



# **WIPO Arbitration and Mediation Center**

## **ADMINISTRATIVE PANEL DECISION**

**The Reverend Dr. Jerry Falwell and The Liberty Alliance v. Gary Cohn, Prolife.net,  
and God.info**

**Case No. D2002-0184**

### **1. The Parties**

- 1.1 The titular Complainants are Dr. Jerry Falwell, an individual resident of the Commonwealth of Virginia, United States of America, having a position at Liberty University, 1971 University Boulevard, Lynchburg Virginia, United States of America, and The Liberty Alliance, a corporation organized under the laws of the District of Columbia, United States of America, with its principal place of business at 3906-B Wards Road, Lynchburg, Virginia, United States of America. Complainants petition this Panel to consolidate their disputes pursuant to paragraph 4(f) of the Uniform Domain Name Dispute Resolution Policy (the "Policy").
- 1.2 The Respondents are Gary Cohn, an individual resident of the State of Illinois, with an address at 1954 First Street, Highland Park, Illinois, United States of America, God.info, and Prolife.info, who are listed as the respective registrants of the domain names at issue and who list the same address as that of Mr. Cohn. Complainants petition this Panel to consolidate their disputes pursuant to paragraph 4(f) of the Policy. Hereinafter Respondents will be jointly and severally referred to as "Respondent."

### **2. The Domain Names and Registrars**

The domain names at issue are <jerryfalwell.com> and <jerryfallwell.com>, which domain names are registered with eNom, Inc., of Redmond, Washington, and Bulkregister.com, Inc., of Baltimore Maryland, respectively, both in the United States of America (the "Registrars").

### **3. Procedural History**

- 3.1 A Complaint was submitted electronically to the World Intellectual Property Organization Arbitration and Mediation Center ("the Center") on

February 22, 2002, and the signed original together with four copies forwarded by express courier was received on February 26, 2002. An Acknowledgment of Receipt was sent by the Center to the Complainant, dated March 1, 2002.

- 3.2 On March 4, 2002, Network Solutions, Inc., the registrar named in the Complaint, advised the Center that it was not the registrar for the domain names at issue and advised the Center of the identities of the Registrars.
- 3.3 On March 5, 2002, the Center advised Complainants of the need to amend the Complaint to reflect the true identities of the Registrars. On March 6, 2002 by electronic means and on March 11, 2002 in hardcopy, the Center received an amended Complaint (hereinafter the "Complaint") setting forth the true identities of the Registrars.
- 3.4 On March 7, 2002, the Center received confirmation from the Registrars that the domain names at issue were registered with the respective Registrars.
- 3.5 The Center determined that the Complaint satisfies the formal requirements of the Uniform Domain Name Dispute Resolution Policy ("the Policy"), 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"). The Panel has independently determined and agrees with the assessment of the Center that the Complaint is in formal compliance with the requirements of the Policy, the Rules, and the Supplemental Rules. The required fees for a three-member Panel were paid on time and in the required amount by the Complainant.
- 3.6 No further formal deficiencies having been recorded, on March 12, 2002, a Notification of Complaint and Commencement of Administrative Proceeding (the "Commencement Notification") was transmitted to the Respondent (with copies to the Complainant, the Registrars, and ICANN), setting a deadline of April 1, 2002, by which the Respondents could file a Response to the Complaint. The Commencement Notification was transmitted to the Respondent by courier and by e-mail to the e-mail addresses indicated in the Complaint. In any event, evidence of proper notice is provided by the evidence in the record of the Respondent's participation in these proceedings.
- 3.7 A Response was received electronically on March 29, 2002 and in hardcopy on April 3, 2002. An Acknowledgment of Receipt (Response) was sent by the Center on April 2, 2002.
- 3.8 On April 3, 2002, Complainant submitted a "Reply to Response." On April 5, 2002, Complainant submitted a "Supplement to Complaint on the Issue of Tarnishment and Request for Leave to File". On April 9, 2002, Respondent submitted a "Response to Supplemental Filing." It is within the discretion of the Panel whether to accept and consider these supplemental filings. Rules, paragraph 12.
- 3.9 On April 26, 2002, the Center sent a Notification of Appointment of Administrative Panel, appointing Diane Cabell, Tony Willoughby, and M. Scott Donahey, each of whom had previously submitted a Statement of Acceptance and Declaration of Impartiality and Independence. M. Scott Donahey was designated Presiding Panelist.

