

Before the:

**WORLD INTELLECTUAL PROPERTY ORGANIZATION
ARBITRATION AND MEDIATION CENTER**

PAUL MCMANN
(Complainant)

-v-

JEANMARIE MCEACHERN
(Respondent)

Case No: D2007-1597 - YP

Disputed Domain Names:

<http://www.paulmcmann.com>
<http://www.paulmcmannsucks.com>

RESPONSE
(Rules, para. 5(b))

I. Introduction

[1.] On December 21, 2007, the Respondent received a Notification of Complaint and Commencement of Administrative Proceeding from the WIPO Arbitration and Mediation Center (the **Center**) by email informing the Respondent that an administrative proceeding had been commenced by the Complainant in accordance with the Uniform Domain Name Dispute Resolution Policy (the **Policy**), approved by the Internet Corporation for Assigned Names and Numbers (**ICANN**) on October 24, 1999, the Rules for Uniform Domain Name Dispute Resolution Policy (the **Rules**), approved by ICANN on October 24, 1999, and the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the **Supplemental Rules**). The Center set January 10, 2008, as the last day for the submission of a Response by the Respondent. Subsequently, Respondent requested a fourteen-day extension, which was opposed by Complainant, and the Center granted her a seven-day extension until January 17, 2008, to submit her Response. Respondent now submits this First Amended Response.

II. Respondent's Contact Details
(Rules, para. 5(b)(ii) and (iii))

[2.] The Respondent's contact details are:

Name: Jeanmarie McEachern
Address: 422 River Street, Boston, Mass. 02126
Telephone: +16175711146
Fax: n/a
E-mail: Mattafam@msn.com

[3.] The Respondent's authorized representative in this administrative proceeding is:

Gregory A. Beck
Public Citizen Litigation Group
1600 20th St. NW, Washington, DC 20009
(202) 588-7713
gbeck@citizen.org

[4.] The Respondent's preferred method of communications directed to the Respondent in this administrative proceeding is:

Electronic-only material

Method: e-mail
Address: gbeck@citizen.org
Contact: Gregory A. Beck

Material including hardcopy

Method: Post
Address: 1600 20th St. NW, Washington, DC 20009
Fax: 202-588-7795
Contact: Gregory A. Beck

III. Response to Statements and Allegations Made in Complaint
(Policy, paras. 4(a), (b), (c); Rules, para. 5)

[5.] The Respondent hereby responds to the statements and allegations in the Complaint and respectfully requests the Administrative Panel to deny the remedies requested by the Complainant.

IV. Factual Background
(Policy, paras. 4(a), (b), (c); Rules, para. 3)

This complaint marks the fourth attempt by complainant Paul McMann to shut down the website of an unhappy former customer. Three courts have already rejected McMann’s attempts to shut down respondent Jeanmarie McEachern’s site, in the process rejecting McMann’s argument that the site defamed him and misappropriated his name and photograph. As these courts have found, McEachern’s website, although undoubtedly critical of McMann, does not violate McMann’s rights and is protected by the First Amendment to the U.S. Constitution.

McMann is a real-estate developer in Massachusetts. McEachern and her husband signed a contract with McMann to develop some land, but the work was never completed and the dispute over the agreement eventually led to a lawsuit. To express her displeasure with the transaction, McEachern created a website and anonymously registered it with the domain name paulmcmann.com. The website prominently features McMann’s name with a statement that McMann has “turned lives upside down,” and a warning to the reader to “Be aware. Be prepared.” The site states that “[t]here are a number of people”—more than five and less than one thousand—“who have had negative dealings with this man.” Although McEachern acknowledges on the site that she is “sure there are people who have had positive experiences,” she notes that she hasn’t met any. McEachern at one point also posted a photograph of McMann on the site that she took from McMann’s own business website, but the picture was subsequently removed.

Links from McEachern’s main web page lead to a section of the site called “Known Companies,” which contains a list of businesses registered in McMann’s name obtained from the Massachusetts state corporations website, and to an unaffiliated Internet message board on which McMann posted a message soliciting a hacker to attack Doe’s site. *See* <http://antionline.com/showthread.php?t=273752&>

page=1. The page also contains a link to a message board where readers are invited to “sound off about your own experiences.” The site warns the reader to “keep all entries factual and truthful.” McEachern sells no advertising on the site and makes no money from it. A prominent disclaimer states that the site is not affiliated with McMann.

