



NATIONAL
ARBITRATION
FORUM

DECISION

Savin Corporation v. savinsucks.com
Claim Number: FA0201000103982

PARTIES

Complainant is **Savin Corporation**, Stamford, CT (“Complainant”) represented by **David A. Einhorn**, of **Anderson, Kill & Olick, P.C.** Respondent is **savinsucks.com**, Milford, CT (“Respondent”) represented by **Peter Sachs**.

REGISTRAR AND DISPUTED DOMAIN NAME

The domain name at issue is <**savinsucks.com**>, registered with **Network Solutions, Inc.**

PANEL

The undersigned certifies that each of them has acted independently and impartially and to the best of their knowledge, has no known conflict in serving as Panelist in this proceeding.

Anne M. Wallace, Q.C., David H. Bernstein and David E. Sorkin as Panelists.

PROCEDURAL HISTORY

Complainant submitted a Complaint to the National Arbitration Forum (“the Forum”) electronically on January 22, 2002; the Forum received a hard copy of the Complaint on January 22, 2002.

On January 23, 2002, Network Solutions, Inc. confirmed by e-mail to the Forum that the domain name <**savinsucks.com**> is registered with Network Solutions, Inc. and that the Respondent is the current registrant of the name. Network Solutions, Inc. has verified that Respondent is bound by the Network Solutions, Inc. 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 (the “Policy”).

On January 24, 2002, a Notification of Complaint and Commencement of Administrative Proceeding (the “Commencement Notification”), setting a deadline of February 13, 2002 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@savinsucks.com by e-mail.

A timely Response was received and determined to be complete on February 12, 2002.

On February 21, 2002, pursuant to Complainant's request to have the dispute decided by a three-member Panel, the Forum appointed Anne M. Wallace, Q.C., David H. Bernstein and David E. Sorkin as Panelists.

Complainant filed a Reply on February 19, 2002, and Respondent Filed a Sur-response on February 28, 2002. The Panel has disregarded both of these submissions. Although Article 7 of The Forum's Supplemental Rules purports to permit such supplemental filings, the Rule does not require a Panel to accept those materials. In fact, the Supplemental Rule could not require Panels to accept these supplemental filings because that would violate Uniform Rule 12 of the ICANN Policy, which vests the discretion to request and accept supplemental materials solely with the Panel. No provider's Supplemental Rules can override the Policy or Uniform Rules and the discretion they vest in the Panels appointed thereunder. Because no new information or arguments were supplied within the supplemental filings, and because the Panel had no questions for the parties to address in supplemental materials, the Panel will not consider either Complainant's reply nor Respondent's Sur-response.

RELIEF SOUGHT

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

PARTIES' CONTENTIONS

A. Complainant

The domain name <**savinsucks.com**> is confusingly similar to Complainant's registered trademark. Savin holds four valid and subsisting federal trademark registrations for the mark SAVIN (Reg. Nos. 2,230,303; 1,174,900; 1,500,782 and 836,540) (the "Savin Marks") in the United States alone. Savin first registered its SAVIN mark in 1968. All of these trademarks are used in connection with, among other things, business machinery and parts and services used in connection therewith, including photocopier, printer and facsimile machines and parts therefor. Savin also has registered its mark SAVIN as a domain name (<savin.com>) with Network Solutions, Inc. and is using that domain in connection with a Web site. Moreover, Savin has spent considerable time and money in advertising and marketing its products bearing its well-known marks.

Two marks need not be identical to be likely to be confusing. See *General Electric Co. v. Pars Int'l Computer, Inc.*, D2000-0368 (WIPO July 25, 2000) (finding <1-800-ge.com> to be confusingly similar to GE). There is a likelihood of confusion where a complainant's mark is contained in a respondent's domain name because only "essential" or "virtual" identity is needed to establish confusing similarity under the Policy. See *Cellular One Group v. the Design Factory*, D2000-1670 (WIPO Jan. 29, 2001) (holding <cellularoneltd.com> confusingly similar to CELLULARONE and CELLONE); see also *Heineken Brouwerijen B.V. v. Lott*, D2000-1487 (WIPO Jan. 30, 2001) (holding <planetheineken.com> confusingly similar to HEINEKEN).

In general, the use of a complainant's trademark in connection with a generic term does not avoid the confusing similarity created by the use of complainant's trademark. See *Trump, et al. v. Rafeli*, FA 100238 (Nat. Arb Forum Nov. 6, 2001) (finding a likelihood

of confusion between TRUMP and <trumpinternational.net>, <trumphouse.net>, <trumpland.net>, <trumpskys.com>, <trumppalace.com>, <trumpair.com> and <trumptown.com>); *Trump v. Graham*, FA 100177 (Nat. Arb. Forum Nov. 2, 2001) (finding a likelihood of confusion between TRUMP and <trumptrade.com> and <trumpbarter.com>); *Marriott Int'l, Inc. v. Nicewarner*, FA 99692 (Nat. Arb. Forum Nov. 1, 2001) (finding likelihood of confusion between MARRIOTT and <marriottcorp.com> and <marriottcorps.com>); *State Farm Mut. Auto. Ins. Co. v. All Phase Builders*, FA 99608 (Nat. Arb. Forum Oct. 11, 2001) (finding likelihood of confusion between STATE FARM and <statefarm-claims.com>); *Park 'N Fly Services Corp. v. Level Propane*, Claim No. FA 99656 (Nat. Arb. Forum Oct. 29, 2001) (finding likelihood of confusion between PARK 'N FLY and <parknflyfree.com> and <parkandflyfree.com>).

