



WIPO Arbitration and Mediation Center

ADMINISTRATIVE PANEL DECISION

Paul McMann v. J McEachern

Case No. D2007-1597

1. The Parties

Complainant is Paul McMann, Weston, Massachusetts, United States of America, represented by Jus Maxima Law Offices, India.

Respondent is J McEachern, Concord, Massachusetts, United States of America, represented by Public Citizen Litigation Group, United States of America.

2. The Domain Names and Registrar

The disputed domain names <paulmcmann.com> and <paulmcmannsucks.com> are registered with GoDaddy.com, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on October 29, 2007. On October 31, 2007, the Center transmitted by email to GoDaddy.com, Inc. a request for registrar verification in connection with the domain name <paulmcmann.com>. On October 31, 2007, GoDaddy.com, Inc. transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details.¹

The Complaint has been thrice amended: first to substitute Respondent’s name for the name of the privacy service, second to correct an administrative defect, and third to add the domain name <paulmcmannsucks.com> to the Complaint.

Following Complainant’s request to add this additional domain name to this proceeding, on November 26, 2007, the Center transmitted by email to GoDaddy.com, Inc. a request for registrar verification in connection with that domain name. On November 26, 2007, GoDaddy.com, Inc. transmitted by email to the Center its

¹ Respondent registered the domain name <paulmcmann.com> using a privacy service. The Registrar confirmed the name and whois particulars of the actual registrant.

verification response confirming that the Respondent is listed as the registrant and providing the contact details. Complainant filed its Third Amended Complaint, the pleading now at issue,² on December 21, 2007.

The Center verified that the Complaint together with the amendments to the Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the “Policy”), the Rules for Uniform Domain Name Dispute Resolution Policy (the “Rules”), and the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the “Supplemental Rules”).

In accordance with the Rules, paragraphs 2(a) and 4(a), the Center formally notified the Respondent of the Complaint, and the proceedings commenced on December 21, 2007. In accordance with the Rules, paragraph 5(a), the due date for Response was January 10, 2008. At Respondent’s request the Center extended the due date for the Response to January 17, 2008. The Response was filed with the Center on January 18, 2008.

The Center appointed Richard G. Lyon as the sole panelist in this matter on January 28, 2008. The Panel finds that it was properly constituted and has jurisdiction over this proceeding. The Panel has submitted his Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Center to ensure compliance with the Rules, paragraph 7.

On January 30, 2008, the Panel issued Procedural Order No. 1, requesting additional documentation regarding one of the lawsuits that Complainant has brought against Respondent. Complainant submitted the requested documents on February 5, 2008.

4. Factual Background

A. The Parties and the Disputed Domain Names

The basic facts in this proceeding are simple and not disputed.

Complainant is a commercial builder who does business under his own name in and around Boston, Massachusetts, United States of America. He has a trademark for his name registered with the Commonwealth of Massachusetts. Until March 2006, Complainant owned the disputed domain name <paulmcmann.com>. Through inadvertence Complainant failed to renew this domain name.

Respondent is an individual residing in Concord, Massachusetts, United States of America. Concord is a suburb of Boston. Respondent and her husband entered into a contract with Complainant to develop some land, but the work was never completed and a dispute eventually led to a lawsuit. In March 2006 Respondent retaliated by registering the disputed domain name <paulmcmann.com> and launching a criticism site at that web address.

On a website at this domain name Respondent maintains a list of companies owned by Complainant and a blog to which she invites members of the public to post information regarding dealings with Complainant. The website includes two disclaimers. At the top is noted: “The website is not affiliated in any way with Paul McMann, who is a small Massachusetts real estate developer or any of his companies”; at the bottom,

² References in this decision to the “Complaint” are to the Third Amended Complaint.

“The information provided on this website is either an opinion or can be backed up with public records”. Respondent registered the second disputed domain name, <paulmcmannsucks.com>, in November 2007. The newly-created website at “www.paulmcmannsucks.com” has a similar disclaimer of affiliation with Complainant and a similar blog inviting posts about business dealings with Complainant.

B. Litigation between the Parties Involving the Disputed Domain Names

Complainant has commenced three actions in court against Respondent.

