



DECISION

Meijer, Inc. v. Porksandwich Web Services
Claim Number: FA0105000097186

PARTIES

The Complainant is **Meijer, Inc.**, Grand Rapids, MI, USA (“Complainant”) represented by **Chadwick C. Busk**. The Respondent is **Porksandwich Web Services**, Lafayette, IN, USA (“Respondent”) represented by **Michael H. Payne**.

REGISTRAR AND DISPUTED DOMAIN NAMES

The domain names at issue are <**meijerphoto.com**> and <**meijerphotolab.com**>, registered with **NameSecure**.

PANEL

The undersigned certifies that he has acted independently and impartially and to the best of his 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 to the National Arbitration Forum (“the Forum”) electronically on May 10, 2001; the Forum received a hard copy of the Complaint, together with Annexes A-I, on May 14, 2001.

On May 11, 2001, NameSecure confirmed by e-mail to the Forum that the domain names <**meijerphoto.com**> and <**meijerphotolab.com**> are registered with NameSecure and that the Respondent is the current registrant of the name. NameSecure has verified that Respondent is bound by the NameSecure registration agreement and has thereby agreed to resolve domain-name disputes brought by third parties in accordance with ICANN's Uniform Domain Name Dispute Resolution Policy.

On May 23, 2001, a Notification of Complaint and Commencement of Administrative Proceeding (the "Commencement Notification"), setting a deadline of June 12, 2001 by which Respondent could file a Response to the Complaint, was transmitted to Respondent via e-mail, post and fax, to all entities and persons listed on Respondent's registration as technical, administrative and billing contacts, and to postmaster@meijerphoto.com and postmaster@meijerphotolab.com by e-mail.

The Forum received a Response, together with Annexes A-T, on June 13, 2001, one day past the deadline. Apart from its late filing, the Response was complete. In the interests of fairness, particularly since the Response was only one day late, the Panel has accepted and fully considered the Response as if it were timely filed.

On June 21, 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.

RELIEF SOUGHT

The Complainant requests that both contested domain names be transferred from the Respondent to the Complainant.

PARTIES' CONTENTIONS

A. Complainant

1. Confusing similarity/identity

The Complainant contends that each of the contested domain names is identical or at least confusingly similar to the Complainant's registered "Meijer" mark as well as its common law marks in "Meijer Photo" and "Meijer Photo Lab", therefore satisfying the confusing similarity requirement in paragraph 4(a) of the Policy.

In that regard, the Complainant contends that it has exclusive common law trademark rights in the marks "Meijer Photo" and "Meijer Photo Lab" by reason of its first use of these marks in the geographical areas in which it does business, including Indiana, where the Respondent resides.

2. Legitimacy

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

First, the Complainant takes the position that the Respondent is not entitled to use either of the contested domain names as a way to voice his legitimate consumer criticism of the Complainant because neither of those names signifies its use for purposes of parody or criticism. In that regard and as the Panel understands, the Complainant appears to be contending that the Respondent's purpose in using either of these domain names as a web address for his complaint site, i.e., a site independent of the Complainant but which presents a forum for criticism of the Complainant, is not apparent from that name alone. Such a user, upon entering that name would think (s)he was accessing a site affiliated with the Complainant but, in fact, would reach the Respondent's complaint site; hence causing confusion.

The Complainant further contends that where contested domain names that included trademarks or service marks of complainants were used by respondents as addresses for complaint sites that voiced criticism of those complainants, such use was sanctioned by various panels provided those domain names included another word that indicated that the name was being used as a vehicle to provide parody or criticism. Specifically, the Complainant points to various pejorative terms, such "sucks" or "stinks" which, when appended to a mark of a third party complainant to form a contested domain name, clearly indicated that the use of the name was in conjunction with a site that provided critical comment of that complainant. In that regard, the Complainant points to *Wal-Mart Stores, Inc. v. wallmartcanadasucks.com* D2000-1104 (WIPO Nov. 23, 2000) where an administrative panel found that the respondent had rights or legitimate interests in respect of the domain name WALLMARTCANADASUCKS.COM to use it as a foundation for criticism of complainant Wal-Mart. There, the panel stated that "it is critical whether the accused domain name itself signifies parodic or critical purposes, as opposed to imitation of trademark." Since neither of the contested domain names here includes any pejorative term which would clearly denote the purpose for which that name was being used and hence ameliorate user confusion, the Complainant contends that the Respondent is tarnishing the Complainant's marks and more generally harming the Complainant's "reputation and ability to effectively advertise and sell its photo lab goods and services from its stores and over the Internet".