Specifically, other UDRP panels have found that domain names that simply combine a trademark and the word “sucks”, are not immune from scrutiny for likelihood of confusion. In fact, the majority of panel decisions addressing the issue of whether a domain name containing complainant’s trademark next to “sucks.com” have found the subject domain name confusingly similar to the complainant’s trademark. See e.g. *Cabela’s Inc. v. Cupcake Patrol*, FA 95080 (Nat. Arb. Forum Aug. 29, 2000) (“Respondent’s domain name is sufficiently similar to Complainant’s marks that the search engine results will confusingly list the Respondent’s domain name when searching for Complainant’s mark”); *Wal-Mart Stores Inc. v. McLeod*, D2000-0662, (WIPO Sept 19, 2000) (“the Panel concludes that a domain name is ‘identical or confusingly similar’ to a trademark for purposes of the Policy when the domain name includes the trademark, or a confusingly similar approximation, regardless of the other terms in the domain name”); *Diageo PLC v. Zuccarini*, D2000-0996, (WIPO Oct. 22, 2000) (“Internet users with search engine results listing Respondent’s domains are likely to be puzzled or surprised by the coupling of Complainant’s mark with the pejorative verb ‘sucks’”); *Direct Line Group Ltd. V. Purge I.T.*, D2000-0583. (WIPO Aug. 13, 2000) (stating that as to the similarity between DIRECT LINE and <directlinesucks.com>, “[s]ome will treat the additional ‘sucks’ as a pejorative exclamation and therefore dissociate it after all from the Complainants; but equally others may be unable to give it any very definite meaning and will be confused about the potential association with the Complainants”).

However, Respondent need not completely confuse Web users in order to damage Complainant. The damage to Complainant occurs by causing Web users to go to Respondent’s Web site. See *Diageo PLC v. Zuccarini*, D2000-0996 (WIPO Oct. 22, 2000) *Diageo PLC v. Zuccarini*, D2000-0996 (WIPO Oct. 22, 2000) (“Such users, including potential customers of Complainant, are not likely to conclude that Complainant is the sponsor of the identified websites...it is likely (given the relative ease by which websites can be entered) that such users will choose to visit the sites, if only to satisfy their curiosity. Respondent will have accomplished his objective of diverting potential customers of Complainant to his websites by the use of domain names that are similar to Complainant’s trademark”). Even those users who would understand that there is no association, might choose to visit the site, if only to satisfy their curiosity. This effect would damage Complainant, to the extent Respondent would intentionally disrupt Complainant’s business.

Courts and other UDRP Panels have recognized that the intentional registration of a domain name in which the second-level domain contains another's valuable trademark weighs in favor of a likelihood of confusion. See *Minnesota Min. and Mfg. Co. v. Taylor*, 21 F.Supp.2d 1003, 1005 (D.Minn. 1998); *Intermatic Inc. v. Toeppen*, 947 F.Supp. 1227, 1235-1236 (N.D.Ill. 1996); *Cabela's Inc. v. Cupcake Patrol*, FA 95080 (Nat. Arb. Forum Aug. 29, 2000).

Respondent has stated that consumers cannot be confused between <savin.com> and <**savinsucks.com**>, since consumers looking for SAVIN will not type <**savinsucks.com**> in their Web server. Based on the above decisions, Respondent's argument must be disregarded.

Respondent's domain name contains Complainant's exact mark SAVIN. Respondent uses Complainant's SAVIN mark with a generic term, sucks, which does not indicate the use to which Complainant's domain name has been, is or will be put. The registration and use of <**savinsucks.com**> is likely to cause confusion among consumers familiar with the Savin Marks.

At this time, Respondent only "uses" the domain name <**savinsucks.com**> passively. Other than passive use, the only use Respondent could make of the domain name would be as a host name. Complainant intended to avoid any dispute if Respondent agreed not to use the domain name as a host name for a Web site at any time in the future. Respondent refused to do so. Any such use of <**savinsucks.com**> would likely cause confusion among the Web users. Web users would be drawn to the Web site, which would appear whenever a consumer typed in the search name Savin while looking for Complainant's products on the Internet. Those consumers would be puzzled by the association of Complainant with the site.

Respondent does not conceal the fact that he has specifically appropriated Complainant's mark for his domain name registration <**savinsucks.com**>. Therefore, based on Respondent's own admissions and statements the domain name does create, as it is intended to, confusion with Complainant's SAVIN marks.

Registering a domain name with knowledge that it contains or is confusingly similar to another's trademark is a factor evidencing lack of a bona fide use. See *McNeil Consumer Brands, Inc. v. Meriweb Solutions*, D2000-0612 (WIPO Aug. 3, 2000) (listing factors to be evaluated in determining bad faith and stating that registrant's knowing use of a domain name similar to complainant's trademark evidences bad faith rather than bona fide use).

Merely using a domain name containing Complainant's mark in competition with Complainant does not establish a bona fide commercial use. See *Backstage Fashion, Inc. v. Back Stage, Inc.*, FA 100135 (Nat. Arb. Forum Nov. 5, 2001) ("[u]sing a domain name identical to Complainant's service mark with the result of diverting potential customers from Complainant to Respondent is not a bona fide offering of goods"); *Park 'N Fly Services Corp. v. Level Propane*, FA 99656 (Nat. Arb. Forum Oct. 29, 2001) (holding that use of domain names confusingly similar to complainant's mark to attract users to respondent's Web site is not a bona fide use).

