



NATIONAL ARBITRATION FORUM

DECISION

Richard Dawkins v. J. Gabriel
Claim Number: FA1004001317157

PARTIES

Complainant is **Richard Dawkins** (“Complainant”), represented by **Paul S. Cha**, of **Holme Roberts and Owen LLP**, Denver, CO 80203, USA. Respondent is **J. Gabriel** (“Respondent”), New Jersey, USA.

REGISTRAR AND DISPUTED DOMAIN NAME

The domain name at issue is **<richarddawkins.com>**, registered with **Netfirms, Inc.**

PANEL

The undersigned certifies that each has acted independently and impartially and to the best of his or her knowledge has no known conflict in serving as a Panelist in this proceeding.

The panel included R. Glen Ayers, Chair, Houston Putnam Lowry, Chartered Arbitrator, and G. Gervaise Davis.

PROCEDURAL HISTORY

Complainant submitted a Complaint to the National Arbitration Forum electronically on April 2, 2010.

On April 5, 2010, Netfirms, Inc. confirmed by e-mail to the National Arbitration Forum that the **<richarddawkins.com>** domain name is registered with Netfirms, Inc. and that the Respondent is the current registrant of the name. Netfirms, Inc. has verified that Respondent is bound by the Netfirms, Inc. registration agreement and has thereby agreed to resolve domain-name disputes brought by third parties in accordance with ICANN’s Uniform Domain Name Dispute Resolution Policy (the “Policy”).

On April 7, 2010, the Forum served the Complaint and all Annexes, including a Written Notice of the Complaint, setting a deadline of April 27, 2010, by which Respondent could file a Response to the Complaint, via e-mail to all entities and persons listed on Respondent’s registration as technical, administrative, and billing contacts, and to postmaster@richarddawkins.com. Also on April 7, 2010, the Written Notice of the Complaint, notifying Respondent of the email addresses served and the deadline for a Response, was transmitted to Respondent via post and fax, to all entities and persons listed on Respondent’s registration as technical, administrative and billing contacts.

A timely Response was received and determined to be complete on April 19, 2010.

On April 30, 2010, pursuant to Complainant's request to have the dispute decided by a three-member Panel, the National Arbitration Forum appointed a panel of R. Glen Ayers, Chair, Houston Putnam Lowry, Chartered Arbitrator and G. Gervaise Davis.

RELIEF SOUGHT

Complainant requests that the domain name be transferred from Respondent to Complainant.

PARTIES' CONTENTIONS

A. Complainant

Complainant is an individual who is associated with New College at Oxford University in the United Kingdom. He is an esthologist, an evolutionary biologist, a socio-biologist, and a popular science author. He is also a well-known atheist.

Complainant, although he has not filed for or received a registered trademark as to his name, asserts that registration is not necessary where a famous name has been established as an identifier of goods and services. Dawkins states that he has established common law trademark rights in his name "by authoring many well-known, popular, and well-selling books since 1976." Dawkins further asserts that his common law trademark has been established by "public speaking, appearing on television, establishing The Richard Dawkins Foundation for Reason and Science..., receiving awards and public recognition, and appearing in documentary films all related to evolutionary biology, gene-centered evolution, atheism, and/or criticizing creationism...." The Complainant goes on to provide evidence of his books and other publications, and evidence of his public career as a speaker or lecturer on evolution and related topics, including atheism. Dawkins says that he holds a number of honorary degrees and awards and that he has established a "strong and well-known program on the Internet."

The disputed domain name, <**richarddawkins.com**>, is obviously confusingly similar, says Complainant, to the distinctive RICHARD DAWKINS mark. The addition of ".com" is of no significance.

The Complainant submitted an original complaint and then attempted to negotiate a settlement. In the course of those discussions, the Complainant discovered that the owner of the domain name in question is an individual named J. Gabriel.

Complainant asserts that Respondent uses "the disputed domain name to direct Internet users to Respondent's website...." Complainant asserts that the website "features links to third-party websites, including Amazon.com Associate pages, which offer goods and services in direct competition with the Complainant.

Complainant asserts that Respondent is "using a confusingly similar domain name...for commercial gain...to compete with Complainant's sales." Complainant asserts that Respondent has no rights or legitimate interests in the disputed domain name.

The domain name was registered on August 1, 1999, but as of that date, Complainant alleges that “Respondent had constructive notice of Complainant’s rights in and to its ‘RICHARD DAWKINS Mark....”

Complainant also asserts that there is no evidence that Respondent is commonly known by the domain name and offers evidence to the contrary. Further, Complainant says he has never granted use of his name to Respondent.

