

322 West 57th Owner LLC v. Administrator, Domain, C/O Mecca Hosting, 88 USPQ2D 1491
(W.I.P.O. 2008)

**322 West 57th Owner LLC v. Administrator, Domain, C/O Mecca
Hosting**

**World Intellectual Property Organization
88 USPQ2D 1491
Case No. D2008-0736**

Decided August 6, 2008

Headnotes

TRADEMARKS AND UNFAIR TRADE PRACTICES

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

Respondent's disputed Internet domain name "sheffield57resident.com" is confusingly similar to complainant's "Sheffield57" trademark for real estate agencies and brokerage, since generic word "resident" and generic top-level domain ".com" are only differences between domain name and mark, since addition of gTLD is irrelevant in assessing confusing similarity or identity of mark and domain name, and since addition of generic word "resident" to mark does not confer sufficient distinctiveness on domain name to avoid confusion among Internet users.

[2] Acquisition, assignment, and maintenance of marks — Acquisition through use — In general (§305.0501)

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

Infringement; conflicts between marks — Defenses — Fair use (§335.1003)

Respondent has established rights and legitimate interests in disputed Internet domain name "sheffield57resident.com," which respondent uses to operate "gripe site" as resident of complainant's "Sheffield57" apartment building, since site contains only speech critical of complainant and its efforts to convert building from apartments to condominiums, and there is no evidence that respondent engaged in any commercial activity through site, sought to benefit financially from use of domain name, or had any purpose other than disseminating her criticism of complainant, since respondent's addition of term "resident" to "Sheffield57" mark, although insufficient to distinguish domain name for purposes of assessing confusing

similarity, suffices to dramatically change meaning, identification, or overall impression created by mark in minds of ordinary Internet users, and since use of domain name to plainly describe residents of "Sheffield57" building as target of Web site's content is not likely to disparage reputation of underlying mark or cause initial interest confusion; thus, in appropriate circumstances, use of non-pejorative term in conjunction with mark to form domain name for site solely providing commentary may sufficiently distinguish domain name from mark to legitimize use of name as fair use.

Case History and Disposition

Administrative proceeding pursuant to Uniform Domain Name Dispute Resolution Policy, in which complainant 322 West 57th Owner LLC seeks transfer of disputed Internet domain name "sheffield57resident.com" from respondent Administrator, Domain, C/O Mecca Hosting (Suzanne Jansson, registrant) to complainant. Transfer denied.

Attorneys:

Fried, Frank, Harris, Shriver & Jacobson, New York, N.Y., for complainant.

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Opinion Text

Opinion By:

Michaelson, panelist.

1. The Parties

The Complainant is 322 West 57th Owner LLC, New York, New York, United States of America represented by Fried, Frank, Harris, Shriver & Jacobson, United States of America.

The Respondent, according to the Complaint, is Administrator, Domain, C/O Mecca Hosting, Colorado Springs, Colorado, United States of America. The actual registrant of the name, who is also a proper respondent here, though not captioned in the Complaint or even known to the Complainant as of its final amendment to the Complaint on May 28, 2008, is Ms. Suzanne Jansson, New York, New York, United States of America. For simplicity, the Panel will collectively treat both C/O Mecca Hosting and Ms. Jansson as the Respondent, except in those instances in the discussion below where context dictates otherwise with a specific reference to just one of these two parties.

2. The Domain Name and Registrar

The disputed domain name <sheffield57resident.com> is registered with Network Solutions, LLC.

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 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 email form on May 13, 2008, and in hard copy form on May 15, 2008, with accompanying Annexes 1-28. The Center received, by email and from the Complainant, various amendments to the Complaint dated May 20, 21, 23 and 28, 2008. For simplicity, the Panel will refer to the Complaint as that which stands as amended through the Complainant's final amendment dated May 28, 2008.

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, the Center, in accordance with paragraph 5 of the Supplemental Rules, verified that the Complaint complied with the formal requirements of the Rules and the Supplemental Rules. In that regard, on May 13, 2008, the Center requested confirmation from the Registrar as to whether the Registrar received a copy of the Complaint from the Complainant and to confirm contact and registrant information set forth in the Complaint relative to the disputed domain name. The Center also requested the Registrar to specify, for the domain name: (a) whether the Policy applies to the 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 the name, (c) the language of the registration agreement, and (d) whether the name will remain "locked" during the proceeding.

