



NATIONAL
ARBITRATION
FORUM

DECISION

Spence-Chapin Services to Families and Children v. Stanley Wynman
Claim Number: FA0110000100492

PARTIES

The Complainant is **Spence-Chapin Services to Families and Children**, New York, NY (“Complainant”). The Respondent is **Stanley J. Wynman**, Bogota, NJ (“Respondent”) **Michael T. Stewart**, of **Peri & Stewart LLC**.

REGISTRAR AND DISPUTED DOMAIN NAME

The domain name at issue is <**spence-chapin.com**>, registered with **Register.com**.

PANEL

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

Mr. Peter L. Michaelson, Esq., as Panelist.

PROCEDURAL HISTORY

The Complaint was brought pursuant to the Uniform Domain Name Dispute Resolution Policy (“Policy”), available at <http://www.icann.org/services/udrp/udrp-policy-24oct99.htm>, 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 ICANN Rules for Uniform Domain Name Dispute Resolution Policy (“Rules”) as approved on October 24, 1999, as supplemented by the National Arbitration Forum Supplemental Rules for Uniform Domain Name Dispute Resolution Policy then in effect (“Supplemental Rules”).

The Complainant submitted a Complaint, together with Exhibits 1-6, to the National Arbitration Forum (“the Forum”) electronically and in hard-copy form on October 5, 2001.

On October 12, 2001, Register.com confirmed by e-mail to the Forum that the contested domain name <**spence-chapin.com**> is registered with Register.com and that the Respondent is the current registrant of the name. Register.com has verified that: (a) the status of the contested domain name is “active”, and (b) the language of the registration agreement is English. Though the registrar did not mention the registration agreement governing the Respondent, it is clear to the Panel, in view of the November 8, 2000 registration date of the contested domain name, that the Respondent is bound by the Register.com registration agreement and has thereby agreed to resolve domain name disputes by third parties in accordance with the Policy.

On October 15, 2001, a Notification of Complaint and Commencement of Administrative Proceeding (the “Commencement Notification”), setting a deadline of November 5, 2001 by which the Respondent could file a Response to the Complaint, was transmitted by the Forum to the Respondent via e-mail, post and fax, to all entities and persons listed on the Respondent’s registration as technical, administrative and billing contacts, and to postmaster@spence-chapin.com by e-mail.

A timely response, together with a single exhibit, was received by the Forum on November 5, 2001, which also on the same date determined it to be complete.

An additional submission was received from the Complainant in a timely manner on November 12, 2001.

Since the additional submission was timely received and the appropriate fees for this submission have been paid to the Forum -- both as per Supplemental Rule 7, the Panel has considered this submission.

On November 20, 2001, pursuant to Complainant’s request to have the dispute decided by a single-member Panel, the Forum appointed Mr. Peter L. Michaelson, Esq., as Panelist and set a due date of December 4, 2001 to receive the decision from the Panel.

Owing to travel schedule of the Panel that overlapped with this due date, the Panel, by order dated December 4, 2001, extended the due date of the decision to December 11, 2001 so as to afford the Panel with sufficient time to thoroughly consider this matter and properly prepare its reasoned decision.

RELIEF SOUGHT

The Complainant requests that the domain name be transferred from the Respondent to the Complainant.

PARTIES’ CONTENTIONS

A. Complainant

1. Confusing similarity/identity

The Complainant contends that the contested domain name is identical to its mark “Spence-Chapin”, with exception of the addition of the extension “.com”.

Hence, the Complainant concludes that the requirements of paragraph 4(a)(i) of the Policy are satisfied.

2. Rights and legitimate interests

The Complainant contends that the Respondent has no rights or legitimate interests in the contested domain name.

Specifically, the Complainant states that the Respondent has never represented the Complainant or its programs in any way, nor is the Respondent either an agent or service/information provider for Complainant.

Thus, the Complainant concludes that the Respondent cannot demonstrate any rights or legitimate interests in the contested domain name pursuant to paragraph 4(a)(ii) of the Policy.

3. Bad faith use and registration

The Complainant contends that the Respondent registered and is using the contested domain name in bad faith.