A. First Lawsuit

Upon discovering the site, McMann filed suit against McEachern as “John Doe” in the U.S. District Court for the District of Massachusetts. *McMann v. Doe*, 460 F. Supp. 2d 259 (D. Mass. 2006). McMann claimed that Doe had violated his right to privacy, infringed his copyright in his photograph, and defamed him. Without attempting to notify McEachern of the lawsuit, though her email address was posted prominently on the site, McMann then filed an ex parte motion for leave to subpoena GoDaddy.com and Domains by Proxy, Inc., two jointly operated companies that registered the paulmcmann.com domain name and hosted the website.

The court dismissed the case sua sponte. It initially held that it lacked jurisdiction over the case because McMann alleged no federal claims and the state citizenship of John Doe could not be determined for purposes of diversity jurisdiction. The court then went on to examine whether a subpoena against Doe would otherwise have been proper. Acknowledging that “anonymous speakers should not be able to use the internet to freely defame individuals,” the court nevertheless held that McMann had failed to state a claim for any cause of action that justified violating Doe’s First Amendment right to speak anonymously. The court rejected McMann’s claim that McEachern (referred to as “John Doe”) had misappropriated his identity, noting that she did not operate the site for commercial purposes, “but rather as part of a declaration of [her] opinion of Mr. McMann.” The court also rejected McMann’s claim for defamation, noting that the content on McEachern’s website was bland, vague, subjective, and not provably true or false. Accordingly, the court dismissed the case.

B. Second Lawsuit

Six days later, McMann filed a second case against McEachern, again as “John Doe,” in Arizona state court, stating essentially the same facts as in the Massachusetts complaint. Again without notifying McEachern that he was attempting to reveal her identity, McMann then sent a subpoena to McEachern’s domain name registrar seeking identifying information. After receiving notification of the subpoena from her registrar, McEachern filed a motion to quash and to dismiss on the grounds that the court lacked jurisdiction and that McMann failed to state a claim for relief sufficient to overcome her First Amendment right to anonymity. The court agreed that McMann had not met his burden of stating a claim, and therefore dismissed the case. *See Exh. 1* (decision).¹

C. Third Lawsuit

McMann then filed a third lawsuit in Massachusetts state court, again alleging essentially the same set of facts, but this time against McEachern in her own name, along with her husband. McMann moved for a preliminary injunction against the site, and, for the third time, did not provide notice of the lawsuit to McEachern. When McMann’s counsel was unable to produce proof of service, the judge ordered notice, and, after a hearing, denied the requested injunction. In his complaint, McMann has indicated his intention not to appeal that decision. However, McMann has not dismissed the case, which remains pending.

After enduring three lawsuits from McMann, McEachern registered a new domain name, paulmcmannsucks.com, which she also used to host her criticism of McMann. McMann now asks this Panel to grant him ownership of both McEachern’s websites. As three courts have already found, however, he has no right to shut down the site. This Panel should also reject McMann’s request.

¹ Contrary to McMann’s representation, the dismissal was not on a technical jurisdictional ground. As is plain from the court’s order, the court dismissed the case

A. Whether the domain names are identical or confusingly similar to a trademark or service mark in which the Complainant has rights;
(Policy, para. 4(a)(i))

Paragraph 4(a)(i) of the Policy provides that the domain name at issue must be identical or confusingly similar to a trademark or service mark in which the complainant has rights. McMann claims to have trademark rights in the phrase “Paul McMann.”

Although McMann registered his name as a trademark in Massachusetts shortly before bringing this action, he has no real trademark rights in the name. McMann’s registration states that the name’s first use in commerce is August 28, 1958, his date of birth. *See* Exh. 2 (trademark application); Exh. 3 (real estate license with date of birth). Given the recent date of the registration, and the fact that it is impossible that McMann could have used his name in commerce since birth, the Massachusetts registration should not be regarded as competent evidence of trademark registration. Indeed, previous panels have noted that Massachusetts, like many states, operates a “deposit” system with little review of a trademark’s validity. *Int’l Org. for Standardization ISO v. Capaccio Envtl. Eng’g, Inc.*, D2006-1190 (WIPO Nov. 28 2006). For this reason, the United States Patent and Trademark Office does not consider state registrations as competent evidence of trademark usage. *See, e.g., Upjohn Co. v. Universal Wholesale Corp.*, 161 U.S.P.Q. 558 (T.T.A.B. 1969); *Philip Morris, Inc. v. Liggett & Myers Tobacco Co.*, 139 U.S.P.Q. 240 (T.T.A.B. 1963). Because she believes the Massachusetts trademark registration was fraudulently obtained, McEachern on January 17, 2008, filed an action to cancel McMann’s

because McMann did not establish that he had a claim, and therefore the court refused to violate the owner’s anonymity.