Subsequently, on May 14, 2008, the Registrar provided its response to the Center through which it specified name and contact information pertinent to the disputed domain name to the extent, as it then existed, in its WhoIs database. Specifically, it stated that C/O Mecca Hosting was listed as the registrant for the name. The response also indicated that: (a) the Policy applies to the name, (b) Network Solutions, LLC is the registrar, (c) the Registrant submitted to the jurisdiction of the courts at the location of the principal office of the Registrar, (d) the registration agreement is in English and (e) the name will remain locked during the proceeding. Subsequently, on June 17, 2008, C/O Mecca Hosting, being solely a domain name reseller which provides a privacy feature and not a

registrant, informed the Center, via email, of the true identity of and contact information for the actual registrant, Respondent Jansson.

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The Center verified that the Complaint satisfied the formal requirements of the Policy, the Rules and the Supplemental Rules.

On May 29, 2008, the Center formally notified Respondent C/O Mecca Hosting of the filing of the Complaint, including an indication that the Center was forwarding a complete copy of the Complaint to that Respondent, together with all its exhibits, by post or courier and by email. 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 May 29, 2008, under paragraph 4(c) of the Rules, this administrative proceeding is deemed to have commenced on that date.

Having reviewed the Complaint and all the correspondence, including that between the Center and the Registrar, 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 June 18, 2008, to file its Response with the Center and the Complainant.

On June 17, 2008, the Center received an email message from Respondent C/O Mecca Hosting which informed the Center: (a) that this Respondent is merely a reseller of domain registrations which include a privacy feature, and (b) identified the identity and provided contact information for the true registrant, Respondent Jansson. The Center acknowledged, by email on June 23, 2008, its receipt of this message. As of June 23, 2008, the Center had received no response from Respondent Jansson.

Accordingly, pursuant to the Rules and Supplemental Rules, by email letter dated July 7, 2008, the Center contacted the undersigned, Mr. Peter L. Michaelson, Esq., requesting his service as a Sole Panelist for this dispute. Subsequently, on July 8, 2008, Mr. Michaelson accepted and returned, by facsimile to the Center, a fully executed Statement of Acceptance and Declaration of Impartiality and Independence. The Center, through an email letter dated July 9, 2008, 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 July 23, 2008. Owing to unexpected time conflicts experienced by the Panel all of which constituted unforeseen circumstances, the Center, at the request of the Panel, extended this due date to August 6, 2008.

Inasmuch as Respondent C/O Mecca Hosting identified Respondent Jansson to the Center on June 17, 2008—one day before the expiration of the response period and as such rather late in the process, apparently Respondent Jansson was never formally notified of this administrative proceeding and served with the Complaint by either the Complainant or the Center. Thus, Respondent Jansson, due to her rather late identification as the actual registrant, was effectively denied an opportunity at that time to participate in this proceeding.

As such, ordinarily the Panel would require both the Complainant and the Center to restart the administrative procedure by effectuating service of the Complaint on the true registrant, i.e., Respondent Jansson, and provide her with a 20-day period to file a response. Apparently, as this Panel can best discern from the record, Respondent Jansson evidently received a copy of the complaint, though rather delayed but seemingly inadvertently so, from Respondent C/O Mecca Hosting.

Judging from email correspondence dated July 23, 2008 evidently between the two Respondents and the Center, C/O Mecca Hosting informed Ms. Jansson on July 23, 2008 and evidently in response to the Center's notification of the extended due date for receipt of the Panel's decision, that the Center would likely restart this administrative process and she would receive appropriate information directly from the Center. Respondent Jansson filed an abbreviated response in the body of the July 23, 2008 email message.

Subsequently on July 25, 2008, Respondent Jansson filed, by email with the Center, a formal response, together with Annexes 1-4.

In the interests of fairness particularly in light of the late identification of Respondent Jansson and the rather unorthodox manner in which she ultimately received a copy of the

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Complaint, the Panel, in spite of the delay with which the Response has been filed, has nevertheless accepted and fully considered her Response. Given this, the Panel sees no valid reason to require the Center to restart this administrative process and require that both of the Respondents, particularly Respondent Jansson, be formally served with the Complaint and then require Respondent Jansson to re-file her Response during the ensuing response period. Doing so would basically incur duplicative effort and unnecessary cost on all concerned including the Center, and also unduly delay the Panel's ultimate resolution of this matter.