In that regard, the Complainant states that it has been using its current domain name “spence-chapin.org” in conjunction with its web site since 1996.

Given this, the Complainant contends that, inasmuch as the Respondent does not represent the Complainant or its programs, Internet users searching for information on the Complainant may easily confuse the contested domain name ending in the generic top level domain (gTLD) “.com” with the same name, i.e. the Complainant’s current domain name, that ends in the gTLD “.org”. As such, the Complainant believes that the Respondent’s registration of the Complainant’s name but with a gTLD “.com” extension creates confusion for users searching for legitimate agency generated information about the Complainant’s services and programs. Accordingly, the Complainant contends that the Complainant’s prospective clients could easily go, by virtue of inadvertently entering the contested domain name as a web address, to the Respondent’s page by mistake, and contact the Respondent through info@spence-chapin.com, rather than contacting the Complainant at info@spence-chapin.org in order to receive the program and services information the Complainant provides to its potential clients. Accordingly, the Complainant contends that the Respondent intends, through use of the contested domain name which essentially matches the Complainant’s domain name, to disrupt the

Complainant's business by causing a likelihood of confusion to arise among those Internet users who seek its web site rather than the Respondent's site.

Consequently, the Complainant concludes that the Respondent's activities demonstrate bad faith use and registration of the contested domain name pursuant to paragraph 4(a)(iii) of the Policy.

B. Respondent

1. Confusing similarity/identity

While the Respondent does not dispute that the contested domain name includes the mark used by the Complainant, the Respondent takes the position that paragraph 4(a)(i) of the Policy is not met because the Complaint "possesses no registered service marks or trademarks in the 'Spence-Chapin Services to Families and Children' name."

Furthermore, the Respondent states that the Complainant attempts to shorten its legal name to make it appear more similar to the domain name at issue.

In addition, the Respondent points to that fact that it, not the Complainant, has applied for a trademark application for the mark "SPENCE-CHAPIN". This application was filed on December 26, 2000 and assigned serial number 76/186607. The Respondent has provided, in the sole exhibit to the Response, a copy of entries in the publicly accessible TESS (Trademark Electronic Search System) and TARR (Trademark Application and Registrations Retrieval) databases accessible through the web site of the United States Patent and Trademark Office (PTO). From these entries, the Panel takes note of the facts that this application was filed on an intent-to-use basis for use in connection with "adoption informational services"(international class 42), and was the subject of a non-final office action mailed by the PTO on May 22, 2001. Further, based on the information in these entries, the Panel infers that the Respondent has not yet used his mark "SPENCE-CHAPIN" in inter-state commerce.

Moreover, the Respondent states that even if the Complainant could show a registered service or trademark, "the Respondent could not be deemed to be infringing on such non-existent marks because he is not selling and does not intend to profit commercially from providing similar wares or services."

Hence, the Respondent contends that the Complainant has failed to satisfy paragraph 4(a)(i) of the Policy.

2. Rights and legitimate interests

The Respondent contends that he has a legitimate interest in the contested domain name, hence negating the Complainant's assertion that it has no rights or legitimate interest under paragraph 4(a)(ii) of the Policy.

In particular, the Respondent states that it intends to use the contested domain name for "the dual non-commercial purposes of publicizing criticism of the Complainant and providing without compensation unbiased adoption information" [emphasis removed from original].

3. Bad Faith

Here, the Respondent contends that his activities do not amount to bad faith use and registration.

Specifically, the Respondent states that the Complainant has made no allegation that the Respondent, at any time, offered to sell the domain name to the Complainant. In that regard, the Respondent states that he made no such offer because his intention is to use the contested domain name in publicizing, ostensibly through a web site addressed by the name, information about the Complainant. The Respondent contends that the Complainant apparently recognizes that the Respondent intends to publish such criticism.