The First Action was filed in the United States District Court for the District of Massachusetts in 2006. In *Paul McMan v. John Doe*³ Civil Action No. 06-11825, Complainant asserted claims under Massachusetts state law for violation of his statutory right of privacy, infringement of his common law right to privacy, including common law copyright, and defamation. Complainant sought leave to subpoena the Registrar’s domain name registry for Respondent’s identity. In an opinion issued October 31, 2006, reported at 460 F. Supp. 2d 259, the district court denied this motion. First the court determined that it lacked subject matter jurisdiction, since the causes of action all arose under state law and there was no proof that the fictitious defendant resided in a state other than Massachusetts.⁴ Given the “novelty of the jurisdictional issues” the court added an alternative ground for dismissal. After carefully considering procedural issues relating to discovery generally and “Constitutional concerns” including the then-anonymous poster’s rights to free speech and anonymous speech, the court stated that it would deny the motion on the merits and dismiss the complaint for failure to state a claim. This conclusion was based in part upon the Court’s determination that the substance of the postings on Respondent’s website were “bland, vague and subjective and do not constitute defamation”, therefore bringing them within the ambit of the First Amendment.

Complainant then filed the Second Action in state court in Maricopa County, Arizona,⁵ also against “John Doe”, Case No. CV2006-092226. After full briefing and oral argument, by Minute Order dated January 18, 2007, the Arizona court granted Respondent’s Motion to Quash Complainant’s Request for Subpoena for the Registrar to obtain Respondent’s contact information on grounds similar to the court’s “alternative” holding in the First Action: “The Court believes that the correct standard to be applied in this situation is that announced in, *Doe v. Cahill*, 884 A.2d 451 (2005). Under that standard the Plaintiff [Complainant] must show that its claim would survive a Motion for Summary Judgment before being entitled to discover the identity of an anonymous speaker through any compulsory discovery process.” The Arizona court dismissed the Second Action without prejudice.

Complainant at some point discovered Respondent’s identity, for following dismissal of the Second Action he commenced the Third Action in Massachusetts state court against Respondent, Respondent’s husband, and the Registrar. In *Paul McMan v. GoDaddy.com, William G. Thompson, and Jean M. McEachern*, Superior Court,

³ Complainant brought this action against a fictitious defendant, claiming not to know Respondent’s identity. Respondent acknowledges that she used a privacy service to register <paulmcmann.com> but asserts that her identity was at all times available from the website at that address. The Panel notes that a recent examination of the website confirms that Respondent, and her current address, are now so listed.

⁴ In the United States of America, the federal district courts have limited subject matter jurisdiction, generally limited to cases involving an issue of federal (United States) law or involving citizens of different states.

⁵ Complainant presumably selected Arizona because that is the district in which the Registrar maintained its principal office.

Middlesex County No. MICO200702882, Complaint asserts claims for defamation and commercial disparagement against Mr. Thompson and the Registrar, and civil conspiracy against all defendants. Complainant asks for money damages and an injunction prohibiting continued operation of Respondent's website. After a hearing, the court on October 17, 2007, denied Complainant's motion for preliminary injunction. Complainant's action for damages and a permanent injunction remains pending. Complainant has recently filed an amended complaint against only Respondent and her husband, alleging trademark infringement, defamation, commercial disparagement, and intentional infliction of emotional distress. Again Complainant seeks money damages, an injunction (including prohibition on registration of any domain name that includes Complainant's name), attorneys' fees, and additional relief.

Shortly after commencement of the Third Action, Respondent registered the disputed domain name <paulmcmannsucks.com>.

5. Parties' Contentions

A. Complainant

Complainant contends as follows:

Rights in a Mark

Complainant has rights in his name as a trademark by virtue of his Massachusetts registration and continuous use of that name in commerce for a number of years. One of the disputed domain names is identical to the name and the second is confusingly similar to it.

No Right or Legitimate Interest

Complainant has never authorized Respondent to use his name, and Respondent is in no way affiliated with Complainant. Respondent's use of the disputed domain name has never been legitimate or *bona fide* under the Policy as "Respondent does not have the right to identify or sale" as Complainant, which she has done by adopting his name as the web address for her criticism site. Complainant cites a number of Policy decisions holding that the Constitutional right to free speech does not extend to use of another's mark as the site at which the criticism is gathered. Quoting (without attribution) from this Panel's decision in *Justice for Children v. Reetso / Robert W. O'Steen*, WIPO Case No. D2004-0175, Complainant argues: "Under the Policy the most revered and thoughtful critic or political speaker may not increase his audience by taking advantage of the renown or attraction that attaches to another's protected mark. Respondent is not entitled to use a soapbox or broadcast frequency owned by Complainant to lure Complainant's audience to his harangue."

