party trademarks with the intent of selling those domains back to the trademark owners at prices far beyond Respondent’s out of pocket cost to register the domains.”

6. Discussion and Findings

A. Similarity

Without any hesitation whatsoever, the Panel finds that confusion is likely to arise as a result of the Respondent's use of each the contested domain names.

[1] No doubt exists that each of the contested domain names, taken in and of themselves, is confusingly similar to the Complainant's mark NCAA. The difference between each of those names and that mark is simply the inclusion of a generic descriptor, here being "FOOTBALL," followed by a numerical designation of a year, either "2005" or "2006." This difference certainly does not add sufficient distinguishing characteristics to either of the domain

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names to ameliorate any user confusion that will inevitably arise as a result of the Respondent using that name to address its website. See, e.g., *Lane-Labs USA, Inc. v. Powell Productions*, NAF Case No. FA 155896 (July 1, 2003).

In fact, given the widespread notoriety and reputation enjoyed by the NCAA, particularly since 1911 (i.e., continuously over the past 93 years), with respect to collegiate sports, notably football, it stands to reason and the Panel so finds that merely adding the term "football" followed by a year designator to the Complainant's mark NCAA would only exacerbate, rather than ameliorate, likely user confusion.

Moreover, this outcome is accentuated inasmuch as the Complainant owns the domain name <ncaafootball.com>. Hence, it is quite foreseeable that those Internet users intent on seeking information, via the Internet, from the Complainant regarding its football activities in a given year, and with prior knowledge of the Complainant's website at "www.ncaafootball.com," would simply add a year designator to that name in order to reach a corresponding website operated by the Complainant or sanctioned by it.

However, by doing so, those users would instead be directed to the Respondent's site but

nevertheless think that an affiliation of some sort exists between the Complainant and the Respondent, when, in fact, no such relationship would exist at all. See, e.g., *Cable News Network LP, LLP v. Elie Khouri d/b/a Channel News Network et al.* NAF Case No. FA117876 [68 USPQ2d 1570] (December 16, 2002); *Leiner Health Services Corp. v. ESJ Nutritional Products*, NAF Case No. FA173362 (September 16, 2003); *Am. Family Life Assurance Company of Columbus v. defaultdata.com*, NAF Case No. FA 123896 (October 14, 2002); *AT&T Corp. v. Abreu*, WIPO Case No. D2002-0605 (September 11, 2002); *Pfizer Inc. v. Order Viagra Online*, WIPO Case No. D2002-0366 (July 11, 2002); *L.F.P., Inc. v. B and J Props.*, NAF Case No. FA 109697 (May 30, 2002); *Frampton v. Frampton Enters, Inc.*, WIPO Case No. D2002-0141 (April 17, 2002); *Spence-Chapin Servs. to Families and Children v. Wynman*, NAF Case No. FA 100492 (December 10, 2001); *MPL Communications v. LOVEARTH.net*, NAF Case No. FA 97086 (June 4, 2001); *Meijer, Inc. v. Porksandwich Web Servs.*, NAF Case No. FA 97186 (July 6, 2001); *MPL Communications v. IWebAddress.com*, NAF Case No. FA 97092 (June 4, 2001); *Am. Home Prods. Corp. v. Malgioglio*, WIPO Case No. D2000-1602 (February 19, 2001); *Surface Prot. Indus., Inc. v. The Webposters*, WIPO Case No. D2000-1613 (February 5, 2001); *Dollar Fin. Group, Inc. v. VQM NET*, NAF Case No. FA 96101 (January 25, 2001); *eBAY Inc. v. G L Liadis Computing, Ltd.*, WIPO Case No. D2000-1463 (January 10, 2001); *Treeforms, Inc. v. Cayne Indus. Sales Corp.*, NAF Case No. FA 95856 (December 18, 2000); and *The Pep Boys Manny, Moe and Jack of CA v. E-Commerce Today, Ltd.*, eResolution Case No. AF-0145 (May 3, 2000).

Therefore, the Panel finds that each of the contested domain names sufficiently resembles the Complainant's mark NCAA as to cause confusion. Hence, the Complainant has shown sufficient similarity between its registered mark NCAA and each of the contested domain names under paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

The Panel believes that the Respondent has not provided any basis, under paragraph 4(a)(ii) of the Policy, that would legitimize any claim it has to either of the contested domain names.