Outside of Respondent's registration of the domain name <**savinsucks.com**>, Respondent has never used the term or mark SAVIN or SAVINSUCKS. Respondent holds no trademark registration and has claimed no common law trademark rights to the term SAVINSUCKS or the terms SAVIN SUCKS. Other than its registration of the domain name <**savinsucks.com**>, Respondent has never used nor made any claim to the term SAVINSUCKS or the terms SAVIN SUCKS as a mark or indicator of Respondent's business. ICANN Rule 3(b)(ix)(2); ICANN Policy ¶ 4(a)(ii).

Respondent has not used the domain name in connection with a business. Respondent refuses to withdraw the domain name, despite the fact that the domain name contains Complainant's registered trademark. Respondent's refusal to "enter into any agreement regarding any possible use of the domain name", strongly suggests that Respondent will be using the domain name <**savinsucks.com**> as a host name, and such usage would in fact harm Complainant.

"Free speech", does not grant a registrant the right to use a domain name that is confusingly similar to complainant's trademark. Specifically, in cases where a Web site was operated under the domain name, panels distinguished "between the domain name itself and the contents of the site which is reached through the domain name". See *Estee Lauder Inc. v. estelauder.com, estelauder.net and Jeff Hanna*, D2000-0869 (WIPO Sept. 25, 2000). Although a right to free speech was found "to provide a platform to criticize Complainant," see *id.*, and "the contents of Respondent's websites may also be a perfectly legitimate use of those rights", the Panel found that "Respondent could well have chosen to use a domain name that was not confusingly similar to Complainant's and/or in which Complainant had no rights." "Respondent's free expression rights do not here give it a right or legitimate interest in the domain name at issue." See *id.* Respondent never claimed any bona fide use in the domain name. Respondent only has made a nonspecific assertion of First Amendment Right, and a general "right to opine".

Using a domain name containing Complainant's mark to divert customers away from Complainant does not establish a bona fide fair use. See *Backstage Fashion, Inc. v. Back Stage, Inc.*, FA 100135 (Nat. Arb. Forum Nov. 5, 2001) (finding no fair use where respondent's site used complainant's mark to attract customers and, thus, divert them away from complainant). As stated above, Respondent has stated his intention to attract Web users' attention to his domain name via the consumer recognition of the SAVIN mark.

The circumstances listed under § 4(b) are a non-exclusive list of examples of circumstances evidencing bad faith. See *Fabricas Agrupadas de Munecas de Onil S.A.(FAMOSIA) v. Gord Palameta*, D2000-1689 (WIPO Mar. 14, 2001) ("The examples of bad faith set forth in [section 4(b) of] the Policy have at least one element in common: All of them effectively require that the respondent, at the time the domain name was registered, harbored an intent that related in some manner to the complainant or its trademark. This intent may, of course, be inferred from the respondent's subsequent conduct or other surrounding circumstances, but it must have existed when the domain name was registered in order for that registration to have occurred in bad faith"); *Koninklijke Phillips Electronics v. Kurapa C. Kang*, D2000-0163 (WIPO Mar. 27, 2001) (stating that "circumstances of bad faith are not limited to those listed under paragraph 4(b) of the policy").

Failure to make any bona fide use of a registered domain name, that contains another's trademark, is evidence of bad faith registration and use of that domain name. *See McNeil Consumer Brands*, D2000-0612 (WIPO Aug. 3, 2000) (listing failure to use domain name as factor evidencing bad faith).

Passive holding of a domain name has been held to be evidence of bad faith registration and bad faith use of that domain name. *See Telstra Corporation Ltd. v. Nuclear Marshmallows*, D2000-0265 (WIPO Feb. 18, 2000) (stating the concept of a domain name "being used in bad faith" is not limited to positive action; inaction is within the concept and holding that bad faith was shown by passive holding of a domain name); *see also Trump v. Rafaeli*, FA 100238 (Nat. Arb. Forum Nov. 6, 2001) (stating that registration and passive holding support finding of bad faith); *Mariott Int'l, Inc. v. Nicewarner*, FA 99692 (Nat. Arb. Forum Nov. 1, 2001) (holding that failure to use a domain name with "a Website or in any other way" is bad faith use); *Cabela's Inc. v. Cupcake Patrol*, FA 99508 (Nat. Arb. Forum Aug. 29, 2000) (finding passive holding of <cabelassucks.com> to constitute bad faith); *Solomon R. Guggenheim Found. v. Zuzazu*, FA 95319 (Nat. Arb. Forum Oct. 5, 2000); *Marubeni Corp. v. Eagle Data Ltd.*, FA 95418 (Nat. Arb. Forum Oct. 2, 2000).

Respondent currently is making no Web or Internet based use of the domain name <**savinsucks.com**> and has stated that he intends to use it to harass Complainant. Such passive use of the domain name is evidence of Respondent's bad faith.

Other than passive use, the only use Respondent could make of the domain name would be as a host name. When Complainant attempted to negotiate a settlement of the matter, Respondent refused to "enter into any agreement regarding any possible use of the domain name". Complainant is left to assume that Respondent intends to use his domain name as a host name.

Respondent is perfectly aware of the fact that using the domain name as a host name would divert consumers from Complainant, to Respondent's Web site. As stated above, the majority of panel decisions addressing the issue of whether a domain name containing complainant's trademark next to "sucks.com," have found, against Respondent's opinion, that the subject domain name was confusingly similar to the complainant's trademark.