As to the issue of bad faith, Complainant asserts that Respondent is unabashedly disrupting the business of Complainant. Complainant asserts that Respondent receives “fees for diverting Internet users” to various websites unrelated to Complainant’s mark. Further, Complainant asserts that diversions to websites which sell, for example, herbal medicines, constitute diversions of “Internet users...for commercial gain.” Complainant also asserts that this creates a likelihood of confusion, for Complainant suggests that diversion to websites somehow indicates that “Richard Dawkins” is a source or sponsor or is affiliated with or endorses these unrelated websites.

While Respondent has attempted to provide disclaimers on the website, Complainant argues that such disclaimers are not sufficient. More importantly, Complainant suggests that Respondent has engaged in a pattern of such conduct, registering the names of other well-known persons, authors and actors, for purposes of driving Internet traffic to the unrelated websites described in the Complaint.

B. Respondent

Respondent, J. Gabriel, filed a timely written response. Respondent asserts that all of the books listed in the Complaint by the Complainant were written “years after the registration date of August 1, 1999.” Respondent argues that Mr. Dawkins did not become a public figure until the publication of what is perhaps his best-known atheist tract, *The God Illusion*, in 2006.

Respondent goes on to cite legal opinions and argues that the “legitimate non-commercial and fair use of such a common law mark is protected.” Respondent describes his use of the name as “fair use” and asserts that Respondent has created a “fan-based site”.

Respondent attempts to rebut the issue of rights in the name by arguing, in the context of common law mark, that it is “irrelevant.” Respondent essentially argues if and when permission is granted, that is a relevant issue, but the lack of permission is not determinative. Respondent argues that his use of Complainant’s name as a domain name is due to his interest in Complainant and Complainant’s published works. Respondent asserts that he has utilized the website in a “bona fide offering of goods and services”. Respondent states that he became a fan after reading material by and about Dawkins and established a “fan site.”

Respondent denies any commercial benefit and states that links or banners were added “when it was common practice for web-host to place them there in exchange for free web-hosting services, so the... website would not have to pay the monthly fees. These

have never benefited Respondent for any commercial gain....” Respondent asserts bad faith and asserts that the “click through links” are to link the website reader to Dawkins’ books and reviews of those books, and the sources of those books and reviews of those books. Respondent does admit receiving cease and desist letters, and states that those letters offer to purchase the domain for \$1,000.00. Respondent states that Respondent was simply not interested in selling the domain name.

As to bad faith, Respondent denies bad faith and notes that Complainant has established its own domain name and related webpage at <**richarddawkins.net**>.

Respondent also states that he has not attempted to disrupt Complainant’s commercial activities but, if anything, has only enhanced public recognition and awareness of Mr. Dawkins and his work. Respondent states that there is no likelihood of confusion or an intentional attempt “to attract, for commercial gain, Internet users...by creating a likelihood of confusion....” Respondent asserts that “the mere use of the name of a celebrity on the front page [of a magazine] does not mean that the magazine is claiming any kind of specific rights in relation to the name....” Respondent also asserts that its use of disclaimers is appropriate. Respondent denies the use of any properties of a Twitter account and states that Twitter understands that the account “represents not Richard Dawkins himself, but the website domain name, <**richarddawkins.com**>.” Respondent also denies that he has improperly registered other websites and argues that both websites that he did register were not disputed by the famous individuals to which they were linked. Respondent asserts that “[t]here is no profit or monetary gain to the Respondent made from these sites as to other registered domain names utilizing the names of famous persons.” Respondent asserts that he has made fair use of the domain name with no effort to sell the domain name or use it in a commercial context.

Respondent asserts that Complainant has not met his burden of proof that Respondent ever used the disputed name in bad faith. Respondent goes on to once again assert Respondent’s good faith as shown by the simple fact that Respondent refused to sell the domain for \$1,000.00, because the domain name was not a commercial enterprise, but “was registered by a fan in good faith...and...was registered for other fans who respect and admire” Mr. Dawkins.

C. Additional Submissions

None.

FINDINGS

The Panel unanimously finds that Richard Dawkins has established a common law trademark in his name. The three Panel members agree that Mr. Dawkins has perhaps done the most thorough job in establishing the existence of the common law trademark in a personal name that any of the three panelists have seen. *See* decisions by the various panelists including: *William J. Clinton v. Web of Deception*, FA0904001256123 (Nat. Arb. Forum June 1, 2009); *Richard L. Bayless v. Cayman Trademark Trust*, FA0602000648245 (Nat. Arb. Forum April 3, 2006); and *Delta Air Transport NV v. Sonza*, D2503-372 (WIPO Aug. 5, 2003) (dissent).

Put as simply as possible, when any one of the three panelists hears the name “Richard Dawkins”, each thinks automatically of the books and articles written by Mr. Dawkins supporting evolution, opposing creationism, and defending or asserting atheism.

Mr. Dawkins’ public career is identified almost exclusively with those issues, all as very well pointed out in the Complaint.

