

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

REV. DR. JERRY FALWELL)	
)	
Liberty University)	
1971 University Boulevard)	
Lynchburg, Virginia 24502)	
)	
and)	
)	
LIBERTY ALLIANCE)	
)	
3806-B Wards Road)	
Lynchburg, Virginia 24502)	
)	
Complainants)	Disputed Domain Names
)	
v.)	JERRYFALWELL.COM
)	JERRYFALLWELL.COM
GARY COHN)	
)	
Prolife.net and God.info)	
1954 First Street)	
Highland Park, Illinois 60035)	
)	
Respondent.)	

RESPONSE

Introduction

In this proceeding, Jerry Falwell, a notoriously humorless right-wing preacher, is trying to shut down a non-commercial Internet site that makes fun of him for blaming the September 11 bombing of American landmarks on the supposed moral decline of America, and quotes the Bible at Falwell in exactly the same way that Falwell likes to quote it at other people. Falwell expresses concern that members of the Internet viewing public may learn of Gary Cohn’s “false thinking” about the Bible, and complains that even if the site claims to be a parody, it really isn’t very funny.

However, the panel need not choose between Falwell’s and Cohn’s religious views, nor must

it decide whether the site is funny. It need not even decide the controversial question whether an individual may use the UDRP to compel transfer of a domain name using his non-trademarked personal name to himself, to the exclusion of all other persons with the same name. Cohn has registered these two names for the purpose of mounting a non-commercial web site that expresses his constitutionally protected opinions about Falwell. This purpose is recognized as legitimate and good faith under established UDRP precedent. The complaint should be rejected as yet another example of “cyberbullying,” where the URDP is invoked to suppress dissent and not to further established trademark principles.

A. Respondent’s Contact Details (for both domain names)

[1] Gary Cohn
1954 First Street
Highland Park, Illinois 60035
gary@prolife.net

[2] Respondent may be contacted though the following counsel for the purpose of this administrative proceeding:

Paul Alan Levy
Public Citizen Litigation Group
1600 - 20th Street, N.W.
Washington, D.C. 20009
(202) 588-1000: Voice
(202) 588-7795: Fax
plevy@citizen.org

[3] Respondent’s preferred methods of contact are as follows:

For electronic material (no attachments larger than 1 MB):
Paul Alan Levy at plevy@citizen.org

For material including hard copy and electronic materials larger than 1 MB:
Paul Alan Levy
Public Citizen Litigation Group
1600 - 20th Street, N.W.

Washington, D.C. 20009
(202) 588-7795: Fax

[4] Respondent has no objection to the desire of the complainants to pursue this matter jointly; he also has no objection to the panel's consideration of the two domain names in the same proceeding. However, he objects strenuously to one of the reasons offered for the joint proceeding – the allegation that God.info is a fictitious name. The use of the name God.info – at Cohn's own mailing address – is consistent with the purpose of registering the two domain names and the creation of the underlying web site, that is, to parody complainant Jerry Falwell. Entry of the domain name God.info into a browser points toward respondent Cohn's web site, which also makes clear exactly how Cohn can be contacted.

B. Response to Complainants' Statements and Allegations.

The complaint is based on three related propositions:

- 1) That a famous individual can use the UDRP to demand transfer of domain names that incorporate his personal name because mere fame establishes a common law trademark in his own name.
- 2) That no other person can have a legitimate interest in a domain name that incorporates a personal name unless that person has the same name; and
- 3) That the use of a domain name incorporating the name of an individual complainant disrupts that individual's business, will lead internet viewers to false teachings about the Bible, and hence is necessarily done in bad faith.

As we explain in this brief, each of these contentions is erroneous.

1. Substantial Precedent Calls Into Questions the Ability of Famous Individuals to Use the UDRP to Preempt Domain Names Similar to Their Nontrademarked Personal Names.

The first flaw in the complaint is that, as the complaint acknowledges, Jerry Falwell has never attempted to register his name as a trademark. Although complainants cite a handful of cases that have allowed individuals, who were found to have used their names as trademarks for goods and

services of various kinds, to pursue UDRP proceedings against domain names that resembled such trademarks, what complainants never do in this case is demonstrate that Falwell has been using his name as a trademark to identify certain goods and services. Instead, complainants content themselves with a demonstration that Falwell is a very famous person.

