

ANDERSON KILL & OLICK, P.C.

Attorneys and Counsellors at Law

1251 AVENUE OF THE AMERICAS ■ NEW YORK, NY 10020
TELEPHONE: 212-278-1000 ■ FAX: 212-278-1733
www.andersonkill.com

David A. Einhorn, Esq.
(212)278-1359
deinhorn@andersonkill.com

February 19, 2002

VIA EMAIL AND FACSIMILE 866-743-4517

Michelle Hultman
Case Coordinator
National Arbitration Forum

Re: Savin Corporation v. savinsucks.com
File No. FA0201000103982

Dear Ms. Hultman:

Please find attached Complainant's additional submission filed in response to Respondent's Response filed on February 12, 2002. We are transmitting the submission by email and the submission with attachments by facsimile and are serving the same on Respondent. We will provide National Arbitration Forum ("NAF") with payment for the Additional Submission by telephone with a credit card today.

Additionally, in response to your letter dated February 12, 2002 listing the 5 panelists from which the NAF will select a third panelist, Complainant strikes Honorable Charles McCotter and Honorable Daniel Banks, Jr. from the list.

Please feel free to call me at the above-listed telephone number should you require any further information with regard to this proceeding.

Very truly yours,

David A. Einhorn

Attachments

cc: Mr. Peter Sachs
savinsucks.com
76 Hawley Avenue
Milford, CT 06460
psachs@iconn.net

DCDOCS-66731.1



NATIONAL
ARBITRATION
FORUM

Savin Corporation)
333 Ludlow Street)
Stamford, CT 06902)
)
(Complainant))
)
v.)
)
savinsucks.com)
76 Hawley Avenue)
Milford, CT 06460)
)
(Respondent))
_____)

Domain Names In Dispute:
savinsucks.com

**ADDITIONAL SUBMISSION IN ACCORDANCE WITH
THE UNIFORM DOMAIN NAME DISPUTE RESOLUTION POLICY**

1. This Additional Submission is hereby submitted in response to Respondent's Response filed February 12, 2002 and in support of Complainant's Complaint in the above-captioned proceeding, for decision in accordance with the Uniform Domain Name Dispute Resolution Policy, adopted by the Internet Corporation for Assigned Names and Numbers (ICANN) on August 26, 1999 and approved by ICANN on October 24, 1999 (ICANN Policy), and the Rules for Uniform Domain Name Dispute Resolution Policy (ICANN Rules), adopted by ICANN on August 26, 1999 and approved by ICANN on October 24, 1999, and the National Arbitration Forum (NAF) Supplemental Rules (Supp. Rules). ICANN Rule 3(b)(i).

2. **COMPLAINANT INFORMATION**

Complainant's contact information remains the same as identified in the Complaint.

3. COMPLAINANT'S ARGUMENT

A. The Respondent's Domain Name Is Confusingly Similar to Complainant's Trademark SAVIN

As stated in Complainant's original Complaint, the Respondent's "savinsucks.com" domain name is confusingly similar to Complainant's SAVIN trademark. Complainant's Complaint supports this statement with numerous panel decisions under the ICANN Policy which hold that Respondent's use of Complainant's exact trademark in connection with a generic term creates a likelihood of confusion.

Respondent's only argument in support of the contention that these cases are not controlling precedent is the conclusory statement that Respondent is not a "cybersquatter." See Response at 2. Such a grand conclusion does not shed any light on the issues of the case. Complainant doubts that any of the respondents in the cited cases would have admitted that they were "cybersquatters." Moreover, whether or not Respondent may be labeled a "cybersquatter" is not determinative of whether the domain name savinsucks.com will cause confusion with Complainant's registered SAVIN mark. Respondent himself relies on a case that held a "sucks" domain name caused confusion with the incorporated mark. *Bloomberg L.P. v. Secaucus Group*, No. FA0104000097077 (NAF June 7, 2001) (holding "michaelbloombergsucks.com" caused confusion with MICHAEL BLOOMBERG).