To determine whether the Respondent, under the present facts, has any rights or legitimate interests in

either of the domain names, two issues arise:

- (a) first, given that the Respondent and the prior registrant of both names, Mr. Kaldenberg (including KDB which he owns), are related—though only socially, should the actions of the prior registrant be imputed to the Respondent so as to collectively view the actions of both registrants in assessing whether the Respondent has rights or legitimate interests to these names under the Policy; and
- (b) second, is the Respondent's claim of exercising his rights to free speech, as guaranteed by the First Amendment to the US Constitution, through the contested

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domain names absolute so as to mandate his retention of both names in conjunction with his web (gripe) site regardless of any conduct that may be imputed to him? If no, then what countervailing considerations must be assessed?

1. Relationship of the registrants

The Panel agrees with the Respondent that, in most instances, the actions of a prior registrant would be irrelevant in assessing that of the present registrant. This assumes that both registrants are strictly dealing with each other in a totally disinterested, arms-length fashion. Other than consummating a given transaction, neither entity has any other interest in or dealings with the other. Clearly, this is not the case where a continuing relationship of any sort exists between the prior and present registrants. Where such a relationship exists, the question arises whether, under the facts at issue and given the nature of the relationship, the actions of the prior registrant should be imputed to the present registrant such that the conduct of both entities, from the perspective of assessing the propriety of that action, is viewed collectively, i.e., as one single entity, one single actor.

Relationships provide motivation and means through which otherwise totally independent entities would likely collude with each other so as to satisfy their own long-term collective interests at the expense of the short-term interests of either entity were it to act totally independent of the other.

As such, UDRP Panels need to be acutely sensitive to the existence of any past, present and/or

continuing relationship among the relevant actors when assessing the facts in any given case scenario in order to discern whether the relationship itself engendered any untoward influence, motivation or opportunity which would color an otherwise legitimate domain name transfer or related transaction between the actors, when transacting on an arms-length disinterested basis, a sham; specifically a sham intentionally calculated and undertaken to deprive a third-party trademark owner of its right to a domain name.

Here, the Respondent states, contrary to the Complainant's assertion, that he had no role in the prior registrant, KDB, meaning that the Respondent, Dusty Brown, had never been, e.g., an agent, employee, supplier, business partner or had any ownership interest in KDB, prior to the time ownership of the contested domain names were transferred to him. Yet, the lack of such a formal business relationship does not end the inquiry. Social or familial relationships can be equally problematic, if not more so, as formal ones, and provide ample opportunities, in furtherance of the relationship, for illicit collusive action. The closer the relationship, the more likely its participants will cooperatively act in the joint interest of maintaining and/or even enhancing the relationship, inasmuch as the resulting gain is expected to ultimately benefit both participants more so than any short-term loss suffered by either.

The Respondent admits that he and Mr. Kaldenberg (the latter being the owner of KDB) are both students of Iowa State University and more importantly are acquaintances of each other. Clearly, the picture of the Respondent on Mr. Kaldenberg's personal website with the caption "Here is a picture of Dusty Brown...he isn't sober" leads this Panel to reasonably infer that these two individuals are more than just mere acquaintances, as the Respondent would have the Panel believe, but in fact are more closely and casually related to the point of having a social friendship between themselves and hence an environment that provides ample motivation and opportunity for collusive action. Thus, it is only reasonable for the Panel to then impute the conduct of KDB, including that of its owner Mr. Kaldenberg, to that of the present registrant, Respondent Dusty Brown. The present record is simply devoid of any evidence, let alone persuasive, that would convince this Panel that each of these individuals acted in a totally disinterested fashion towards the other and hence their conduct should be viewed and assessed in any other fashion than collectively with the actions of Mr. Kaldenberg and

KDB being imputed to those of the Respondent.

If UDRP Panels could not impute conduct where appropriate between transacting registrants—as here, then any prior registrant could very easily and successfully shield its names from transfer, and, by doing

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so, thwart the action of the Policy. Specifically, a prior registrant, after receiving notice of a dispute, involving a trademark owner claiming rights in various names then owned by that registrant, and in contemplation of an eventual UDRP proceeding, could simply assign ownership of those names to a related third party, such as, e.g., a friend, spouse, business colleague or a “friendly” organization. The receiving party, in anticipation of a UDRP complaint being filed against it by the trademark owner, would then simply act totally consonant with the Policy as long as that party owned the domain names. This, in turn, would essentially force a Panel, were it to focus solely on the present registrant’s conduct to the exclusion of that of the prior registrant, to refuse transfer of those names to the trademark owner for want of a UDRP violation. Immediately after such a decision resulted, the present registrant would simply transfer those names back to the prior registrant and thus re-establish the prior status quo, with the trademark owner ultimately denied the benefit of those names to its detriment and that of the public. Such an outcome, which would effectively frustrate and eviscerate the Policy and one which this Panel will not permit, is clearly senseless and counterproductive, and can not and will not be sanctioned.

