

WIPO Arbitration and Mediation Center

ADMINISTRATIVE PANEL DECISION

Challenger Limited and Challenger Group Holdings Limited v. Domain Privacy Service FBO Registrant / Sean Butler

Case No. D2014-0852

1. The Parties

The Complainants are Challenger Limited and Challenger Group Holdings Limited of Sydney, New South Wales, Australia, represented by Baker & McKenzie, Australia.

The Respondent is Domain Privacy Service FBO Registrant of Burlington, Massachusetts, United States of America ("United States") / Sean Butler of Attadale, Western Australia, Australia.

2. The Domain Name and Registrar

The disputed domain name <challenger-info.com> (the "Domain Name") is registered with Domain.com, LLC (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on May 22, 2014. On May 22, 2014, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On May 22, 2014, the Registrar transmitted by email to the Center its verification response confirming that the Respondent, Sean Butler is the actual registrant of the Domain Name, the Domain Privacy Service being no more than a privacy service, and providing the contact details for Mr. Butler. In this determination, the Panel will refer only to Mr. Butler as the Respondent.

The Center verified that the Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the "Policy" or "UDRP"), 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 May 27, 2014. In accordance with the Rules, paragraph 5(a), the due date for Response was June 16, 2014. The Response was filed with the Center on June 16, 2014.

The Center appointed William P. Knight, Richard G. Lyon and Alistair Payne as panelists in this matter on July 1, 2014. The Panel finds that it was properly constituted. Each member of the Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Center to ensure compliance with the Rules, paragraph 7.

4. Factual Background

The Complainants are members of a group which provides financial services, including financial management, insurance and annuities, having offices around Australia as well as in London, United Kingdom of Great Britain and Northern Ireland ("United Kingdom"). The Complainants and their related companies trade predominantly under the name "Challenger". Members of the group provide services to retail customers, such as annuities, widely advertised as "Challenger Annuities", as well as corporate clients. The second Complainant is the registered owner of trade marks in Australia for CHALLENGER, CHALLENGER & device and CHALLENGER FINANCIAL SERVICES GROUP. The earliest of these registrations was registered in Australia from November 12, 2003. The other two registrations of the trade marks exclusively comprising the word "challenger" were registered in Australia on November 22, 2005. The domain name <challenger.com.au> is registered in the name of the second Complainant. It can be said that the Challenger group of companies, of which the first Complainant is the head, and its trade marks are very well known in Australia in respect of financial services.

According to Whois search results, the Domain Name was registered by the Respondent on February 12, 2013. The website at the Domain Name consists first of a commentary regarding business dealings between Mr. Brian Benari, the chief executive officer of the first Complainant, and the Respondent, from which the Respondent casts unflattering aspersions of Mr. Benari and his ethics. The Respondent, who does not conceal his identity in any way at the website to which the Domain Name resolves, uses this commentary as a platform to question whether the consumer can trust a financial services firm that has at its head a person whom the Respondent alleges is unethical and dishonest. The website then provides links to press commentary critical of the Complainants' group and

material and links to textual and video material in relation to an Australian Senate inquiry into banking and other legal proceedings concerning financial institutions unrelated to the Complainants accused of sharp, unethical or improper practices. The Respondent's website does not advertise or offer for sale goods or services of any kind.

5. Parties' Contentions

A. Complainant

In accordance with paragraph 4(a) of the Policy, the Complainant asserts:

- (i) that the Domain Name is confusingly similar to its CHALLENGER trade marks;
- (ii) that the Respondent has no rights or legitimate interests in respect of the Domain Name;
- (iii) that the Domain Name has been registered and is being used in bad faith.

The Complainants argue that they and their related companies have acquired a substantial reputation in Australia in investment management in relation to the CHALLENGER brand and registered trade mark.