Complainant's citation of the Lucent Technologies, Inc. v. LucentSucks.com, 95 F. Supp.2d 528 (E.D. Va 2000), is misplaced. The central issue of Lucent was jurisdiction. The case was filed before the effective date of the Anti-Cybersquatting Consumer Protection Act (the "ACPA") and was dismissed for lack jurisdiction. See id. at 535-536. The Court, in dictum, noted that it did not believe there could be a likelihood of confusion between the plaintiff's trademark and the defendant domain name, however, the court did not fully consider the issue. See id.; see also Wal-Mart Stores, Inc. v. Walsucks & Walmarket Puerto Rico, Case No. D2000-0477 (WIPO July 20, 2000)(explaining that Lucent did not analyze the domain name and trademark at issue in that case). The Wal-Mart Stores decision goes on to explain that "the court in LucentSucks.com overstates the holding of the district court in Bally Total Fitness, mistakenly indicating that the defendant in Bally Total Fitness had used Bally's mark in its domain name. This is not accurate. The defendant in Bally Total Fitness used Bally's mark on its web page, appending the word "sucks." Wal-Mart Stores, at n.12. This statement suggests that the dictum in Lucent may have been based on a cursory review of and an erroneous understanding of the precedent it cited.

Respondent cites Bally Total Fitness v. Faber, 29 F. Supp.2d 1161 (C.D. Cal 1998) for the proposition that savinsucks.com cannot be likely to cause confusion with the SAVIN mark. As just explained, Bally did not consider whether a domain name containing another's trademark next to the term "sucks," registered as a domain name, caused confusion with the trademark. Bally involved whether a web page heading, not a

registered domain name, that included the words "ballysucks" was likely to cause confusion with the mark BALLY. *See id.* at 1162 (considering the web page heading "www.compupix.com/ballysucks"); *see also Wal-Mart Stores*, Case No. D2000-0477 (WIPO July 20, 2000)(explaining that *Bally* did not involve a domain name or any second level domain, but only a web page). Thus, the *Bally* case dealt with a different scenario from the present case. Further, *Bally* was not decided under ICANN Policy that controls the outcome of this proceeding.

Respondent similarly cites *Lockheed Martin Corp. v. Parisi*, Case No. D2000-1015 (WIPO Jan. 26, 2001). *Lockheed* involved a domain name that was linked to a web site and offered consumer criticism of Lockheed Martin Corporation. Respondent has never used the domain name savinsucks.com in connection with any web site. Additionally, that decision expressly admits that it reached a decision contrary to the overwhelming majority of decisions addressing the issue of decisions addressing "-sucks.com" domain names and followed "[o]nly one" decision under the ICANN Policy permitting continued registration of such a web site. Lastly, like *Lucent*, *Lockheed* incorrectly refers to the *Bally* decision as having considered the domain name "ballysucks.com." Thus, the decision may have been based on an erroneous understanding of the legal precedent on which it relied.

That one case found by the *Lockheed* panel was *Wal-Mart Stores, Inc. v. walmartcanadasucks.com*, Case No. 2000-1104 (WIPO Nov. 23, 2000). Respondent cites to that decision as well. As stated in *Lockheed*, the *walmartcanadasucks.com* decision is contrary to the vast majority of panel decisions finding a likelihood of confusion in ordering the transfer of "-sucks.com" domain names. Further, *walmartcanadasucks.com* involved a domain name used in conjunction with a web site to disseminate consumer criticism and the panel expressly stated that such use by that respondent would not confuse viewers of the web site. The instant Respondent has made no such use of the domain name savinsucks.com. Thus, *walmartcanadasucks.com* is distinguishable from the facts of the present case.

The *walmartcanadasucks.com* panel also stated that the domain name itself signifies its "critical purpose" and consumers thus are aware that it is not sponsored by the complainant. However, Complainant submits that such a determination is not clear, especially given the breadth of the availability of the Internet and the World Wide Web to those whose first language is not English. *See Dixons Group PLC v. Purge I.T.*, Case No. D2000-0584 (WIPO Aug. 13, 2000)(holding dixonssucks.com to be likely to cause confusion with the mark DIXONS and noting that even though some users may be able to identify the domain name as pejorative, others may be unable to give definite meaning to the domain name and may be confused).

The Complaint in this proceeding sets forth clear reasoning based on numerous decisions under the ICANN Policy that unambiguously state that domain names such as Respondent's, placing "sucks" next to a trademark, are likely to cause confusion with the trademark it incorporates. Respondent presents no authoritative decisions involving the same issues involved in this proceeding that refute or distinguish any of the decisions

Complainant has cited. Rather, the crux of Respondent's argument is the self-serving and conclusory statement that he is not a "cybersquatter."

