



# WIPO Arbitration and Mediation Center

## ADMINISTRATIVE PANEL DECISION

**Bridgestone Firestone, Inc., Bridgestone/Firestone Research, Inc., and Bridgestone Corporation v.  
Jack Myers**

**Case No. D2000-0190**

### 1. The Parties

The Complainants are three corporations, Bridgestone Firestone, Inc., an Ohio corporation with its principal place of business in Nashville, Tennessee, USA; Bridgestone/Firestone Research, Inc., a Delaware corporation with its principal place of business in Akron, Ohio, USA; and Bridgestone Corporation, a Japanese corporation with its principal place of business in Tokyo, Japan.

The Respondent is Jack Myers, an individual residing in Norwood, Pennsylvania, USA.

### 2. The Domain Name and Registrar

The domain name at issue is <bridgestone-firestone.net> (the Domain Name). The registrar with which the Domain Name is registered is Register.com (the Registrar).

### 3. Procedural History

The WIPO Arbitration and Mediation Center (the Center) received the Complainant's Complaint by email on March 20, 2000, and in hardcopy on March 23, 2000. On March 28, 2000, the Center sent the Complainant an Acknowledgment of Receipt of the Complaint.

The Center sent the Registrar, via email, a Request for Registrar Verification. On March 30, 2000, the Registrar transmitted via email to the Center a Registrar Verification Response confirming that the Domain Name is registered with the Registrar and that the Respondent is the current registrant of the Domain Name. The Registrar's Response set forth contact information for the Respondent, including email and mailing addresses.

The Center completed a Formalities Compliance Review and verified that the Complaint satisfied the formal requirements of the ICANN Uniform Dispute Resolution Policy (the Policy), the Rules for Uniform Domain Dispute Resolution Policy (the Uniform Rules), and the Supplemental Rules for Uniform Domain Dispute Resolution Policy (the WIPO Supplemental Rules). Complainant made the required payment to the Center. Upon independent review, the Administrative Panel also finds that the Complaint satisfies the formal requirements of the Policy, the Uniform Rules, and the Supplemental Rules.

On March 28, 2000, the Center transmitted to the parties, with copies to the Registrar and ICANN, a Notification of Complaint and Commencement of Administrative Proceeding, setting a deadline of April 16, 2000, by which the Respondent could file a Response to the Complaint. On April 14, 2000, the Center received a Response from the Respondent.

In view of the agreement of the parties to the appointment of a single panelist, the Center invited Dana Haviland to serve as the panelist. On April 27, 2000, after having received Ms. Haviland's Statement of Acceptance and Declaration of Impartiality and Independence, the Center transmitted to the parties via email a Notification of Appointment of Administrative Panel and Projected Decision Date, in which Dana Haviland was formally appointed as the sole panelist. The Decision Date was subsequently extended to July 7, 2000. The Panelist finds that the Administrative Panel was properly constituted and appointed in accordance with the Uniform Rules and the WIPO Supplemental Rules.

On April May 5, 2000, the Complainant requested leave to file a Further Statement. On May 12, 2000, the Administrative Panel requested Further Statements from both parties pursuant to Rule 12. Complainant's Further Statement was transmitted to the Center on May 12, 2000. Respondent's Further Statement, which was transmitted to the Center on May 27, 2000, noted that Complainant had not provided Respondent with copies of the case authorities cited in Complainant's Further Statement. In view of the fact that Respondent is not represented by counsel in this Administrative Proceeding, the Administrative Panel requested that the Complainant provide copies of the legal authorities cited to the Respondent and to the Panel. On June 3, the Complainant caused such copies to be delivered to the Respondent and to the Panel.

In accordance with the Rules, the Administrative Panel shall issue its Decision based on the Complaint, the Response, the Further Statements of the parties, the evidence presented, the file documents, the Policy, the Rules, and the Supplemental Rules. Under Rule 15(a), the Panel may also decide the Complaint on the basis of "any rules and principles of law that it deems applicable."

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

The Complainants have registered the trademarks Bridgestone and Firestone and various permutations thereof in a series of registrations dating from March 29, 1921, through April 13, 1999. The trademarked products and services include rubber tires, other rubber products, and related and accessory products. The Complainants have also registered the domain name <bridgestone-firestone.com>. Additionally, the Complainants have registered the domain names <ihatebridgestone.com>, <ihatefirestone.com> and <bridgestonesucks.com>.

