Decision for dispute CAC-UDRP-102016

Case number	CAC-UDRP-102016
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Domain names	HUMANAWARENESSINSTITUTE.ORG

Case administrator

Name	Sandra Lanczová (Case admin)

Complainant

Organization	HAI Global

Complainant representative

Organization	Turner Boyd LLP

Respondent

Name	Dane Rose

OTHER LEGAL PROCEEDINGS

The Complainant has declared that there are no such proceedings. The Panel is also not aware of any other proceedings in this matter.

IDENTIFICATION OF RIGHTS

The Complainant is the proprietor of a United States trade mark HUMAN AWARENESS INSTITUTE, for services in class 41 (educational services), issued 22 November 2016 (5085108)

FACTUAL BACKGROUND

The Complainant is a provider of services established in the United States of America. It declares that it has been in business under the name Human Awareness Institute for a number of decades (a Declaration from its Executive Director dates this to 'at least 1980'), although its trade mark was the subject of a 2015 application and was issued in 2016. It provides courses in the USA and other jurisdictions. Its activities essentially comprise of the provision of workshops and similar events, regarding relationships, sexuality, and the like.

The Respondent, an individual with an address in the United States of America, registered the disputed domain name on 2 July 2017. According to the Complainant (and not contradicted by the Respondent), the Respondent has attended various courses provided by the Complainant over the last fifteen years.

The Complainant's legal representative wrote to the Respondent (email of 28 February 2018), setting out its position that the use of the disputed Domain Name 'infringes on [the Complainant's] registered trademark' and requesting transfer, offering to pay 'initial registration fees' and 'any fees associated with the transfer'. The Respondent replied on the same day, accepting that the Respondent's intention was to reach a broad audience through the chosen Domain Name, but denying that the reader would think that the Respondent's website was the official site of the Complainant.

PARTIES CONTENTIONS

The Complainant submits that the disputed Domain Name is identical to its mark. It declares that the Respondent is not a licensee nor has the Respondent received its permission to use the mark, and that the Respondent has no rights or legitimate interests in the disputed Domain Name. Highlighting a record of contact between Complainant and Respondent (e.g. the Respondent's attendance at courses provided by the Complainant), the Complainant argues that bad faith is present on various bases (e.g. that the Respondent intends to 'lure people interested in Complainant’s services to Respondent’s website, where Respondent includes links to his own materials').

The Respondent has taken part in these proceedings and so resists the requests for transfer. The Respondent makes various submissions regarding 'therapeutic ethics' and offers specific criticisms appearing to raise objections to certain practices of the Complainant. These submissions disclose an ongoing dispute between the parties regarding the provision of services. The Panel is not competent to pass judgment on the specific arguments made by the Respondent (regarding, for instance, the quality of the services provided by the Complainant or the response made by the Complainant to the Respondent's previous communications not concerning the disputed Domain Name). The core argument relevant to the UDRP made by the Respondent appears to be that there is no confusion caused by the Respondent's website, which is 'educational in nature and serves the very public [the Complainant] says it is committed to serving'.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the disputed domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights (within the meaning of paragraph 4(a)(i)of the Policy).

There is no dispute regarding this aspect as (disregarding the top-level domain, in accordance with usual UDRP practice) the disputed Domain Name is identical to the Complaint's valid trade mark.

NO RIGHTS OR LEGITIMATE INTERESTS

The Complainant has not, to the satisfaction of the Panel, shown the Respondent to have no rights or legitimate interests in respect of the disputed domain name (within the meaning of paragraph 4(a)(ii) of the Policy).

The assessment of this dispute turns on paragraph 4(c)(iii) of the Policy, which identifies situations where a Respondent is 'making a legitimate noncommercial or fair use of the Domain Name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue' as examples of rights or legitimate interests relevant to the assessment of paragraph 4(a)(ii).

This case can therefore be contrasted with other cases where a commercial aspect or motive allows for a quick dismissal of the Respondent's contentions under this heading. For instance, a Panel found that a customer of a company, who claimed an intention to provide space for criticism, but instead offered pay per click links to competitors, did not have rights or legitimate interests in a domain name identical to that of the company (WIPO Case D2015-0447, Northwestel Inc v John Steins).