Additionally, the Complainant contends that the Respondent's registration and use of the contested domain names as addresses for its complaint site does not constitute fair use inasmuch as that use inherently and inevitably misleads and diverts users, and in particular customers of the Complainant, to the Respondent's website.

In that regard, the Complainant cites to *E. & J. Gallo v. Hanna Law Firm* D2000-0615 (WIPO Aug. 3, 2000) where a domain name at issue and the complainant's trademark

were nearly identical to each other. Though the respective parties were not competitors, the panel found that the domain name was used to "(a) to induce a visitor to a site in order to criticize the very entity whose name is used as the address for the site, and (b) to divert the visitor from a legitimate site authorized by the entity." In ordering transfer of the contested domain name, the panel held that: "The right to express one's views is not the same as the right to use another's name to identify oneself as the source of those views."

The Complainant distinguishes the prior panel decisions, discussed by the Respondent, in *Bridgestone Firestone et al. v. Myers* D2000-0190 (WIPO July 6, 2000) and *TMP Worldwide Inc. v. Potter* D2000-0536 (WIPO Aug. 5, 2000) in which respective panels refused to transfer trademarked domain names to the trademark holders in recognition of both respondents' rights to use the trademarks for noncommercial purposes, i.e., criticism of the complainants. Specifically, the Complainant notes that the contested domain names in *Bridgestone* and *TMP* did not involve a ".com" gTLD (generic top level domain), rather those ending ".net" and ".org." gTLDs. Both panels viewed this fact as being important inasmuch as the absence of the respondents' ".com" domain names made it clear to Internet users that the sites were non-commercial in nature. Second, the respondent in *Bridgestone* posted disclaimers on his website as to its source, so that a "reasonably prudent Internet user can tell that the site is not the trademark holder's 'official' site."

The Complainant then argues that, the facts in the *Bridgestone* and *TMP* decisions are clearly distinguishable from those here, inasmuch as:

- (a) the Respondent has registered and is using Complainant's "Meijer Photo" and "Meijer Photo Lab" trademarks as ".com" domain names, which in itself suggests a commercial purpose;
- (b) as of the date of the Complaint, the Respondent has no disclaimers on its website and in fact posts the Complainant's name, address, and phone number on the Respondent's home page at **meijerphoto.com** along with an unauthorized hyperlink to the Complainant's web form (as shown in Annex H to the Complaint) for submitting a message to the Complainant's Public and Consumer Affairs Department on the Complainant's website;
- (c) the Respondent's website contains false and disparaging factual and legal conclusions about the Complainant's photo lab business (i.e., that Meijer is negligent; Meijer has ruined the photos of scores of customers) without any proof, whatsoever. In that regard, the Complainant points to a sole posting (a copy of which appears in Annex F to the Complaint) on the discussion forum on the Respondent's website that originated from a customer of the Complainant and describes a very positive experience with the Complainant's photo lab.

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

3. Bad Faith

The Complainant contends that, for each of several reasons, the Respondent registered and is using both contested domain names in bad faith.

Specifically, the Complainant takes the position that the Respondent's primary purpose in registering and using the **MEJERPHOTO.COM** and **MEJERPHOTOLAB.COM** domain names is not to voice a legitimate consumer complaint, but rather to tarnish and disparage the "Meijer Photo" and "Meijer Photo Lab" names and the goods and services sold at each Meijer Photo lab located in the approximately 140 Meijer stores in Michigan, Ohio, Kentucky, Illinois, and Indiana and over the Internet.

