



**NATIONAL
ARBITRATION
FORUM**

NATIONAL ARBITRATION FORUM

DECISION

Homer TLC, Inc. v. GreenPeople
Claim Number: FA0508000550345

PARTIES

Complainant is **Homer TLC, Inc.** (“Complainant”) represented by **Carrie L. Johnson** 2100 IDS Center, 80 South Eighth Street, Minneapolis, MN, 55402. Respondent is **GreenPeople** (“Respondent”), 524 S 3rd Ave #1, Highland Park, New Jersey 08904.

REGISTRAR AND DISPUTED DOMAIN NAME

The domain name at issue is <**homedepotsucks.com**>, registered with **Wild West Domains, Inc.**

PANEL

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

Houston Putnam Lowry, Chartered Arbitrator, as Panelist.

PROCEDURAL HISTORY

Complainant submitted a Complaint to the National Arbitration Forum electronically on August 30, 2005; the National Arbitration Forum received a hard copy of the Complaint on August 31, 2005.

On August 30, 2005, Wild West Domains, Inc. confirmed by e-mail to the National Arbitration Forum that the <**homedepotsucks.com**> domain name is registered with Wild West Domains, Inc. and that the Respondent is the current registrant of the name. Wild West Domains, Inc. has verified that Respondent is bound by the Wild West Domains, 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 September 6, 2005, a Notification of Complaint and Commencement of Administrative Proceeding (the "Commencement Notification"), setting a deadline of September 26, 2005 by which Respondent could file a Response to the Complaint, was transmitted to Respondent via e-mail, post and fax, to all entities and persons listed on Respondent's registration as technical, administrative and billing contacts, and to postmaster@homedepotsucks.com by e-mail.

A timely Response was received and determined to be complete on September 26, 2005.

An additional submission from Complainant was received in a timely manner on October 4, 2005.

An additional submission from Respondent was received in a timely manner on October 10, 2005.

On October 3, 2005, pursuant to Complainant's request to have the dispute decided by a single-member Panel, the National Arbitration Forum appointed Houston Putnam Lowry, Chartered Arbitrator, as Panelist.

RELIEF SOUGHT

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

PARTIES' CONTENTIONS

A. Complainant

(a) Homer TLC, Inc. is the owner of the famous HOME DEPOT and THE HOME DEPOT trademarks. Homer TLC, Inc. through its predecessor in interest and licensee (collectively "Complainant"), commenced use of the marks THE HOME DEPOT and HOME DEPOT (hereinafter the "Marks") in connection with its products and services at least as early as 1979. Since that time, Complainant has continually used the Marks in commerce in the United States and abroad.

(b) Complainant has worldwide sales under the Marks in the tens of billions of US Dollars each year. Complainant operates over 1900 retail stores in the United States, Canada and Mexico and employs over 325,000 people.

(c) Over the years, Complainant has prominently used and promoted the Marks in advertising, sales, and various other ways. Complainant's sales and advertising expenses under the Marks have been extensive. As a result, the Marks serve to identify and indicate the source of Complainant's services and products to the consuming public, and to distinguish its services and products from those of others. As a result of Complainant's long usage and promotion of the Marks, they have become well known to, and widely recognized by consumers.

(d) Complainant owns at least 31 United States federal registrations for trademarks incorporating “HOME DEPOT,” and owns hundreds of registrations for HOME DEPOT trademarks worldwide.

(e) Complainant markets its products and services under the Marks through its web site at <homedepot.com> (for example, among other things, Complainant markets building supplies, paint, power tools, batteries, cleaners, tile adhesives, vinyl sheeting, appliances, pet supplies, fertilizers and roofing supplies on its website). Complainant’s web site has been in operation since 1992.