No doubt complainant is a very important Jerry Falwell. But he is scarcely the only Jerry Falwell in the world, or even in the United States. In order to achieve the protection of the trademark laws, preventing other persons from using the name in a way that might cause confusion about whether this Jerry Falwell is the sponsor of a statement, he must show that he has used his name **as a trademark**. "The key to the law of trademarks is the use of a word or symbol in such a way that it identifies and distinguishes a **commercial** source." *Edmiston v. Jordan*, 1999 WL 1072492 (S.D.N.Y.1999), *quoting* 4 McCarthy on Trademarks and Unfair Competition, § 28:8, at 28-11 (4th ed. 1996) (emphasis in original). In this regard, Professor McCarthy distinguishes between the use of a name to denominate a person and use to denominate a business: "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.

Complainants have failed to satisfy this key element of the test for the establishment of a trademark. All their evidence of Falwell's personal fame, and of the meaning that most members of the public would draw from seeing a reference to the name "Jerry Falwell," may help them establish one of the elements of a claim under the right of publicity. But the UDRP does not encompass the right of publicity, only the right against infringement that creates a likelihood of

confusion of a trademark. Consequently, this case must be treated as one, like the case of *Springsteen v. Burgar*, Case No. D2000-1532 (WIPO Arbitration Panel 1/25/01), <http://arbiter.wipo.int/domains/decisions/html/2000/d2000-1532.html>, where the complaint should be rejected for failure to establish that the famous name has been used as a trademark.

Moreover, the limited remedies available to a UDRP panel create another significant problem here. This complaint has been brought by an individual named Jerry Falwell who lives in Lynchburg, Virginia. But a simple search on switchboard.com identified two different Jerry Falwells in Virginia alone, as well as two different addresses for a Jerry Falwell in Kentucky (contact by telephone revealed that those listings are for the same individual). The same source identifies a Jerome Falwell in Michigan, who might well be known as Jerry Falwell, plus three persons named Falwell with the first initial J, who might also be known by the nickname "Jerry." Annex A attached to this Response identifies several persons who may use the name Jerry Falwell. Absent proof that the Jerry Falwell of Lynchburg Virginia has established a trademark in that name, why should he have any greater right to the domain names identical or similar to jerryfalwell.com than these other Jerry Falwells, just because he had the thousands of dollars needed to pursue this proceeding against the respondent? And yet the relief that the complainants in this proceeding demand is that the domain name be transferred to them, to the exclusion of all other persons who may have rights in the name.

2. Both the UDRP and the Trademark Laws Permit the Use of a Name for a Website That Is About the Owner of the Name, Rather Than Being Sponsored by the Owner of the Name.

The fundamental flaw in the complainants' argument is that it rests on an erroneous assumption – that a domain name necessarily identifies the owner or sponsor of the web site located

at that domain name. In fact, a domain name may just as easily reflect the subject or title of a web site as its owner or sponsor, and hence a person who desires to create a web site that is “about” the owner of a well-known (or trademarked) name, has just as legitimate a claim to that domain name as does the owner of the name or trademark. The UDRP specifically recognizes this defense in paragraph 4(c)(iii): “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.”

Thus, many UDRP decisions have upheld the use or registration of domain names that were identical to a trademark, by persons other than the owner of the trademark, where the purpose was to mount a web site about the owner of the name. The largest number of such cases have involved the use of the name for the purpose of criticizing the name owner. For instance, a dissatisfied customer of Bosley Medical Institute was allowed to retain the domain name bosleymedical.com to establish a web site criticizing BMI’s sales and medical practices, *Bosley Medical Institute v. Kremer*, D2000-1647 (WIPO February 28, 2001), <http://arbiter.wipo.int/domains/decisions/html/2000/d2000-1647.html>; a former employee of the Bridgestone-Firestone tire company was allowed to keep the name bridgestone-firestone.net to present his side of a dispute over pension payments, *Bridgestone Firestone, Inc. v. Myers*, D2000-0190 (WIPO July 6, 2000), <http://arbiter.wipo.int/domains/decisions/html/2000/d2000-0190.html>; and a member of a building society was permitted to register the name britanniabuildingsociety.org for a web site that criticized the practices of the building society. *Britannia Building Society v. Britannia Fraud Prevention*, D2001-0505 (WIPO July 6, 2001)