The remaining issue is therefore one of the most contentious issues in the UDRP jurisprudence, which is the correct approach to be taken in so-called 'criticism' cases'; as neither party has taken account of this complexity, the Panel has made reference to critical and reference material on the UDRP, especially the comprehensive text by Bettinger and Waddell (Domain Name Law and Practice, 2nd edition, Oxford University Press 2015) and the WIPO Jurisprudential Overview.

In earlier editions of the Jurisprudential Overview, the presentation was of 'view 1' and 'view 2' (the former generally ruling

out criticism as a legitimate use (often in conjunction with trademark doctrines such as initial interest confusion), and the latter considerably more willing to accept the point (often in conjunction with free speech jurisprudence)). The current edition (edition 3.0) dispenses with the presentation of different views. This change is characteristic of the third edition and potentially adds further confusion; see discussion in G Levine, 'Charting the Balance between Trademark Owners and Domain Name Holders: A Jurisprudential Overview' (6 June 2017) http://www.circleid.com/posts/30170606_charting_balance_between_trademark_owners_and_domain_name_holders/. In respect of the issue under consideration, the current edition says in a single paragraph (2.6.2) that:

"Panels find that even a general right to legitimate criticism does not necessarily extend to registering or using a domain name identical to a trademark (i.e., <trademark.tld> (including typos)); even where such a domain name is used in relation to genuine noncommercial free speech, panels tend to find that this creates an impermissible risk of user confusion through impersonation. In certain cases involving parties exclusively from the United States, some panels applying US First Amendment principles have found that even a domain name identical to a trademark used for a bona fide noncommercial criticism site may support a legitimate interest."

It is also important to distinguish between 'plain' and 'pejorative' cases (the Panel's labels, though see further Bettinger and Waddell at IIIE.332-339 (emphasising the 'two major categories' of criticism), and - by implication - paragraphs 2.6.2 and 2.6.3 of the current Jurisprudential Overview (which deal in turn with what this Panel is calling plain and pejorative). The present case is obviously in the 'plain' category; it would be in the 'pejorative' category (and perhaps easier to decide) if it instead concerned (for instance) humanawarenessinstitutesucks.com. In some disputes (though not the present), it is also necessary to identify whether the argument is based on criticism or on another exercise of freedom of expression (e.g. parody). Finally, it is famously argued that this matter is an area where the particular requirements of US law, including the constitutional context, are relevant (though, as Bettinger and Waddell argue at IIIE.337, it is now, in light of the body of decisions consulted, too simplistic to suggest that the nationality of the parties or the panelists determine the matter).

While the Panel notes that both parties in the present case are in the US, it takes the view that disposing of the case by this route would be unhelpful (though it could have led to the same result). The statement in the Jurisprudential Overview as of 2017 is too closely tied to the specific mention of the First Amendment to the US Constitution, and (as Bettinger and Waddell had argued in 2015), has already been overtaken by a broader range of decisions. Instead, the Panel notes that close attention to the implications of a decision under the UDRP for the ability to criticise reflects an important point in municipal and international law regarding the need to balance property rights with other rights (including freedom of expression, which is famously protected in one way in the US Constitution but by diverse means in many other systems). It is also the case that even in earlier decisions (e.g. the dissent in WIPO Case D2006-1627 Joseph Dello Russo v Michelle Guillaumin), reference is made to the purposes of the UDRP and not exclusively matters of US law.

The Panel also notes that ample authorities in favour of and against finding rights or legitimate interests in 'plain' criticism cases are available, including in recent cases and in decisions with full participation of Respondents. Some Panels doubt whether it is possible for a Respondent to succeed in situations where criticism is expressed in the 'plain' category. For instance, the Panel in Case 100610 S Morova v Radek Procházka (a case like the present where the Respondent was critical of the practices of the Complainant and using a website at a disputed Domain Name arguably identical to the Complainant's mark to set out that criticism) argues that 'by using the trade mark alone in the domain name, the registrant is impersonating the trade mark owner to draw internet users to that site' and so concludes that 'there is no right or legitimate interest in impersonating another'. On the other hand, other Panels have found in favour of Respondents for 'criticism' sites where the disputed Domain Name is identical or similar to the Complainant's mark. For instance, a three-member Panel unanimously found (in WIPO Case D2012-0293, Jams/Endispute v Ken Flynn) that the Respondent was not making money from his use fo the Domain Name, which 'appears to be used solely in sincere pursuit of Respondent’s free speech rights'. The Panel added that the Respondent in that case 'claims to have had an unsatisfactory experience' with the Complainant (an arbitration provider) and that 'whether the content of the website is actionable under the law for reasons unrelated to the Domain Name itself is not for this Panel to consider', and ruled in favour of the Respondent.