The Complainants say that the Domain Name is identical or confusingly similar to their company names, the first Complainant's registered trade marks and its principal corporate domain name. They argue that the difference between the ".com.au" country code Top-Level Domain in their domain name and the generic Top-Level Domain ("gTLD") ".com" in the Domain Name should not be relevant when assessing confusing similarity. They also argue that the use of the word "info" in the Domain Name in addition to their CHALLENGER trade mark is not sufficient to eliminate any risk of confusion.

The Complainants submit that the Respondent has no rights or legitimate interests in the Domain Name because the website at the Domain Name does not disclose any such right or legitimate interest. Rather, the Complainants argue, the Respondent has used the Complainants' name and mark "in order

to mislead and divert Internet users looking for the Complainants' business to the [the Respondent's website] with a view to coerce the Complainants' CEO Mr. Benari to enter into an independent arbitration or negotiation with Mr. Butler, to reach a settlement with Mr. Butler; or otherwise with a view to obtaining a payment or other benefit from Mr. Benari" and that this is not a legitimate interest in the use of the Domain Name. The Complainants note that the Respondent's website does not include any formal disclaimer making clear that it is not authorized by or connected with the Complainants in any way.

The Complainants argue that such conduct on the part of the Respondent also amounts to registration and use of the Domain Name in bad faith as it "seeks to damage the Complainants' and Mr. Benari's reputation", referring to the decision in *Compagnie Generale des Matières Nucleaires v Greenpeace International* WIPO Case No. D2001-0376 (the "COGEMA case").

The Complainants also suggest that the conduct of the Respondent may breach the rights of the first Complainant in its trade mark registrations under the Trade Marks Act 1995 (Cth) as well as being in breach of the Australian Consumer Law (Schedule 2 to the Competition and Consumer Act 2010(Cth)).

B. Respondent

The Respondent denies:

- (i) that the Domain Name is confusingly similar to its CHALLENGER trade marks;
- (ii) that the Respondent has no rights or legitimate interests in respect of the Domain Name;
- (iii) that the Domain Name has been registered and is being used in bad faith.

The Respondent argues that the Complainants do not have exclusive rights to the word "challenger", due to its inclusion in the Dictionary. The Respondent also challenges the relevance of many of the Complainants' assertions, including the companies' ASIC listings, the Complainants' operation of an investment firm, the Complainants' goodwill, the Complainants' awards and the advertising of the Complainants' services.

The Respondent argues that the Domain Name is not identical to the Complainants' marks and that the website does not purport to be that of the Complainants, nor to sell similar or associated products. The Respondent asserts that the similarity of the Domain Name to the Complainants' marks is not sufficient to cause confusion.

The Respondent argues that he possesses rights and a legitimate interest in the Domain Name due to the fact that the use of the Domain Name is noncommercial and does not relate to the sale of any goods or services. The Respondent alleges that the Complainants have made groundless threats in relation to the Domain Name, and have been aware of its existence for some time.

The Respondent alleges that the purpose of the website at the Domain Name is to provide a warning to the public about a senior officer of the Complainants. The Respondent asserts that he seeks for Mr. Benari, the senior officer, to act honestly or be dealt with appropriately by the Complainants, and that he possesses no ulterior motive such as affecting negotiations between Mr. Benari and himself or forcing Mr. Benari to make him any payment.

The Respondent asserts that if the Complainants believe the content of the website is in breach of the Australian Consumer Law, or other laws within Australia, the Complainant should "take the case within Australia" and that "it has nothing to do with the domain name dispute".

The Respondent also attests that the Domain Name was registered and is being used in good faith, rather than for the purposes of selling or renting the Domain Name, to prevent the Complainants from using the Domain Name, or otherwise for commercial gain.

The Respondent argues that his registration of the Domain Name in 2013 is irrelevant, as the Complainants had left the Domain Name available. The Respondent asserts that he was not aware of the Complainants' marks at the time of registering the Domain Name. The Respondent argues that he registered the Domain Name for legitimate purposes, namely to expose the serious misconduct of a senior officer of the Challenger investment firm operated by the Complainants.