(f) The domain name <**homedepotsucks.com**> is confusingly similar to the Marks. See Policy ¶4(a)(i). ICANN panels have found that, when a domain name incorporates a distinctive mark in its entirety that creates sufficient similarity between the mark and the domain name to render it confusingly similar. See *Lowen Corp. v. Henry Chan*, D2004-0430 (WIPO August 5, 2004) (finding that the domain name lowensigns.com is confusingly similar to LOWEN). The addition of the word “sucks” to a distinctive mark does not mitigate confusing similarity and ICANN Panels have “routinely found confusing similarity” when a domain name combines a well-known mark with a generic or slang term. See *Wachovia Corp. v. Alton Flanders*, D2003-0596 (WIPO September 19, 2003) (citing *ADT Services AG v ADT Sucks.com*, D2001-0213 (WIPO April 23, 2001); see also *Société Air France v. Virtual Dates, Inc.*, D2005-0168 (WIPO May 24, 2005) (finding the domain name “airfrancesucks.com” confusingly similar to the mark AIR FRANCE).

(g) Respondent has no rights or legitimate interest in the domain name <**homedepotsucks.com**>. See Policy ¶4(a)(ii).

(1) Respondent is not commonly known by the name Home Depot, nor does Respondent operate a business or other organization under the HOME DEPOT mark or name. See Policy ¶4(c)(ii). Respondent’s tradename is GreenPeople. In the past <**homedepotsucks.com**> was registered to Organic Consumers Education Fund. Organic Consumers Education Fund appears to be a related entity to GreenPeople. The administrative contact for both Organic Consumers Education Fund and Respondent is Steve Urow and the content of the website under both Respondent and Organic Consumers Education Fund was essentially the same for a period of time. These apparently related entities have owned <**homedepotsucks.com**> for many years.

(2) Respondent was put on constructive notice of Complainant’s rights in the Marks through Complainant’s federal registrations, which long precede Respondent’s registration and use of the Domain Name. Respondent is not using the HOME DEPOT mark under license from Complainant and Complainant has not otherwise granted Respondent permission to use the Marks for any purpose. Respondent and its predecessor previously ran an apparent “complaint site” against Complainant at

<homedepotsucks.com>. This “complaint site” also addressed specific environmental issues such as the sale of “old-growth” wood. As further discussed below, that old “complaint site” has been removed and **homedepotsucks.com** is now used for commercial purposes. Respondent’s prior use of **<homedepotsucks.com>** as a vehicle for protest of Complainant is further evidence that Respondent is well aware of Complainant and Complainant’s rights in the Marks.

- (3) Respondent is not making a legitimate non-commercial or fair use of the domain name without intent for commercial gain. Rather, Respondent is using the **<homedepotsucks.com>** domain name for commercial gain by diverting traffic to its commercial website located at the domain name **<greenpeople.org>**. The **<greenpeople.org>** website consists of multiple links to various websites of competitors of Complainant who offer the same type of products to those sold by Complainant (including among others, cleaners, paint, siding, lumber, building supplies, energy supplies, fertilizer, pet supplies, and appliances). Internet users who reach Respondent’s site are able to search any geographic area in the United States (and worldwide) and retrieve lists of businesses selling these competitive products.
- (4) Complainant anticipates that Respondent will try to justify its infringing commercial use of Complainant’s federally registered and famous Marks by arguing that Respondent’s use of the domain name **<homedepotsucks.com>** constitutes fair use as an expression of free speech under the First Amendment of the United States Constitution. That is simply not the case. At the time of the filing of this complaint, the domain name **<homedepotsucks.com>** directs searchers to a commercial website offering links to services of providers of the same type of products as those sold by Complainant. Respondent’s website is supported by advertisers, and the search services provided on the site lead users to lists of hyper-links that direct users to additional commercial entities, including competitors of Complainant. Respondent’s website markets these entities’ products as “environmental” and “healthy.” On information and belief, the entities linked through Respondent’s website are members of Respondent’s organization and pay Respondent to publish a link to their business. Respondent’s **<greenpeople.org>** website contains little to no expressive speech or protest and none whatsoever against Complainant.