Furthermore, the Respondent asserts that even if there were some cognizable element of bad faith, such bad faith may be negated by establishing fair use and the exercise of free speech citing to: *Lucent Technologies, Inc. v. LucentSucks.com*, 95 F. Supp.2d 528, 535-536 (E.D.Va. 2000); *Bridgestone Firestone, Inc. v. Myers*, D2000-0190 (WIPO July 6, 2000); and *America Online, Inc. v. Frank Albanese* D2000-1604 (WIPO January 25, 2001). The Respondent opines that "the fact that criticism will be lodged against the Complainant is not enough to dislodge the domain name from the Respondent" and the free speech concerns at issue here support a denial of the relief requested in the Complaint. On that point, the Respondent states that "In most cases that have specifically denied a complainant's relief, the Complainant at least established in the first instance that it had a particular service or trademark. In this case, ..., the Complainant does not even establish this and as in such cases where the complainant has failed in establishing this essential element, the complaint should be dismissed" citing to *Canadian Tire Corporation v. McFadden* D2001-0383 (WIPO May 24, 2001). Moreover, the Respondent states that "even in cases where a proper trademark or service mark has been established, domain name transfers have been denied in cases where the domain name is utilized to criticize the complainant" citing to *Lockheed Martin Corporation v. Dan Parisi* D2000-1015 (WIPO January 26, 2001); and *The Royal Bank of Scotland plc v. Natwestfraud.com and Umang Mahotra* D2001-0212 (WIPO June 18, 2001).

Consequently, the Respondent concludes that the Complainant has failed to show bad faith use and registration as required by paragraph 4(a)(iii) of the Policy.

C. Complainant's additional submission

In its additional submission, the Complainant raises two points.

First, as to the confusing similarity/identity requirement of paragraph 4(a)(i) of the Policy, the Complainant has locally and nationally used the names "Spence-Chapin" and "Spence-Chapin Services to Families and Children" since 1948. Moreover, the Complainant states that, through its domain name "spence-chapin.org", the Complainant has had a presence on the Internet since 1996.

The Complainant notes that its response, the Respondent focuses on the fact that Complainant's trademark or service mark is not registered. The Complainant contends that it is well-settled law that legal rights may be created without registration of a trademark or service mark, and given the Complainant's historical use of its name and domain name "Spence-Chapin", the Complainant, even absent such registration, has established such rights. In addition, as to paragraph 4(a)(i) of the Policy, the Complainant states that all that is required under that paragraph is that the "domain name is identical or confusingly similar to a trademark or service mark in which complainant has rights" and not whether the Respondent has any intention or not of commercializing its site.

Second, with respect to the bad faith requirement of paragraph 4(a)(iii), as illustrated in paragraph 4(b) of the Policy, the Complainant takes the position that one way to evidence bad faith is where a respondent registers a domain name "primarily for the purpose of disrupting the business of a competitor." The Complainant asserts that the Respondent is doing just that by using a similar, in fact virtually identical name (identical with exception of the gTLD), and a virtually identical e-mail address (info@spence-chapin.com). As a result of doing so, the Complainant contends that prospective, current or former clients seeking information from the Complainant could easily be directed to the Respondent's site rather than the Complainant's site.

The Complainant expressly recognizes the Respondent's right to criticize the Complainant, provided that, in doing so, the Respondent, through the use of a nearly identical domain name, does not invite confusion among those Internet visitors seeking information from the Complainant.

Furthermore, as to the lack of any offer to sell the contested domain name by the Respondent, the Complainant notes that such an offer is not the only aspect illustrative of bad faith under paragraph 4(b) of the Policy and is not the particular aspect under this paragraph upon which the Complainant is relying.

As to the Respondent's assertion that it intends to use of the contested domain name in conjunction with a site that will offer criticism about the Complainant, the Complainant

responds that its claim of bad faith does not rest on the Respondent's plans to offer such criticism. In that regard, the Complainant states: "The objective of this Complaint is not to avoid criticism but to avoid confusion. There are many ways for Respondent to criticize Complainant without using a confusingly similar, essentially identical, domain name." Moreover, the Complainant asserts that "the First Amendment is not a defense to an allegation of trademark infringement" citing to *MGM-Pathe Communications Co. v. Pink Panther Patrol*, 774 F. Supp. 869 (S.D.N.Y. 1981) where the court found that the Pink Panther Patrol, a gay rights patrolling association, could not assert a First Amendment defense to a charge of infringement because the public could easily draw an inference that the sponsor of the famous Pink Panther movie had loaned its name to the defendant organization.