6. Discussion and Findings

Pursuant to paragraph 4(a) of the Policy, the Complainants must establish each of the following three elements to prevail in their request for transfer of the Domain Name from the Respondent:

1. The Domain Name is identical or confusingly similar to a trade mark or service mark in which the Complainants have rights; and
2. The Respondent has no rights or legitimate interests in respect of the Domain Name; and
3. The Domain Name has been registered and is being used in bad faith.

A. Identical or Confusingly Similar

The Panel finds that the Complainants have trade mark rights in CHALLENGER, and other trade marks comprising the word "challenger", for the purposes of the Policy, as well as associated reputational rights.

The Panel is also satisfied that the Domain Name is confusingly similar to the Complainants' CHALLENGER trade marks. The gTLD ".com" and the relatively generic additional word "info" within the Domain Name do not carry sufficient distinguishing weight to differentiate the Domain Name so as to prevent confusing similarity.

Therefore, the Panel finds that the Domain Name is confusingly similar to the Complainants' trade marks and that the Complainants have established this first element of the Policy.

B. Rights or Legitimate Interests

In short, this matter turns on the proper application of paragraph 4(c)(iii) of the Policy, under which the Respondent may have a right or legitimate interest in the Domain Name if he shows that he is making legitimate noncommercial or fair use of the Domain Name without intent for commercial gain to misleadingly divert consumers or to tarnish the trade mark or service mark at issue. In this case, the Respondent's claim is that the Domain Name is a legitimate "criticism site".

It is uncontested that the Respondent is making no commercial use whatsoever of the Domain Name, in that no goods or services of any kind are offered on the website, nor are there any links designed to lead to any commercial benefit to the Respondent. It is self-evident that the Domain Name is intended, in one sense, to attract Internet users, potential consumers of the Complainants' services. That is usually the function of domain names. However, for such diversion to disentitle the Respondent from claiming that the protection of paragraph 4(c)(iii) of the Policy applies, such diversion must be for the purpose of misleading consumers, or to tarnish the trade mark or service mark at issue, *for commercial gain*. There is no question of this with the Respondent's selection and use of the Domain Name. Even if some negotiation advantage in his dispute with Mr. Benari was found to be the Respondent's objective, the Panel Majority has reservations that this would automatically amount to seeking "commercial gain". Be that as it may, the Complainants have not established that this was the Respondent's objective and there is nothing on the Respondent's website to make that obviously the case.

Therefore, the question remains whether the usage of the Domain Name is "legitimate" or "fair". In making this determination in this case, two important considerations must be borne in mind:

1. The Panel Majority cannot and will not make any determination as to the legal rights of the Complainants, let alone Mr. Benari, in respect of the Respondent's accusations against Mr. Benari. That is not the role of an administrative panel under the Policy and, even if it were, the Panel Majority does not have all the evidence relevant to such matters. If the Panel Majority is unable to make these determinations, then how can it make a determination of whether the use made of the Domain Name is legitimate or fair? The Panel Majority concludes that these words must, in the context of the Policy, have a narrower meaning – or, at least, that this is so in the case of the word "legitimate".
2. All decisions in respect of the proper application of paragraph 4(c)(iii) of the Policy must take into account the particular circumstances of the disputed domain name and the circumstances of the complaint. In particular it is relevant to look at the environmental circumstances and context in which the Respondent has developed the content of his website.

The *WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Second Edition* (the "WIPO Overview 2.0") [Section 2.4](#) deals with criticism sites. It begins by observing that the criticism site must be "genuine". In other words, it must be used for a "free speech purpose" to ventilate genuinely held opinions and not as a mere ruse or pretext. In *Wal-Mart Stores, Inc. v. Walsucks and Walmarket Puerto Rico*, [WIPO Case No. D2000-0477](#), the disputed domain name, along with others, was being offered for sale to the highest bidder and the respondent was seeking money from the complainant, and in *Rolux Watch U.S.A., Inc. v. Spider Webs, Ltd.*, [WIPO Case No. D2001-0398](#), whilst the disputed domain name resolved to a website which purported to be a site for consumer commentary, this was found to be a sham, devoid of content, which in any event made no reference to the complainant's watches.