Respondent’s use of the domain name **<homedepotsucks.com>** merely to redirect Internet users to its commercial website at **<greenpeople.org>** is not protected speech under the First Amendment. Rather, it is Respondent’s attempt to use Complainant’s Marks to redirect traffic to for-profit competitive products and services in exchange for compensation. Use of the domain name for this purpose is illegitimate. *See Clear Channel Comms. v. RadioAid.com LLC*, FA0405000273224

(NAF July 13, 2004) (ordering transfer of <clearchannelsucks.net>). In *Clear Channel*, the Panel found that the respondent's use of the domain name <clearchannelsucks.net> to redirect users to his primarily commercial website did not constitute a legitimate fair use. The respondent argued that his website constituted a "protest" against the complainant, Clear Channel Communications; however, the Panel found that, although there were a few references on linked websites to protest of Clear Channel, the site was primarily commercial in nature and did not constitute a legitimate fair use of the complainant's trademark. *Clear Channel*, FA273224 at 5.

Similarly, in *Wachovia Corp. v. Alton Flanders*, the Panel ordered transfer of the domain names <wachovia-sucks.com>, <wachoviabanksucks.com>, and <wachoviasucks.com> after finding that the domain names did not point to protest websites and instead directed users to competitive products and services. *Wachovia*, D2003-0596 at 3. The Panel wrote

The domain names at issue here do not point to a protest site . . . [rather they] point to competitive financial products and services. Simply having a domain name with "-sucks" in the name cannot, by itself, establish fair use, one must look to the content of the website to determine if there is an exercise of free speech which allows the Respondent to rely on the fair use exception. To do otherwise would legitimize cybersquatters, who intentionally redirect traffic from a famous mark, simply through the use of a derogatory term.

Id. at 3. Like the subject domain names in *Wachovia* and *Clear Channel*, The domain name <homedepotsucks.com> does not point to a protest website. It points to a commercial website. Such use is not legitimate fair use under the UDRP. *See id.* *See also Société Air France*, D2005-0168.

(h) Respondent registered and is using the domain name <homedepotsucks.com> in bad faith. *See* Policy ¶4(b)(iii). The ICANN policy clearly explains that bad faith can be found where a respondent, by using a domain name, intentionally attempts to attract, for commercial gain, Internet searchers to its website or other on-line location, by creating a likelihood of confusion with the complainant's mark as to source, sponsorship, affiliation, or endorsement of the website or location or of a product or service on the website or location. *See* Policy ¶4(b)(iv).

(1) Respondent is intentionally using the HOME DEPOT mark in its domain name to attract Internet searchers for commercial gain. *See Dell Inc. v. Innervision Web Solutions*, FA0503000445601 (NAF May 23, 2005). In *Dell*, the respondent used the complainant's DELL mark with the generic terms "computers" and "sucks" ("dellcomputerssuck.com") to redirect

Internet users to its own commercial website.¹ This website offered products similar to those manufactured and sold by the complainant (namely, computer products). The NAF panel found that this use was evidence that the respondent was attempting to attract Internet users for commercial gain through use of the complainant's mark. Finding that such a use was a use in bad faith under ¶4(b)(iv) of the Policy, the panel ordered the domain name transferred to the complainant.

Like the respondent in *Dell*, Respondent is realizing commercial gain by redirecting Internet users to its commercial website. Moreover, upon information and belief, Respondent is receiving compensation from the various website owners who are linked through its directory website and from the advertisers who sponsor its website. This activity alone constitutes commercial gain because Respondent is receiving compensation.

- (2) Furthermore, Respondent is using the domain name **<homedepotsucks.com>** to disrupt Complainant's business. Respondent redirects the domain name **<homedepotsucks.com>** to its website at greenpeople.org where it offers links to competitive goods and services. By using the domain name in this manner, Respondent is using the Marks to draw customers away from Complainant and consequently damage its business. This use is a bad faith use of the domain name under the Policy. *See Société Air France*, D2005-0168 at 5-6 (ordering transfer of the domain name **<airfrancesucks.com>** and finding bad faith based in part on respondent's registration and use of the domain name to disrupt the complainant's business).