Bad Faith

For the same reasons Respondent's registration and use of the disputed domain names were in bad faith, and undertaken to disrupt Complainant's business. Much of the content of Respondent's website is "defamatory". Respondent's use of a proxy registration to hide her name further indicates her bad faith in registration and use of the disputed domain names.

B. Respondent

Respondent contends that Complainant has failed to meet any of the Policy criteria:

Rights in a Mark

Complainant lacks a valid trademark in his name. The Massachusetts registration is not evidence of a mark and there are serious deficiencies in Complainant's registration, including a claimed use in commerce since his date of birth.⁶ Complainant cites *InterNational Organization for Standardization ISO v. Capaccio Environmental Engineering, Inc.*, WIPO Case D2006-1190, as evidence that Massachusetts, like many states, operates a “deposit” system with little review of the trademark’s validity, and that the United States Patent & Trademark Office does not consider state registrations as competent evidence in trademark usage. Complainant has not provided competent evidence of his use of his name as a business identifier to establish common law trademark rights sufficient to invoke the Policy.

Right and Legitimate Interest; No Bad Faith

Citing cases decided under the Policy, Respondent asserts that her use of the disputed domain names for non-commercial criticism sites directed against Complainant and his business practices is “an exercise of her First Amendment Right of Freedom of Speech, not an effort to commandeer the customers of complainant’s business”. As such her use is non-commercial and protected by paragraph 4(c)(iii) of the Policy, and not in bad faith. Respondent’s sites include prominent disclaimers of any affiliation with Complainant. As such her use of the disputed domain names has been legitimate, under trademark law and the Policy; as “bad faith under the Policy is not synonymous with criticism”. Nor is use of a proxy registration evidence of bad faith; such a registration, not involving false information, is usually harmless and is here consistent with First Amendment Right to remain anonymous in her criticism.

6. Discussion and Findings

A. Identical or Confusingly Similar

Complaint must establish two things to meet the requirements of paragraph 4(a)(i) of the Policy: whether he has rights in a mark, and, if so, whether the disputed domain names are identical or confusingly similar to it.

Complainant has established rights in his name sufficient to invoke the Policy. A state trademark registration usually suffices to establish such rights, see, e.g., *Teresa Christie, d/b/a The Mackinac Island Florist v. James Porcaro, d/b/a Weber's Mackinac Island Florist*, WIPO Case No. D2001-0653, *WIPO Overview of WIPO Panel Views on Selected UDRP Questions* (“WIPO Overview”), paragraph 1.1. Unlike some states of the United States of America and contrary to Respondent’s assertion, Massachusetts does not issue trademarks automatically upon filing; the Secretary of the Commonwealth does give filings some scrutiny before authorizing a mark,⁷ so the exception in the Overview does not apply.

⁶ Respondent has asked the court in the Third Action to order cancellation of the trademark, an application that apparently remains pending.

⁷ “About Trademarks and Service Marks,” website of the Secretary of the Commonwealth of Massachusetts, “<http://www.sec.state.ma.us/cor/corpweb/tmsmsm/tmsminf.htm>”.

In any event Respondent, who had done business with Complainant, was well aware of Complainant's use of his name as a commercial identifier when she registered the disputed domain names; that was one reason she selected these names for her websites. That fact alone is enough to satisfy the first element of paragraph 4(a)(i) here, even if as Respondent argues there are technical defects in his state registration.⁸ See, e.g., *James Good o/a Pornreports.com v. Mark Anderson*, WIPO Case No. D2004-0391; *Teresa Christie, d/b/a The Mackinac Island Florist v. James Porcaro, d/b/a Weber's Mackinac Island Florist, supra*.

One of the disputed domain names is identical to Complainant's mark and the other has the mark as its dominant feature, so the second element is also satisfied. Addition of a derogatory term does not obviate confusion under paragraph 4(a)(i). WIPO Overview, paragraph 1.3 (Majority View); *Joseph Dello Russo M.D. v. Michelle Guillaumin*, WIPO Case No. D2006-1627.

B. Rights or Legitimate Interests

As the parties' respective pleadings and citations make clear, neither the courts in the United States of America nor panels in Policy proceedings have reached a clear consensus as to whether a critic may use her subject's trademark as a web address to post critical commentary, even when (as in this proceeding) the gripe site is entirely non-commercial. As to the Policy, see WIPO Overview, paragraph 2.4, and discussion in *InMed Diagnostic Services, LLC, InMed Diagnostic Services of S.C., LLC, InMed Diagnostic Services of MA, LLC and InMed Diagnostic Services of IL, LLC v. James Harrison*, WIPO Case No. D2006-1230.⁹ Panels remain divided over whether such use is "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" and so within the safe harbor of paragraph 4(c)(iii) of the Policy. Compare majority opinion and D. Bernstein, dissenting, in *Joseph Dello Russo M.D. v. Michelle Guillaumi, supra*.