<http://arbiter.wipo.int/domains/decisions/html/2001/d2001-0505.html>.¹ As the panel stated in *Bridgestone-Firestone*, “The Respondent’s use of the Domain Name to designate a website for criticism and commentary about the Complainants constitutes legitimate noncommercial use and fair use within the meaning of the Policy. The ‘fair use doctrine applies in cyberspace as it does in the real world.’” (citation omitted).

In a number of other cases, domain names selected for the purpose of praising the name owner, so-called “fan sites,” were also upheld under the UDRP. For example, in *Springsteen v. Burgar*, Case No. D2000-1532 (WIPO Arbitration Panel 1/25/01), <http://arbiter.wipo.int/domains/decisions/html/2000/d2000-1532.html>, the panel refused to take the name bruce.springsteen.com away from a fan and transfer it to the well-known musician, ruling, “Users fully expect domain names incorporating the names of well known figures in any walk of life to exist independently of any connection with the figure themselves, but having been placed there by admirers or critics as the case may be.” Similarly, the arbitrator in *UEFA v. Hallam*, <http://arbiter.wipo.int/domains/decisions/html/2001/d2001-0717.html> (2001), upheld the right of a soccer fan to register the name uefa2004.com for the purpose of creating a soccer fan discussion web site devoted to the soccer championship scheduled to be held in 2004 by UEFA (Europe’s

¹*Pensacola Christian College Inc v. Gage* (12/12/2001), <http://www.arbforum.com/domains/decisions/101314.htm>; *Dorset Police and Geery Coulter*, <http://www.eresolution.com/services/dnd/decisions/0942.htm>; *Mayo Foundation for Education and Research v. Briese*, <http://www.arbforum.com/domains/decisions/96765.htm> (2001). See also *RMO Inc v. Burbidge*, <http://www.arbforum.com/domains/decisions/96949.htm> (2001) (“The use of domain names for non-commercial purposes is a recognized method of proving rights and legitimate interests on the part of such user even when the use may cause some disadvantage or harm to other parties. See *Kendall v. Mayer*, D2000-0868 (WIPO Oct. 26, 2000), *TMP Worldwide, Inc. v. Potter*, D2000-0536 (WIPO Aug. 5, 2000). See also *Lockheed Martin Corp. v. Etheridge*, D2000-0906 (WIPO Sept. 24, 2000).”).

official soccer federation). *See also Newport News v. VCV Internet*, AF-0238 (eResolution July 18, 2000), <http://www.eresolution.com/services/dnd/decisions/0238.htm> (upholding use of domain name newportnews for directory site devoted to city of Newport News); *Pocatello Idaho Auditorium District v. CES Marketing Group*, <http://www.arbforum.com/domains/decisions/103186.htm> (2002) (same ruling for Pocatello).

Given the complainants' repeated invocation of the trademark laws of the United States, which would govern should one of the parties seek judicial intervention to contest the outcome of this proceeding, it is noteworthy that respondent will also prevail under those authorities. Thus, the courts have developed the concept of "nominative fair use," where the speaker uses the trademark to speak about the trademark holder or its goods and services. *Brookfield Communications v. West Coast Video*, 174 F.3d 1036, 1065-66 (9th Cir. 1999); *New Kids on the Block v. New America Pub.*, 971 F.2d 302, 306-309 (9th Cir. 1992); *see also* McCarthy on Trademarks § 23.11. The owner of a trademark cannot use his control over the use of that mark to prevent others from expressing their constitutionally protected opinions.