Respondent has stated his intent to express his negative opinion about Complainant "whether it be through verbal, written or electronic means." Respondent's purpose in using the domain name, passively or otherwise, is to attract would be Savin consumers. By attracting consumers away from Complainant, Respondent intentionally damages Complainant's business. Such use by Respondent does not constitute a legitimate or bona fide use of the domain name. Respondent has no right to use Complainant's mark in order to attract Web users even if his intentions are to criticize. By diverting consumers away from Complainant into Respondent's Web site, Complainant would, through Respondent's bad faith use of the domain name, be damaged.

On December 21, 1999, March 23, 2000 and April 27, 2000 respectively, in an attempt to settle this dispute and to alleviate the confusion caused by Respondent's registration of the domain name <**savinsucks.com**>, Complainant wrote letters to Respondent. Complainant intended to avoid any dispute if Respondent simply withdrew the domain

name <**savinsucks.com**>, or if Respondent agreed not to use the domain name as a host name for a Web site at any time in the future.

Respondent has refused to withdraw the domain name. Respondent believes he can use the domain name registration system as a tool for harassing Complainant, by manipulating Complainant's own trademark. His continued holding of the domain name is his way of harming Complainant, as stated by him.

Respondent has not used the domain name <**savinsucks.com**> for any legitimate business purpose and has never made a legitimate non-commercial use of that domain name. It appears, based on Respondent's actions, that Respondent is now merely using the domain name <**savinsucks.com**> in order to harass Complainant, tarnish the Savin Marks and harm Complainant's business. Thus, it is clear that Respondent's actions constitute bad faith use of that domain name under the UDRP § 4(b).

Respondent's only purpose in registering the domain name <**savinsucks.com**> was to harass Complainant and to harm Complainant's business. Other than his passive use, the only use Respondent could make of the domain name would be to use it as a host name. Respondent refused to agree not to use the domain name <**savinsucks.com**> as a host name in the future. Usage of the domain name as a host name would cause consumers to be drawn away from Complainant's Web site to another Web site, which would damage Complainant.

First, such use by Respondent would cause Complainant money damages. Complainant's Web site contains information about all of Complainant's goods and services, and includes also a list of all of Complainant's dealers to make it easy for the consumers to find a dealer near them to purchase Complainant's goods. Also, since Complainant's Web site contains substantial promotion and advertisement material, it is apparent that Complainant's Web site, at <savin.com>, is an essential tool for Complainant's trade. Any active use by Respondent would cost Complainant sales and the real dollar value of those sales and created a likelihood of confusion with Complainant's SAVIN MARKS. Each diversion of consumers by Respondent, and a loss of clientele due to such diversion, would cause Complainant substantial damages.

Second, Respondent's use of the domain name is disrupting to Complainant in that Complainant, having a duty to protect its trademarks under U.S. Trademark Law, see *Electro-Coatings, Inc. v. Precision Nat'l Corp.*, 204 U.S.P.Q. 410, 421 (TTAB 1979), has been forced to bring this proceeding against Respondent in order to enforce its trademark right in the Savin Marks and protect itself from infringement and consumers from confusion.

Registering and using a domain name that is known to contain another's trademark evidences bad faith registration of that mark. See *Umbers & Toltec Scenic R.R. Comm'n v. Ravin*, FA 99599 (Nat. Arb. Forum Oct. 30, 2001) (holding respondents' knowledge of complainant's mark to evidence registrants' bad faith use of the mark for a domain name offering railroad services); see also *Trump v. Graham*, FA 100177 (Nat. Arb. Forum Nov. 2, 2001) (holding respondent's likely knowledge of the TRUMP mark to be evidence bad faith). Respondent, is undoubtedly aware of the goodwill and reputation of the SAVIN MARKS. Respondent nonetheless registered the domain name <**savinsucks.com**>, incorporating Complainant's registered and well-known trademark. Any possible use by

Respondent will harass Complainant and harm Complainant's business, using its own marks for that purpose.

Respondent has intentionally caused confusion with the SAVIN MARKS and continues to intentionally use the domain name in bad faith. Respondent, with the intent to harass Complainant and harm Complainant's business, registered a domain name that incorporates the Savin Marks next to a generic term, "sucks."

In his reply to the cease and desist letters sent to Respondent on December 21, 1999 and March 23, 2000, Respondent has expressed his general intent to harass Complainant and to tarnish Complainant's trademark ("...does Savin suck? ... That is my opinion and I may express it in any legal way I see fit, whether it be through verbal, written or electronic means").

Further evidencing Respondent's bad faith, he has registered the domain name <andersonkillsucks.com> after corresponding with Complainant's counsel regarding <savinsucks.com>. Anderson Kill & Olick is the firm serving as Complainant's counsel and <andersonkill.com> is the domain name used by the firm. By that, Respondent has clearly show his intent to harass Complainant, and registration of <andersonkillsucks.com> was made to "prove" to Complainant that Respondent does not believe he can be stopped from manipulating business names with the sole purpose of harassment. ("I have just registered the domain name andersonkillsucks.com").

Respondent is aware of the fact that Anderson Kill & Olick is a famous mark. Respondent is a former attorney with Anderson Kill & Olick and is therefore aware of the long use that the firm has made of this name to identify its legal services. Before registering <andersonkillsucks.com>, Respondent undoubtedly visited <andersonkill.com>, which Anderson Kill & Olick is using as its host name for a Web site that promotes its legal services. As is evidenced in the Web site, Anderson Kill & Olick is a very established firm, with branches in many locations in the U.S., and enjoys a good reputation. Further, at the time Respondent was an attorney employed by Anderson Kill & Olick, Complainant was a client of the firm. Thus, Respondent's malicious intent in registering both <savinsucks.com> and <andersonkillsucks.com> is clear.

