



# CPR Institute for Dispute Resolution

**Kelson Physician Partners, Inc.**

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File Number: CPR003Date of Commencement: July 24, 2000Domain Names: kelsonmd.comRegistrar: Network Solutions, Inc.Arbitrator: Louise E. Dembeck

vs.

**Virginia A. Mason**

70 Hardy Road

Londonderry, NH 03053

E- mail mason@kelsonmd.com

Phone: unknown

Fax unknown

Before LOUISE E. DEMBECK, Arbitrator

## PROCEDURAL HISTORY

The Complaint was filed with CPR on July 20, 2000 and, after review for administrative compliance, served on the respondent on July 24, 2000. The Respondent did not file a Response on or before August 13, 2000, the requisite due date, nor did the Respondent request that the period of time for the filing of the response be extended. Respondent did, however, send a letter by email to CPR on August 15, 2000, indicating that a hard copy was also being sent to CPR concurrently by USPS guaranteed overnight mail. 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 the Complaint and the Respondent's August 15, 2000 letter, I find as follows:

## FINDINGS

Respondent's August 15, 2000 letter was not only untimely pursuant to Rule 5(a) of the ICANN Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules"); but, it failed, as well, to comply with any of the requirements of Rule 5(b)(i)-(ix). As a result, it cannot qualify as a Response in this proceeding.

Neither the Rules nor the CPR Supplementary Rules provide for consideration to be given to any communications from the parties, other than the Complaint and the Response, submitted after commencement of the Administrative Proceeding. Nevertheless, in accordance with Rule 10(b), the Panel is required to ensure that each party is given a fair opportunity to present its case and, to that end, Rule 10(a)

gives the Panel discretion to conduct the Administrative Proceeding in such manner as it considers appropriate in accordance with the ICANN Policy and Rules. Moreover, pursuant to Rule 10(d), the Panel has the authority to determine the admissibility, relevance, materiality and weight of the evidence. Accordingly, I have considered and admit, Respondent's August 15, 2000 letter to the record. It cannot, however, be given the weight of a Response due, notably, to the lack of certification required by Rule 5(b)(viii) that the information contained therein is to the best of Respondent's knowledge complete and accurate and not being presented for any improper purpose.

Respondent's registered domain name, "kelsonmd.com," was registered with Network Solutions, Inc. on November 5, 1999. In registering the name, Respondent agreed to submit to this forum to resolve any dispute concerning the domain name, pursuant to the Uniform Domain Name Dispute Resolution Policy (the "UDRP").

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

- i. Respondent's domain name must be 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 "kelsonmd.com" is identical or confusingly similar to Complainant's federally registered service mark, "Kelson", registered with the United States Patent and Trademark Office on July 22, 1997, in International Class 35, for use in connection with "business management services for health care providers." Complainant's service mark registration claims first use in interstate commerce on March 1, 1996.

In addition, Complainant alleges that Respondent's domain name "Kelsonmd.com," "except for a dot (.) placed between the word kelson and the letters md and the addition of the '.com' top level domain," is identical to Complainant's previously registered domain name "kelson.md" also registered with Network Solutions, Inc.

Respondent does not dispute that the domain name "kelsonmd.com" is identical or confusingly similar to Complainant's domain name and to its federally registered service mark.

I therefore conclude that the registered domain name is identical or confusingly similar to Complainant's protected mark.

**RIGHTS AND LEGITIMATE INTERESTS:** Complainant alleges that Respondent has no rights or legitimate interest with respect to the domain name at issue. As support for this allegation, Complainant notes that, to the best of its knowledge, Respondent, whose name is Virginia A. Mason, has never offered goods or services for sale under the name "kelson," has never been known as or by the name, nickname or maiden name "Kelson," and has no logical connection to or interest in the term "kelson," except for her involvement in an ongoing dispute between her employer, Hampshire Pediatrics, and Complainant. Respondent, on the other hand, neither claims to have used or intended to use the term "kelson" on or in connection with the offering of goods or services nor to have been commonly known by the name "kelson." Rather, Respondent alleges that her website, <http://www.kelsonmd.com>, which incorporates the domain name at issue, "is a freedom of speech cite with **no** commercial content or value."

UDRP Paragraph 4(c) provides that Respondent's rights or legitimate interests in a domain name may be demonstrated, without limitation, by (i) before any notice to Respondent of the dispute, Respondent's use of, or 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 (ii) Respondent has been commonly known by the domain name; or (iii) 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's contention that her website "is a freedom of speech cite with no commercial content or value" seeks to raise a First Amendment issue and suggests reliance upon the circumstances described in Paragraph 4(c)(iii) which, if proved by Respondent, could demonstrate Respondent's rights or legitimate interests in the domain name at issue.

Although deciding a First Amendment Constitutional issue is outside the scope of this arbitration, several federal court decisions have held that incorporating the registered trademark of another into one's domain name in order to attract internet users to a site with competing or critical views to those of the legitimate trademark owner is **not** protected by the right of fair use. [*Compare Planned Parenthood Fed'n of America v. Bucci*, 1997 U.S. Dist. LEXIS 3338 (S.D.N.Y. 1997); *Jews for Jesus v. Brodsky*, 993 F. Supp. 282 (D.N.J. 1998), and *Bally Total Fitness v. Faber*, 29 F. Supp. 2d 1161 (C.D. Cal. 1998).]