Thus, for example, the courts uniformly recognize that the concept of fair use, as construed consistently with the First Amendment, allows the publisher or author of a book about a famous person to use that person's name in the title of the book. *Twin Peaks Production v. Publications Int'l*, 996 F.2d 1366, 1379 (2d Cir. 1993); *Rogers v. Grimaldi*, 875 F.2d 994, 999 (2d Cir. 1989). Domain names can play the same role as a book title in denominating the subject of the underlying web site. For example, apples.com is the domain name of a web site about apples, even though "Apple" is also the trademark of a well-known computer company.

By the same token, when a dissatisfied consumer established a web site at

northlandinsurance.com to publicize his grievances about the small amount that Northland Insurance Company had paid on a claim that he had submitted, the court held that the consumer had made a legitimate use of the domain name for the purpose of expressing his opinions about the complaining company. *Northland Ins. Co. v. Blaylock*, 115 F. Supp.2d 1108 (D. Minn. 2000). The web site was critical of the plaintiff on its face, and there was no possibility that any member of the public could have been confused about whether Northland was the sponsor of the web site. Here, too, Cohn's web site plainly represents an attack on Falwell, and no person visiting his site could possibly be confused about whether Falwell himself is the sponsor of the site. The non-confusing and noncommercial nature of the sites is apparent from the copy of Cohn's web site, which is attached to this Response as Annex B.

In this regard, we disagree with the complainants' assertion that the web site's disclaimer of sponsorship by Falwell is irrelevant to the case. The complainants argue that "a disclaimer should be given little weight at United States law," but the decisions are expressly to the contrary. Even in a commercial advertisement, "The First Amendment demands use of a disclaimer where there is a reasonable possibility that it will suffice to alleviate consumer confusion." *Consumers' Union v. General Signal Corp.*, 724 F.2d 1044, 1053 (2d Cir. 1983).

Complainants have cited a handful of cases in support of its position, but they are distinguishable because each involved the registration and use of confusing domain names for commercial purposes. For example, in *OBH, Inc. v. Spotlight Magazine*, 86 F. Supp.2d 176 (W.D.N.Y. 2000), the owner of a commercial apartment location service that competed with the newspaper *Buffalo News* for both advertising and readers, registered the domain name thebufallonews.com for the purpose of promoting its own service. Similarly, although the case of

People for the Ethical Treatment of Animals v. Doughney, 263 F.3d 359 (4th Cir. 2001), may have been a closer one, because of the parodic character of the underlying web site, the defendant in that case was a classic cybersquatter – he registered a large number of domain names using the trademarks of other persons, including the domain name www.peta.org. *Id.* at 362. After PETA asked him to give it the domain name, he responded with the typical gambit of the hardened cybersquatter: He asked them to make him an offer for the domain name, and threatened to keep it and drive a great deal of traffic to his own site, unless they paid him enough money. *Id.* at 363. And, he established a web site that PETA would abhor, linking to a series of commercial enterprises that use animal products that can be obtained only by killing the animals, to give PETA extra reason to surrender to his extortion. *Id.* at 363, 366. There are no such commercial or bad-faith elements present in this case that support a finding that Cohn’s use of the domain names “jerryfalwell.com” and “jerryfallwell.com” are anything other than a legitimate effort to subject the individual complainant in this case to sarcastic criticism.

Complainants argue that if a domain name is confusingly similar to a trademark, that is sufficient to establish liability even if the underlying web site is obviously not confusing with respect to source. This argument, which rests on the doctrine of “initial interest confusion,” ignores the strict limitations of that doctrine under U.S. trademark law. Trademark law generally protects only against confusion on the part of the “reasonably prudent consumer.” *Dreamwerks Prod. Grp. v. SKG Studio*, 142 F.3d 1127, 1129 (9th Cir. 1998); *see also Homeowners Grp. v. Home Mktg. Specialists*, 931 F.2d 1100, 1111 (6th Cir. 1991) (“the typical buyer exercising ordinary caution”). Trademark law does not guard against merely shortlived confusion on the part of persons who are only casually acquainted with the business of the trademark holder. *Safeway Stores v. Safeway*

Discount Drugs, 675 F.2d 1160, 1167 (11th Cir. 1982). Thus, a finding of initial interest confusion is likely to be probative of likelihood of confusion only where parties are commercial competitors whose products are closely related, and where the target audience is unlikely to take care when making decisions about which products to purchase. *Checkpoint Systems v. Check Point Software Tech.*, 269 F.3d 270, 296-297 (3d Cir. 2001).