FINDINGS

A copy of the WHOIS registration record for the contested domain names has been provided by the Forum. As indicated on that record, the Respondent registered, with Register.com, the contested domain name "spence-chapin.com" on November 8, 2000.

The Complainant is a non-profit company, specifically a social service provider and under the IRS regulations, a non-profit 501(c)(3) organization. The Complainant is incorporated in the State of New York and has been continuously providing social services under its name "Spence-Chapin" since 1948 – for a period in excess of 50 years. During this period, the Complainant uses its name in all its brochures, annual reports, correspondence and advertising. Furthermore, since 1996, the Complainant has been using its domain name "spence-chapin.org" as an address of its web site and, in that regard, has provided, in Exhibit 2 to the Complaint, a copy of a page of its 1997 Annual Report announcing this web site.

Specifically, the Complainant has provided, as Exhibit 3(c) to the Complaint, a copy of its 1948 Annual Report, and, in Exhibits 3(a) and 3(b), copies of its 2000 and 1994 annual reports, respectively, and, in Exhibits 4(a), 4(b) and 4(c), copies of its Summer 2001, Spring 2001 and Spring 1998 newsletters. The Complainant has also provided a copy of each its ASAP adoption program brochure and its Adoption Resource Center Fall/Winter 2001/2002 brochures in Exhibits 5(a) and 5(b), respectively, and, in Exhibit 6, of an advertisement it ran in The Brooklyn Papers on October 1, 2001 for its Adoption Resource Center. All of these items conspicuously display the Complainant's name "Spence Chapin", as a mark used in connection with the Complainant's adoption services, and/or its domain name "spence-chapin.org".

The Complainant serves the New York metropolitan area through its branch offices in Summit, New Jersey (since 1997) and Central Islip, New York (since 1991). The Complainant is well known locally in the New York metropolitan area and nationally as a leader in adoption. It serves all parties in adoption, provides adoption education programs to the public, and has placed approximately 16,000 children in adoptive homes

since its inception in the early 1900s as two nurseries founded by Clara Spence and Alice Chapin.

Since November 8, 2000, the date on which the Respondent registered the contested domain name, he has not yet commenced use of this name. The Respondent intends to eventually use this name as an address of his web site through which he will provide criticism of the Complainant's services as well as other information on adoption.

On December 26, 2000, the Respondent filed, with the US Patent and Trademark Office (PTO), a US trademark application to register the service mark "SPENCE-CHAPIN" in block letters for use in connection with "adoption information services" (in international class 42). This application was filed on an intent-to-use basis. At least as of the date of the Response, the Respondent has not yet filed appropriate papers (e.g. an amendment to allege use) with the PTO to show use of the mark in inter-state commerce (which is a pre-requisite to obtaining a federal trademark registration).

DISCUSSION

Paragraph 15(a) of the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules") instructs this Panel to "decide a complaint on the basis of the statements and documents submitted in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable."

Paragraph 4(a) of the Policy requires that the Complainant must prove each of the following three elements to obtain an order that a domain name should be cancelled or transferred:

- (1) the domain name registered by the Respondent is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;
- (2) the Respondent has no rights or legitimate interests in respect of the domain name;
- and
- (3) the domain name has been registered and is being used in bad faith.

Identical and/or Confusingly Similar

The Panel finds that confusion would likely arise as a result of the Respondent's eventual use of the contested domain name.

In that regard, the contested domain name includes the Complainant's common law mark "SPENCE CHAPIN", which has clearly acquired requisite secondary meaning and distinctiveness as a result of the Complainant's continuous and rather extensive use since 1948 in its geographic market – both in the New York metropolitan area as well as, more generally speaking, nationwide.

There can be no question here that the contested domain name, by virtue of its inclusion of the term "SPENCE CHAPIN", if used in the manner intended by the Respondent or by

a third-party to which the Respondent might transfer that name, will likely cause user confusion.