This dispute concerns one domain name, specifically: < sheffield57resident.com >.

The language of this proceeding is English.

4. Factual Background

As indicated in the WhoIs registration record provided in Annex 1 to the Complaint, the Respondent registered the disputed domain name on September 18, 2007, with the registration expiring on September 18, 2008.

A. The Complainant's SHEFFIELD57 Mark

The Complainant currently owns a United States of America ("US") trademark registration for its mark SHEFFIELD57. The Complainant has provided, in Exhibit 1 to Annex 6 (Declaration of Mr. Swig) to the Complaint, a hard-copy printout of the entry for this mark in the publicly available on-line TARR (Trademark Applications and Registrations Retrieval) database provided by the US Patent and Trademark Office. Pertinent details of that registration are as follows:

1. SHEFFIELD57 (stylized) US registration 3,268,376; registered: July 24, 2007

This mark is currently registered for use in connection with "real estate agencies; real estate brokerage" in International class 36. The registrant claims that both first use and first use in commerce of this mark when used in conjunction with these services commenced as of September 10, 2006.

B. The Complainant and its activities

The Complainant develops, manages and markets real estate. In 2005, the Complainant acquired a 27-year old apartment building located at 322 West 57th Street, New York, New York which was then and still is known as the "SHEFFIELD57 Building". The Complainant acquired the building with an intent to subsequently convert it into condominiums. To effectuate the conversion, on July 19, 2007, the Complainant recorded the "SHEFFIELD57 Declaration of Condominium" in the Office of the City Register in the City of New York. The Complainant then began and is currently renovating and upgrading the building as part of the conversion process. (Declaration of Mr. Swig ("Swig Declaration") which appears in Annex 6 to the Complaint), for which it has received publicity in the local news media.

The Complainant advertises and markets its building and related services through diverse media, including major, national publications such as *The New York Times*, through signage on the building itself and various marketing materials available at the building (at which the condominiums are actually sold) and through its website at "www.sheffield57.com". The Complainant has provided copies of various marketing materials in Swig Declaration Annex 6, Exhibits 2 and 3, and pictures of the building showing its signage in Annex 6, Exhibit 4.

As of the date of the Complaint, May 12, 2008, the Complainant has sold and closed on a number of condominium units in the building.

Various prior tenants, here being holdover occupants, in the building have apparently objected to its conversion from apartments to condominiums and have not vacated their apartments even though their leases for those apartments have expired. As such, the Complainant has filed a number of civil actions to legally evict those tenants from the building. Further, a number of those tenants have privately demanded that the Complainant offer them units in the building at sub-market prices (see Swig Declaration).

C. Respondent Jansson and her activities

The disputed domain name was registered, under a privacy shield, by Respondent C/O Mecca Hosting on behalf of Respondent Jansson. Though her identity as the actual registrant was not known to the Complainant since at the time it filed the Complaint and last amended it on May 28, 2008, Respondent was

C/O Mecca Hosting. Subsequently on June 17, 2008 and in response to a request from the Center, Respondent C/O Mecca Hosting disclosed Respondent Jansson's identity as the actual registrant, and provided requisite contact information it then had on file for her.

Respondent Jansson is a resident of the SHEFFIELD57 building.

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Her website, to which the disputed domain name resolves, provides information critical of the Complainant and its efforts in renovating and converting the SHEFFIELD57 building into condominiums, and the then current physical condition of the building. For example and as shown in hard-copy printouts of pages from that site and provided in the Swig Declaration, Annex 6, Exhibit 7, one of the pages of the website bears the heading "Information about Sheffield 57" and immediately below that in a relatively larger font: "WHAT YOU MUST KNOW AS A BUYER OR INVESTOR — FACTS THAT CURRENT RESIDENTS ALREADY KNOW". Immediately below the latter text is the following:

"ADVERTISING

BUYER, ARE YOU AWARE that the amenities advertised by Swig are not there? Ask to see the swimming pool, driveway, weightroom

Advertisements show a nice driveway in front of the Sheffield lobby connecting 56 and 57 st.