On August 28, 1999, the Respondent registered the Domain Name <bridgestone-firestone.net> with the Registrar. The Respondent is a former employee and current pensioner of the Firestone Tire and Rubber Company, an affiliate of Complainants. The Respondent has been engaged in a dispute with the Complainants over pension payments since 1990.

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

Complainants

Complainants contend that the Domain Name is identical and confusingly similar to Complainants' trademarks Bridgestone, Firestone and Bridgestone/Firestone and to Complainants' domain name <bridgestone-firestone.com>.

Complainants contend that Respondent has no rights or legitimate interests in the Domain Name because the terms Bridgestone, Firestone, and Bridgestone/Firestone have no meaning other than to identify the Complainants' goods and services and distinguish them from competitors. Complainants contend that their trademarks are famous and have acquired substantial goodwill.

Complainants contend that the Respondent registered and is using the Domain Name in bad faith in three respects:

- for the purpose of selling or transferring the Domain Name to Complainants as evidenced by the Respondent's demand on his website that the Complainants buy both the Domain Name and the website, with the words "Why Bridgestone/Firestone must pay John Myers";
- to attract Internet users to Respondent's website for financial gain, by creating a likelihood of confusion as to the source or sponsorship of the website;
- to divert potential consumers to Respondent's website in order to defame, tarnish and dilute Complainants' trademarks.

Complainants have cited numerous trademark infringement, dilution, and unfair competition cases from U.S. courts in support of their claim.

Complainants request a decision requiring that the Domain Name <bridgestone-firestone.net> be transferred to the Complainants.

#### Respondent

Respondent admits that the Domain Name uses the Complainants' trademarks, but raises the defenses of free speech and "fair use". He contends that the website is a "complaint" site that is engaged in no commercial activity and that the use of the trademarks is for the purpose of identifying the companies that are the basis of the complaint site. Respondent contends that in using the Complainants' trademarks in the Domain Name, he is protected by the guarantee of free speech under the First Amendment of the U.S. Constitution and is exempted from liability by the "fair use" exemption under the U.S. Federal Anti-Dilution Act of 1996 for use of a famous mark if the use is for noncommercial purposes or for news reporting and commentary.

Respondent further asserts that no prudent Internet user would be confused as to the source or sponsorship of the website, and submits copies of pages of the site – the home page stating that "This website is not affiliated in any way with Bridgestone/Firestone, Inc." and pages whose content is sharply critical of the Complainants. With respect to his "fair use" through "news reporting and commentary" defense, he submits copies of site pages containing news articles about Complainants and other pages titled "Consumer/Employee Forum" which include not only unfavorable comments about Complainants but disparaging comments about Respondent and favorable comments about Complainants.

## 6. Discussion and Findings

At the outset, it must be noted that the Panel does not have jurisdiction to decide claims of trademark infringement, dilution, unfair competition or other statutory or common law causes of action. Thus most of the legal authorities cited by the parties are not strictly applicable. Further, such causes of action require extensive factual development and analysis which these domain name administrative proceedings are not designed to accommodate. See *E.I du Pont de Nemours and Co. v. Avant Garde Composition*, ICANN [Case No. D2000-0130](#) (whether trademark had become generic term was better resolved by court).

The Panel's jurisdiction is limited to the determination whether the Complainant has proved the necessary elements of a claim for transfer or cancellation of a domain name under the Policy and the Rules. Policy, Paragraph 4(a). The discussion and decision herein will therefore be governed by the terms of the Policy, although reference by analogy may be made to principles of U.S. law, as two of the Complainants are U.S. corporations, Respondent is a U.S. resident, and both parties have cited U.S. law in their submissions.

Under the terms of the Policy, the Complainant must prove three distinct elements in order to prevail on a claim for transfer of a domain name. These elements are set forth in Paragraph 4(a) of the Policy:

- that the domain name registered by the respondent is identical or confusingly similar to a trademark or service mark in which the complainant has rights; and
- that the respondent has no rights or legitimate interests in respect of the domain name; and
- that the domain name has been registered and is being used in bad faith.

#### **Identity or confusing similarity of domain name and trademark**

The Panel finds that the Domain Name <bridgestone-firestone.net> registered by the Respondent is identical or confusingly similar to Complainants' trademarks.

#### **No legitimate interest in domain name**

Respondent is not a licensee of the Complainants and is not otherwise authorized to use the Complainants' marks. However, the Policy sets forth examples of circumstances whereby a domain name registrant may demonstrate a right or legitimate interest in a domain name, including:

... 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.