The Complainant owns common law rights in its mark "SPENCE CHAPIN", under which the Complainant can base its claim under the Policy. Directly contrary to the Respondent's view, paragraph 4(a) of the Policy does not restrict its reach only to registered marks, but, through what has now become a well-established principle through numerous panel decisions, also encompasses unregistered common law marks pursuant to national and/or state law that governs the recognition of those marks and the Respondent's actions in connection therewith. Such marks are indeed recognized and subject to protection under § 43 of the Lanham Act (15 U.S.C. §1125(a)) which states, in pertinent part: "Any person who, on or in connection with any goods or services, or any container for goods, uses in commerce *any word, term, name, symbol, or device*, or any combination thereof ... (A) is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person ... shall be liable in a civil action by any person who believes that he or she is or is likely to be damaged by such act." [emphasis added] See, e.g., *Meijer, Inc. v. Porksandwich Web Services* FA 97186 (Nat. Arb. Forum July 6, 2001); *MPL Communications v LOVEARTH.net* FA 97086 (Nat. Arb. Forum June 4, 2001); *MPL Communications v IWebAddress.com* FA 97092 (Nat. Arb. Forum June 4, 2001).

In that regard, this Panel can not conceive of any situation where such confusion would not likely arise when and if the Respondent, or any third-party not affiliated with the Complainant to which the Respondent were to transfer the contested domain name, were to start using that name in conjunction with services similar to those provided by the Complainant under its "SPENCE CHAPIN" mark, or, as here, provide criticism of the Complainant.

Such confusion would undoubtedly cause Internet users intending to access the Complainant's website, but who reach a website through the contested domain name, to think that an affiliation of some sort exists between the Complainant and the Respondent or its third-party transferee, when, in fact, no such relationship would exist at all. See *MPL Communications v LOVEARTH.net* cited supra; *Meijer, Inc. v. Porksandwich Web Services* cited supra; *MPL Communications v IWebAddress.com* also cited supra; *American Home Products Corp. v. Malgioglio* D2000-1602 (WIPO Feb. 19, 2001); *Surface Protection Indus., Inc. v. The Webposters* D2000-1613 (WIPO Feb. 5, 2001); *Dollar Financial Group, Inc. v. VQM NET* FA 96101 (Nat. Arb. Forum Jan. 25, 2001); *eBAY Inc. v. G L Liadis Computing, Ltd.* D2000-1463 (WIPO Jan. 10, 2001); *Treeforms, Inc. v. Cayne Indus. Sales Corp.* FA 95856 (Nat. Arb. Forum Dec. 18, 2000) and *The Pep Boys Manny, Moe and Jack of California v. E-Commerce Today, Ltd.* AF-0145 (eResolution May 3, 2000).

It is simply inconceivable to the Panel that an Internet user familiar with the Complainant, SPENCE-CHAPIN, would think that a web site accessible by

"spence-chapin.com" was not affiliated in some manner with the Complainant, particularly since the Complainant extensively provides adoption services in its trade area, adoption services.

As such, the Panel finds that sufficient similarity exists under paragraph 4(a)(i) of the Policy between the contested domain name and the Complainant's mark.

Rights or Legitimate Interests

Reduced to its essential element, this dispute, lying at the confluence between trademark rights and free speech considerations under the First Amendment to the United States Constitution, raises the issue of whether, under the Policy, the Respondent can legitimately use the Complainant's common law mark, without more, as an address for the Respondent's complaint site.

Fortunately, this is not a issue of first instance as it has been the subject of a continuing series of panel decisions as well as court decisions.

This Panel clearly recognizes, as axiomatic, the well-established rights which members of the public have to establish complaint web sites for voicing and disseminating critical comment on any matter of interest to them, including, e.g., commercial establishments, and in doing so use the names and marks of those establishments. See *E. & J. Gallo Winery v. Hanna Law Firm* D2000-0615 (WIPO Aug. 3, 2000) and *Compagnie de Saint Gobain v. Com-Union Corp.* D2000-0020 (WIPO Mar. 14, 2000).