#### **4. Factual Background**

- 4.1 Complainants are Dr. Jerry Falwell a religious minister and educator and The Liberty Alliance, a corporation of which Complainant Falwell is principal spokesperson and which corporation is the registrant of <falwell.com>. For purposes of factual background, the Panel will treat Dr. Falwell as the sole Complainant.
- 4.2 Complainant is the pastor of Thomas Road Baptist Church, a 20,000 member congregation of the Christian religious persuasion. Complainant appears weekly on a televised program entitled "Old Time Gospel Hour." Complainant is the founder and chancellor of Liberty University, a Christian oriented institution of higher education in Lynchburg, Virginia, United States of America.
- 4.3 Complainant has used the domain name <falwell.com> to resolve to a web site, on which he answers questions posed regarding biblical issues. The web site receives thousands of "hits" every week.
- 4.4 Complainant claims a common law trademark in his name. Complainant alleges that he has appeared on the cover of *Time* magazine, and in 1987 Complainant finished second only to former United States President Ronald Reagan in a poll conducted by *Good Housekeeping* magazine to determine America's Most Admired Men.
- 4.5 Complainant has not granted Respondent permission to use Complainant's name. Indeed, on October 26, 2001, Complainant sent Respondent a cease and desist letter, by email and by overnight courier.
- 4.6 Respondent is an individual. He has used the domain names at issue to resolve to a web site at which he offers parody, satire, and implied and direct criticism of Complainant and Complainant's views. The web site is non-commercial in nature, but does link to a discussion forum which service is hosted by a commercial third party, Delphi Forums. Delphi Forums does not appear to be connected to Respondent nor do any advertisements for Delphi appear on the Respondent's pages.

#### **5. Parties' Contentions**

- 5.1 Complainant contends that Respondent has registered domain names that are identical and/or confusingly similar to Complainant's common law trademark. Complainant further contends that Respondent has no rights or legitimate interests in respect of the domain names at issue, in that Respondent is using Complainant's common law trademark, or a variation thereof, in the domain name itself, and that this is unnecessary to accomplish Respondent's purported objective of satirizing or parodying Complainant. Finally, Complainant contends that Respondent's web site does not fall within the definition of parody, and therefore is a bad faith use.
- 5.2 Respondent apparently admits that the domain names at issue are identical or similar to Complainant's name, but denies that Complainant's name is protectable under the Policy. Respondent further contends that it has legitimate interests in respect of the domain names at issue, since it is 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 . . . at issue. Policy, paragraph 4(c)(iii). Finally, Respondent contends it did not register, nor is it using, the mark in bad faith, because of the above assertions, and because there is no possibility of confusion with Complainant. Respondent requests that the Panel find that Complainant is guilty of "cyberbullying," which the Panel interprets as a request for a finding of Reverse Domain Name Hijacking.

## 6. Discussion and Findings

Paragraph 4(f) of the Policy permits the Panel, in its sole discretion, "to consolidate . . . any or all disputes" pending between the parties. The majority notes that there are no disputes pending between The Liberty Alliance and any of the named Respondents. The Liberty Alliance is essentially included as a party-complainant as a matter of convenience to Dr. Falwell. "The Liberty Alliance is the registrant of Dr. Falwell's own domain name, FALWELL.COM, and it is to The Liberty Alliance that Dr. Falwell herein asks that the disputed domain names be transferred." Complaint, Section II,A, at paragraph 2. Accordingly, the majority finds that The Liberty Alliance is not a proper party to the present proceeding, and it is hereby dismissed as a Complainant. The sole legitimate Complainant to this dispute is Dr. Jerry Falwell.

The dissenting panelist would not have dismissed The Liberty Alliance as a complainant. In the view of the dissenting panelist, if the name of the First Complainant had been a trade mark or service mark, The Liberty Alliance might well have had rights to it in the same way that the trademark rights to the name of the English designer, Elizabeth Emanuel, are owned by the company for which she worked and not by her. The dissenting panelist would have dismissed the complaint of The Liberty Alliance on the ground that it had failed to prove that the name of the First Complainant is a trademark or service mark.

Respondent admits that he is effectively the registrant of the domain names at issue, and admits using the pseudonyms God.info and Prolife.net in the registration of the domain names at issue to emphasize the satiric nature of the use of the domain names at issue. Therefore, Complainant's disputes are not only with the named registrants, but with Mr. Cohn, as well. Therefore, the Panel exercises its discretion to consolidate the disputes against the three named Respondents.

Paragraph 12 of the Rules provides that "[i]n addition to the complaint and response, the Panel may request, in its sole discretion, further statements or documents from either of the parties." The Panel made no such request. The Panel affirmatively wishes to discourage the litigation tactic of always trying to secure the last word on any subject of dispute. Accordingly, the panel refuses to accept or to consider for any purpose the supplemental pleadings submitted in this matter.

Paragraph 15(a) of the Rules instructs the Panel as to the principles the Panel is to use in determining the dispute: "A Panel shall decide a complaint on the basis of the statements and documents submitted in accordance with the Policy, these Rules, and any rules and principles of law that it deems applicable."

Since both the Complainant and Respondent are domiciled in the United States, since both registrars have their principal places of business in the United States, and since United States' courts have recent experience with similar disputes, to the extent that it would assist the Panel in determining whether the Complainant has met its burden as

established by Paragraph 4(a) of the Policy, the Panel shall look to rules and principles of law set out in decisions of the courts of the United States.