FACT, THERE IS NO PERMIT FOR THIS DRIVEWAY. THEY MAY NEVER GET ONE.

The intended driveway is part of a public plaza. Permission from the City of New York is needed and they are having trouble getting it."

Other information is provided on the website (also shown in the pages provided in the Swig Declaration, Exhibit 6, Annex 7) as to Respondent Jansson's views concerning the building, e.g., the condition of various floors as having squeaks, the presence of asbestos in popcorn ceilings and tiles, and so forth, and, as a result and from her perspective, that the Complainant's advertising for the building is deceptive.

The website, by clicking on a link marked "DISCLAIMER" on the home page, displays a page (a copy of which also appears in the Swig Declaration, Exhibit 6, Annex 7) with the heading in relatively large font: "SHEFFIELD 57 RESIDENT" followed immediately below, in a smaller font with the text:

"DISCLAIMER

This material reflect the opinions of rental tenants at the Sheffield and does not necessarily represent the opinions of all the residents. Information contained herein can be verified on public websites or by visiting the building."

The Complainant takes serious issue with and disputes the information provided by Respondent Jansson on her website as to its veracity and that the Complainant's advertising, as contended by Respondent Jansson, is in any way deceptive.

5. Parties' Contentions

A. Complainant

(i) Identical or Confusingly Similar

The Complainant contends that the disputed domain name is confusingly similar to the Complainant's SHEFFIELD57 Mark.

Here, the Complainant states that the name incorporates its SHEFFIELD57 mark followed by the generic word "resident", with the addition of that word being insufficient to reduce any confusion resulting between the Respondent's use of the name and the Complainant's mark.

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

(ii) Rights or Legitimate Interests

The Complainant contends that, for any of several reasons, the Respondent has no rights or legitimate interests in the disputed domain name pursuant to paragraphs 4(a)(ii) and in particular, 4(c) of the Policy.

First, the Complainant states the name is not the legal name of the Respondent nor is the Respondent known by that name.

Second, the Complainant states that it has never authorized or granted permission to the Respondent to use the Complainant's mark.

Third, the Complainant contends that inasmuch as the disputed domain name includes the Complainant's mark, the Respondent is not using its website in connection with a *bona fide* offering of goods or services. In that

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regard, while the Complainant recognizes that the Respondent may have a right to refer to the mark in critical comment, but by appropriating the mark in its entirety and without any distinguishing material in the disputed domain name and thus without any criticism apparent from the name itself, use of the name here does not constitute fair use, citing to *Council of American Survey Research Organizations v. The Consumer Information Organization LLC, aka Pinelands Web Services*, WIPO Case No. D2002-0377 (July 19, 2002). Further, the Complainant, citing to *Monty and Pat Roberts, Inc. v. Keith*, WIPO Case No. D2000-0299 (June 9, 2000) contends that even though criticism is apparent from content on the website itself, there is nothing in the name to evidence that it is being used for a site devoted to criticism. Thus, the Complainant concludes that the Respondent cannot claim any legitimate rights in the disputed domain name, which includes the Complainant's mark, simply by virtue of any First Amendment (free speech) rights to use that mark in critical speech within the content of the website itself.

(iii) Registered and Used in Bad Faith

The Complainant contends that the Respondent registered and is now using the disputed domain name in bad faith under paragraph 4(a)(iii) of the Policy.

As a predicate, the Complainant argues that holdover occupants in the SHEFFIELD57 building have a natural economic self-interest in financially benefiting from any damage they could

cause to Complainant's efforts to market condominium units in the building (see Swig Declaration). Specifically, by disrupting the Complainant's marketing efforts, those occupants could potentially adversely impact the sales of those units. By doing so or just threatening to do so, the Respondent could gain leverage and hence an unfair advantage against the Complainant in an effort to secure sub-market prices to purchase units in the building and thus benefit financially at the Complainant's expense.

As evidence of the Respondent's (Jansson's) actions to unfairly achieve such leverage, the Complainant points to the content of the Respondent's website which provides misleading characterizations of both the Complainant and the condition of the building itself, as well as to other specific actions of the Respondent. These actions include the Respondent's intentional unauthorized use of the Complainant's mark in the disputed domain name to cause initial interest confusion. In that regard, by virtue of current naming conventions used on the Internet, potential purchasers or other interested parties seeking information on the Complainant's condominium units in the SHEFFIELD57 building may very likely form and use the disputed domain name to reach the Complainant's website. However, by entering the name into their browsers, those individuals are instead diverted to the Respondent's website and therethrough exposed to misleading and inaccurate statements that are damaging to the Complainant and its building. Further, even apart from the damaging information on the Respondent's website, such diversion deprives the Complainant of Internet traffic that it would otherwise attain.