The Complainant states that various courts have determined that a web site operated by an unhappy consumer under a domain name containing a plaintiff's trademark was used in bad faith where the consumer's allegations are false and reflect an intent to use the plaintiff's registered mark to harm the company's reputation and ability to do business on the Internet. For example, in *Cardservice Int'l, Inc. v. McGee* 950 F. Supp. 737 (E.D. Va. 1997), *aff'd mem.*, 129 F. 3d 1258 (4th Cir. 1998), a trademark owner with superior rights was granted injunctive relief against the owner of the domain name equivalent of its mark, where the domain name registrant, after receiving a cease and desist letter from the plaintiff, turned his site into a consumer criticism location and threatened to "bad mouth the heck out of" the plaintiff. *Id.* at 742. Among other things, the defendant posted statements on the disputed site accusing plaintiff of trying to steal his domain name; used the disputed site to refer visitors to plaintiff's competitors; and threatened to divert plaintiff's business to other locations. The court characterized these actions as "malicious;" not a "reasonable continuation" of ongoing litigation and indicative of "an intention . . . to use [plaintiff's] registered mark to harm the company's reputation and ability to do business on the Internet." *Id.* at 742-43.

The Complainant avers, through its sworn affidavit, a copy of which appears in Annex G to the Complaint, that the Respondent's allegation on his home page that the Complainant's "ongoing negligence" in the operation of its one-hour photo lab has resulted in "scores of people" having their photos destroyed is totally false. In that regard, the Complainant states that the Respondent has failed to produce these "scores" of unhappy Meijer customers to substantiate either his factual or legal conclusions. Given this, the Complainant concludes that these unfounded allegations clearly evidence Respondent's malicious intent to use Complainant's own trademarks and federally-registered service mark to harm the Complainant's reputation and ability to effectively advertise and sell its photo lab goods and services from its stores and over the Internet.

B. Respondent

1. Confusing similarity/identity

The Respondent contends that neither of the contested domain names is confusingly similar to the Complainant's "Meijer" mark. The Respondent notes that to further curtail any uncertainty, it has placed disclaimers in more than one area of its website; the first of which appears in its splash introduction, as indicated on Annexes A – G of the Response, and another on its index.html ("Home") page as indicated in Annex H to the Response.

As to the Complainant's marks, the Respondent acknowledges the Complainant's service mark registration and its various logos in Annexes C and D to the Complaint, which the Complainant uses in promoting its goods and services. Notwithstanding that, the Respondent states that both of these logos contain the phrase "Meijer one hour Photo Lab" or "Meijer 1 hour photolab", but neither of the terms "one hour" or "1 hour" appears in either of the contested domain names.

2. Legitimacy

The Respondent appears to contend that its use of the contested domain names is legitimate inasmuch as that use constitutes noncommercial and fair use without intent for commercial gain or to tarnish the Complainant's marks.

Specifically, the Respondent avers that it uses the contested domain names to promote awareness of what it believed to be negligent photo-finishing services provided by the Complainant and to provide a forum where individuals could "document their experiences with the photo-processing department at the Complainant's Lafayette, Indiana store" and post their views, both favorable and unfavorable, of those services.

The Respondent avers, in so doing, its intention was not to "defame, tarnish, or disparage Meijer's reputation, but to promote awareness of what we believe to be negligent service".

3. Bad Faith

The Respondent contends that it neither registered nor uses either of the contested domain names in bad faith.

In that regard, the Respondent stated that "We wanted a domain that was easy to remember, so we purchased **MEIJERPHOTO.COM**, assuming that if Meijer Corporate had any legitimate concerns about cybersquatting or the like, they would have already purchased/parked it."

Moreover, the Respondent states that "The original reason we used the phrase 'ongoing negligence' on our website stemmed from the enormous amount of similar experiences we encountered after only two days of casual conversation with co-workers".