Even if, as Respondent suggests, the content on Respondent's website could somehow render incorporation of Complainant's registered service mark into Respondent's domain name a "fair use," however, in order to prevail under Paragraph 4(c)(iii), Respondent must also establish that such use is without intent for commercial gain to misleadingly divert consumers or to tarnish Complainant's service mark.

With respect to these issues, from the record, it is undisputed that Respondent is employed by Hampshire Pediatrics, a medical practice which, among other things, operates in the same market as Complainant's practice. In addition, Respondent is the wife of one of the physician owners of Hampshire Pediatrics, Dr. Andrew J. Shuman. A review of Respondent's website <http://www.kelsonmd.com>, reveals that there is a hotlink to the Hampshire Pediatrics' website and confirms Complainant's allegation that Respondent's content has the effect of creating a negative impression of Complainant.

Given the lack of any evidence to the contrary submitted by Respondent, it is reasonable to infer (a) that Respondent's website invites, if not directs, users from the domain name "kelsonmd.com" to the competing Hampshire Pediatrics website; (b) that this design could feasibly mislead and, ultimately divert, at least some computer users looking for Complainant's "kelson.md" website, to the commercial gain of Hampshire Pediatrics; (c) that any such diversions have the potential for the indirect, if not the direct, advantage of Respondent; (d) that Respondent is aware of this potential; and (e) that Respondent is using the domain name with that intent. Moreover, it would defeat the spirit if not the letter of the UDRP if, in a dispute alleged to arise from an abusive registration of a domain name, a competitor could avoid the appearance of having the requisite "intent for commercial gain" merely by causing or permitting the abusive registration to be taken in the name of an employee, relative or other entity owned or controlled by the competitor.

Accordingly, Respondent has failed to establish that she meets the criteria set forth in Paragraph 4(c)(iii) and I, therefore, conclude that Respondent does not have rights or legitimate interest with respect to the domain name at issue.

**BAD FAITH:** In support of the contention of Respondent's bad faith registration and use, Complainant alleges that Respondent's intent in registering and using the domain name at issue is to disrupt Complainant's business and tarnish its reputation by luring current and potential customers of Complainant to Respondent's website where they will likely encounter respondent's "opinions" as to Complainant's alleged nonperformance of contractual duties with Respondent's employer (Hampshire Pediatrics). This is the subject of an ongoing contractual dispute between Complainant and Hampshire Pediatrics having nothing to do with the domain name at issue. Respondent contends, as discussed earlier, that her website is "a freedom of speech site with **no** commercial content or value."

Paragraph 4(b) of the UDRP provides that indications of bad faith include, without limitation, (i) registration for the purposes of selling, renting or transferring the domain name to the Complainant for value in excess of Respondent's cost; (ii) a pattern of registration in order to prevent Complainant from reflecting the mark in a corresponding domain name; (iii) registration for the primary purpose of disrupting the business of a competitor; or (iv) 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.

It is clear from the record that Respondent is integrally involved in the longstanding dispute, between Complainant and Hampshire Pediatrics, a company in competition with Complainant, and that the outcome of that dispute, in one way or another, will have an impact on Respondent as the impact of Respondent's website is likely to inure to the benefit of Hampshire Pediatrics. I find that the Respondent has registered the domain name at issue with the primary purpose of diverting present and potential customers of Complainant to Respondent's website and from there to the website of Hampshire Pediatrics, thus disrupting the business of its competitor, the Complainant. Having determined that Respondent satisfies the criteria for a finding of bad faith registration pursuant to Paragraph 4(b)(iii), it is unnecessary to examine the criteria set forth in Paragraph 4(b)(iv).

Accordingly, I find that, whether or not Respondent established and maintained the domain name for direct or indirect commercial gain, Respondent did register and use the domain name in bad faith, as that term is defined in the UDRP.

At this point, I note that there are sufficient and uncontroverted facts contained in the record to support this finding solely from the standpoint of the purposes of the Rules relating to registration of domain names which Rules are binding on the parties notwithstanding that there may be other legal or equitable rights which may be vindicated in another forum.

## CONCLUSION

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

## REMEDY

Complainant has requested transfer of the domain name "kelsonmd.com." I have given consideration to whether cancellation, rather than transfer, would be the appropriate remedy inasmuch as Complainant could have sought its own generic top level dot com (.com) domain name but chose, instead, to obtain a country specific domain name, to wit, the domain name for the Country of Moldavia (md). The remedy of cancellation, unfortunately, leaves open the possibility for anyone, including the Respondent or a party related to Respondent, to subsequently apply and obtain registration of the domain name following cancellation. Such an outcome would clearly result in frustrating the intent of the UDRP. [*See, generally, ISL Marketing AG and The Federation Internationale de Football Association v. J.V. Chung, Worldcup 2002.com, W Col, and Worldcup 2002, WIPO Case No. D2000-0034*]

Accordingly, Complainant's request to transfer the domain name "kelsonmd.com" is hereby GRANTED. The domain name shall be transferred to Complainant, Kelson Physician Partners, Inc. d/b/a Kelson Pediatric Partners.

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Signature of Arbitrator

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Date