Given this, the Complainant alleges that the Respondent's efforts in both registering and using the name to disrupt the Complainant's business evidences bad faith under paragraph 4(b)(iii) of the Policy.

Lastly, bad faith is also shown by the Respondent Jansson's use of a privacy screen, here being Respondent C/O Mecca Holding, to disguise her true identity as the actual registrant of the name.

B. Respondent

Through its email message of June 17, 2008, Respondent C/O Mecca stated that it is solely a domain name reseller which provides a privacy feature, and identified Respondent Jansson as the actual registrant of the disputed domain name and provided contact information for that registrant.

Basically, Respondent Jansson, through the Response, contends that:

- (a) the domain name, due to its inclusion of the term "resident" is not confusingly similar to the Complainant's mark SHEFFIELD57;
- (b) as a resident of the SHEFFIELD57 building, she has legitimate rights and interests in the name as it reflects her current status; and
- (c) since her website solely provides critical speech, by way of complaints as to the condition of the building, and has no commercial activity and does not divert

potential customers for the building's condominiums to any other building, her use and

registration of the name were not in bad faith.

Further, Respondent Jansson contends that inclusion of the term “resident” in the disputed domain name implies that the name is associated with content posted by or concerned with a resident of the SHEFFIELD57 building. As such, a potential non-resident purchaser for any condominium unit in the building, seeking to reach an appropriate website operated by the Complainant, is not likely to form a domain name that includes the term “resident” in order to reach such a site; though she concedes that a building resident could be a potential purchaser.

6. Discussion and Findings

A. Identical or Confusingly Similar

The Panel finds that the disputed domain name is confusingly similar to the Complainant’s SHEFFIELD57 Mark.

[1] From a simple comparison of the disputed domain name, <sheffield57resident.com >, to the Complainant’s mark, no doubt exists that the name is confusingly similar to the mark.

The only differences between the disputed domain name and the mark SHEFFIELD57 are the addition of the generic word “resident” as a suffix to that mark to form a composite term “sheffield57resident”, along with appending the gTLD (generic top level domain) “.com” to that term to form the name – with the last addition being irrelevant in assessing confusing similarity or identity under paragraph 4(a) of the Policy and thus ignored.

It is now very well-established in UDRP precedent, including numerous decisions previously rendered by this Panel, that a minor variation, such as adding short letter or number groups or even generic or highly descriptive words to a mark, is usually insufficient in and of itself, when used in forming a domain name that results from modifying the mark, to confer requisite and sufficient distinctiveness to that name to avoid user confusion. Here, adding the generic word “resident”, to the mark SHEFFIELD57 is clearly one such minor variation. See, e.g., *Dreamworks Animation, LLC v. Creahq, Mike Furlong*, WIPO Case No. D2008-0505 (May 28, 2008); *Marvel Manufacturing Company Inc. v. Koba Internet Sales, LF*, WIPO Case No. D2008-0265 [87 USPQ2d 1276] (May 5, 2008); *MySpace, Inc. v. Edwin De Jesus, EDJ Associates Inc.*, WIPO Case No. D2007-1878 (March 12, 2008); *BlackRock, Inc. v. blackrockfinancialservices.com*, WIPO Case No. D2007-1627 (January 4, 2008); *F. Hoffmann-La Roche AG v. Transliner Consultants*, WIPO Case No. D2007-1359 (November 14, 2007); *National Football League v. Peter Blucher d/b/a BluTech Tickets*, WIPO Case No. D2007-1064 (September 24, 2007); *Toilets.com, Inc. v. Rons Porta Johns*, WIPO Case No. D2007-0952 (August 27, 2007); *Associated Bank Corp. v. Texas International Property Associates*, WIPO Case No. D2007-0334 (June 28, 2007); *Gerber Childrenswear Inc. v. David Webb*, WIPO Case No. D2007-0317 (April 24, 2007); *SPX Corp. v. Hevun Diversified Corp.*, NAF Case No. FA791657 [81 USPQ2d 1621] (November 13, 2006); *Google Inc. v. Burns*, NAF Case No. FA726096 (August 16, 2006); *The Cheesecake Factory Inc. and The Cheesecake Factory Assets Co., LLC v. Say Cheesecake*, WIPO Case No. D2005-0766 (September 12,