B. Respondent

- a. ***Respondent's Domain Name Is Not Identical to, Nor Confusingly Similar to, Complainant's Mark.*** ICANN Rule ¶ 3(b)(ix)(1); ICANN Policy ¶ 4(a)(i).

Respondent's domain name, **<homedepotsucks.com>** is neither identical nor confusingly similar to Complainant's trademark or service mark. According to the ICANN Policy, Complainant must demonstrate the following element to be successful in its Complaint: "*Respondent's domain name is identical or confusingly similar to a trademark or service mark in which Complainant has rights.*" ICANN Policy ¶ 3(b)(ix)(1).

¹ In *Dell*, the respondent changed the content of his website after receiving a cease-and-desist letter from the complainant. After receipt of the letter, the respondent redirected the domain name to a "protest" site with no commercial content. The respondent then attempted to argue that his use of the domain name was a legitimate fair use under the First Amendment. The Panel called the respondent's argument of fair use as a protest site "untenable" and found that respondent's use of the domain name was not "without intent for commercial gain."

Complainant alleges it owns the marks HOME DEPOT and THE HOME DEPOT. See Complaint ¶11. The domain at issue is <homedepotsucks.com>, and by the addition of the distinctive word “sucks”, the domain is not identical to HOME DEPOT or THE HOME DEPOT.

Complainant argues that <homedepotsucks.com> is confusingly similar to its marks. Both Complainant and Registrant are residents of the United States and, as such, we look to the test under U.S. law to determine whether the domain is confusingly similar to the Complainant's marks. The test is whether consumers are *likely to be confused* and has been applied in numerous trademark cases, including *Bally Total Fitness v. Faber*, 29 F. Supp.2d 1161 (C.D.Cal. 1998). The defendant in *Bally Total Fitness* registered the domain BallySucks.com and, as in the present case, used the domain to express complaints about Bally's health club business. Plaintiff owned a service mark, BALLY. The court dismissed the case, stating that, as a matter of law, Bally could not prove a likelihood of confusion between <ballysucks.com> and the Bally's marks and because “No reasonable consumer comparing Bally's official web site with Faber's site would assume Faber's site ‘to come from the same source, or thought to be affiliated with, connected with, or sponsored by, the trademark owner’.”

This line of cases has also been followed by numerous UDRP decisions. In *Lockheed Martin Corp. v. Parisi*, (World Intellectual Property Organization (“WIPO”), D2000-1015, Jan. 26, 2001) the administrative panel found that “[b]oth common sense and a reading of the plain language of the Policy support the view that a domain name combining a trademark with the word “sucks” . . . cannot be considered confusingly similar to the [complainant's] trademark.” Similar conclusions are seen in analogous cases. See *Wal-Mart Stores, Inc. v. walmartcanadasucks.com*, D2000-1104 (WIPO Nov. 23, 2000); see also *E&J. Gallo Winery v. Hanna Law Firm*, D2000-0615 (WIPO Aug. 3, 2000) (suggesting in dicta that the addition of sucks or other identifier to a famous mark would be sufficient to defeat a claim that the domain names confusingly similar); see also *KB Home v. RegisterFly.com*, FA 506771 (Nat. Arb. Forum Aug. 30, 2005) (where the Panel also finds that the <kbhomesucks.com> domain name is not confusingly similar to Complainant's KB HOME mark because “no reasonable person would conclude that a real estate developer would have any relationship with a domain name that adds the word “sucks” to its mark.”)