Policy, Paragraph 4(c)(iii).

The Panel finds that 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." See *Brookfield Communications, Inc. v. West Coast Entertainment Corp.*, 174 F.3d 1036, 1065 (9th Cir. 1999). In *Brookfield*, a trademark infringement case, the court found that the domain name in question, which was used for a commercial website, infringed on the plaintiff's trademark, after an extensive factual analysis of several factors on the issue of likelihood of confusion, including in particular the relatedness of the products and services offered. The *Brookfield* court cited a number of cases for the proposition that fair use could include the use of a trademark to identify the trademark holder's products in certain circumstances, but rejected the defendant's fair use defense, noting that the trademark was being used in the domain name to describe the domain name holder's products and not simply to identify the trademarked products. The court also noted that the domain name utilized the <.com> top level domain, "signifying the commercial nature of the site", and pointed out that "web users often assume, as a rule of thumb, that the domain name of a particular company will be the company name followed by '.com'". *Id.* at 1044-1045.

In this case, the Respondent is not using the website for commercial purposes and has not appropriated the <.com> domain, which the Complainants have themselves registered and are using for a commercial website. This case is more closely analogous to the facts in *Bally Total Fitness Holding Corp. v. Faber*, 29 F.Supp.2d 1161 (C.D. Cal. 1998), one of the cases cited approvingly by the Ninth Circuit Court of Appeals in *Brookfield* on the fair use issue. In *Bally*, the court held that the defendant's use of a trademark in an Internet site for purposes of consumer commentary and criticism did not infringe or dilute the plaintiff's mark. The court held that the defendant was "exercising his right to publish critical commentary about Bally" and that he could not

do so without making reference to Bally:

Faber is using Bally's mark in the context of a consumer commentary to say that Bally engages in business practices, which Faber finds distasteful or unsatisfactory. This is speech protected by the First Amendment...As such; Faber can use Bally's mark to identify the source of the goods or services of which he is complaining. This use is necessary to maintain broad opportunities for expression. *Id.* at 1165, 1167.

The court in *Bally* thus recognized both fair use and free speech as defenses to trademark infringement and dilution in the Internet context. In *Bally*, the defendant was not using the trademark in the domain name itself, however, but on the website, which prominently stated, *inter alia*, "Bally sucks." The *Bally* court distinguished cybersquatting cases like *Panavision International v. Toeppen*, 141 F.3d 1316 (9<sup>th</sup> Cir. 1998) on the grounds that the use of the trademark in domain names in those cases created a high likelihood of consumer confusion, *i.e.*, that reasonably prudent consumers would believe that the site using the appropriated name was the trademark owner's site. However, the court pointed out that "no reasonably prudent Internet user would believe that "Ballysucks.com" is the official Bally site or is sponsored by Bally." *Bally* at 1163-1164.

The Panel sees no reason to require domain name registrants to utilize circumlocutions like <trademarksucks.com> to designate a website for criticism or consumer commentary. "We must be acutely aware of excessive rigidity when applying the law in the Internet context; emerging technologies require a flexible approach." *Brookfield, supra*, 174 F.3d at 1054. In the cybersquatting cases, the domain names in question generally were <trademark.com> domain names, which prevented the trademark holder from utilizing the customary commercial domain name for its "official" site. *See, e.g., Panavision International v. Toeppen, supra*. Here, however, the domain name registrant has not usurped the <.com> domain but has utilized only the <.net> domain, has posted disclaimers on the website homepage, and has included criticism and commentary on the site so that a reasonably prudent Internet user can tell that the site is not the trademark holder's "official" site. *See Western Hay Company v. Carl Forester*, ICANN Case No. FA0001000093466 (Internet user who arrived at respondent's "discussion forum" website would not be confused).