registration in Massachusetts state court. *See* Exh. 4 (complaint). That action is pending.²

Nor has McMann alleged or demonstrated that he uses his name in commerce such that he could have established a common-law trademark right. Although previous panels have not answered the question of whether the Policy applies to protection of personal names in the absence of a showing of common-law trademark or service mark rights, *see Kendall v. Mayer*, D2000-0868 (WIPO Oct. 26, 2000), under United States trademark law a personal name can achieve protectable status only after it has had such an impact on a substantial part of the buying public that it has established secondary meaning. “Secondary meaning grows out of long association of the name with the business, and thereby becomes the name of the business as such . . . submerg[ing] the primary meaning of the name as a word identifying a person, in favor of its meaning as a word identifying that business.” 2 McCarthy on Trademarks & Unfair Competition § 13:2, at 13-6 (4th ed. 2001); *see generally id.* §§ 28:8 through 28:12. In other words, the person’s name must have, in the public’s mind, become synonymous with the business. McMann has not attempted to establish that there is such a widespread recognition of his name, nor could he. McMann operates multiple businesses, but none of them are named “Paul McMann.”

B. Whether the Respondent has rights or legitimate interests in respect of the domain names;

(Policy, para. 4(a)(ii))

Paragraph 4(a)(ii) of the Policy requires a complainant to show that the respondent has no legitimate interest in the name at issue. Paragraph 4(c)(iii) states

² The International Organization for Standardization ISO panel held that in order for it to disregard a state registration, the respondent must make “a clear showing that the registration is invalid or inconsistent with overriding federal rights.” The fact that McMann registered his name’s first use in commerce as his date of birth constitutes such a clear showing.

that any noncommercial fair use of the domain name, without intent for commercial gain to misleadingly divert consumers, constitutes a legitimate interest in the domain name. Therefore, “use of a mark in a domain name where the Internet site involves commentary, comparative advertising, criticism, parody, or news reporting is beyond the scope of the . . . Policy.” *TMP Worldwide, Inc. v. Potter*, D2000-0536 (WIPO Aug. 5 2000).

As previous panels have recognized, the right to engage in criticism constitutes a legitimate interest in a mark. For example, in *Bosley Medical Institute v. Kremer*, a dissatisfied customer of Bosley’s established a website criticizing the company’s sales and medical practices. Under the noncommercial fair use provision of the Policy, the panel upheld the consumer’s use of the domain name “bosleymedical.com.” D2000-1647 (WIPO Feb. 28 2001). Similarly, another panel allowed a former employee of the Bridgestone-Firestone tire company to keep the name “bridgestone-firestone.net” to present his side of a dispute over pension payments. *See Bridgestone Firestone, Inc. v. Myers*, D2000-0190 (WIPO July 6 2000); see also *Britannia Bldg. Soc’y v. Britannia Fraud Prevention*, D2001-0505 (WIPO July 6 2001) (permitting a member of a building society to keep the name “britanniabuildingsociety.org” for a web site that criticized the practices of the society).³

³ United States courts have also recognized that the First Amendment to the U.S. Constitution protects the right to use a trademark for purposes of commentary or criticism. *See, e.g., Lamparello v. Falwell*, 420 F.3d 309 (4th Cir. 2005) (holding that First Amendment concerns limited application of federal trademark law to the website fallwell.com, a gripe site about Reverend Jerry Falwell); *Taubman Co. v. Webfeats*, 319 F.3d 770, 776 (6th Cir. 2003) (holding that the First Amendment protected the website “shopsatwillowbend.com” from a claim by the “Shops at Willow Bend” shopping mall); *Ficker v. Tuohy*, 305 F. Supp. 2d 569, 572 (D. Md. 2004) (holding that that a congressional candidate’s website robinficker.com was protected by the First Amendment against claims by opposing candidate Robin Ficker); *Crown Pontiac, Inc. v. Ballock*, 287 F. Supp. 2d 1256 (N.D. Ala. 2003) (holding that the gripe site crownpontiacnissan.com was protected against claims by the car dealer Crown Pontiac Nissan); *Northland Ins. Co. v. Blaylock*, 115 F. Supp.2d 1108 (D. Minn. 2000) (holding that the critical site northlandinsurance.com was protected critical speech about Northland).