Prior Panels, when faced with conduct by related parties, have not hesitated to impute conduct from one party to the other, as needed to remedy perceived cybersquatting. In that regard, see, e.g., *Wolter Verwaltungs and Kanner Corporation v. Susam Yocom*, WIPO Case No. D2004-0021 (February 29, 2004) and *Top Driver, Inc. v. Benefits Benefits*, WIPO Case No. D2002-0972 (January 7, 2003).

Consequently, given the social relationship between the Respondent and the prior registrant of both names, Mr. Kaldenberg and KDB, the Panel imputes the conduct of both latter entities to the

Respondent in assessing both legitimacy of his rights and bad faith use and registration.

The following facts, when viewed in their entirety, illuminate the true character of the May 20th transfer of the two contested names from prior registrant KDB to Respondent Dusty Brown:

- (a) while KDB owned the <ncaafootball2005.com>name, it offered that name for sale at a price (starting at \$ 10,000) which was far in excess of its costs of registration—itsself indicative of bad faith use and registration under paragraph 4(b)(i) of the Policy;
- (b) shortly after Mr. Kaldenberg and his counsel received, on May 10, 2004, e-mail notice of this dispute from counsel for the Complainant’s licensee, Mr. Kaldenberg removed this “sale” content from the site to which the <ncaafootball2005.com> name resolved and used that name to then re-direct Internet users to his own personal website;
- (c) on May 20, 2004, counsel for the Complainant’s licensee wrote a second letter to Mr. Kaldenberg informing the latter of the apparent change in site content and use of the name;
- (d) neither Mr. Kaldenberg nor his counsel responded to the second letter;
- (e) on May 20, 2004—obviously after having received the second letter, Mr. Kaldenberg and KDB transferred ownership of both contested domain names to the Respondent; and
- (f) just five days after gaining ownership of those domain names, the Respondent changed the content at the “www.ncaafootball2005.com” site to that of his gripe site and set both names to direct Internet users to that site.

After collectively viewing these facts and this inference, the Panel is left with only one inescapable conclusion: the domain name transfer was a sham, specifically a calculated attempt that involved first intentionally insulating and separating Mr. Kaldenberg’s conduct (and that of KDB) from the names by transfer to the Respondent and second cloaking the use of those names under the penumbra of Constitutionally protected speech, i.e., as addresses of a common gripe site, in an concerted attempt to frustrate their subsequent transfer by an UDRP Panel—including this one.

The Panel infers that should an UDRP Panel issue a decision denying transfer of the contested names to the Complainant, it

stands to reason, by virtue of the social relationship between the registrants, that the Respondent would then simply assign ownership of both names back to Mr. Kaldenberg and KDB for their attempted sale, at an exorbitant price, either to the Complainant, NCAA, or to a third party intent on doing so—to the ultimate detriment of the Complainant.

2. Free speech considerations

The Panel now turns its attention to the issue of whether the Respondent has a legitimate interest, resulting from use of both names that incorporate the Complainant's registered mark NCAA to resolve to his gripe site, that is absolute and hence protected under the free speech guarantee of the First Amendment to the U.S. Constitution, regardless of his actions, including those imputed to him.

The Panel rules he does not.

The general issue of whether a respondent has a legitimate interest in a domain name which contains a complainant's mark and is used to resolve to a website that provides criticism of the activities of the mark's owner has been considered by quite a number of UDRP Panels.

As indicated in the extremely thorough, thoughtful and well-reasoned decision in *Howard Jarvis Taxpayers Association v. Paul McCauley*, WIPO Case No. D2004-0014 (April 22, 2004), the Panel there observed that the issue was rather unsettled. The Panel first noticed a divergence—though not relevant here—apparently existed in prior UDRP decisions where, on the one hand, domain names that were used for legitimate criticism where nonetheless transferred where those cases involved non-US parties or panelists, but on the other hand, were not so transferred when the names were so used by where US parties and/or panelists were involved. The Panel then observed that, where US parties and/or panelists were involved, domain name transfer was repeatedly ordered in situations where some “indicia of bad faith existed that tended to suggest that criticism was not the respondent's primary motive.” Specifically, the Panel stated:

“The Panel acknowledges that transfer has been ordered in some trademark.TLD criticism cite UDRP cases involving U.S. parties. Although the panels in those cases generally did not analyze

the issue with the level of detail as is being applied in this case, the Panel notes that, in many of those cases, there were indicia of bad faith that tended to suggest that criticism was not the respondent's primary motive. *See, e.g., Council of American Survey Research Organizations (CASRO) v. Consumer Information Organization LLC*, Case No. D2002-0377 (WIPO July 19, 2002) (ordering transfer of domain name <casro.com> where criticism site was used to market products, respondent owned over 1200 domain names, and many of respondent's domain names incorporated famous marks); *New York Times Co. v. New York Internet Services*, Case No. D2000-1072 (WIPO December 5, 2000) (ordering transfer of domain name <newyorktimes.com> where respondent received financial benefit from advertising on commentary site); *Estée Lauder, Inc. v. Estelauder.com, Estelauder.net, and Jeff Hanna*, Case No. D2000-0869 (WIPO September 25, 2000) (ordering transfer of <estelauder.com> and <estelauder.net> where domains of complaint sites established by law firm incorporated misspelling of complainant's trademark, complainant submitted considerable evidence of actual confusion, respondent concealed sponsorship of complaint sites by law firm, and respondent reserved other domain names incorporating famous marks); *Rollerblade, Inc. v. McCrady*, Case No. D2000-0429 (WIPO June 25, 2000) (ordering transfer of domain name <rollerblade.net> where panel rejected respondent's use of site for rollerblading photos as pre-textual and found respondent made "overtures to be bought off" in order to transfer domain name). Similar issues appear to have informed court decisions that have ruled for plaintiffs in these circumstances. *See People for the Ethical Treatment of Animals (PETA) v. Doughney*, 263 F.3d 359 [60 USPQ2d 1109] (4th Cir. 2001) (ordering transfer of domain name <peta.org> despite use as parody website after finding bad faith intent to profit by registrant); *Jews for Jesus v. Brodsky*, 993 F.Supp. 282 [46 USPQ2d 1652] (D.N.J. 1998), *aff'd*, 159 F.3d 1351 (3d

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Cir. 1998) (finding confusion where criticism site was confusingly designed to look like official Jews For Jesus site and defendant admitted his intent was to deceive consumers about the sponsorship of his website); *Planned Parenthood v. Bucci*, 42 U.S.P.Q.2d 1430 (S.D.N.Y. 1997) (finding confusion where criticism site was confusingly designed to look like official Planned

Parenthood site in order to lure readers into the site before delivering its anti-abortion message), *aff'd*, 152 F.3d 920 (2d Cir. 1998), *cert. denied*, 119 S. Ct. 90 (1998). Nevertheless, in some of these cases, the Panels broadly held that there is no legitimate interest in a trademark.TLD criticism cite, and there are other such decisions as well. *E.g.*, *Prem Rawat Found. v. Leason*, File No. FA0401000231883 (NAF March 27, 2004) (although Panel held that Respondent's site was not a *bona fide* criticism site, Panel also noted its view that, "while the content of Respondent's website may enjoy First Amendment protection, such protection does not spawn rights or legitimate interests with respect to a domain name which is confusingly similar to another's trademark. Respondent cannot claim rights or legitimate interests in the domain name").

The Panel then concluded—with which this Panel completely agrees—"that the weight of authority suggests that a consensus is emerging that trademark.gTLD domain names, when used for U.S.-based criticism sites, can constitute a legitimate interest, especially where there are not indicia of bad faith." *Ibid*. Given the facts there at hand, the Panel found that the respondent's site was a "classic criticism site" and, in the absence of any evidence that reflected bad faith, denied transfer of the domain name to the complainant. Also see *American Lubefast Franchising, Inc. v. Chung Rigby*, WIPO Case No. D2004-0329 (July 26, 2004) where, in spite of the Respondent's contention that it was using <americanlubefast.com> to address a gripe site and thus its use was a legitimate exercise of its free speech rights under the First Amendment, the Panel found bad faith use and registration of that name as a result of the respondent having offered that name for sale to the Complainant for US\$20,000 and ordered that name transferred. In *Council of American Survey Research Organizations v. The Consumer Information Organization, LLC, aka Pinelands Web Services*, WIPO Case No. D2002-0377 (July 19, 2002), a majority of the Panel found the respondent used the contested domain name in bad faith and not solely in conjunction as an address of a website that provided criticism of an owner of a correspond mark contained within the name. Further, in *Bridgestone Firestone, Inc. et al v. Jack Myers*, WIPO Case No. D2000-0190 (July 6, 2000), the Panel found that a domain name was used, without any purpose of commercial gain, to address a website that provided criticism, and hence denied its transfer. The Panel cited *Name.Space, Inc., v. Network Solutions, Inc.* 202 F.3d 573, 585 (2d Cir. 2000) where the Second Circuit, with respect to free speech, held that "Domain Names ... per se are neither automatically entitled to nor excluded from the protections of the First Amendment, and the appropriate inquiry is one that fully addresses