The Panel is aware of the line of trademark infringement cases holding that <trademarksucks.com> domain names may be protected as free speech because of their "communicative content" while <trademark.com> domain names serve merely as "source identifiers" and are thus unprotected. *See, e.g., OBH, Inc. v. Spotlight Magazine, Inc.*, 86 F.Supp.2d 176 (W.D.N.Y. 2000), cited by Complainants. The Panel declines, however, to adopt that distinction for purposes of analysis of the Policy's requirements and notes that the Second Circuit Court of Appeals has recently expressly rejected this distinction because "the nature of the domain names is not susceptible to such a uniform, monolithic characterization," in view of the "lightning speed development" and "extraordinary plasticity" of both the Internet and the domain name system. *See Name.Space, Inc. v. Network Solutions Inc.* 202 F.3d 573, 585 (2d Cir. 2000). With respect to free speech, the Second Circuit held in *Name.Space* that "Domain names ... per se are neither automatically entitled to nor excluded from the protections of the First Amendment, and the appropriate inquiry is one that fully addresses particular circumstances presented with respect to each domain name." *Id.* In *Avery Dennison Corp. v. Sumpton*, 189 F.3d 868 (9<sup>th</sup> Cir. 1999), a trademark dilution case, the Ninth Circuit Court of Appeals noted that the use of a <trademark.net> domain name rather than a <trademark.com> domain name raised genuine issues of material fact on virtually every element of the dilution claim, including whether such use constituted "commercial use". 189 F.3d at 879-880. The Court noted that "<.net> applies to networks and <.com> applies to commercial entities," and that "a factfinder could infer that dilution does not occur with a <trademark.net> registration." *Id.* at 880-881. Such fact-intensive analyses on issues of trademark infringement and dilution are beyond the scope of this administrative proceeding and are better carried out by arbitrators or courts.

The question presented in this case is whether fair use and free speech are defenses to a claim for transfer of a domain name under the Policy. Under Paragraph 4 (c)(iii) of the Policy, noncommercial fair use is expressly made a defense, as noted above. Although free speech is not listed as one of the Policy's examples of a right or legitimate interest in a domain name, the list is not exclusive, and the Panel concludes that the exercise of free speech for criticism and commentary also demonstrates a right or legitimate interest in the domain name under Paragraph 4 (c)(iii). The Internet is above all a framework for global communication, and the right to free speech should be one of the foundations of Internet law.

At least one other ICANN panel has recognized the possibility of a free speech defense in an ICANN proceeding, while rejecting the defense under the facts of the case in question. In *CSA International (a.k.a.*

*Canadian Standards Association) v. John O. Shannon and Care Tech Industries, Inc.*, ICANN [Case No. D2000-0071](#), the Panel rejected respondents' free speech defense and transferred both <trademark.com> and <trademark.net> domain names to the complainant, finding that respondents were engaged in commercial use of the marks, because the respondents were not only criticizing the trademarked products but promoting the respondents' own products on the websites and on linked websites.

In this case, the Respondent's principal purpose in using the domain name appears not to be for commercial gain, but rather to exercise his First Amendment right to criticize the Complainants. The use of the <trademark.net> domain name appears to be for the communicative purpose of identifying the companies, which are the subject of his complaints. He is not misleadingly diverting users to his website, as he has not utilized the <.com> domain and has posted adequate disclaimers as to the source of the website. It does not appear that his actions are intended to tarnish, or have tarnished, the Complainants' marks.

Nor does it appear that Respondent's registration and use of the Domain Name have harmed Complainants commercially. Respondent's use of the <.net> domain has not prevented Complainant from making its commercial presence known on the Internet. The Panel notes that the Complainants themselves have registered various <trademark.com> and <trademarksucks.com> domain names, but apparently decided not to register the <trademark.net> domain name before it was registered by Respondent. Since there are now seven generic top level domains, with more in the process of being approved, as well as some 240 country top level domains, there are hundreds of domain name permutations available to Complainants. Respondent's use of one of those permutations other than the principal <.com> domain name for purposes of critical commentary is a legitimate noncommercial and fair use. Complainants have thus failed to prove the second element of a claim for transfer of a domain name under the Policy.

#### **Bad faith registration and use of the domain name**

Paragraph 4(b) of the Policy sets forth four examples of bad faith, which are not exclusive, but which "shall be evidence of registration and use of a domain name in bad faith":

- (i) circumstances indicating that you have registered or you have acquired the domain name primarily for the purpose of selling, renting or otherwise transferring the domain name registration to the Complainant who is the owner of the trademark or service mark or to a competitor of that Complainant, for valuable consideration in excess of your documented out-of-pocket costs directly related to the domain name; or
- (ii) you have registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that you have engaged in a pattern of such conduct; or
- (iii) you have registered the domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your web site or other on-line location, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of your web site or location or of a product or service on your website or location.

The Panel finds that the Complainant has not presented evidence sufficient to establish bad faith registration and use of the Domain Name by Respondent. There is no evidence that the Respondent (i) registered the Domain Name primarily to sell it to the Complainants, (ii) engaged in a pattern of conduct to prevent trademark owners from reflecting their marks in domain names, (iii) sought to disrupt the business of a competitor, or (iv) intentionally attempted to attract Internet users to his site for commercial gain.