2005); *Napster, Inc. v. Vinscani*, WIPO Case No. D2005-0531 (July 19, 2005); *Caesars Entertainment Inc. v. Nova Internet Inc.*, WIPO Case No. D2005-0411 (June 22, 2005); *Lockheed Martin Corporation v. The Skunkworx Custom Cycle*, WIPO Case No. D2004-0824 [74 USPQ2d 1486] (January 18, 2005); *Lockheed Martin Corp. v. Deborah Teramani*, WIPO Case No. D2004-0836 (December 1, 2004) and *National Collegiate Athletic Assoc. v. Dusty Brown*, WIPO Case No. D2004-0491 (August 30, 2004); *Lane-Labs USA, Inc. v. Powell Productions*, NAF Case No. FA155896 (July 1, 2003); and particularly *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).

Therefore, the Panel finds that the disputed domain name is confusingly similar to the Complainant's SHEFFIELD57 Mark as to cause confusion; hence, the Complainant has satisfied its burden under paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

The Panel, despite the Complainant's rather emphatic assertions to the contrary, finds that the Respondent has established rights and legitimate

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interests in the disputed domain name under paragraph 4(c)(iii) of the Policy.

[2] When distilled to its kernel, this dispute involves a so-called "gripe site" operated by Respondent Jansson, as a resident of the SHEFFIELD57 building, which: (a) solely contained speech critical of the Complainant and its efforts in converting that building from apartments into condominiums, and (b) is addressed by the disputed domain name which incorporates the Complainant's trademark SHEFFIELD57 followed by the term "resident". The Complaint now seeks transfer of the domain name based on its rights in the mark. There is no evidence of record that Respondent Jansson engaged in any commercial activity through her website or sought to financially benefit in any way from her use of the domain name.

As this Panel noted in *Citgo Petroleum Corporation v. Richard Antinore*, WIPO Case No. D2006-1576 (March 14, 2007), websites that serve as a medium through which a respondent posts its negative views may be broadly and generically referred to as "gripe sites." It is now rather well established in UDRP precedent that, at least in cases involving parties based in the US, a respondent's site that solely provides criticism, regardless of the severity or directness of that criticism, is protected under the First Amendment to the US Constitution as being an exercise of that respondent's right of free speech. However, such protection is not absolute. If the respondent engages in actions that evince bad faith, and particularly conduct that commercially exploits the name for the respondent's pecuniary benefit, thus indicating that the respondent's intentions were not aimed solely at providing critical comment, then any such protection which would otherwise arise is lost.

Such was the situation in *Citgo*. There, the respondent used the domain names <nomocitgo.com> and <nomocitgo.org> as addresses of a website containing comment critical of the government of Venezuela, which owned the complainant Citgo, and also offered to sell each of these two and other similar names and the gripe site itself to the

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complainant for a total of USD 10,500 –a sum far in excess of the costs of registering the names. This Panel held that when the facts were viewed in their totality of the evidence, the respondent's primary purpose was not to disseminate critical speech but rather to coerce the complainant into purchasing his gripe site and the domain names and thus extort a significant sum of money for the cessation of respondent's negative criticism, hence effectively forcing the complainant to pay to silence the respondent. Thus, this Panel concluded that the respondent had no rights or legitimate interests in either of those domain names.

Also, see *National Collegiate Athletic Association v. Dusty Brown*, WIPO Case No. D2004-0491 (August 30, 2004) where this Panel came to a similar conclusion regarding domain names, <ncaafootball2005.com> and <ncaafootball2006.com>, used as addresses of a gripe site containing critical comment of complainant NCAA but where the respondent also demanded payment of a considerable sum (in excess of USD10,000) from the complainant for transfer of these names. Since the over-riding purpose behind the respondent's actions was to extort revenue from the NCAA to the respondent's own benefit rather than solely disseminate critical content, this Panel concluded, as it subsequently did in *Citgo*, that the respondent had no rights or legitimate interests in either of the domain names.