B. Respondent Has No Bona Fide Interest In The Domain Name

Complainant has presented no evidence of any bona fide interest or active use of the domain name. Respondent admits having no bona fide commercial use for the domain name and does not claim to be known by the domain name. See Response at 4.

Respondent has not used his domain name to make any consumer commentary regarding Complainant. Respondent claims to have a First Amendment right to register savinsucks.com. However, despite that numerous opportunities to express his opinions about Complainant in correspondence, by telephone directly with Complainant and by using a web site, Mr. Sachs has never listed one single complaint about Complainant. This complete failure to express any opinion or criticism concerning Complainant evidences Respondent's lack of any intent to criticize Complainant and highlights the failure of Respondent's only argument that the domain name has a bona fide use.

Next, by citing the ICANN Policy §§ 4(c) and 15 (a), Respondent is attempting to create a new category of protection specifically tailored for "-sucks.com" domain names that are not associated with web sites. Respondent presents no support for his contention that the rights of a trademark holder should be limited so as to prevent it from protecting its trademark against registrants of "-sucks.com" domain names who have no bona fide use for the domain name.

Respondent's citation to a number of cases is misplaced. Respondent cites *Bloomberg L.P. v. Secaucus Group*, No. FA0104000097077 (NAF June 7, 2001), for the proposition that consumer commentary and criticism is a legitimate use of a domain name. However, *Bloomberg* is based expressly on the fact that the domain name, although at first inactive, later was linked to "a free speech site" and thereby used for expressing consumer commentary and criticism. Thus, the facts supporting the *Bloomberg* decision are different from the present facts as Respondent has not linked savinsucks.com to any web site, let alone "a free speech site."

Similarly, in *Bosley Medical Group and Bosley Medical Institute, Inc. v. Kremer*, Case No. D2000-1647 (WIPO Feb 28, 2001), the respondent had submitted evidence of the preparation of his site to be used for consumer commentary and criticism. In *Compusa Mgmt. Co. v. Customized Computer Training*, No. FA0006000095082 (NAF Aug. 17, 2000), the panelist concluded that the respondent had a bona fide use for the domain names without citing any relevant factual contentions. Thus, it is not clear how that decision supports Respondent's contentions in the present proceeding, regarding a site with respect to which he has made no legitimate use. Lastly, *Bridgestone-Firestone, Inc. v. Myers*, Case No. D2000-0190 (WIPO July 6, 2000) expressly states that the panel found "use of the Domain Name to designate a website for criticism and commentary" to be a legitimate use. Thus, unlike the present proceeding, none of the proceedings Respondent cites involved passive holding of a domain name and the *Bosley, Compusa*

and *Bridgestone-Firestone* proceedings did not even involve “-sucks.com” domain names.

More recent decisions have cited to some of these decisions, including the *Bloomberg* decision, and distinguished those facts from facts more analogous to the present facts. See *Kendall/Hunt Publishing Co. v. headhunterbob*, Claim No. FA0111000102247 (NAF Jan. 14, 2002)(A.M. Wallace, Q.C. as panel Chair). *Kendall/Hunt* involved the domain name “kendallhuntsucks.com” that had been used with a web site containing disparaging commentary about the complainant, but the domain name was not in use at the time of the decision. The panel concluded that the domain name had been registered and, through passive holding, used in bad faith. See also *Vivendi Universal v. Sallen and GO247.COM, INC.*, Case No. D2001-1121 (WIPO Nov. 7, 2001)(citing *Bloomberg*, but finding “vivendiuniversalsucks.com” to have been registered and held passively in bad faith).

C. Respondent Has Registered The Domain Name In Bad Faith

Respondent's claim that he is not a "cybersquatter", see Response at 6, is again grandly over-conclusive and is a decision for the arbitration panel to make. The tenor of Mr. Sachs' correspondence and telephone conversations to Complainant and Complainant's counsel show that his purpose in registering the domain name is to harass Complainant.¹ Mr. Sachs has encouraged and taunted Complainant to bring legal action against the domain name and has even registered the name of Complainant's law firm as another “-sucks.com” web site. See Complaint at Exhibits 4 & 6. Such conduct unmistakably demonstrates Mr. Sachs' desire to be noticed by and harass Complainant. Further, despite all of his statements and correspondence, he has never listed one single complaint about Complainant to evidence his alleged desire to comment on or criticize Complainant.

