

# CPR Institute for Dispute Resolution

## Citizens Clean Elections Committee

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File Number: CPR 0305

Date of Commencement: February 14, 2003

Domain Name(s): azcleelections.com, azcleelections.net,  
azcleelections.org

Registrar: Register.com

Arbitrator: Steven M. Weinberg

vs.

## Matt Shaffer

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Before STEVEN M. WEINBERG, Arbitrator

## PROCEDURAL HISTORY

The Complaint was filed with CPR on February 14, 2003 and, after review for administrative compliance, was promptly served on the Respondent. The Respondent filed a Response on or before March 5, 2003. I was appointed Arbitrator pursuant to the Uniform Domain Name Dispute Resolution Policy ("UDRP") and Rules promulgated by the Internet Corporation for Domain Names and Numbers (ICANN). Upon the written submitted record including Complainant's Complaint and Respondent's Response, I find as follows:

## FINDINGS

Respondent's registered domain names, azcleelections.com, azcleelections.net, azcleelections.org, were registered with Register.com on November 20, 2000. In registering the name, Respondent agreed to submit to this forum to resolve any dispute concerning the domain name, pursuant to the UDRP.

The UDRP provides, at Paragraph 4(a), that each of three findings must be made in order for a Complainant to prevail:

- i. Respondent's domain name is identical or confusingly similar to a trademark or service mark in which complainant has rights; and
- ii. Respondent has no rights or legitimate interests in respect of the domain name; and
- iii. Respondent's domain name has been registered and is being used in bad faith.

**IDENTITY/CONFUSING SIMILARITY:** Complainant alleges that the domain names azcleelections.com, azcleelections.net, azcleelections.org (the "Domain Names") are identical or confusingly similar to Complainant's service mark "Citizens Clean Elections Commission," which is a state agency of Arizona that administers the Citizens Clean Elections Act. The official web site of the Commission is [www.ccec.state.az.us](http://www.ccec.state.az.us). The Domain Names were registered by the Respondent while he was employed by, and at the direction of the Complainant. These domain names were intended for use in linking persons interested in the Act to the Commission's official web site.

Respondent admits that he registered these domain names while he was employed by the Commission and does not challenge that they are similar to the Complainant's name, "Citizens Clean Elections Commission." Respondent instead challenges that the Complainant's contention that it has protectible rights in its name, alleging that the name "Arizona Citizens Clean Elections Commission" "is the name of a public entity" and "is not trademarked or service marked."

While Respondent is correct that the Commission has not registered its name for trademark or service mark protection under the statutory Trademark Law of Arizona, the Commission does have protectible rights in its name under the common law. The common law of Arizona, as elsewhere, recognizes that names and other designations used in connection with services can be protectible under the law of trademarks and/or trade names if they identify a single source of those services. *See Legislative History* to Ariz. Rev. Stat. Chapter 10, Article 3. In that regard, the "Citizens Clean Elections Commission" is a name that uniquely identifies the services offered and rendered by that body in Arizona, and as such has protectible rights in that name. There is no requirement for protection of a name that the services involved be offered for a fee. For example, not-for-profit organizations such as the Better Business Bureau that offer free services have received trademark protection for their names. *See, e.g., Council of Better Business Bureaus, Inc. v. Better Business Bureau of South Florida, Inc.*, 200 USPQ 282 (DC SFla 1978).

Respondent acknowledges in his Response that the purpose in his registering the Domain Names for the Complainant was for browsers to use these Domain Names as links to the Complainant's web site, which means that the Domain Names were selected because they would be recognized as being associated with the Commission and the Act.

I therefore conclude that Complainant has protectible rights in its name Citizens Clean Elections Commission and that the Domain Names are identical or confusingly similar to Complainant's protected name.

**RIGHTS AND LEGITIMATE INTERESTS:** Complainant alleges that Respondent has no rights or legitimate interests with respect to the Domain Names at issue. In support for this allegation, Complainant alleges that Respondent registered the Domain Names while employed by Complainant for the Complainant's benefit. Respondent, on the other hand, contends that Complainant never used the Domain Names during Respondent's employ and that Respondent intends to use, and is now using the Domain Names for use in criticizing the Act that the Complainant administers, and to use the Domain Names "as a forum for public debate on the issue of 'Clean Elections in Arizona.'"

