

UDRP decision highlights differing views on criticism sites International - Hogan Lovells LLP

Cybersquatting

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In a recent decision issued by the [World Intellectual Property Organisation](#) (WIPO) in accordance with the [Uniform Domain Name Dispute Resolution Policy](#) (UDRP), a wild animal trainer called Mahamayavi Bhagavan 'Doc' Antle has been [granted the transfer](#) of the domain name 'docantle.com'. The domain name was registered on November 9 2008 by Carole Baskin, who was the founder of the organisation Big Cat Rescue.

The complainant was the founder and director of [The Institute of Greatly Endangered and Rare Species](#) (TIGERS) and the [Rare Species Fund](#) in Myrtle Beach, South Carolina. He was an animal trainer who had written a number of books and appeared on several TV shows. For all these activities he stated that he was known as 'Doc Antle'.

The respondent was the founder of Big Cat Rescue in Tampa, Florida, a non-profit organisation involved in the protection of exotic cats and the prevention of animal abuse. The respondent had a website at '[www.911animalabuse.com](#)' where she informed the public about suspected animal abuse, and the domain name 'docantle.com' was pointing to a page on this website criticising the complainant.

On October 14 2014 the complainant filed a UDRP complaint with WIPO. To be successful in a complaint under the UDRP, a complainant must prove all of the following:

- (i) the domain name is identical, or confusingly similar, to a trademark or service mark in which the complainant has rights;
- (ii) the respondent has no rights or legitimate interests in respect of the domain name; and
- (iii) the domain name has been registered and is being used in bad faith.

With regard to the first prong, the complainant submitted that he had acquired common law trademark rights in the term 'Doc Antle' as he had been using this name for 30 years in relation to his business and, therefore, it had acquired a secondary meaning. The complainant also asserted that the domain name was identical to the DOC ANTLE mark, since it incorporated the mark in its entirety.

The respondent argued that the complainant was not commonly known as 'Doc Antle'. In fact, the respondent observed that, on the complainant's website, the complainant was presented as 'the director of TIGERS', and not as 'Doc Antle'. The respondent also argued that neither the complainant's YouTube videos nor his books referred to him as 'Doc Antle', but instead as 'Bhagavan Doc Antle' or 'Doc Bhagavan Antle'. Moreover, the respondent denied that DOC ANTLE was a mark since it was not associated with a specific kind of goods or services in the public mind, and no goods or services were offered on the complainant's website. The respondent contended that a person could not acquire trademark rights from fame alone. Therefore, the respondent claimed that the complainant did not have common law trademark rights for DOC ANTLE, since it was only a personal name and not a mark identifying particular goods or services.

The panel held that, for a name to be recognised as a mark it should have acquired a secondary meaning identifying goods or services in commerce. The panel observed that the complainant was regularly referred to as 'Doc Antle' and, even if he did use variations of the 'Doc Antle' name, he had still established reputation and goodwill in this name for the products and services that he commercialised (animal training and related entertainment services). The panel observed that, if a third party were to set up in competition with the complainant under the 'Doc Antle' name to provide similar services to the complainant, the latter could establish reputation and goodwill in his name and would likely have grounds for a passing-off action. Therefore, the panel found that the complainant had common law rights in DOC ANTLE. Finally, the panel found that the domain name was visually virtually identical to the DOC ANTLE mark (despite the omission of a space between the two words).

With regard to the second limb of the three-prong test, the complainant submitted that the respondent was neither his agent nor his licensee and could not demonstrate a legitimate non-commercial or fair use of the domain Name. Therefore, the complainant concluded that the respondent was tarnishing the mark and misleading potential customers.

The respondent asserted that the use of the domain name was intended neither for commercial gain nor to

misleadingly divert consumers. The respondent argued that she was making a legitimate use of the domain name since she did not offer goods or services at the website 'www.docantle.com', but brought the complainant's alleged behaviour to the attention of the public. Furthermore, the respondent claimed that the registration and use of the domain name for purposes of non-commercial criticism constituted a legitimate fair use and was not tarnishment. Finally, the respondent affirmed that there was no risk of confusion considering the criticism on the website.

The panel considered that the respondent had targeted the complainant when registering the domain name. The panel stressed that it did not need to make any finding concerning the respondent's criticism of the complainant. However, the panel recognised an already established principle under the UDRP that the right for the respondent to express her opinion did not imply the right to use another's name and trademark in a confusing manner to identify oneself as the source of the views. This is even more the case when the domain name in dispute is identical to the trademark of the complainant.

Further, the panel considered that the respondent was free to criticise the complainant's behaviour on her own website, but by registering a domain name identical to the complainant's mark, the respondent had impermissibly and deceptively taken advantage of the mark DOC ANTLE. The panel pointed out that the respondent's use of the domain name would generate an audience likely to seek information about the complainant, more so than if the respondent were to have chosen a domain name that was different from the complainant's name and mark. The panel therefore found that the respondent had no rights or legitimate interests in the domain name.

The third limb of the three-prong test under the UDRP requires a complainant to establish that a domain name was both registered and used in bad faith. The complainant argued that the respondent was a direct competitor of his since the respondent's association, Big Cat Rescue, had a zoo and was charging entrance fees for it. The complainant noted that the respondent's website offered the possibility for internet users to donate and was generating money via advertising displayed on her pages. According to the complainant, this illustrated the commercial gain that the respondent was hoping to obtain from misdirecting potential customers of the complainant's website to 'www.911animalabuse.com' instead and, therefore, her bad faith in both use and registration of the domain name.

The respondent considered that she had used the domain name for free speech purposes and to inform the public about the complainant's behaviour. However, the panel considered that, by using the domain name to redirect internet users to the respondent's website, the respondent was generating confusion since users would generally be expecting to reach the complainant's website via the domain name.

In light of these circumstances, the panel determined that the respondent had registered and used the domain name in bad faith, and did not need to come to any conclusions about whether or not the respondent was in fact making any commercial gain. The panel concluded by stressing that the respondent's right of free speech could not justify the deception of Internet users. If the respondent wished to publicise her views on the complainant, she could do so in any number of ways without deceptively taking advantage of the complainant's name and mark.

The panel therefore decided to transfer the domain name to the complainant.

The decision is in line with general practice under the UDRP whereby most panels, although not all, take the view that the right to criticise does not extend to registering and using a domain name that is identical, or confusingly similar to, a complainant's trademark. However, a small group of panels, particularly in the United States, take the view that a respondent has a legitimate interest in using a trademark as part of a domain name for a genuine criticism site if such use is fair and non-commercial, irrespective of whether the domain name as such connotes criticism. Cases involving criticism sites are therefore one of the few areas where UDRP panels' views may legitimately differ on the same facts, particularly when a domain name is identical to the trademark at issue, which makes it difficult to predict the outcome of a complaint. In such circumstances, a complainant may find the selection of a three-member panel worth considering to reduce the risk of a denial.

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