In this case, McEachern engaged in noncommercial, fair use of the name “Paul McMann.” McEachern sells no advertising and otherwise makes no money from the site. She sells no products or services from the site, so there is no possibility that visitors could mistakenly purchase something from McEachern believing they were purchasing from McMann. Finally, McEachern devotes her site to purposes of criticizing McMann, and no reasonable visitor to the site would believe that McMann had created the site for purposes of criticizing himself. As in *Bosley* and *Bridgestone*, McEachern’s use of the name was an exercise of her First Amendment right to freedom of speech, not an effort to commandeer the customers of the complainant’s business.⁴

Moreover, previous panels have recognized the doctrine of nominative fair use, which protects use of a trademark to accurately refer to the trademark owner. Nominative fair use is based on the rationale that the owner of a trademark cannot use his control over the mark to prevent others from expressing their constitutionally protected opinions. *See Pfizer, Inc. v. Van Robichaux*, WIPO Case No. D2003-0399 (WIPO Sept. 25 2006); *see also New Kids on the Block v. New Am. Pub.*, 971 F.2d 302, 306-309 (9th Cir. 1992); McCarthy on Trademarks § 23.11. In *Pfizer*, the panel articulated a three-part test for nominative fair use: (1) the goods or services are not readily identifiable without the use of the mark, (2) only so much of the mark is used that is necessary to identify the service or goods, (3) the user does not suggest sponsorship or endorsement by the mark holder. McEachern satisfies this test. First, there is no practical way to refer to McMann other than by his name. Second, McEachern uses only McMann’s name, and there are not any other aspects of McMann’s name that McEachern could have used. Third, McEachern never suggests

⁴ McMann’s contention that the respondent “intentionally attempted to attract, for commercial gain, internet users to the Respondent’s web sites or other on-line location” is spurious. McMann alleges no facts—and there are none—that could support this claim. The site is clear on its face: McEachern does not compete with McMann or otherwise generate money from the site.

that her website is sponsored by McMann. Indeed, the website includes a prominent disclaimer at the top of the page, in bold red type, stating: “This website is not affiliated in any way with Paul McMann who is a small Massachusetts real estate developer or any of his companies.” Even without the disclaimer, any visitor to McEachern’s site would realize immediately, based on the site’s critical content, that McMann did not sponsor it.⁵

C. Whether the domain names have been registered and are being used in bad faith.

(Policy, para. 4(a)(iii))

Paragraph 4(a)(iii) of the Policy mandates that the domain name holder must register or use the name in bad faith. For a finding of bad faith, the complainant must prove that the respondent acquired the domain name for the primary purpose of selling the name to the true owner of the trademark or with the intent to reap commercial gains from customers of a competitor. *See* Policy paragraph 4(b). McMann cannot make that showing here.

Although McMann is correct that, in some cases, the mere *passive* holding of a domain name, without using the name for any viable purpose, may support an inference of bad faith, it does not follow, as he suggests, that making *active* use of a domain name also creates such an inference. Unlike the decisions cited by McMann, the respondent in this case did not passively squat on the complainant’s trademark. Instead, she actively used the domain name to exercise her right to express her opinion. Such use does not constitute bad faith. *See Bridgestone/Firestone v. Jack*

⁵ Unlike *Kirkland & Ellis LLP v. DefaultData.com*, in which the respondent used the domain name of a law firm to criticize the whole legal industry and the panel found no fair use, D2004-0136 (WIPO April 2, 2004), McEachern uses the domain name to specifically criticize McMann. Moreover, although there is some disagreement in the panel authority, recent panels have recognized an emerging consensus that use of domain names for purposes of criticism is a protected use. *Howard Jarvis Taxpayers Ass’n v. Paul McCauley*, D2004-0014 (Apr. 22, 2004).

Myers, D2000-0190 (WIPO July 6, 2000); *Kendall v. Mayer*, D2000-0868 (WIPO Oct. 26, 2000). Indeed, the only inference that can be drawn from McEachern’s use of the domain name for criticism of Paul McMann is the obvious one—that she intended to use the domain name for purposes of criticism.