Furthermore, in its Response, the Respondent averred the following apparently as evidence of its good faith registration:

"The original reason we used the phrase 'ongoing negligence' on our website stemmed from the enormous amount of similar experiences we encountered after only two days of casual conversation with co-workers. On April 19, 2001 I (Mike) was contacted via telephone by Chad Busk, representing Meijer Corporate. Busk informed me that my domain name was too similar to the Meijer trademark. He suggested a more acceptable domain name include a descriptive word, i.e. MEIJERPHOTOSUCKS.COM. Busk also requested that I remove the disclaimer from the site. I concurred, reiterating that we wish to avoid a legal proceeding. At this time we had not yet registered or purchased **MEIJERPHOTOLAB.COM** (That was done a week later fulfilling the request of Busk to include a descriptive word in the domain). We were not made aware that Meijer's offer of \$500 in gift certificates would only remain in effect until the close of business April 20, 2001 (the next day; hence this proceeding).

True, when this complaint was filed, our discussion forum only contained a meager two messages: our welcome message, and that of a loyal Meijer customer. Substantiated by Exhibits I – T, our forum has received plenty of attention since Mid May."

Furthermore, the Respondent stated that the Complainant already has a web address for the promotion of its photo finishing services at the following location:
www.meijer.com/photo navigable via www.meijer.com.

Hence, the Respondent contends that its actions do not reflect bad faith use and registration under paragraph 4(a)(iii) of the Policy.

FINDINGS

A copy of the WHOIS registration record for the contested domain names appears in Annex A to the Complaint. As indicated on that record, the Respondent registered, with Internet Domain Registrars, the contested domain name "**meijerphoto.com**" on March 11, 2001, and "**meijerphotolab.com**" on March 19, 2001.

The Complainant currently owns the following valid and subsisting United States service mark registration, a copy of which appears in Annex B to the Complaint, on which this dispute is based.

mark: MEIJER (stylized)

US registration 1,333,646; registered April 30, 1985

This service mark was registered for use in connection with:

"Automotive and vehicular service station services featuring gasoline, gasohol and/or diesel fuel; and dry cleaning services" all in international class 37;

"Retail photo finishing and film processing services" in international class 40; and

"Retail grocery store services; retail department store services; retail automotive and vehicular parts outlet services; retail liquor store services; retail bakery services; retail pharmacy services; restaurant and catering services; retail beauty salon and barber shop services; ice cream parlor services; retail watercraft and marine store services featuring sailboats, rowboats, prams, canoes, rafts, boat ladders, seats for watercraft, marine batteries, boat lights, oar locks, anchors, oars, paddles, life vests and cushions, boat horns, bilge pumps, boat car carriers, boat fenders, boat fuel tanks, lines and adapters, boat tie-down straps, rope, water skis, outboard motors and the like" all in international class 42.

This mark claims first use in commerce, for the services listed in all three classes, of April 23, 1984.

The Complainant owns and operates approximately 140 "supercenters" (selling food, clothing and general merchandise in the same store) throughout Illinois, Indiana, Ohio, Kentucky and Michigan. The Complainant is the 11th largest privately-held company in the United States (according to the *Forbes Private 500*) and employs almost 100,000 people. The Complainant is recognized as the first retailer to own and operate a supercenter in the United States and is an industry-leader in promoting the concept of "One-Stop Shopping."

Beginning around 1985, the Complainant opened one-hour photo processing labs in its stores and began to heavily advertise and promote this service to its customers. An early "Meijer One-Hour Photo Lab" logo is reproduced in Annex C to the Complaint. The phrases "Meijer Photo" and "Meijer Photo Lab" are essential parts of the logo. The latest version of the logo can be seen on the advertising brochure for the Complainant's photograph reconstruction services, a relevant excerpt of which appears in Annex D to the Complaint. The Complainant also heavily promotes its one-hour photo labs on its website, www.meijer.com, at the following location: www.meijer.com/photo/. The Complainant states that it soon plans to sell goods and services from the "photo lab" portion of its website.