Paragraph 4(a) of the Policy directs that the Complainant must prove each of the following:

- (1) that the domain names registered by the Respondent are identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and,
- (2) that the Respondent has no rights or legitimate interests in respect of the domain names; and,
- (3) that the domain names have been registered and are being used in bad faith.

Complainant claims a common law trademark in his personal name. The Complainant has failed to show that his name, well known as it is, has been used in a trademark sense as a label of particular goods or services. The dissent notes that this failure is attributable not only to Dr. Falwell, but to The Liberty Alliance as well. There are many well-known ministers, religious figures, and academics. Are their sermons or lectures to be considered commercial goods? Complainant failed to provide any marketing brochures, trade advertisements, or other evidence of use as a trademark. On September 3, 2001, WIPO issued its Final Report on the Second WIPO Domain Name Process (the "Second WIPO Report"). In that report, WIPO carefully considered to what degree protection should be extended to personal names. In its recommendations, WIPO clearly indicated that the Policy should be limited to personal names that had been commercially exploited. "Persons who have gained eminence and respect, but who have not profited from their reputation in commerce, may not avail themselves of the UDRP to protect their personal names against parasitic registrations. The UDRP is thus perceived by some as implementing an excessively materialistic conception of contribution to society." Second WIPO Report, paragraph 199.

Complainant is careful to avoid any suggestion that he has exploited his name for "materialistic" or "commercial" purposes. Complainant is an educator and religious minister. He has used his name to advance his views as to morality and religion. That Complainant has acquired a certain fame in the United States is without question. However, this kind of fame is not cognizable under the Policy. *See, e.g., Kathleen Kennedy Townsend v. B. G. Birt*, WIPO Case No. D2002-0030 (April 11, 2002).

This does not mean that Complainant is without a remedy. He may have claims under the Anticybersquatting Consumer Protection Act ("ACPA"), which expressly provides for protection of personal names, or perhaps his actions lie in tort. Complainant is free to pursue his claims in U.S. courts.

Moreover, while not necessary to our decision, the majority finds that Respondent is making "a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish<sup>1</sup> the trademark . . . at issue." Policy, paragraph 4(c)(iii). The fact that the trademark is used in the domain name does not in and of itself defeat the legitimate noncommercial fair use of the trademark in question. *Bruce Springsteen v. Jeff Burgar and Bruce Springsteen Club*, WIPO Case No. D2000-1532 (January 25, 2001). Nor does initial interest confusion

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<sup>1</sup> "Tarnishment" is intended to be limited to acts done with intent to commercially gain. Second Staff Report on Implementation Documents for the Uniform Dispute Resolution Policy, submitted for the ICANN Board meeting of October 24, 1999, paragraph 4.5,c. n. 2.

affect the legitimate noncommercial fair use of the trademark. *See, e.g., Strick Corp. v. Strickland*, 162 F. Supp. 2d 372, 377 (E.D. Pa. 2001). The dissenting panelist takes the view that the intended impersonation of another can rarely if ever be fair or legitimate and particularly in circumstances where the Complainant's name has been taken without adornment and where the purpose behind the impersonation of the person in question is to damage him. In the view of the dissenting panelist the fact that the unsuspecting visitor to the Respondent's web site is immediately disabused is irrelevant. By then the damage has been done. The visitor has been misleadingly diverted, and the Complainant has been damaged.

Complainant argues that the use being made of the name does not fall within the definition of "parody." However, whether regarded as parody, satire, or critical commentary, the majority believes that legitimate noncommercial fair use commentary is involved. Whether the commentary is in good taste, whether it is funny, whether it is effective, all is beside the point. *See, e.g., Wal-Mart Stores, Inc. v. Wal-Martcanadasucks.com and Kenneth J. Harvey*, WIPO Case No. D2000-1104 (November 23, 2000), at 18-19.

Respondent effectively asks for a finding of reverse domain name hijacking. The Panel declines to so find. There is a split of authority among panelists as to whether the mere use of a trademark in a domain name defeats fair use. *Compare, Estée Lauder, Inc. v. Estelauder.com, Estelauder.net, and Jeff Hanna*, WIPO Case No. D2000-0869 (September 25, 2000), *with The New York Times Company v. New York Internet Services*, WIPO Case No. D2000-1072 (December 5, 2000). Thus, Complainant could have well believed the Panel might have found that any use of the trademark in a domain name precluded fair use.

## 7. Decision

For all of the foregoing reasons, the Panel decides that the domain names registered by Respondent are identical or confusingly similar to the mark in which the Complainant claims rights, but that Complainant's rights in his personal name are not protectable under the Policy. The majority also finds that Respondent has rights to or legitimate interests in respect of the domain names at issue. Accordingly, the relief requested in the Complaint is denied.

The Panel declines to find reverse domain name hijacking.

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M. Scott Donahey  
Presiding Panelist

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Diane Cabell  
Panelist

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Tony Willoughby  
Panelist, dissenting in part

Dated: June 3, 2002