particular circumstances presented with respect to each domain name.” In *Justice for Children v. R neetsso/Robert W. O’Steen* WIPO Case No. D2004-0175 (June 4, 2004), the Panel, in spite of the respondent there asserting free speech grounds for retaining its domain name, found the respondent used the domain name to expressly and intentionally disrupt the activities of the complainant, hence finding bad faith and ordered the name transferred. Compare *John I. Kendall v. Donald Mayer re: <skipkendall.com>* WIPO Case No. D2000-0868 (October 26, 2000) where a Panel refused to order transfer of a domain name which was used to address a site critical of a trademark owner and particularly in the absence of any showing that, *inter alia*, the Respondent registered and used the name in an attempt to sell it at a profit.

However, here, the evidence unmistakably shows that the Respondent’s primary motive in registering and using the contested domain names was manifestly commercial and not to provide criticism.

Specifically, the prior registrant was motivated to register at least one of the domain names, <ncaafootball2005.com>, for only one reason: to sell it to the Complainant (or to a third party who would ultimately seek

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to do the same) for a price (at least US\$10,000) well in excess of its cost of registration. In that regard, Mr. Kaldenberg admitted that the primary business purpose of KDB is to register domains for the purpose of selling them to third parties at a price significantly higher than KDB’s costs of registration. This in and of itself constitutes bad faith under paragraph 4(b)(i) of the Policy. Furthermore, the prior registrant not only registered that name, but also registered the other contested domain name <ncaafootball2006.com>, which he transferred with the former name to the Respondent, hence evincing a pattern of conduct also actionable as bad faith under paragraph 4(b)(ii) of the Policy.

Obviously, Mr. Kaldenberg’s motivation in registering both names, transferring them to the Respondent and ultimately having the Respondent link them to his gripe site was not solely to provide a *bona fide* vehicle for legitimate criticism of the Complainant—as would surely be protected in and of

itself under the First Amendment, but was commercial: perpetuating his offer to sell both names to the Complainant and eventually profit from doing just that—even if he himself could not continue his offer during the pendency of a UDRP proceeding. Whatever intent he and/or the Respondent had in using the names as providing such a source of criticism was and remains clearly subservient to that of commercially profiting from the sale of the domain names.

Otherwise, given the admitted nature of KDB’s business, why would Mr. Kaldenberg have registered both names in the first place and then seek to retain their ownership through a sham transaction with the Respondent if neither he nor the Respondent intended to eventually profit from those domain names? From the record presented, the Panel sees no other plausible reason.

Further, neither Mr. Kaldenberg nor the Respondent has proffered any evidence, let alone persuasive, as to why the latter could not achieve their goal of providing their gripe site through domain names, other than those at issue. In that regard, see *Universal City Studios, Inc. v. David Burns and Adam-12 Dot Com*, WIPO Case No. D2001-0784 (October 1, 2001) where the Panel, in evaluating a claim made by the respondent that its use of the contested domain name in conjunction with its “fan site” was free speech and hence protected under the First Amendment, stated:

“Since the respondent is arguing to retain a contested domain name for use with its fan site, it makes clear sense to impose a burden on the respondent to show why it could not maintain its fan site, hence exercise its right of free speech, but for use of the contested domain name. In essence, the respondent is charged with showing that no other reasonable alternatives were then available to him (her) but to use that name in order to fully exercise its rights of free speech to present a fan site. Here, the Respondent made no such showing.”

Such is the case here.

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

C. Registered and Used in Bad Faith

The Panel believes that the Respondent’s actions, with respect to each of the contested domain

names, constitutes bad faith registration and use.

As specifically discussed above, when the conduct of the prior registrant (and its organization KDB) is imputed to the Respondent, there is no question that both entities collectively registered and used both the domain names in violation of paragraphs 4(b)(i) and (ii) of the Policy.

Thus, the Panel concludes that the Complainant has provided sufficient proof of its allegations and thus has met its burdens under paragraph 4(a) of the Policy so that the relief it now seeks can be granted.

7. Decision

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

The contested domain names, specifically <ncaafotball2005.com>and <ncaa football2006.com>, are ordered to be transferred to the Complainant.

**- End of Case -
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