Respondent does not and cannot point to a bona fide use of the domain name savinsucks.com. The domain name is no more than an infringement of the SAVIN registered trademark, made in an attempt to harass Complainant. Respondent asserts that the domain name is consumer commentary, but provides absolutely no explanation of how the domain name possibly could be commentary. See Response at 6. Additionally, his assertion that the "commentary" is protected First Amendment speech is completely unsubstantiated. See id. The only decision cited by Respondent, *Alitalia-Linee Aeree Italiane S.p.A. v. Colour Digital*, D2000-1260 (WIPO Nov. 23, 2000), held the subject domain name was registered and used in bad faith and ordered it transferred.

Respondent takes issue with the holding in *Telstra Corporation Ltd. v. Nuclear Marshmallows*, Case No. D2000-0265 (WIPO Feb. 18, 2000)(stating that passive holding of a domain name evidences bad faith registration and use). However, *Telstra* has been

¹ Excerpts from Respondent's letters are quoted in section D herein. Respondent's letters also state that “[t]he fact that your client “does not like” my ownership of [savinsucks.com] is irrelevant.” Mr. Sachs also has attempted to misquote Complainant's statements about Complainant's counsel. See a copy of an email from Pete Heinsohn to David Einhorn dated 02/05/02 attached hereto at Exhibit 1.

supported by countless panel decisions in just the two years since it was decided. See *Television Broadcasts Ltd. v. Lee*, No FA0111000102523 (NAF Feb. 4, 2002) (citing *Bayshore Vinyl Compounds Inc. v. Michael Ross* AF-0187 (eResolution July 17, 2000)). The ‘use’ requirement has been found not to require positive action, inaction being within the concept: *Telstra Corp. Ltd v. Nuclear Marshmallows*, D2000-0003 (WIPO Feb.18, 2000); *Barney’s, Inc. v. BNY Bulletin Board* D2000-0059 (WIPO Apr. 2, 2000); *CBS Broadcasting, Inc. v. Toeppen* D2000-0400 (WIPO July 6, 2000); *Video Networks Limited v. King* D2000-0487 (WIPO July 20, 2000); *Recordati S.P.A. v. Domain Name Clearing Co.* D2000-0194 (WIPO July 21, 2000) and *Revlon Consumer Products Corp. v. Yoram Yosef aka Joe Goldman* D2000-0468 (WIPO July 27, 2000); see also *Spence-Chapin Svcs to Families and Children v. Wynman*, No. FA0110000100492 (NAF Dec. 10, 2001) and the Complaint at 7 (citing a completely different string of decisions supporting a bad faith finding upon respondent’s passive holding of a domain name).

Complainant does hold several domain names passively. However, each of those domain names contain Complainant’s registered SAVIN mark and it obtained those domain names through litigation and by agreement from other registrants, like Respondent, who had no bona fide use for those domain names and were using the names to infringe Complainant’s trademark.

The domain name "savinsucks.com" was never deactivated. See a printout of the VeriSign WHOIS database dated 1/15/02 listing savinsucks.com as expired, but registered, attached hereto at Exhibit 2. Respondent asserts that the domain name was deactivated. This assertion is erroneous. The domain name remained activated as evidenced by its listing in the WHOIS database for several months after the domain name had been scheduled to expire. The domain name could not have been registered by another party during that period because it was “in use by another Registrant.” See a copy of an email from Network Solutions, Inc. (“NSI”) to Complainant’s counsel re: the registration status of savinsucks.com attached hereto at Exhibit 3. The Forum actually froze the registration, which subsisted from its original registration date, at the time this proceeding was initiated. Moreover, the registration was renewed by Sachs one day after this proceeding was filed and such renewal would not have been possible had the domain name been deactivated. See a printout of the VeriSign WHOIS database dated February 15, 2002 attached hereto at Exhibit 4.

D. Complainant's Claim For Transfer Of The Domain Name Is Well-Founded In The Decisions Under The ICANN Policy & Should Be Granted

Complainant's claims against Respondent are all grounded in decisions under the ICANN Policy and are fully supported by the ICANN Policy. Respondent's argument that Complainant's claims are brought in bad faith or are meant to harass Respondent attempt to turn the situation on its head. Respondent's letters to Complainant's counsel state, in reference to his “right” to register the domain name savinsucks.com:

There is nothing that you or your client can do about it. However, if you disagree, please proceed with an action against me. It will be my pleasure

to argue on your client's behalf that Savin must, in fact, suck. (See Complaint at Exhibit 4)(emphasis original).