The Respondent, Porksandwich Web Services, which is an unregistered business alias of Michael Payne, registered the contested domain names after the Meijer Photo Lab at the Lafayette, Indiana, Meijer store accidentally ruined two rolls of film during processing on April 9, 2001. Although Mr. Payne was approached by various Meijer personnel in an effort to reasonably compensate him for his loss, he refused all offers, insisting that he would not accept less than \$1,000.00. In that regard, Mr. Busk, Counsel for the

Complainant, recounts, as follows, the substance of what was apparently a telephone conversation he had with Mr. Payne on April 19, 2001:

"During the morning of April 19, 2001, I verbally contacted Mr. Payne with the following settlement offer. Meijer would give him \$500 in Meijer gift certificates, reimburse his \$50 registration fee for **MeijerPhoto.com**, and pay him another \$50 to register a mutually-acceptable domain name indicating legitimate consumer criticism of Meijer, in exchange for which he would assign the **MeijerPhoto.com** domain name to Meijer. (At the time of this offer, I was not aware that Payne had also registered **meijerphotolab.com**, nor did he advise me of such.) I gave him a deadline to accept this offer until the close of business on Friday, April 20, 2001. Payne did not accept this offer by that deadline or even contact me to discuss it further. The offer was not renewed, and we find ourselves in this proceeding."

Further, as reported by the Respondent, during the April 19, 2001 telephone conversation, Mr. Busk apparently suggested that an acceptable domain name would be one that includes a descriptive word, i.e., such as "sucks", apart from the Complainant's mark, thereby forming, e.g., "meijerphotosucks.com". Apparently, Mr. Busk also requested that the Respondent remove the disclaimer from the Respondent's website, though the record before the Panel does not reflect if this was to occur on the Respondent's site accessible through the contested domain name "meijerphoto" or on that accessible through the "acceptable" domain name. In any event, the Respondent concurred indicating it wished to avoid a legal proceeding.

One week later, the Respondent registered or purchased the other contested domain name "**meijerphotolab.com**" in an effort, it believed, to fulfill Mr. Busk's request to include a descriptive word in its "**meijerphoto.com**" domain name.

The Respondent was not aware that the Complainant's offer made on April 19, 2001 of \$500 in gift certificates would only remain in effect until the close of business on the next day.

On or about April 28, 2001, the Respondent changed the content of its home page at **MeijerPhoto.com**, alleging that first, the Complainant was engaged in the widespread loss of "scores" of customers' film rolls as a result of the Complainant's "ongoing negligence." A copy of Respondent's home page (as of the date this Complaint was filed) with this language appears in Annex F to the Complaint.

The contested domain name **meijerphotolab.com** is used by the Respondent to re-direct Internet users to its website at **meijerphoto.com**.

The Respondent's **meijerphoto.com** website includes a "Discussion Forum" for "people to share their experiences at the Meijer Photo Lab." As of the date the Complaint was filed, the messages posted on the Discussion Forum (a copy of which appear, as noted

above, in Annex F to the Complaint) consist only of a “welcome message” by “Mike and Raquel” and a message from a “Loyal Customer” stating in part that “As far as the One Hour Photo Lab goes, there isn’t anywhere else I would trust my photos.”

An affidavit (which appears in Annex G to the Complaint) of Steven M. Walden, Meijer Photo Operations Specialist for Central Indiana and Illinois, states that the loss of the Respondent’s film was the result of operator error, and the Meijer employee who attempted to process Respondent’s film has since been re-assigned to another area.

The Complainant states that at no time up to the date of this Complaint has Respondent had any notice on his **meijerphoto.com** web site disclaiming any affiliation with, or sponsorship by, Complainant’s Photo Lab business. In that regard, the Respondent has the Complainant's name, address, and phone number on the Respondent's own home page as well as a hyperlink to the Complainant's web-based form (seen in Annex H to the Complaint) accessible on the Complainant's meijer.com web site through which a message could be sent to the Complainant's Public and Consumer Affairs Department.

Since the filing of the Complaint, other comments, copies of which appear in Annexes I-T of the Response, regarding the Complainant's photo lab have been posted to the Respondent's Discussion Forum.

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 current use of each of the contested domain names.

In that regard, each of the contested domain names includes the Complainant's registered mark "MEIJER", which has clearly acquired requisite secondary meaning and

distinctiveness as a result of the Complainant's apparently continuous and rather extensive use since 1984 in its geographic market.

There can be no question here that each of the contested domain names, by virtue of its inclusion of the term "MIEJER", as currently used by the Respondent or by a third-party to which the Respondent might transfer that name, will likely cause user confusion.