The Panel Majority therefore observes that "legitimacy" at least, in this context, refers to a "genuine free speech purpose". In this regard, the Panel Majority is guided by the decision in *Britannia Building Society v. Britannia Fraud Prevention*, [WIPO Case No. D2001-0505](#) (the "Britannia case") in which the learned panel observed:

"Although Complainant does allege that Respondent has registered and used the Domain Name misleadingly to divert customers to its highly critical site, with the probable intent of tarnishing the mark at issue, such allegations fail to undermine the legitimacy of Respondent's use.... Here, there is no diversion "for commercial gain" and thus no loss of legitimacy. That some internet users might initially be confused into thinking that, because of the use of the mark in the Domain Name, <britanniabuildingsociety.org> is Complainant's official web site is of no moment. First, any such confusion would immediately be dispelled by Respondent's prominent disclaimer and the link that is displayed to Complainant's official site. Second, and in any event, such a low level of confusion is a price worth paying to preserve the free exchange of ideas via the internet. A user who misleadingly stumbles upon Respondent's site while looking for Complainant's official site need only click the "back" button to return to her search, or the link helpfully provided by Respondent.

"As for Complainant's assertion of "tarnishment," that phrase, too, has a specific meaning that does not apply here. Tarnishment in this context refers to such unseemly conduct as linking unrelated pornographic, violent or drug-related images or information to an otherwise wholesome mark. See, e.g., *Nicole Kidman v. John Zuccarini d/b/a Cupcake Party*, WIPO Case No. D2000-1415; cf. *Etam, plc v. Alberta Hot Rods*, WIPO Case No. D2000-1654. In contrast, fair-use criticism, even if libelous, does not constitute tarnishment and is not prohibited by the Policy, the primary concern of which is cybersquatting. ... Claims sounding in commercial libel must be brought in other legal venues."

The same panel continued:

"The goals of the Policy are limited and do not extend to insulating trademark holders from contrary and critical views when such views are legitimately expressed without an intention for commercial gain. Use of the Policy to provide such insulation would radically undermine freedom of discourse on the internet and would undercut the free and orderly exchange of ideas that the Policy seeks to promote."

WIPO Overview 2.0 then observes two strands regarding such "criticism sites". The first, which is more prominent outside the United States, is that the right to criticize does not necessarily extend to registering and using a domain name that is identical or confusingly similar to the complainant's trade mark. That is especially the case if the respondent is using the trade mark alone as the domain name (i.e., <trademark.tld>) as that may be understood by Internet users as impersonating the trade mark owner. The second is that, irrespective of whether the disputed domain name as such connotes criticism, the respondent has a legitimate interest in using the trade mark as part of the domain name of a criticism site if such use is fair and noncommercial.

The Panel Majority does not accept the view that there is a simple geographical split between United States parties and circumstances and those outside the United States, as the very early decision in the *Britannia* case makes clear. Indeed, one of the purposes of the Policy is to maintain international standards and prevent forum shopping. There is as great a concern regarding the right to freedom of expression in the laws of Commonwealth countries as in the United States as, in Australia, is attested by the vigor of the debate concerning amendment to statutory restrictions on vilification based on ethnicity or religion.

The Panel Majority observes with interest the discussion of this issue in *Covance, Inc. and Covance Laboratories Ltd. v. The Covance Campaign*, WIPO Case No. D2004-0206 (the "Covance case"). In that case, the panel drew a distinction between the circumstances in which a respondent may use a trade mark in a disputed domain name in the context of legitimate criticism cases. The panel's approach was to distinguish the disputed domain name on the grounds that it was not identical to the complainant's trade mark (although it was arguably confusingly similar) because it featured an additional element which, even though not a negative modifier such as in the "sucks" line of cases, did connote some difference from what Internet users might have expected in a domain name belonging to the complainant trade mark owner and in practice was in any event unlikely to result in confusion. In addition the panel was of the view that Internet users arriving at the respondent's website could not possibly have thought in the circumstances that it was associated with, or endorsed by, the complainant.