Although the Respondent's website sets forth an offer to transfer the domain name and website to Complainants at cost if the Complainants pay Respondent the pension payments he claims are owed to him, it does not appear that the sale of the domain name was the Respondent's primary purpose in registering or using the domain name. On the contrary, the Respondent's primary purpose from the time of registration of the Domain Name to date appears to be the exercise of his free speech right to criticize the Complainants.

Moreover, the same facts establishing fair use and the exercise of free speech negate a finding of bad faith intent. See *Lucent Technologies, Inc. v. LucentSucks.com*, 95 F.Supp.2d 528, 535-536 (E.D.Va. 2000).

"The explosion of the Internet is not without its growing pains. It is an efficient means for business to disseminate information, but it also affords critics of those businesses an equally efficient means of disseminating commentary." *Bally, supra*, at 1168.

This phenomenon is now so common on the Internet that those establishing such websites dedicated to criticizing persons, products, or businesses, are known as "cybergrippers." See *Lucent, supra*, at 536, n.9.

In *Compagnie de Saint Gobain v. Com-Union Corp.*, ICANN [Case No. D2000-0020](#), the Panel recognized an "inalienable freedom of speech and expression" and stated that "It goes without saying that shareholders or other interested parties have the right to voice opinions, concerns and criticisms with respect to a listed company and that the Internet constitutes an ideal vehicle for such activities," but transferred a <trademark.net> domain name to the complainants despite the respondent's initial use of the site for criticism of the complainants by shareholders. In discussing the bad faith element of the case, the Panel in *Compagnie de Saint Gobain* stated that the issue was not freedom of speech and expression but the choice of the domain name used to exercise the right of free speech, and found bad faith because the respondent "knowingly chose a domain name which is identical and limited to the trademark of complainants," when respondent "could have chosen a domain name adequately reflecting both the object and independent nature of its site, as evidenced today in thousands of domain names." This analysis resembles the rationale in the cases making the <trademark.com> vs. <trademarksucks.com> distinction discussed above, and the decision is therefore not followed here for the reasons discussed above. The Panel in *Compagnie de Saint Gobain* also found bad faith because the respondent had failed to renew two of the domain name registrations at issue and had substituted a brief history of the Saint Gobain forest and hyperlinks to online gambling websites for the former critical content of the third website, from which the Panel inferred that the "real current intent" of the respondent was to prevent the complainant from reflecting its trademark in the domain name. For this reason as well, the Panel herein does not follow this prior decision, because, as discussed above, the evidence in the case before this Panel shows that the Respondent has not registered or used the Domain Name in bad faith but has consistently used the Domain Name website for noncommercial critical commentary.

The ICANN cases cited by Complainants are not applicable here because both involved commercial use of domain names without any issue of fair use or free speech, and with bad faith by respondent found in both cases. See *The Stanley Works and Stanley Logistics, Inc. v. Camp Creek Co., Inc.*, ICANN [Case No. D2000-0113](#) (ten domain names transferred where evidence showed respondent solicited compensation for the domain names, intended to tarnish marks and disrupt complainant's business, and engaged in a pattern of cybersquatting); *Nike, Inc. v. Granger and Associates*, ICANN [Case No. D2000-0108](#) (domain name transferred where evidence showed respondent had marketing contract with complainant and promised, then refused in bad faith to transfer domain name).

The Policy's list of circumstances showing bad faith is not exclusive, and the Complainants also contend that the Respondent's use of the Domain Name is intended "to defame, tarnish and dilute the trademarks" and is thus in bad faith. The merits of the Complainants' defamation, tarnishment and dilution claims are, however, like the Respondent's claims against the Complainants for pension payments, beyond the scope of jurisdiction of the Panel in this administrative proceeding.

The Panel thus finds that the Complainants have failed to establish the third essential element of their claim, bad faith registration and use of the domain name.

## 7. Decision

For all of the foregoing reasons, the Panel decides that although the Domain Name registered by Respondent is identical or confusingly similar to the trademarks in which the Complainants have rights, the Respondent has legitimate fair use and free speech rights and interests in respect of the Domain Name, and the Respondent has not registered and used the Domain Name in bad faith. The Panel therefore denies the claim

of the Complainants for transfer of the Domain Name.

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Dana Haviland  
Presiding Panelist

Dated: July 6, 2000