Moreover, McMann is wrong when he argues that McEachern’s registration of two domain names suggests bad faith. Although some panel decisions have held that the registration of more than one domain name can be evidence of bad faith, the rationale behind these decisions is that the purchase of multiple domain names may indicate that the respondent is attempting to prevent the complainant from using its own trademark on the Internet. See *Ourisman Dodge, Inc. v. Ourisman “Okie doke” Dodge dot com and Ourificeman Dodge dot com*, WIPO Case No. D2001-0108 (WIPO Mar. 22 2001). Here, the second domain name registered by McEachern, paulmcmannsucks.com, is not a website that McMann would be likely to use for his own business. McEachern’s registration of this domain name therefore provides no evidence that McEachern was trying to prevent McMann from registering his own name.

Without authority, McMann argues that McEachern’s use of the word “sucks” in the second domain name shows bad faith. Contrary to McMann’s apparent understanding, however, “bad faith” under the Policy is not synonymous with criticism. Instead, as the panel explained in *The Vanguard Group, Inc. v. Lorna Kang*, the Policy is narrow in scope. It applies only to disputes involving alleged bad faith registration and use of domain names – conduct commonly known as “cybersquatting” or “cyberpiracy”. The Policy does not apply to other kinds of disputes between trademark owners and domain name registrants.

D2002-1064 (WIPO Dec. 2, 2003). McMann’s real complaint is that McEachern’s site is “derogatory” toward him, but that complaint is not within the scope of the Policy and, in any case, three courts have already rejected McMann’s claims of defamation.

Finally, McMann asserts that the use of a proxy to register anonymously “clearly signifies bad faith.” This statement misinterprets prior panel decisions. For example, in *Ticketmaster Corp. v. Dmitri Prem*, WIPO Case No. D2000-1550 (WIPO Jan. 16 2001), the panel found bad faith because in applying for the registration of the site through a proxy, the respondent provided *false* information to the registrar. Here the respondent provided no false information, and used a proxy only to exercise her First Amendment right to remain anonymous. *See McMann v. Doe*, 460 F. Supp. 2d 259 (D. Mass. 2006); *see generally, Dendrite Int'l, Inc. v. Doe*, 342 N.J. Super. 134 (N.J. App. Div. 2001). As the U.S. District Court for the District of Massachusetts held, McEachern has a First Amendment right to communicate anonymously her opinions about McMann. Indeed, it is ironic that McMann would argue that McEachern’s anonymity shows bad faith after two courts have already rejected his attempts to breach that anonymity.

IV. Administrative Panel

(Rules, paras. 5(b)(iv) and (b)(v) and para. 6; Supplemental Rules, para. 7)

[6.] The Respondent elects to have the dispute decided by a single-member Administrative Panel.

V. Other Legal Proceedings

(Rules, para. 5(b)(vi))

The history of the other cases between the parties was set out in the introduction. As explained there, McMann filed suit twice previously against McEachern as “John Doe,” and both cases were dismissed. Although McMann states that both these suits were dismissed on jurisdictional technicalities, both courts in fact found that McMann failed to state a claim. McMann’s third case against McEachern regarding the Paul McMann site is pending in Massachusetts state court. Although McMann states in his complaint that he does not intend to appeal the denial of his motion for a preliminary injunction in that case, the case has not yet been dismissed.

In addition, McEachern on January 17, 2008, filed an action to cancel McMann's registration in Massachusetts state court on the ground that the trademark was fraudulently obtained. That action is pending.

Finally, McMann makes an offhand reference to previous litigation between the parties that resulted in a favorable settlement to him. That dispute involved the contract to develop property and has no relation to the domain names at issue here.

VI. Communications

(Rules, paras. 2(b), 5(b)(vii); Supplemental Rules, para. 3)

- [7.] A copy of this Response has been sent or transmitted to the Complainant on January 17, 2008 by email to suryasenthil@jusmaxima.com.
- [8.] This Response is submitted to the Center in electronic form (except to the extent not available for annexes), and in four (4) sets together with the original.

VII. Payment

(Rules, para. 5(c); Supplemental Rules, Annex D)

n/a.

VIII. Certification

(Rules, para. 5(b)(viii), Supplemental Rules, para. 12)

- [9.] The Respondent agrees that, except in respect of deliberate wrongdoing, an Administrative Panel, the World Intellectual Property Organization and the Center shall not be liable for any act or omission in connection with the administrative proceeding.
- [10.] The Respondent certifies that the information contained in this Response is to the best of the Respondent's knowledge complete and accurate, that this Response is not being presented for any improper purpose, such as to harass, and that the assertions in this Response are warranted under the Rules and under applicable law, as it now exists or as it may be extended by a good-faith and reasonable argument.

Respectfully submitted,

/s/Gregory A. Beck
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