Other decisions have also been concerned with the question of whether it was obvious as to the lack of any sponsorship or approval from the trade mark owner, such as by the existence of a clear disclaimer. These considerations alone distinguish the *COGEMA* case, upon which the Complainants relied, as well as the fact that disputed domain name had not been used at all by the respondent, other than as a threat to the complainant, as well as other decisions where the respondent's website was made to appear like the complainant's website, in order to deceive them as to a connection with the complainant, albeit for political or other purposes of protest.

In *Midland Heart Limited v. Uton Black* WIPO Case No. D2009-0076, another decision concerning parties and circumstances outside the United States, the learned panel distilled the following considerations as being relevant to the determination of rights or legitimate interests in a criticism site case:

- (a) Has the domain name been registered and is it being used genuinely for the purpose of criticising the owner of the mark?
- (b) Does the registrant believe the criticism to be well-founded?
- (c) Does the registrant have intent for commercial gain?
- (d) Is it immediately apparent to Internet users visiting the website at the domain name that it is not a website of the owner of the mark?
- (e) Has the respondent registered all or most of the obvious domain names suitable for the owner of the mark?
- (f) Where the domain name is one of the obvious domain names suitable for the owner of the mark, is a prominent and appropriate link provided to the latter's website (if any)?
- (g) Where there is a likelihood that email intended for the complainant will be sent using the domain name in issue, are senders immediately alerted in an appropriate way that their emails have been misaddressed?

In this case, the Panel Majority answers these questions as follows:

(a) The Panel Majority is satisfied that the Domain Name was registered and is being used genuinely for the purpose of criticising the Complainants. Recent public controversies concerning Australian financial institutions have raised prominently not merely the misconduct of employees and management attempts to cover up that misconduct, but also the issue of the ethical standards of those in management. The Respondent is entitled to draw conclusions from this public debate that his dealing with Mr. Benari raises this very

issue, however misguided the Respondent may be. Contrary to the submissions of the Complainants, the Respondent's website does not merely ventilate his dispute with Mr. Benari but covers the full field of the ethical standards to be met by those who manage financial institutions and the danger to consumers and investors presented when those managers have compromised moral and ethical standards.

(b) The Panel Majority accepts that the Respondent believes his criticism of the Complainants to be well-founded, for the reasons just mentioned.

(c) As already found, the Panel Majority is satisfied that the Respondent does not use his website in any way in trade or commerce and it is by no means apparent that the Respondent seeks to extort some benefit from the Complainants or Mr. Benari.

(d) It is immediately apparent to Internet users visiting the Respondent's website at the Domain Name that it is not a website of the Complainants or any of their related companies.

(e) There is no evidence that the Respondent has registered any other relevant domain names suitable for the Complainant.

(f) The Panel Majority considers that the addition of the word "-info" makes the Domain Name not one that would be one of the obvious domain names suitable for the Complainants and hence, along with the obvious lack of sponsorship or approval by the Complainants of the matter on the Respondent's website, no further disclaimer or link to the Complainants' website is necessary.

(g) There is no evidence regarding email intended for the Complainants being sent using the Domain Name.

It must be self-evident that, in order to criticize a person or entity, one must use that person's or that entity's name. The question then is, to what extent can that name be used in a domain name for this purpose. It would be unreasonable for there to be a blanket rule against using that name, even as part of a domain name, and therefore to deny a person wanting to make a complaint in the public arena the most obvious and effective way of drawing attention to the subject matter of that complaint.

On balance, taking into account all of these considerations, the Panel Majority has concluded that the Respondent's use of the Domain Name demonstrates a right or legitimate interest in the Domain Name for the purpose of making genuine criticism of the Complainants. In all the circumstances, the Panel Majority finds that the second requirement of the UDRP is not met in this case.