Such pattern of conduct has been viewed by other UDRP panels as an additional evidence of bad faith. See *Sony Kabushiki Kaisha v. Inja, Kil*, D2000-1409 (WIPO Dec. 9, 2000) (viewing the registration of other domain names incorporating well known marks as a pattern of conduct indicating bad faith); *Koninklijke Phillips Electronics v. Kurapa C. Kang*, D2000-0163 (WIPO Mar. 27, 2001).

B. Respondent

- a. The Respondent's domain name, <savinsucks.com> is neither identical, nor confusingly similar to Complainant's trademark.**

Complainant has not alleged that Respondent's domain name is "identical" to Complainant's trademark. Rather, Complainant has alleged that Respondent's domain name is "confusingly similar" to Complainant's trademark. Complainant first claims <savinsucks.com> is "confusingly similar" because it contains Complainant's trademark "SAVIN." The decisions Complainant has cited in support of this proposition are distinguishable from this proceeding. Most of the domain names at issue in the cited decisions had been registered by "cybersquatters," with the intent to profit

from a subsequent sale of the name. Complainant has not alleged, nor could it truthfully allege that Respondent is a “cybersquatter.” Therefore, any decision in which “cyber squatting” was found is distinguishable from this proceeding. Furthermore, the domain names at issue in the cited decisions did not criticize the complainants’ trademarks. The Respondent’s domain name does clearly criticize Complainant’s trademark. The Policy was not intended to provide a quick and easy means of quashing criticism.

Complainant next alleges that Respondent’s domain name is “confusingly similar” because it contains Complainant’s trademark “SAVIN,” plus the word “SUCKS.” The decisions Complainant cites in support of this proposition are again, distinguishable, because they also involved domain names that had been registered by “cybersquatters.” Moreover, courts and panels have found that such use of the word “SUCKS” causes no confusion.

In *Lucent Technologies, Inc. v. Lucentucks.com*, 95 F.Supp.2d 528 (E.D. Va. 2000), the court noted that “the average consumer would not confuse <lucentucks.com> with a website sponsored by plaintiff.” In *Bally Total Fitness v. Faber*, 29 F.Supp.2d 1161 (C.D. Cal. 1998), where the defendant had created a “Bally Sucks” website, the court held that the parties’ marks were not similar, because the defendant’s addition of the word “sucks” [to the plaintiff’s trademark] was a major, rather than a “minor change.”

In *Lockheed Martin Corporation v. Dan Parisi*, D2000-1015 (WIPO Jan. 26, 2001) (domain names at issue: <lockheedsucks.com> and <lockheedmartinsucks.com>.), the panel held that “[b]oth common sense and a reading of the plain language of the Policy support the view that a domain name combining a trademark with the word “sucks” or other language clearly indicating that the domain name is not affiliated with the trademark owner cannot be considered confusingly similar to the trademark.” In *Wal-Mart Stores, Inc. v. walmartcanadasucks.com*, D2000-1104 (WIPO Nov. 23, 2000) the panel held “a reasonably prudent user would not mistake the walmartcanadasucks.com site for any of Wal-Mart’s official sites.” The Wal-Mart panel also expressed doubt as to whether “a domain name including “sucks” ever can be confusingly similar to a trademark to which “sucks” is appended.”

Complainant next alleges that Respondent’s domain name is “confusingly similar” because web users may be confused when they visit Respondent’s website, if only to satisfy their curiosity. Complainant has admitted Respondent has no website, so no such “visits” could occur. For a web user’s curiosity to be piqued at all, there would have to be an occurrence of <**savinsucks.com**> on the World Wide Web for him to investigate. At this writing, the string <**savinsucks.com**> does not appear in any Internet search engine despite the fact that it has been registered for over two years.

Indeed, the only way web users could even attempt to “visit” <**savinsucks.com**> would be if they intentionally typed <**savinsucks.com**> into their web browser. In that case, they would not be looking for “SAVIN,” they would be looking for <**savinsucks.com**>. Complainant has not offered any evidence that web users looking for the “SAVIN” website instinctively type <**savinsucks.com**> into their browsers.

Complainant next alleges Respondent’s intentional registration of a domain name that contains another’s valuable trademark weighs in favor of finding a “likelihood of confusion.” Again, the cited decisions are distinguishable because they involved domain names registered by “cybersquatters.”

Complainant next alleges, “[t]he registration and use of <**savinsucks.com**> is likely to cause confusion among consumers familiar with the Savin Marks.” First, Complainant has cited no source for the proposition that registration in and of itself can cause confusion. Second, Complainant has stated “Respondent does not actively use the domain name” but “[a]ny such [future] use would likely cause confusion among the Web users.” Thus, Complainant admits that the Respondent’s non-active “use” of the domain name causes no confusion with respect to Complainant’s trademark.

Since all of the decisions cited by Complainant are distinguishable from the present proceeding; since Complainant has not provided any evidence of actual confusion; and since Complainant’s own admissions and statements show that there is no confusion, Complainant has failed to prove that <**savinsucks.com**> is identical, or confusingly similar to Complainant’s trademark.

b. Respondent has rights or legitimate interests in respect to the domain name, <savinsucks.com>”

Respondent has neither claimed any use of <**savinsucks.com**> in connection with a bona fide offering of goods or services, nor has it claimed to be known by the domain name <**savinsucks.com**>.