In each instance, as under the present facts, the domain name not only included a complainant's trademark but other terms, whether it be words as in *Citgo* or numbers as in *National Collegiate Athletic Association*.

However, what clearly distinguishes the present dispute from either *Citgo* or *National Collegiate Athletic Association* is the total absence on the record of any evidence whatsoever showing that Respondent Jansson's purpose in registering and using the disputed domain name was anything other than to disseminate her criticism of the Complainant. There is no evidence that she ever offered the disputed domain name for sale to the Complainant or anyone else, let alone at a price in excess of its costs of registration. There is no evidence from the website content itself –as supplied by the Complainant– of any commercial activity associated with the site. Internet visitors to her site are neither presented with any offers to purchase any items nor are they directed to any website that offers condominium units that compete with those in the SHEFFIELD57 building. All that Respondent's Jansson's website contains is criticism, nothing more.

Other than to observe that Ms. Jansson's website solely contains critical speech, this

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Panel expresses no opinion as to the veracity of any criticism appearing on that site. Any such inquiry will likely entail extensive fact-finding and expert testimony and lies well beyond the rather confined jurisdiction of a UDRP administrative proceeding. Hence, this Panel defers all such inquiries, should the Complainant intend to pursue the matter, to an appropriate judicial forum for resolution.

Since the Panel finds that the over-riding, if not sole, purpose of Respondent Jansson's website is to disseminate her critical speech to others similarly interested, such use of the disputed domain name constitutes legitimate fair use under paragraph 4(c)(iii) of the Policy.

Full Text of Cases (USPQ2d)

Moreover, the Complaint, citing to *Council of American Survey Research Organizations v. The Consumer Information Organization, LLC, aka Pinelands Web Services*, WIPO Case No. D2002-0377 (July 19, 2002) and *Monty and Pat Roberts, Inc. v. Bill Keith*, WIPO Case No. D2000-0299 (June 9, 2000), argues that even though criticism is apparent from the content of the Respondent's (Ms. Jansson's) website, there is nothing in the name to indicate that the site is devoted to criticism. This Panel disagrees. Each of those two cases concerns a domain name which, apart from a gTLD (".com" in one, ".net" in the other) and other minor variations (such as a missing space) –all of which are of no consequence, solely consisted of a complainant's mark. In the first case, the domain name was simply <casro.com>; in the second case the domain name was <montyroberts.net>, in effect forming in each instance a domain name of the form "trademark.gTLD". Clearly, an ordinary third-party Internet viewer, when faced with each name, will merely gain an overall impression of or identify that name in terms of the commonly understood connotation, i.e., its secondary meaning, associated with its corresponding mark and nothing more. There is simply no additional term(s), whether words and/or numbers, in each domain name that would lead to a different result. Therefore, when each name were used in each of these cases as an address to a gripe site (i.e., trademark.gTLD), the corresponding panel justifiably found that such use disparaged the reputation associated with the corresponding mark and was illegitimate. Specifically, the panel in *Council of American Survey Research Organizations*, noted:

"Although, Respondent may have a right to refer to the mark in critical content, the wholesale appropriation of Complainant's mark, without any distinguishing material, creates confusion with Complainant's business and is not fair use merely for the purpose of criticism. No criticism is apparent from the domain name itself."

Similarly, in *Monty and Pat Roberts*, the panel there stated:

"In the instant case, the Panel does not dispute Respondent's right to establish and maintain a website critical of Complainant However, the panel does not consider that this gives Respondent the right to identify itself as Complainant."

See also, *Howard Jarvis Taxpayers Association v. Paul McCauley*, WIPO Case No. D2004-0014 (April 22, 2004) where the domain name at issue, <hjta.com> also serving as an address of a gripe site sharply critical of the stance advocated by the Complainant, contained the Complainant's mark, HTJA without any other terms. Since the website evidenced no activity by the respondent for its own commercial gain, the panel, in a thorough and well-reasoned decision, concluded that the respondent had legitimate interests in the name and thus denied transfer of the name.

In the present case, the name at issue is not formed solely of the Complainant's mark "SHEEFIELD57"; it also contains a succeeding term "resident". While Complaint views this latter term as inconsequential, its view is seriously misplaced. The term "resident", when added to the mark, causes the entire name to be sufficiently distinguishable from the mark.