C. Registered and Used in Bad Faith

As it is necessary for a successful complaint to fulfill all three elements of the Policy, and the Panel Majority has found that the Complainants have not fulfilled the second element, the Panel Majority need not consider whether the Domain Name was registered and used in bad faith. Nevertheless, the Panel Majority concludes that the Complainants have failed to establish that the Domain Name was registered and is being used in bad faith.

As the panel remarked in the case of *Wal-Mart Stores, Inc. v. Richard MacLeod d/b/a For Sale*, [WIPO Case No. D2000-0662](#), as noted in the *Covance* case; "A genuine criticism site, undertaken by its proprietors with no intent other than to protest, ridicule and mock its targets, does not fall astray of the dictates of the Policy, regardless of the outrageousness of the allegations it contains or the vigorosity with which they are made".

The Panel Majority finds that the Complainants have not fulfilled the third element of the Policy.

7. Decision

For the foregoing reasons, the Complaint is denied.

William P. Knight
Presiding Panelist

Alistair Payne
Panelist

Date: July 21, 2014

DISSENTING OPINION

Imagine the following scenario: A major religious or political rally is to be held on a farm, Blackacre, which is in a difficult-to-find location. In order to get to Blackacre, one has to go past the nearby Whiteacre farm, whose owner promotes religious or political views bitterly opposed to those of the Blackacre rally organizer. On the day of the rally, the owner of Whiteacre posts a large billboard near the entrance to his property, stating simply "Blackacre." Numerous people heading for the rally mistakenly follow this sign, to be met by the owner of Whiteacre handing out leaflets denigrating the Blackacre rally organizer and all that he stands for. The people looking for the rally site would never have gone onto the Whiteacre property if they had realized that it was not in fact the rally venue.

Now imagine a comparable modern-day commercial scenario: An individual (we'll call him Sean) enters into a business arrangement with a second individual (Brian) at Brian's instigation. The deal turns sour and Sean, who has lost a considerable sum, believes that Brian is to blame. He thinks the matter important enough to use his remaining resources to trumpet to the world Brian's dishonesty, duplicity, and double-dealing. Internet-savvy, this he does by setting up a website that uses the name of Brian's employer, "www.employer-info.com". Why choose the employer's name? One obvious reason is that most individuals have never heard of nor care a fig about Brian, Sean, or the dispute between them; many more people, however, may wish to do business with or learn more

about the employer. Another is that this approach is more likely to draw attention than, say, using Brian's name. A consequence of both of these reasons is that Brian is more likely to be impacted by the criticism. Another consequence (to the employer and not Brian) is dissatisfaction of customers and prospective customers of the employer for having to read a speech they never sought and likely have no interest in.

The learned (now honorable) panel who posited the first example had this to say: "many people would find it difficult to ascribe the labels 'fair,' 'legitimate,' or in good faith' to the conduct of the proprietor of Whiteacre in that situation. Many would see it as dishonest, or at least borderline so, and would wonder whether acceptance of such conduct is really a necessary price which must be paid to safeguard the widely (but not universally) acknowledged value of freedom of expression." *Grupo Costamex, SA de C.V. v. Stephen Smith and Oneandone Private Registration / 1&1 Internet Inc.*, [WIPO Case No. D2009-0062](#).

I wholeheartedly agree.

The second scenario is not hypothetical, of course. It is this proceeding. Nothing in the record or on the Respondent's website indicates that the Respondent is or was a customer of the Complainants; in fact the Respondent expressly denies it. His beef is with Mr. Benari, who in addition to his business arrangements with the Respondent happens to be the chief executive officer of the first Complainant. While I will not quarrel with my Australian colleagues about that country's current concern over proper management of its financial institutions, I simply cannot read the Respondent's site's content as criticism of the Complainants. Rather it is a forum for the Respondent to broadcast a private grievance with Mr. Benari, a forum intentionally chosen for the reasons and with the consequences I have noted above. The Respondent's disclaimer of any ulterior motive and characterization of his site as fair warning to the Complainants' customers in the Response,¹ neither of which may be found on his website, both miss the point and are at best disingenuous.²