Specifically in the Internet context, recent authority discounts the importance of initial interest confusion in finding a trademark violation when the author of the site using another's trademark has some legitimate interest in the domain name:

[A]ny initial confusion that arises from Defendant's use of his strick.com domain site, specifically, that consumers will realize that they are at the wrong site and will go to an Internet search engine to find the right one, is not enough to be legally significant. . . . It is clear that Internet surfers are inured to the false starts and excursions awaiting them and are unlikely to be dissuaded, or unnerved, when, after taking a stab at what they think is the most likely domain name for particular web site guess wrong and bring up another's webpage.

Strick Corp. v. Strickland, 162 F. Supp.2d 372, 377 (E.D. Pa. 2001).

See also *The Network Network v. CBS*, 54 U.S.P.Q.2d 1150, 1155 (C.D. Cal. 2000) ("there is a difference between inadvertently landing on a web site and being confused").

In this case, respondent has a legitimate interest in using a domain name that identifies the subject of his criticism. He is not a commercial competitor of the complainants, and indeed his site is completely non-commercial, offering no goods for sale and not even carrying any banner advertisements or any other means of recouping the costs of the web site. Moreover, any fundamentalist Christian or other potential adherent of complainant Falwell would know immediately upon reaching Cohn's site that it is a criticism site and not Falwell's own site. Falwell's own evidence, the Google search that is attached to the complaint as Annex 10, reveals

that Falwell's official web site appears at the very top of the list of results that would be obtained by an Internet user who visited Cohn's site, but wanted to find Falwell's own site instead, and thus entered the term "falwell" in a search engine.

Thus, this is not a case where initial interest confusion provides a basis for finding likelihood of confusion and hence a violation of Falwell's purported trademark rights in his own name.

3. Respondent Has Neither Registered Nor Uses the Domain Names in Bad Faith; Rather, It is This Proceeding That Has Been Brought in Bad Faith to Quash Criticism.

Far from showing that respondent Cohn has registered the domain names at issue in bad faith, the facts show that Cohn has acted properly and that it is complainant that is engaged in "cyberbullying," invoking the UDRP to quash a legitimate effort at social criticism. None of the hallmarks for a finding of "bad faith" on the part of respondent, which are set forth in Paragraph 4(b) of the UDRP, is present in this case.

Paragraph 4(b)(i) does not apply because Cohn did not register the domain names at issue for the purpose of extorting the payment of consideration for the transfer of the names. Paragraph 4(b)(iv) does not apply because the domain name is not being used "for commercial gain."

Paragraph 4(b)(ii) does not apply for two reasons. First, no evidence supports Falwell's contention that the domain names at issue will prevent him from registering a domain name using his own name. Falwell has had the domain name of his choice since October, 1998, when complainant Liberty Alliance registered the name with Network Solutions, presumably with Falwell's blessing. *See Annex C attached.* Yet Annex 2 to the Complaint establishes that

jerryfalwell.com was not registered until more than three years later, on March 6, 2001.² Indeed, so far as we are aware, complainants never saw any need to have additional domain names incorporating Falwell's first as well as his last name, until, like the proverbial dog in the manger, they learned that respondent Cohn wanted to use that name for purposes of criticism. Even as late as the summer of 2001, when the new ".info" domain name became available under circumstances that gave trademark owners a leg up in securing names in which they had prior rights, Falwell apparently took no steps to reserve the name falwell.info for himself, because that domain name is also in current use by a Falwell critic. *See* Annex D, attached. Thus, the evidence strongly suggests that Falwell does not have any genuine interest in registering domain names using his full name, and hence Cohn's registration of the domain names at issue in this case cannot be preventing Falwell from doing that.