Here, as in *Bally* and *Lockheed Martin Corp.*, the Respondent created a protest site by adding the classic protest word, “sucks,” to the end of the protested company's name to communicate the message about Complainant's eco-unfriendly business practices and sales of old growth lumber. As noted in *Bally*, the word “Sucks has entered the vernacular as a word loaded with criticism” and the “reasonably prudent user would not mistake [Respondent's] site for [Complainant's] official site. Respondent's use of “THE HOME DEPOT SUCKS!” and “HOME DEPOT SUCKS FOR SOURCING AND SELLING OLD GROWTH LUMBER” on its site makes it crystal clear to visitors that they have not reached the official HOME DEPOT site:



For the foregoing reasons, Respondent's domain name, <**homedepotsucks.com**> is not identical to Complainant's marks and is not likely to be confused with Complainant's marks. Common sense and a plain language reading of the domain name, and Respondent's use of HOME DEPOT SUCKS! on the website, effectively distinguish the Complainant's mark from the Respondent's <**homedepotsucks.com**> domain and not even an inexperienced internet user would consider the two to be confusingly similar. Thus, Complainant has failed to meet the first element required under the ICANN Policy and the Complaint should be dismissed.

b. ***Respondent Has Rights and Legitimate Interests in the Domain.***
ICANN Rule 3(b)(ix)(2); ICANN Policy ¶4(a)(ii).

Even if the Complainant could demonstrate that <**homedepotsucks.com**> is confusingly similar to its marks, Complainant must also demonstrate the Respondent has no rights or legitimate interests in the domain. The following facts will show that Respondent can, in fact, demonstrate a legitimate interest in the <**homedepotsucks.com**> domain name. ICANN Policy 4(c)(iii) which provides the following as a complete defense for Registrant's continued use of the domain as a protest site: "(iii) [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 the trademark or service mark at issue."

Respondent registered the <**homedepotsucks.com**> domain on August 28, 1998, and has maintained a legitimate protest site directed towards the Complainant for seven years.

Respondent is an environmental activist who is dedicated to providing information to the public with the hope that the more the public is informed the more they can responsibly purchase eco-friendly products. Respondent maintains several eco-orientated websites; <greenpeople.org>, <veggiedate.org>, <ecoroomates.com>, and <organicconsumers.org>. These websites are dedicated to providing information and services geared toward eco-friendly consumers.

Respondent operates <**homedepotsucks.com**> with a legitimate "First Amendment" purpose of expressing his views about Complainant. Respondent's <**homedepotsucks.com**> provides information which consumers find valuable in making eco-friendly choices. The right to inform the public is at the very heart of the First Amendment of the U.S. Constitution, which is the law in the country where both parties reside. A consumer wishing to make an informed choice about the products they are purchasing from Home Depot would find <**homedepotsucks.com**> very helpful.

Home Depot cannot use the UDRP as a vehicle to insulate itself from critical views and negative commentary no matter how distasteful the Complainant finds these views. *See Legal & Gen. Group Plc v. Image Plus*, D2002-1019 (WIPO Dec. 30, 2002) (finding legitimate interests in the Respondent's favor because “[T]he goals of the Policy are limited and do not extend to insulating trademark holders from contrary and critical views when such views are legitimately expressed without an intention for commercial gain.”); *see also Britannia Bldg. Soc'y v. Britannia Fraud Prevention*, D2001-0505 (WIPO July 6, 2001) (“Use of the Policy to provide such insulation would radically undermine freedom of discourse on the internet and would undercut the free and orderly exchange of ideas that the Policy seeks to promote.”).

It must be noted that <**homedepotsucks.com**> is an information site and Respondent does not gain any commercial advantage from its use. Complainant has attempted to mischaracterize Respondent's use of the domain as “for commercial gain” because, for several months this year, Respondent removed the protest site located at <**homedepotsucks.com**> and pointed the domain to <greenpeople.org>. Respondent removed the protest site *at a request that was initiated by Home Depot*. *See* Complaint ¶11(g)(4). This redirect was performed in response to a request from The Rainforest Action Network (RAN). RAN contacted the Respondent and informed him that they were in negotiations with Home Depot and that the removal of the protest site would aid their negotiations. Respondent, acting in his belief that Home Depot was acting in good faith and was, at last, making legitimate concessions towards an eco-friendly policy. So believing, Respondent removed the protest site. Respondent substituted the <greenpeople.org> DNS and IP address information in the Whois record, which had the effect of forwarding visitors to the <**homedepotsucks.com**> domain to Respondent's <greenpeople.org> website. Respondent believed that consumers wishing to obtain information on Home Depot's ecological buying practices would benefit from information on eco-friendly products as well.