Complainant first claims that Respondent’s refusal to “enter into any agreement regarding any possible use of the domain name strongly suggests that Respondent will be using the domain name <**savinsucks.com**> as a host name.” Respondent has no obligation to accept any settlement offer. His refusal to accept any such offer does not “strongly suggest” anything, nor does it have any bearing on whether he has rights or legitimate interests in respect to the domain name.

Complainant next cites *Estée Lauder Inc. v. estelauder.com, estelauder.net and Jeff Hanna*, D2000-0869 (WIPO Sept. 25, 2000) in support of the proposition that “free speech does not grant a registrant the right to use a domain name that is “confusingly similar” to complainant’s trademark.” The respondent’s domain name in *Estée Lauder* was nearly identical to complainant’s trademark. The Respondent’s domain name here is not even “confusingly similar.” The complainant in *Estée Lauder* “had also submitted considerable and largely unrefuted evidence of actual confusion.” *Id.* Complainant here has provided none. The *Estée Lauder* Panel also found that Respondent had made a “deliberate attempt to attract or divert Internet users who make a common error or spelling mistake in their Internet search.” Respondent in this proceeding has made no use of his domain name and it appears in no search engine.

Complainant next cites *Backstage Fashion, Inc. v. Back Stage, Inc.*, FA 100135 (Nat. Arb. Forum Nov. 5, 2001) in support of the proposition that “using a domain name containing Complainant’s mark to divert customers away from Complainant does not establish a bona fide fair use.” Again, Complainant admits that Respondent has no website associated with <**savinsucks.com**>, so he cannot have ever used his domain name to divert customers away from Complainant’s.

Complainant next claims, “Respondent has stated his intention to attract Web users’ attention to his domain name via the consumer recognition of the SAVIN mark.” Respondent has neither stated nor implied any such intention. By claiming he has, Complainant is intentionally misleading this Panel. Since the Exhibits cited contain no such statements or implications, Complainant’s allegation must be disregarded.

Paragraph 4(c) of the Policy reads “[a]ny of the following circumstances, in particular but without limitation . . . shall demonstrate your rights or legitimate interests to the domain name for purposes of Paragraph 4(a)(ii). (Emphasis added). Paragraph 15(a) of the Rules provide that “The Panel must “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.” Since both Complainant and Respondent here are U.S. entities, and since both parties have cited U.S. law in their submissions, the Panel must deem applicable “the principles of law” found in the United States Constitution. See *Bridgestone Firestone, Inc. v. Myers*, D2000-0190 (WIPO July 6, 2000)

Complainant claims, “[the] Respondent has no right to use Complainant’s mark in order to attract Web users even if his intentions are to criticize.” (Emphasis added.) Although Complainant’s trademark rights are valid, they are nonetheless limited by the Respondent’s First Amendment rights. See *L.L. Bean, Inc. v. Drake Publishers, Inc.*, 811 F.2d 26 (1st Cir.), cert. denied, 483 U.S. 1013, 107 S.Ct. 3254, 97 L.Ed.2d 753 (1987). Under the First Amendment of the United States Constitution, Respondent has an unfettered right to hold or express his opinion that “Savin Sucks”-- through oral, written or electronic means via the registration of a domain name.

Complainant fails to acknowledge *Bally Total Fitness Holding Corp. v. Faber*, 29 F.Supp.2d 1161 (C.D. Cal. 1998), where the court held that defendant was exercising his right to publish critical commentary about Bally when he operated a “Bally Sucks” website. The Bally court found the defendant could not have expressed his opinion about Bally without making reference to the trademark “Bally.” Similarly, Respondent cannot express his opinion about “SAVIN” in his domain name without making reference to “SAVIN.”

Complainant also fails to acknowledge several UDRP decisions that concur with Bally. See *Bloomberg L. P. v. Secaucus Group*, FA 97077 (Nat. Arb. Forum June 7, 2001); (The exercise of free speech for criticism and commentary also demonstrates a right or legitimate interest in the domain name.); *Bosley Medical Group v. Kremer*, D2000-1647 (WIPO Feb. 28, 2001) (Respondent’s use of domain name <bosleymedical.com> as a consumer commentary site was clearly fair use.); *Wal-Mart Stores, Inc. v. walmartcanadasucks.com*, D2000-1104 (WIPO Nov. 23, 2000) (Respondent has rights and legitimate interests to use the domain name <walmartcanadasucks.com> as a forum for criticism of the complainant); *Compusa Mgmt. Co. v. Customized Computer Training*, Claim Number: FA 95082 (Nat. Arb. Forum Aug. 17, 2000) (Respondent’s First Amendment right to offer criticism of the goods and services provided by Complainant via the domain names <stopcompusa.com> and <bancompusa.com> are as legitimate as any commercial activity.); *Bridgestone Firestone, Inc. v. Myers*, D2000-0190 (WIPO July 6, 2000) (Respondent has free speech rights and legitimate First Amendment interests in the domain name <bridgestone-firestone.net>.);

Respondent also has a legitimate interest in preserving the freedom of expression for others. Respondent is an attorney and advocate for Constitutional rights with respect to the Internet. He has testified at the request of the ACLU before a Congressional Panel on "4th Amendment Issues Raised by the FBI’s ‘Carnivore’ Program." See <http://www.house.gov/judiciary/sach0724.htm>. Respondent consults to other attorneys and provides commentary to the media on Constitutional issues with respect to the Internet. Respondent has appeared in national newspaper and magazine articles, as well as in radio and television newscasts.