While the addition of the term "resident" is insufficient to distinguish the disputed domain name from the Complainant's mark for purposes of assessing confusing similarity, it suffices

here to dramatically change the meaning, identification or overall impression of that name, in the minds of ordinary Internet users, from that associated with the mark itself, SHEFFIELED57, to that associated with the specific nature or source of the content on the accessed website, i.e., here being an address of a site containing commentary from residents of the building (which in fact the site solely provided). By so doing, that change legitimizes the use of the name.

In assessing the meaning of a domain name, the name must be viewed in its entirety, i.e.,

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as a unified entity, rather than, as Complainant attempts to do, by being dissected into its component portions with the meaning of each portion determined in isolation. Clearly, it stands to reason, that the overall impression conveyed by the term “sheffield57 resident”, when used as an address of a website, and as defined by the common ordinary meanings of its constituent portions taken together and at least to persons knowledgeable about the Complainant’s activities involving the building, is that of a website having content of interest to residents of the SHEFFIELD57 building. Regardless of what that content is or whether any of it is true or not, the name clearly and plainly describes the intended source or target of that content: those who actually reside in the SHEFFIELD57 building.

Such use, as this Panel finds, is not likely to disparage or even affect the reputation enjoyed by the underlying trademark or cause any initial interest confusion to either those Internet users who then seek out the Complainant to inquire about purchasing a condominium unit in the building, by entering the Complainant’s domain name <sheffield57.com>, or those who, by entry of the disputed domain name, seek out comment from residents of that building. By incorporating the term “resident” within the disputed domain name, the resulting composite name itself unambiguously informs any Internet viewer that Respondent Jansson is not identifying herself as the Complainant and effectively dispels any initial interest confusion that would otherwise likely arise were Respondent Jansson to use a domain name—which she is not—that contained the mark SHEFFIELD57 without more.

Further, the term “resident” is not a pejorative term and certainly not one that is commonly used in domain names which have been viewed as legitimately addressing gripe sites—such as “sucks” as in <xsucks.com> (where x is a trademark of an intended target of criticism). When used in that context as a suffix to a mark, the term “sucks” changes, with respect to the name, the connotation associated with the mark alone to an overall impression, which is now nearly universally recognized throughout the English-speaking Internet user community, as being an address of a website having comment sharply critical to the owner of the mark. Yet, this Panel believes that, in appropriate circumstances, as here, use of a non-pejorative term, in conjunction with a mark, may well suffice to sufficiently distinguish the meaning, identification or overall impression associated with the resulting domain name, when used as an address of a website solely providing commentary of any sort, whether critical or otherwise, from that associated with the mark itself so as to avoid confusion and ultimately disparagement of the mark, and thus legitimize the use of the name as fair use under paragraph 4(c)(iii) of the Policy.

Therefore, the Respondent has rights and legitimate interests in the disputed domain name under paragraph 4(c) of the Policy. Consequently, the Complainant has not satisfied its

burden under paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

In light of the Panel's findings immediately above regarding paragraph 4(a)(ii), all issues concerning whether the Respondent registered and used the disputed domain name in bad faith are now moot. Hence, the Panel sees no need, despite the Complainant's fervent allegations and arguments to the contrary, to opine on such issues. See, e.g., *Marvel Mfg. Co, Inc. cited supra*; *Groovr, Inc. v. Active Interactive, Inc.*, NAF Case No. FA1103425 (December 18, 2007); *CPFilms, Inc. v. Solar Lunar Performance Film*, NAF Case No. FA861127 (February 6, 2007); *Hugo Daniel Barbaca Bejinha v. Whois Guard Protected*, NAF Case No. FA836538 (December 28, 2006); and *Pom Wonderful LLC v. Redavid*, NAF Case. No. FA846577 (January 8, 2006).

Inasmuch as Complainant has failed to meet its burden under paragraph 4(a)(ii) of the Policy, it has failed to establish a case for relief under paragraph 4(a).

7. Decision

Accordingly, under paragraph 15 of the Rules, the relief sought by the Complainant is hereby denied.

The Center shall send a copy of this decision to Respondent Jansson in addition to the two parties specified in the case caption.

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- End of Case -
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