While, as various panels have held, the right to use a domain name which encompasses a complainant's name or mark is not unbridled, nevertheless, panels must tread quite carefully to ensure a proper balance is struck in protecting the rights of trademark owners vis-à-vis not unduly restricting a respondent's right of free speech. The issue distills itself, as the panel in *Compagnie de Saint Gobain* recognized: "[N]ot as Respondent seems to contend, the freedom of speech and expression but the mere choice of the domain name used to exercise this inalienable freedom of speech and expression".

Various panels have assessed the suitability of a contested domain name as an address for a complaint site as hinging on whether that name included, not only a complainant's mark or name, but also and in addition a "communicative element", such as "sucks" or other pejorative term, or a ".net" rather than a ".com" gTLD. In that regard, see: *Bridgestone Firestone et al. v. Myers*, cited supra, where the panel predicated its decision not to transfer the respondent's domain name "bridgestone-firestone.net" as the address of its complaint site owing to its inclusion of the ".net" rather than ".com" gTLD; *Wal-Mart Stores, Inc. v. walmartcanadasucks.com*, also cited supra, where the panel refused to transfer a contested domain name "wallmartcanadasucks.com" which was used as an address of a complaint site owing to its inclusion of the term "sucks"; and *Sears Roebuck and Co. v. Hanna Law Office*, also cited supra, where the panel, having made a finding that a contested domain name, "searsroebuck.com", failed to include any "communicative

message or expression of Respondent's right to air its negative opinions about Complainant", the panel held that use of that domain name as an address of a complaint site was illegitimate and dilutive of the complainant's marks.

Panels, in legitimizing the use of a domain name that incorporated a complainant's name or mark as an address of a complaint site based on its inclusion of a "communicative element" (or the like), appeared guided by *Bally Total Fitness Holding Corp. v. Faber* 29 F. Supp. 2d 1161 (C. D. Cal. 1998) where the Court recognized a need to prevent confusion but that inclusion of such an element would likely preclude it. In so holding, the Court stated: "that the use of the trademark in domain names in those cases created a high likelihood of consumer confusion, i.e., that reasonably prudent consumers would believe that the site using the appropriated name was the trademark owner's site." But, in view of the inclusion of the pejorative element in the domain name there at issue, the Court then concluded "no reasonably prudent Internet user would believe that 'Ballysucks.com' is the official Bally site or is sponsored by Bally". *Id.* at 1163-1164.

In view of *Bally*, various subsequent panel decisions have recognized that the word "sucks", when coupled with a mark or name of an entity to form a domain name, immediately conveys to all who see it an unmistakable, critical and powerful negative connotation that plainly differentiates the entity being criticized from the site airing the criticism. In that regard, the Court in *Bally* observed: "'Sucks' has entered the vernacular as a word loaded with criticism." *Id.*

This Panel could adopt an absolute requirement that every domain name which incorporates a mark or a name and is used as an address for a complaint site must include some form of communicative element (or the like) sufficient to immediately convey the purpose of the site to a prudent Internet user, else use of that name is illegitimate. However, this Panel chooses not to. The Panel is quite mindful that instances could well arise in the future (though the present case is not one) where no such alternative is present and hence precluding such use, on effectively a per se basis, will unreasonably restrict protected critical comment.

Instead, this Panel believes that the proper approach is to scrutinize the facts of each dispute to assess whether reasonable alternatives exist to use of a contested domain name that will still provide an effective avenue for a respondent's critical comment. See *Meijer, Inc. v. Porksandwich Web Services*, cited supra.

In that regard, in *Name.Space v. Network Solutions Inc.* 202 F.3d 573, 585 (2d Cir. 2000), the Court stated: "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 the particular circumstances presented with respect to each domain name." This view was effectively echoed in hearings in the U.S. House of Representatives that ultimately led to the enactment of the U.S. Anticybersquatting Consumer Protection Act (ACPA), which preceded the adoption of the Policy. In a

specific context of explaining why various factors were set forth in the ACPA to determine whether a domain name was adopted in bad faith or not, one of which was "noncommercial or fair use of the mark in a site accessible under the domain name", the House Judiciary Committee stated: "Balance the interests of trademark owners with the interests of those who would make the lawful noncommercial or fair uses of others' marks online, such as in comparative advertising, comment, criticism, parody, news reporting, etc. ... The fact that a person may use a mark in a site in such a lawful manner may be an appropriate indication that the person's registration or use of the domain name lacked the required element of bad faith." H. R. Rep. No. 106-412 at 9 (1999).