For the aforementioned reasons, Respondent is making a legitimate noncommercial and fair use of the domain name, without intent of commercial gain to misleadingly divert consumers, or to tarnish the trademark or service mark at issue. Therefore, Respondent does have rights or legitimate interests in respect of the domain name <**savinsucks.com**>.

c. <savinsucks.com> was not registered in bad faith and is not being used in bad faith.

Complainant has failed to prove that the Respondent’s domain name has been registered and is being used in bad faith. Complainant has made no allegations nor offered any evidence pursuant to any of the four examples in Paragraph 4(b) as evidence of registration and use in bad faith. Instead,

Complainant alleges other “evidence” of bad faith as it is entitled to do “without limitation” in accordance with Paragraph 4(b).

“The general principle taught by precedents seems to be that, when a –SUCKS domain name has been registered for the main purpose of making money, it has been registered in bad faith, while when the purpose was really to provide criticism, political or otherwise, a finding of bad faith would not be appropriate.” *Caixa d’Estalvis y Pensions de Barcelona (“La Caixa”) v. Namezero.com*, D2001-0360 (WIPO May 3, 2001). Complainant has not alleged, nor could it truthfully allege that Respondent is a “cybersquatter.”

Complainant first offers the Respondent’s failure to use the domain name in a bona fide manner as evidence of bad faith. There is no requirement, contractual or otherwise that a domain name be “used” in association with any particular type of “server.” Thousands, if not millions of domain names are not “used” in association with any servers. Indeed, Complainant itself holds several domain names passively.

Complainant cites McNeil, for the proposition that “failure to make any bona fide use of a registered domain name, that contains another’s trademark, is evidence of bad faith registration and use of that domain name.” In McNeil, the respondent registered the domain name <Tylenol.org>, but never used it. The Panel held that by holding the domain name passively, the respondent prevented the complainant from registering and using the name itself. *McNeil Consumer Brands*, D2000-0612 (WIPO Aug. 3, 2000). That decision is distinguishable from this matter. The respondent in McNeil had registered Complainant’s exact trademark “TYLENOL,” and no more. Thus, complainant could not register its exact trademark. Respondent here has not registered Complainant’s exact trademark “SAVIN,” alone. Therefore, Complainant is not preventing Complainant from registering its exact trademark. In fact, Complainant already owns the “.COM” version of the domain name, which contains no more than its exact trademark.

Complainant next offers Respondent’s “passive use” as evidence of bad faith, citing *Telstra Corp. Ltd. v. Nuclear Marshmallows*, D2000-0265 (WIPO Feb. 18, 2000). Respondent believes the concept of “passive use” in Telstra is ill-conceived. It should also be noted that the respondent in Telstra never filed a Response. Under Telstra, “passive use” of a domain name means not using it in connection with any Internet services, such as the web. If one registers a domain name and associates his domain name with an Internet service he uses it “actively.” If one registers a domain name and does no more, he uses it “passively.” Thus, the phrase “passive use” becomes synonymous with the word “registration,” and not synonymous with the word “use.” Therefore, in accordance with the standard rules of statutory construction, the phrase “registration and use” in Paragraph 4(b) of the Policy cannot logically be interpreted as meaning “registration and passive use.”

Although Respondent believes the concept of “passive use” is flawed, his domain name falls within the exception of its Telstra test nonetheless. The Telstra panel held that "passive holding" amounts to "use in bad faith" when "it is not possible to conceive of any plausible actual or contemplated active use of the domain name by Respondent that would not be illegitimate." It is very possible to conceive of several “plausible and legitimate” active uses for <savinsucks.com>, including consumer commentary, which is “speech protected by the First Amendment.” Bally, supra at 1167. Thus, the Respondent’s “passive holding” of <savinsucks.com> fits well within Telstra’s exception for domain names that do have possible “plausible and legitimate” active uses. See also *Alitalia – Linee Aeree Italiane S.p.A v. Colour Digital*, D2000-1260 (WIPO Nov. 23, 2000)

The Telstra Panel also held that the complainant must prove that the respondent both registered the domain name in bad faith and used the domain name in bad faith. Thus, for bad faith to exist here, Respondent (1) must be using the domain name in bad faith; and (2) Respondent must have had the

intent to use the domain name in bad faith at the time he registered it. Complainant admits that Respondent is not “actively using” the domain name, and the Respondent’s “passive use” falls within the “plausible and legitimate” exception of Telstra. Complainant offers the following “evidence” of malicious intent:

“. . . at the time Respondent was an attorney employed by Anderson Kill & Olick, Complainant was a client of the firm. Thus, Respondent’s malicious intent in registering both savinsucks.com and andersonkillsucks.com is clear.”

Clear? The fact that Respondent was, seven years ago one of several hundred attorneys employed by Complainant’s counsel’s firm is entirely irrelevant as to the question of whether Respondent registered <**savinsucks.com**> in bad faith two years ago (5 years after resigning from the firm) and has used it in bad faith at some point during the past two years. Since Complainant offers no relevant evidence that Respondent had any bad faith intent at the time he registered <**savinsucks.com**>, the Telstra test has not been met and bad faith cannot be found.

Complainant next offers the Respondent’s refusal to agree to a settlement offer as evidence of bad faith. Since Respondent had no obligation to accept any settlement offer, his refusal to settle has no bearing on whether the Respondent’s domain name was registered and is being used in bad faith.