There is a more promising approach (see e.g. Case 101294 Upwork v Sunny Kumar, at the present Provider) of taking all of the circumstances into account, consistent with the balance between intellectual property rights and freedom of expression,

neither of which are absolute in many legal systems (the Panelist in Case 101294 identifies European Union law). The Panel finds this approach an important contribution to the debate, especially in light of the ambiguous language of the latest Jurisprudential Overview. As such, it can only be the job of any given Panel to assess whether the Complainant has persuaded it that it would be appropriate to find in its favour on this point. This assessment takes place in light of available evidence (including the website at the disputed Domain Name), though should not be a full assessment of the merits and demerits of the substantive criticism itself. Where a Complainant finds that the critical material presented by a Respondent is problematic from another perspective (e.g. defamation law), recourse should be had to the ordinary courts or regulatory bodies in the appropriate jurisdiction, unless it would be unsafe to define as criticism something that is manifestly not; factors noted in other cases as casting doubt on the applicability of a defence, such as following the look and feel of the Complainant's website (WIPO Case D2012-1618, CFA Properties v Domains By Proxy and John Selvig), or not genuinely referring to and discussing the Complainant (Case 101294 Upwork v Sunny Kumar), would be relevant here. Similarly, where a Respondent has 'used the domain name in ways designed to avoid deception and undue confusion' (WIPO Case D2006-1194, Ryanair v Michael Coulston), this would also be taken into account. Such assessment will necessarily overlap with the consideration of the wording of paragraph 4(c) itself, i.e. specifically excluding situations where there is 'intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue'.

In the present dispute, the Panel notes (through its own examination of the website, in the absence of further relevant information provided via either set of submissions) that the Respondent's website opens with the prominent text 'This Site is Intended to bring Attention to Practices by the Human Awareness Institute Facilitators that I believe to be Unsafe for all concerned. I invite you to be informed and participate in increasing the safety of therapeutic and workshop practices'. It is noted that there is a dispute of fact between Complainant and Respondent (disclosed in their respective submissions) as to whether the criticism is properly expressed, given the Complainant's brief submissions on the exact nature of the relationship between the Complainant and an individual referred to on the Respondent's website. This process is not the correct forum for the definitive resolution of such an issue. It is sufficient to note that the content appears to be criticism of the Complainant, without any attempt to deceive the reader as to the status or authorship of said criticism.

BAD FAITH

The Panel does not determine whether it has been shown that the disputed domain name has been registered and is being used in bad faith (within the meaning of paragraph 4(a)(iii) of the Policy).

The Complainant has raised a number of arguments in respect of this ground, concerning disruption to the business of a competitor, and likelihood of confusion. It is not necessary for the Panel to consider these points any further, in light of the above finding. If consideration had been necessary, a number of the same considerations (e.g. regarding the nature of the information supplied by the Respondent via a website at the disputed Domain Name) would have been taken into account.

PROCEDURAL FACTORS

The Panel is satisfied that all procedural requirements under UDRP were met and there is no other reason why it would be inappropriate to provide a decision.

PRINCIPAL REASONS FOR THE DECISION

The reasons for the decision are as set out above. While the Panel found that the first element was satisfied, on the grounds that the disputed Domain Name was identical to the trade mark of the Complainant, it was not satisfied that the Complainant had demonstrated that the Respondent had no rights or legitimate interests. The Panel took note of the Respondent's provision of information critical of the Complainant and, without expressing a view on the validity of these complaints, considered the various approaches to 'criticism' websites under the UDRP. The Panel did not therefore determine whether the disputed Domain Name was registered and being used in bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Rejected

AND THE DISPUTED DOMAIN NAME(S) IS (ARE) TO BE

1. **HUMANAWARENESSINSTITUTE.ORG**: Remaining with the Respondent

PANELLISTS

Name	**Prof Daithi Mac Sithigh**

DATE OF PANEL DECISION 2018-06-25

Publish the Decision