I encourage you to bring an action against me. I am confident that I will prevail on summary judgment. In fact, I am so confident that I have just registered the domain name "andersonkillsucks.com." (See Complaint at Exhibit 6).

This correspondence evidences Mr. Sachs' intent to harass Complainant by registering savinsucks.com. Mr. Sachs' has further evidenced his intentions since the commencement of this proceeding. Mr. Sachs, who is an attorney, has emailed and telephoned Complainant directly, despite knowing that Complainant is represented by counsel. See Response at Exhibit 2. Even more haunting is that Mr. Sachs' either completely imagined the substance of the conversation he professes to have had with Complainant or fabricated it. Mr. Sachs' summarization and alleged quoting of Complainant's comments in his February 2, 2002 email is completely false. See Exhibit 1. Complainant, in communicating with its attorneys, has characterized Sachs as a tormentor akin to a malevolent character in a Stephen King novel. See id. In the very least, Mr. Sachs' statements evidence his bad faith in registering the domain name savinsucks.com.

Further undermining Respondent's assertion that his registration constitutes a bona fide use of a domain name containing Complainant's registered trademark, Respondent has not made any statements or presented any information identifying any of his opinions, commentary or criticism about Complainant. Respondent has had ample opportunity do so, through correspondence, direct phone calls to Complainant and via "electronic means." However, as made plain by the correspondence and by the passive holding of the domain name, Mr. Sachs has never asserted any opinion, commentary, criticism or complaint.

Respondent's attempt to portray Complainant's references to the statements in the correspondence between Complainant's counsel and Mr. Sachs as "repeated untrue statements" in violation of the certification on the Complaint (see Response at 9) is not well-founded. If anything, it is another attempt by him to stretch the facts to fit his personal agenda and interpretation of the ICANN Policy and Rules.

As explained above, the domain name savinsucks.com was never deactivated by NSI, remained active at the time the Complaint was filed and was then frozen by the Forum, before being renewed by Respondent one day after this proceeding was initiated. See Exhibits 2, 3 & 4. Respondent has since refused to accept Complainant's settlement offer to withdraw this complaint. See Response at Exhibit 2. Thus, contrary to Respondent's contentions, Complainant has in no way revived a dispute that had passed.

CONCLUSION

Based on the foregoing, Complainant respectfully submits that the panelists should grant Complainant's request to transfer the domain name savinsucks.com to Complainant and should deny in full Respondent's claims sounding in bad faith.

4. TRANSMISSION

The Complainant asserts that a copy of this Additional Submission, together with the cover sheet as prescribed by NAF's Supplemental Rules, has been sent or transmitted to the Respondent c/o Peter Sachs, at the address listed for Respondent in the Complaint, in accordance with ICANN Rule 2(b).

5. CERTIFICATION

Complainant agrees that its claims and remedies concerning the registration of the domain name, the dispute, or the dispute's resolution shall be solely against the domain-name holder and waives all such claims and remedies against (a) the National Arbitration Forum and panelists, except in the case of deliberate wrongdoing, (b) the registrar, (c) the registry administrator, and (d) the Internet Corporation for Assigned Names and Numbers, as well as their directors, officers, employees, and agents.

Complainant certifies that the information contained in this Additional Submission in support of its Complaint is to the best of Complainant's knowledge complete and accurate, that the Additional Submission is not being presented for any improper purpose, such as to harass, and that the assertions in this Additional Submission are warranted under these Rules and under applicable law, as it now exists or as it may be extended by a good-faith and reasonable argument.

Respectfully Submitted,

By: David A. Einhorn, Esq.
Daniel J. Healy, Esq.

Anderson Kill & Olick, P.C.
1251 Avenue of the Americas
New York, New York 10020
Attorneys for Complainant

Dated: February 19, 2002

Schedule of Exhibits

Exhibit No.	Date	Description	Tab No.
1.	February 5, 2002	Email from Pete Heinsohn to David Einhorn	1
2.	January 15, 2002	Printout of the VeriSign WHOIS database listing savinsucks.com as expired, but registered	2
3.	December 3, 2001	Email from Network Solutions, Inc. ("NSI") to Complainant's counsel re: the registration status of savinsucks.com	3
4.	February 15, 2001	Printout of the VeriSign WHOIS database	4