Along these lines, in a decision which accords with this Panel's view, the panel in *North American Wilderness Recovery, Inc v. Citizens With Common Sense* FA 97058 (Nat. Arb. Forum July 1, 2001), in accord with the *Name.Space* decision, held: "In other words, fair use can include the name of the person or business the critic would attack, and it will depend on the circumstances of each case whether that use is fair or not. It may well not be a fair use if the domain name offers no hint of its real purpose, but the use of a non-commercial suffix like '.org' or '.net' may suffice to differentiate when criticizing a commercial enterprise. It may well also be a fair use to employ the name together with some added words to indicate a critical purpose."

Oftentimes, where complainants have raised allegations that a respondent's use of a contested domain name is illegitimate -- particular when coupled with conduct of the respondents that might evince bad faith, with the underlying facts being in control and possession of a respondent, various panels, this Panel among them on prior occasions, have shifted the burden of proof to respondents to show those facts that would legitimize the use. In that regard, see, e.g., *Dollar Financial Group, Inc. v VQM NET*, cited supra; *eBay Inc., v. G L Liadis Computing, Ltd.*, cited supra; *Playboy Enterprises Int'l, Inc. v. Rodriguez* D2000-1016 (WIPO Nov. 7, 2000) and *MSNBC Cable, LLC v. Tsys.com* D2000-1204 (WIPO Dec. 8, 2000).

In assessing legitimacy, this Panel believes that where a respondent alleges that its domain name, which includes the mark or name of an entity, is being used to support a complaint site the primary purpose of which is to serve as a vehicle for critical comment about that entity, then it is eminently reasonable to shift the burden of proof to that respondent to show why no reasonable alternatives exist to use of that particular domain name. If, in any dispute, a sufficient factual showing is made that no such alternatives exist, then under the unique facts of that dispute, a panel may conclude that the use there is legitimate. Alternatively, if the respondent makes no such showing, then a panel may find that its use lacks legitimacy, possibly evincing bad faith. See, *Meijer, Inc. v. Porksandwich Web Services*, cited supra; and *Universal City Studios, Inc. v. David Burns and Adam-12 Dot Com* D2001-0784 (WIPO October 1, 2001).

Here, the facts underlying whether such alternatives exist and their practicality lie predominantly, if not solely, with the respondent. It is the respondent, not the

complainant, that intends to establish the complaint site and thus fully appreciates the need and audience for its criticism and how it can effectively reach that audience through that site. It clearly stands to reason that the respondent should be put to its proof as to why he had no reasonable, practical alternatives to the use of the domain name as the address of its complaint site.

The Respondent simply failed to adduce any proof, let alone sufficient, to meet his burden.

Furthermore and apart from the considerations of fair use as discussed above, the Complainant has never authorized the Respondent to utilize the Complainant's "SPENCE-CHAPIN" mark, nor does the Complainant have any relationship or association whatsoever with the Respondent.

Hence, any use to which the Respondent were to put the SPENCE-CHAPIN mark, in connection with services adoption services with which the Complainant uses this mark would directly violate the exclusive common law trademark rights now residing in the Complainant. See, e.g., *America Online, Inc. v John Deep d/b/a Buddy USA Inc.* FA96795 (Nat. Arb. Forum May 14, 2001); *America Online, Inc. v. Xianfeng Fu* D2000-1374 (WIPO Dec. 11, 2000), and *Treeforms, Inc. v. Cayne Ind. Sales Corp.* cited supra.

Thus, the Panel finds that the Respondent does not have any rights or legitimate interests in the contested domain name within paragraph 4(a)(ii) of the Policy.

Registration and Use in Bad Faith

The Panel firmly believes that the Respondent's actions constitute bad faith registration and use of the contested domain name.