Further, the Complaint clearly indicates that Mr. Dawkins’ publications and other work created in the period before the registration of the domain name in 1999, was certainly sufficient to put Respondent on notice of the existence of the common law trademark. Respondent’s assertions that Mr. Dawkins was ill-known or little known, particularly in the U.S., in 1999, when Respondent established the domain name, is quite simply wrong or, at best, seriously mistaken, all as shown by Complainant’s evidence. Dawkins’ first book, *The Selfish Gene*, was published in 1976, followed by a number of well-known books printed in the 1980s and 1990s. A profile of the Complainant appeared in *Wired*, in 1995.

Upon establishment by the Complainant of the existence of a common law mark, the issue of confusing similarity answers itself. The domain name <**richarddawkins.com**> and the trademark RICHARD DAWKINS are certainly confusingly similar. The domain name decisions in this area require the clear establishment of secondary meaning and certainly that has occurred in this case.

Each of the panelists has had some experience in this area. Therefore, when the panelists assert that each individually finds this to be a most compelling set of facts -- clearly showing a common law trademark in the name -- such statements are also evidence of the common law mark.

The mark and domain name being clearly identical, the issue of rights and legitimate interests in the domain name must be addressed next. While the Respondent asserts that Complainant has not established that he has no rights in the domain name, Respondent overstates the legal obligation of the Complainant. The Complainant need only make a *prima facie* case that Respondent has no right to the domain name. The Complainant has clearly done that by stating that the Respondent is not commonly known by name Richard Dawkins, is not a licensee, and otherwise has acquired no rights in the name. *See Hanna-Barbera Productions, Inc. v. Entm’t Commentaries*, FA741828 (Nat. Arb. Forum Aug. 18, 2006). *Hanna-Barbera* stands for the proposition that once a *prima facie* case is made, the burden of proof shifts.

Complainant has also stated that Respondent is using the domain name for commercial gain, but not in a manner in which legitimate rights or interests exist for the benefit of Respondent. Respondent attempts to rebut that fork of the analysis by asserting that its operation of the domain name is merely a fan website. This is legitimate “fair use,” says Respondent. However the links provided by Respondent are links to websites that have nothing to do with Richard Dawkins. Even if there are links to websites having to do with Richard Dawkins, the mixture of links negates the argument of “fair use.”

As to bad faith, Complainant's assertions of bad faith are well presented and persuasive. Complainant has shown that Respondent does receive payments of fees resulting from "diverting Internet users to Third-Party websites." The Panel, in finding that there are "click through" fees involved, is justified in a finding of bad faith. *See T-Mobile USA, Inc. v. utahhealth*, FA 697821 (Nat. Arb. Forum June 7, 2006). That opinion specifically holds that directing Internet traffic to a commercial "linked page" constitutes bad faith.

Here, the Panel finds that Respondent's disclaimers do not mitigate a finding of bad faith registration or use. *See Continental Airlines, Inc. v. Vartanian*, FA 1106528 (Nat. Arb. Forum Dec. 26, 2007), and *Ciccone v. Parisi*, D2000-0847 (WIPO Oct. 12, 2000). In *Ciccone*, the panel said that the disclaimer is not effective "to dispel initial interest confusion that is inevitable" where a party such as the Respondent uses an identical or confusingly similar domain name to direct Internet traffic to a linked click-through page. In fact, in such circumstances, the Internet user does not see the disclaimer until it is already at the linked page.

The Panel also finds that Richard Dawkins had established a common law trademark in his name well before Respondent registered the domain name in 1999 and that the extensive use of the common law mark put Respondent on notice before registration of his website.

DISCUSSION

Paragraph 15(a) of the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules") instructs this Panel to "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."

Paragraph 4(a) of the Policy requires that the Complainant must prove each of the following three elements to obtain an order that a domain name should be cancelled or transferred:

- (1) the domain name registered by the Respondent is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;
- (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

Identical and/or Confusingly Similar

The Panel finds that Richard Dawkins has established a common law trademark in his name. Therefore, the trademark, RICHARD DAWKINS, is confusingly similar or identical to the domain name, <**richarddawkins.com**> .

Rights or Legitimate Interests

Respondent has no rights or legitimate interests in the name.

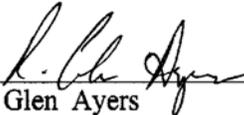
Registration and Use in Bad Faith

Respondent's activities constitute bad faith.

DECISION

Having established all three elements required under the ICANN Policy, the Panel concludes that relief shall be **GRANTED**.

Accordingly, it is Ordered that the <**richarddawkins.com**> domain name be **TRANSFERRED** from Respondent to Complainant.



Honorable R. Glen Ayers
Arbitrator

R. Glen Ayers, Chair
Houston Putnam Lowry, Chartered Arbitrator, Panelist
G. Gervaise Davis, Panelist
Date: May 21, 2010

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