Finally, paragraph 4(b)(iii) does not apply because Cohn is not a "competitor" of Falwell's "business," because there is no evidence either that Cohn is disrupting complainants' "business," or that he registered the domain names for the purpose of effecting such a disruption. As noted earlier in this response, Falwell enjoys the benefit of a top search engine listing, making it very easy for an Internet user, who reaches Cohn's web site in error, to find Falwell's own site instead. Moreover, Cohn is just one of several different individuals who have registered domain names using Falwell's own name in the domain name for the purpose of criticizing Falwell's hypocritical and

²In a transparent attempt to mislead the panel, complainants have attached as Annex 4 to the complaint a more limited version of the WHOIS record for falwell.com, which shows that the record was "updated" on November 5, 2001, but omits the date of the original registration of the name. This document might have led the panel to conclude that the name falwell.com had not been taken by Falwell until after jerryfalwell.com was registered. However, the complete record attached to this response as Annex C shows that, at the time Falwell chose his own domain name, jerryfalwell.com was still available to him.

intolerant positions on a number of current issues. Regardless of whether making such criticism might discourage some people from expressing support for Falwell, that is not the same as registering a name “primarily for the purpose of disrupting the business of a competitor.”

The evidence plainly supports respondent’s good faith in the use of the contested domain names, and just as strongly suggests that this domain name proceeding was brought in bad faith, as attempt to suppress dissent. Several panelists in UDRP proceedings have denounced “‘cyberbullying’ [, which occurs] when a Complainant attempts to use this forum to take away a domain name where any reasonable review of the ICANN Policies and Rules would show that the Complainant’s case is extremely weak and, more importantly, when it may well be that the Complainant holds greater economic power and commands greater resources than the Respondent.” *Maine Bait Company v. Robin Brooks a/k/a Maine Bait*, No. FA0107000098246 (Arb. Forum 2001), <http://www.arbitration-forum.com/domains/decisions/98246.htm>; *Compusa Management Company v. Customized Computer Training*, No. FA0006000095082 (Arb. Forum 2000), <http://www.arbitration-forum.com/domains/decisions/95082.htm>; *Bosley Medical Institute v. Kremer*, D2000-1647 (WIPO February 28, 2001), <http://arbiter.wipo.int/domains/decisions/html/2000/d2000-1647.html>.

Jerry Falwell has a history of suing those who make fun of him. The courts have instructed him that mere allegations that parodies are in “bad taste” or “not really funny” do not suffice to deny his critics the protection of the First Amendment. *Hustler Magazine v. Falwell*, 485 U.S. 46 (1988). Apparently, Falwell has not learned this lesson; or, at least, he thought he could prevail by dragging an individual respondent who had responded pro se to his cease and desist letter into the UDRP in an attempt to strip him of his domain names. However, a simple review of the text of the UDRP,

and the numerous decisions under it, would have revealed that Cohn's non-commercial use of the alleged trademarks for a "gripe site" was protected conduct. The complaint should be dismissed, and the panel should reprimand complainants for their obvious cyberbullying.

REMEDY REQUESTED

The complaint should be rejected.

ADMINISTRATIVE PANEL

Respondent nominates the following three individuals (listed in alphabetical order) for service on the administrative panel in this case:

Diane CABELL, diane@cabell.cc, Berkman Center for Internet & Society, Harvard Law School, Cambridge, Massachusetts, USA

G. Gervaise DAVIS III, ggd@netlawyers.com, Davis & Schroeder, Monterey, California, USA

Milton L. MUELLER, mueller@syr.edu, Syracuse University, School of Information Studies, Syracuse, New York, USA

SERVICE

A copy of this response, and of its attachments, are being transmitted to complainants through their counsel at the following snail mail and email addresses:

John Midlen, Jr.
Midlen Law Center
7618 Lynn Drive
Chevy Chase, Maryland 20815-6043
law@midlen.com

CERTIFICATIONS

Respondent certifies that the information contained in this Response is to the best of 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 these Rules and under applicable law, as it now exists or as it may be extended by a good-faith and reasonable argument.

This entire response consists of fewer than 5000 words.

Respectfully submitted,

Paul Alan Levy

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(202) 588-1000

Attorney for Respondent

March 29, 2002

LIST OF ANNEXES

Annex A: Listings from switchboard.com

Annex B: Web site maintained at the domain names at issue

Annex C: falwell.com whois record

Annex D: falwell.info whois record and home page