Internet site naming conventions are such that it is very plausible to contemplate that Internet users who seek the Complainant's adoption services, particularly those who have seen the Complainant's common law mark, would form a domain name from what they perceive to be the dominant form of its name. Hence, this Panel believes that it is quite conceivable that those users in seeking the Complainant's web site would form a domain name along the lines of "spence-chapin.com" and then enter that name into his(her) browser. The Respondent, presumably knowing this, intentionally choose the name as the addresses for his complaint site. As a result, those users intent on reaching the Complainant's site would be diverted to the Respondent's complaint site instead where they are subjected to and possibly influenced by the complaints listed thereon and, consequently, decide either not to go to the Complainant's web site or seek the Complainant's services. There can be no doubt of his calculated intent to cause user confusion and, by doing so, injure the Complainant's adoption service by diverting those users away from doing business with the Complainant.

In the Panel's mind, these actions are sufficient to establish bad faith registration and use of the contested domain name under the paragraph 4(b)(iii) of the Policy.

Moreover, since the date (November 8, 2000) on which the Respondent registered the contested domain name to the date of the Complaint (October 5, 2001) -- a period of approximately 11 months, the Respondent has not used that name as an address of an operative web site.

Various panels have ordered transfer of a domain name after an extended period of non-use by its registrant, typically referred to as "passive holding". In each instance, non-use was coupled with a complainant having valid trademark rights commencing prior to the date on which the offending domain name was registered coupled with the registrant having actual or imputed knowledge of those rights -- as is the case here. See, e.g., *The Chip Merchant Inc. v. Blue Star Electronics d/b/a Memory World* D2000-0474 (WIPO August 21, 2000), *America Online, Inc. v. Curtis Woods* D2001-0555 (WIPO June 13, 2001), *Chernow Communications, Inc. v. Nathan Kimball* D2000-0119 (WIPO May 18, 2000), *America.com Inc. et al v PSS InterNet Services, Inc.* FA 96784 (Nat. Arb. Forum April 19, 2001), *Awesome Kids LLC and/or Awesome Kids L.L.C. v. Selavy Communications* D2001-0210 (WIPO April 16, 2001) and *Mary-Lynn Mondich and American Vintage Wine Biscuits, Inc v. Shane Brown, d/b/a Big Daddy's Antiques*, D2000-0004 (WIPO February 16, 2000); as well as *Northwest Racing Associates Limited Partnership v. Quantu Marketing* FA 95506 (Nat. Arb. Forum October 6, 2000), *Can't Stop Productions, Inc. v. Kevin Lussie* FA 94966 (Nat. Arb. Forum July 27, 2000), *Liberty Public Limited Company v. Thomas Guarrera* FA 95103 (Nat. Arb. Forum August 17, 2000), *V & S Vin & Spirit Aktiebolag v. Gunnar Hedenlans Peev* FA 95078 (Nat. Arb. Forum August 9, 2000), *Leland Stanford Junior University v. Zedlar Transcription & Translation* FA94970 (Nat. Arb. Forum July 11, 2000), *Georgia Gulf Corporation v. The Ross Group* D2000-0218 (WIPO June 14, 2000), *Sanrio Company, Ltd. and Sanrio, Inc. v. DLI* D2000-0159 (WIPO April 20, 2000), *America Online, Inc. v. Avrasya Yayincilik Danismanlik Ltd.* FA 93679 (Nat. Arb. Forum March 16, 2000) and *Telstra Corporation Limited v. Nuclear Marshmallows* D2000-0003 (WIPO February 18, 2000). In each instance, such passive holding was seen as sufficient evidence of bad faith use and registration under the general provisions of paragraph 4(b) of the Policy. The Panel see no plausible reason to divert from that view, with the passive holding here providing an independent basis for the Panel's finding of bad faith use and registration.

Thus, the Panel concludes that the Complainant has provided sufficient proof of its allegations to establish a prima facie case under paragraph 4(a) of the Policy upon which the relief it now seeks can be granted.

DECISION

In accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the relief sought by the Complainant is hereby **granted**.

The contested domain name, namely <**spence-chapin.com**>, is ordered transferred to the Complainant.

Peter L. Michaelson, Esq., Panelist
Dated: December 10, 2001