Legitimate criticism on a topic completely unrelated to a complainant or its mark is not *bona fide* under paragraph 4(a)(ii) of the Policy, see *PepsiCo, Inc. v. "The Holy See," WIPO Case No. D2003-0229* (food and beverage complainant; anti-abortion website). What about an indirect connection? Would it be legitimate under paragraph 4(a)(ii) to allow a man whose wife is having an adulterous affair with the CEO of a major bank to register and use <majorbank-info.com> to broadcast that fact on the Internet? ("Think twice before you do business with a bank run by a philanderer.") How about using <internationalcharity-info.org> to air a charge that the local charity officer swindled the domain name owner? ("Why donate to an organization that employs a crook?") I'd quickly find either such use illegitimate and plain bad faith.

In this case the relationship between the Complainants and the criticism is tangential at best – in my opinion too attenuated to allow. As noted there is no indication that the Respondent's gripe is with the Complainants, or that the Complainants and Mr. Benari are interchangeable, or that one is the *alter ego* of the other. Much more likely the Respondent's claim of warning off unwary consumers about the integrity of the Complainants' CEO is purely pretextual. In any event incorporating the Complainants' mark into the Domain Name is an admittedly unauthorized and in my opinion highly improper use that will visit harm upon a third party that (so far as the record shows) had nothing to do with the matter being criticized.

I would prefer to decide the Complaint on this basis, avoiding any additional discussion over the competing views in [paragraph 2.4 of the WIPO Overview 2.0](#). The Panel Majority finds otherwise, however, so I must reiterate³ my adherence to View 1.⁴

The Respondent's use of the Complainants' mark in these circumstances emphasizes what I believe is the principal flaw in the reasoning underlying View 2. In an ordinary criticism case, in which the respondent in fact criticizes the complainant, View 2 panels emphasize the non-commercial nature of legitimate criticism and the need to safeguard free expression. That's not the issue in a Policy proceeding. The Policy does not impair the Respondent's or any other person's free speech rights in any way. The UDRP exists solely to determine a party's entitlement or not to use the complainant's mark in the domain name at issue – to borrow a metaphor I have used in other cases, to use the complainant's soapbox without authority as the broadcast medium. As I stated a decade ago in *Justice for Children v. R netso / Robert W. O'Steen*, [WIPO Case No. D2004-0175](#),

"Decisions under the Policy focus upon a respondent's use of another's mark in a domain name to attract Internet users to respondent's site. This is true in typosquatting cases and in cases where a respondent selected his domain name in anticipation of subsequent sale to the mark owner. The content of Respondent's sites in these two categories of cases – cases in which respondents almost uniformly lose – is irrelevant to the harm to the mark owner and to the unwary consumer. That harm results from the confusion caused by the initial attraction to the site by means of borrowing the complainant's mark. And that is exactly the harm the Policy was adopted to address."

Returning to the question I asked in my second scenario above, the answer in this case is clear, just as it is clear in every criticism case involving "trademark.com". The critic selects the target's mark not to advance free speech but to broaden his audience. Doing so without warning the unsuspecting Internet user seeking the mark owner is deception or, as the *Grupo Condomex* panel put it, dishonesty. The Respondent could easily have avoided that⁵ with three letters by registering <challenger-disinfo.com> or some other domain name that indicated no connection with the Complainant. His not doing so amounts to intentional trickery. Whatever his reasons I find such conduct not legitimate and clear evidence of bad faith.

I would order transfer of the disputed domain name, and I therefore respectfully dissent from the Panel Majority's opinion and Decision.

Richard G. Lyon
Panelist (Dissenting)
Date: July 21, 2014

¹ Summarized by the Panel in Section 4, second paragraph.

² Some statements in the Response are downright false, particularly the Respondent's statement that he was unaware of the Complainant's mark when he registered the Domain Name. No critic may honestly make such a denial. That the Respondent does so calls into question the veracity of other self-serving factual assertions in the Response.