Complainant next offers several unsubstantiated allegations of “harassment” on the part of Respondent as evidence of bad faith. Purchasing a domain name that may be used, if used at all, for “consumer commentary” is not “harassment.” Refusing to comply with a “cease and desist” letter is not “harassment.” Using citations of legal precedent in response to “cease and desist” letters is not “harassment.” Respondent legally purchased a domain name and has abided by all of the terms and conditions of the Registrar’s Registration Agreement. Respondent has done nothing to harass Complainant.

Complainant next offers the Respondent’s registration of a domain name that contains its trademark as evidence of bad faith. Again, the decisions cited by Complainant involved domain names registered by “cybersquatters.” See *Umbers & Toltec Scenic R.R. Comm’n v. Ravin*, FA 99599 (Nat. Arb. Forum Oct. 30, 2001); *Trump v. Graham*, FA 100177 (Nat. Arb. Forum Nov. 2, 2001). Since Complainant has not alleged that Respondent is a “cybersquatter,” the decisions cited are distinguishable. Moreover, “An individual who wishes to engage in consumer commentary must have the full range of marks that the trademark owner has to identify the trademark owner as the object of the criticism.” See Bally, supra at 1165.

Complainant last offers Respondent’s registration of <**andersonkillsucks.com**>, which contains Complainant’s counsel’s firm name, plus the word “sucks,” as evidence of bad faith. Respondent registered <**andersonkillsucks.com**>, in accordance with the same rights and legitimate interests he has to register <**savinsucks.com**>. Respondent has a First Amendment right to register and use <**andersonkillsucks.com**> for, if no other reason, consumer commentary. See Bally, supra.

Furthermore, the “pattern of conduct” component of Paragraph 4 (b) (ii) of the Policy refers to domains that are registered “in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name.” Complainant has not alleged that Respondent registered <**savinsucks.com**> to prevent Complainant from registering it.

Lastly, Respondent could not have possibly “used” his domain name actively or “passively” at the time Complainant initiated this proceeding on January 22, 2002, because the domain name had been deactivated three months prior on October 22, 2001. See Complainant’s Exhibit 3. When a domain is in a “deactivated” state, the domain name holder cannot use in any way, shape or form. “When a domain name is deactivated, the Domain Name System (DNS) will no longer have the information

needed to resolve the domain name to its corresponding Internet Protocol (IP) number(s), effectively disabling the domain name as a tool for locating the related computers or organizations.” See <http://www.netsol.com/cgi-bin/glossary/lookup?term=Deactivation>

4. OTHER LEGAL PROCEEDINGS

Respondent is not aware of any other proceedings commenced in connection with the domain name <**savinsucks.com**>. ICANN Rule 3(b)(xi).

C. Additional Submissions

Additional submissions were not considered by the Panel.

FINDINGS

This Panel finds that Complainant has not established bad faith on the part of Respondent.

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

In light of or finding with respect to the third element, the Panel has not considered this element.

Rights or Legitimate Interests

In light of or finding with respect to the third element, the Panel has not considered this element.

Registration and Use in Bad Faith

With respect to this element, the paragraph 4(b) of the Policy reads:

“For the purposes of Paragraph 4(a)(iii), the following circumstances, in particular but without limitation, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith:

- (i) circumstances indicating that you have registered or you have acquired the domain name primarily for the purpose

of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of your documented out-of-pocket costs directly related to the domain name; or

(ii) you have registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that you have engaged in a pattern of such conduct; or

(iii) you have registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your web site or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of your web site or location or of a product or service on your web site or location

On a review of the evidence, none of the four enumerated circumstances exist in this case, for the following reasons:

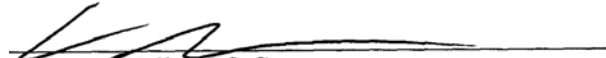
1. There is no evidence that the name was acquired primarily for the purpose of sale.
2. There is no evidence of intent to prevent the owner from reflecting the mark, and in any event there is no pattern.
3. There is no evidence that the primary purpose of the registration was to disrupt the business of the Complainant nor is the Complainant a "competitor" of the Respondent within the meaning of the policy.
4. There is no site operating at this time, nor is there any evidence that Respondent intends for commercial gain, to attract Internet users to a site.

Given that none of the four enumerated policy criteria with respect to bad faith have been met, that leaves the Panel with the question of whether there is bad faith for some other reason. On our reading of the Policy, each Panel is responsible to determine whether there has been bad faith. The four cited examples are situations where, if the evidence exists, the Panel must find bad faith. This does not, however, preclude the Panel finding that other circumstances amount to bad faith in a particular case. The paragraph says, "in particular but without limitation".

The Panel has examined all the evidence and arguments carefully, and cannot find any other circumstances in this case that amount to bad faith.


DECISION

The Complaint of Savin Corporation with respect to the domain name, <**savinsucks.com**>, is hereby **dismissed**.



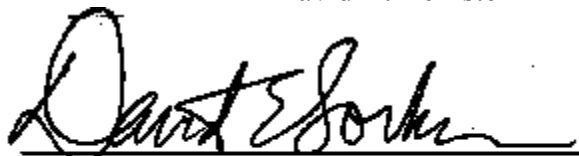
Anne M. Wallace, Q.C.
Arbitrator

Anne M. Wallace, Q.C.



David H. Bernstein, Esq.
Arbitrator

David H. Bernstein



Professor David Sorkin
Arbitrator

David E. Sorkin, Panelists
Dated: March 5, 2002

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