For the reasons given in the majority opinion in the *Dello Russo* case, the Panel may easily resolve this proceeding as to the domain name <paulmcmannsucks.com>. That domain name is in and of itself an exercise of Respondent's First Amendment rights and therefore protected:

"In a proceeding involving parties resident in the United States of America, the free speech guarantee of the First Amendment to the Constitution confers a right or legitimate interest on the use of a domain name that itself is an expression of opinion, at least in the absence of other evidence that the registration of this domain name was merely a pretext for cybersquatting."

Circumstances particular to this proceeding, moreover, provide compelling reasons why the Complaint should be denied as to the <paulmcmann.com> domain name as well.

Strictly speaking none of the judicial opinions in the three lawsuits brought by Complainant is *res judicata* and thus binding upon the Panel. The court in the First Action itself noted that it lacked subject matter jurisdiction, a prerequisite for

⁸ The Panel expresses no opinion on this issue, which as noted in the text is not relevant in the circumstances of this proceeding.

⁹ A number of cases on this subject are collected and discussed in the recent decision in *1066 Housing Association Ltd. v. Mr. D. Morgan*, WIPO Case No. D2007-1461.

application of *res judicata*. The Court in the second action dismissed the action without prejudice so its order, like the order denying the motion in the Third Action, is not a final judgment of the court, a separate requirement for application of that doctrine. Nor is the “alternative” opinion of the court in the First Action binding as collateral estoppel, again because of the court’s lack of subject matter jurisdiction and also because the legal and factual determinations were made under different substantive law standards.

Nevertheless in this, a subsequent administrative proceeding between the same parties involving very similar and sometimes overlapping subject matter, the Panel, a private individual operating within a very limited brief, owes great deference to all three judges’ determinations, even if they be only advisory in nature or of interim effect. All three judges received extensive briefing; two held a hearing with oral argument. Each judge had a record far more elaborately developed than is possible in a Policy proceeding in which testimony and oral argument are normally banned. Judge Tauro’s opinion in the First Action is thoughtful, thoroughly researched, and well reasoned. The Panel will not presume to depart from that opinion or the other courts’ findings and holdings. In light of those findings Complainant has not proven that Respondent lacks a right or legitimate interest in <paulmcmann.com>.

Prudential reasons and Policy precedent support this approach. It was Complainant who chose to proceed first in court, and there to assert claims under state law rather than federal law, the latter of which includes the Anti-Cybersquatting Consumer Protection Act,¹⁰ a statute that authorizes transfer of a disputed domain name on grounds very similar to those under the Policy. This omission, and his advancing charges of intentional torts such as defamation, make it clear that Complainant’s dispute with Respondent goes well beyond entitlement to the disputed domain name. He sought (and in the Third Action currently seeks) money damages and equitable relief and not the disputed domain name. As Complainant began this proceeding only after commencing three lawsuits, the Panel finds it difficult not to conclude that Complainant did so either for tactical advantage in court, as one part of a much broader dispute between the parties, or hoping to find a friendlier audience than the three judges who have ruled against him. When the broader dispute remains pending in court the Panel ought not to assist either party, see *Clover Gifts Inc. v. Airs Fragrance Products*, WIPO Case No. D2005-0776 (“Respondent’s pending action against Complainant, in Complainant’s home district, is the forum in which these matters should be determined.”); *Rudy Rojas v. Gary Davis*, WIPO Case No. D2004-1081 (“a plague o’ both your houses”). The Policy was not intended for this. Particularly the Panel ought not to assist a party that first selected the courts by offering him a third or fourth bite at the same cherry.

As to both disputed domain names the Complaint fails under paragraph 4(a)(ii).

C. Registered and Used in Bad Faith

As the Policy’s requirements are conjunctive the Panel need not address the issue of bad faith.

¹⁰ Complainant cites to this statute in the Complaint here, so he or his counsel was aware that a court action allowed for recovery of the disputed domain names.

7. Decision

For all the foregoing reasons, the Complaint is denied.

Richard G. Lyon
Sole Panelist

Dated: February 9, 2008