UDRP Paragraph 4(c) provides that Respondent's rights or legitimate interests in a domain name may be demonstrated, without limitation, by showing that (a) before notice to Respondent of the dispute, Respondent has used, or made demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services; or (b) Respondent has been commonly known by the domain name; or (c) Respondent is making 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.

Respondent is hard pressed to argue that he has a legitimate interest in the Domain Names. Since he obtained them while an employee of Complainant, his "rights" to them inured exclusively to the benefit of his employer, Complainant, for the use by the Complainant. It is not the basis for a claim of legitimacy that the owner/employer had not used the Domain Names just prior to Respondent's renewal of them. In any event, Complainant asserts that the Complainant had advertised the Domain Names for the past two years as part of a multi-million dollar voter education campaign. Moreover, Respondent has not shown (a) before notice to Respondent of the dispute, Respondent has used, or made demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services; or (b) Respondent has been commonly known by the domain name; or (c) Respondent is making 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.

With respect to (c), Respondent's general, non-specific contention that he plans to use the Domain Names "as a forum for public debate on the issue of 'Clean Elections in Arizona,'" is not enough of a showing on which to base a finding of legitimate rights to the Domain Names. No reason is provided as to why he would need all three of the Domain Names for such purpose, or why he could not use an alternative, such as "forumoncleanelections.org" or similar name. Indeed, the use of the Domain Names to criticize Clean Elections likely would be deceptive. *See, e.g., People for the Ethical Treatment of Animals v. Doughney*, 60 USPQ2d 1109 (CA 4 2001); *Planned Parenthood Federation of America Inc. v. Bucci*, 42 USPQ2d 1430 (SDNY 1997).

I therefore conclude that Respondent does not have rights or legitimate interests with respect to the domain name at issue.

**BAD FAITH:** In support of the contention of Respondent's bad faith registration and use, Complainant notes that Respondent registered the Domain Names as an employee, and that the use of these Domain Names by the Respondent is causing serious disruption to the efforts of the Commission. Respondent contends that he waited until the Complainant's campaign had ended before renewing the Domain Names, that he does not intend to offer them back for ransom to the Complainant, and that he intends to use them for free speech.

Paragraph 4(b) of the UDRP provides that indications of bad faith include, without limitation, (a) registration for the purposes

of selling, renting or transferring the domain name to the Complainant for value in excess of Respondent's cost; (b) a pattern of registration in order to prevent Complainant from reflecting the mark in a corresponding domain name; (c) registration for the primary purpose of disrupting the business of a competitor; or (d) an intentional attempt to attract, for commercial gain, Internet users to Respondent's web site by creating a likelihood of confusion with Complainant's mark as to the source, sponsorship, affiliation or endorsement of Respondent's web site or location, or of a product or service on Respondent's web site or location.

While it cannot be said that Respondent's activities fall expressly within the above examples of bad faith, the renewal of the registrations by Respondent do have as their purpose the disruption of Complainant's "business," that is, in the orderly conduct of administrating the Clean Elections Act. Similarly, as in the *People for the Ethical Treatment of Animals* and *Planned Parenthood* cases, the Respondent's intended purpose in renewing and using the Domain Names is to attract Internet users to Respondent's web site by creating a likelihood of confusion with Complainant's name as to the source, sponsorship, affiliation or endorsement of Respondent's web site or location with Complainant. These activities fall within the spirit of the bad faith activities in Paragraph 4(b) of the UDRP, and therefore cannot support a finding of good faith.

To the extent that there is any room for argument with the foregoing, the fact that Respondent registered the Domain Names while an employee of Complainant for the Complainant's use and at the Complainant's direction negates any claim by Respondent that his renewal of the Domain Names was in good faith, since he did not have any legitimate claim to the Domain Names.

I therefore conclude that Respondent did register and use the Domain Names in bad faith, as that term is defined in the ICANN Policy.

## **CONCLUSION**

In light of my findings above that (a) the registered domain names are identical or confusingly similar to Complainant's protected name; (b) Respondent does not have rights or legitimate interests with respect to the domain names at issue; and (c) Respondent did register and use the domain names in bad faith, as that term is defined in the ICANN Policy, I find in favor of the Complainant.

## **REMEDY**

Complainant's request to transfer the domain names azcleelections.com, azcleelections.net, azcleelections.org is hereby GRANTED. The domain name shall be transferred to Complainant Citizens Clean Elections Committee.

Steven M. Weinberg

March 24, 2003