Even apart from the rights inherent in its U.S. trademark registrations, the Complainant owns common law rights in the marks "Meijer Photo" and "Meijer Photo Lab", under which the Complainant can also base its claim under the Policy. In that regard, paragraph 4(a) of the Policy does not restrict its reach only to registered marks, but, as 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., *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).

Though the Respondent appears to argue that the term "one hour" or "1 hour" is an indispensable component of each of the Complainant's common law marks, the Panel believes that whether that term is or is not is immaterial. Each of the contested domain names includes not only the Complainant's registered mark but also dominant elements of its common law marks as to render that name so similar to those marks that user confusion, based on that similarity, is inevitable. See *Sears Roebuck and Co. v. Hanna Law Office* D2000-0669 (WIPO Sept. 8, 2000).

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 each of the contested domain names, were to start using that name in conjunction with goods and/or services similar to those provided by the Complainant under its various marks, 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 either of the contested domain names, 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; *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, Meijer, would think that a web site accessible by "**meijerphoto.com**" or "**meijerphotolab.com**" was not affiliated in some manner with the Complainant, particularly since the Complainant provides, and rather extensively in its trade area, photo finishing and processing services.

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

Rights or Legitimate Interests

Distilled 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 mark (either its registered mark or dominant portions of its common law mark) thereof, 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 "walmartcanadasucks.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.

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 recent 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. Tysys.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.

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 has established 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. Hence, it clearly stands to reason that the respondent should be put to its proof.

While the Complainant has suggested that the Respondent change the contested domain name "**meijerphoto.com**" to include the pejorative term "sucks", the Respondent intentionally choose not to do so and continued to use this name. Moreover, the Respondent additionally registered the other contested domain name "**meijerphotolab.com**".

Having proceeded in this fashion , the Panel believes that it was incumbent on the Respondent to prove why it had no reasonable, practical alternatives to the use of both of these domain names as the addresses of its complaint site.

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

Thus, the Panel finds that use of both of the contested domain names by the Respondent is illegitimate 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 both of the contested domain names.

Here, the Respondent, in spite of being placed on notice of the Complainant's position, not only ignored the Complainant's request to modify its domain name by including a pejorative term into that name -- such that the use of that name as an address of a complaint site having no connection with the Complainant would be clear to Internet users, but also continued use of that name and in additional registered the other contested domain name "**meijerphotolab.com**". Both of these domain names include, at the least, the registered mark of the Complainant. While neither the Complainant and Respondent compete, the Complainant, as discussed above, provides photo finishing and film

processing services -- which are the very services about which the Respondent's site airs complaints.

Internet site naming conventions are such that it is very plausible to contemplate that Internet users who seek the Complainant's photo-finishing and film processing services, particularly those who have seen the Complainant's common law marks, would form a domain name from what they perceive to be the dominant forms of those marks. 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 "**meijerphoto.com**" and/or "**meijerphotolab.com**" and then enter that name into his(her) browser. The Respondent, presumably knowing this, intentionally choose these names as the addresses for its complaint site. As a result, those users intent on reaching the Complainant's site are 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 not to do business with the Complainant. There can be no doubt, particularly after the Respondent chose to register the second contested domain name, of its calculated intent to cause user confusion and, by doing so, injure the Complainant's photo-finishing and film processing business by diverting those users away from doing business with the Complainant, either through its web site or even its traditional stores.

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

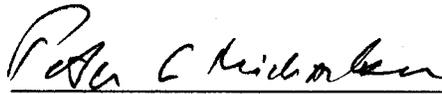
Moreover, since the Respondent has registered multiple domain names, each of which incorporates the Complainant's common law mark (or dominant portions thereof), the Respondent's conduct constitutes a pattern which has effectively prevented the Complainant from reflecting each of those marks in a corresponding domain name; hence constituting bad faith use and registration of each of the contested domain names in violation of paragraph 4(b)(ii) of the Policy.

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.

Both of the contested domain names, specifically "**meijerphoto.com**", and "**meijerphotolab.com**", are ordered TRANSFERRED to the Complainant.



PETER L. MICHAELSON, ESQ.
ARBITRATOR

Dated: July 6, 2001