Contrary to Complainant's unfounded allegations, GreenPeople.org is *not* a commercial website but instead provides information to consumers regarding eco-friendly home products. The <greenpeople.org> domain name is a directory, which provides listings for free. The only commercial benefits that Respondent receives from the <greenpeople.org> website are nominal fees for specialized listings that he uses to cover operational costs. In fact, from 1998 to 2000 <greenpeople.org> had nonprofit status from fiscal sponsor Social and Environmental Entrepreneurs (“SEE”) <saveourplanet.org>. Respondent did not renew beyond the year 2000 because GreenPeople is not a “membership” organization and does not receive donations. Respondent also felt it was unnecessary to pay yearly fees to SEE for retaining nonprofit status.

Complainant relies upon *Dell Inc. v Innervision Web Solutions FA0503000445601 (NAF May 23, 2005)* to support its claim that the relatively brief redirect to GreenPeople.org is a “commercial use” of the domain. The Respondent in *Dell Inc. v Innervision Web Solutions* sold computer systems directly from a website that competed directly against Dell. “Whether Respondent is a competitor of Dell's is to be determined . . . by the types of goods and services he offers for sale. Respondent does not deny that he offers computer systems for sale or that his computer systems compete with Dell's.” *Id.* Respondent in this case does not sell hardware products, nor do the products advertised through free listings on <greenpeople.org> compete directly with Home Depot. A consumer interested in eco-friendly products is not going to find those products at Home Depot. This is in sharp contrast to *Dell*, where a consumer interested in

a Dell computer system was offered an equal and competitive product. In addition, the Respondent in *Dell* sold products directly through its website and the Respondent benefited from those sales. In the present case, Respondent does not sell any products at <homedepotsucks.com>, does not derive revenues from advertising at, or traffic to, the domain, and except for the nominal fees received during the time of the redirect, receives no commercial benefit from the <homedepotsucks.com> site. Surely a website owner who operates his site in a non-profit manner cannot be said to be gaining commercial advantage. *See Lockheed Martin Corp. v. Etheridge*, D2000-0906 (WIPO Sept. 24, 2000) (finding that the Respondent has rights in the <missionsuccess.net> domain name where she was using the domain name in connection with a noncommercial purpose; see also *Baja Marine Corp. v. Wheeler Tech.*, FA 96954 (Nat. Arb. Forum May 17, 2001) (finding that Respondent has rights and legitimate interests in the domain name where Respondent made a non-commercial use of BAJABOATS.COM and received no funds from users of the site connected to the domain name).

It is worth noting that these products are truly eco-friendly and further the Respondent's mission of providing consumers with information and products that support the goal of an eco-friendly planet. The Complainant's reliance on the wholly unsubstantiated and unsupported allegations of the "commercial" nature of <greenpeople.org> is untenable and smacks of an attempt at reverse domain name hijacking. GreenPeople.org provides consumers with information about products that are not offered by Home Depot. GreenPeople.org does receive some revenue from these listings, but <greenpeople.org> cannot be characterized as a commercial site. In addition, Respondent operated the original protest site from 1998 through April of 2005. Only upon being informed that Home Depot was agreeing to institute eco-friendly policies did the Respondent redirect the URL to his <greenpeople.org> and the length of that redirect was four months – during which time Complainant apparently felt it now had the "evidence" of "commercial use" necessary to paint Respondent as a cybersquatter.

Upon learning of the present action filed against him, Respondent reinstated the protest site. Respondent believes that Home Depot is not operating in good faith with respect to its negotiations with RAN, and thus the public deserves to be informed of Complainant's policies. Respondent has operated <homedepotsucks.com> with a legitimate first amendment purpose since 1998. Respondent only removed the protest site when he believed that his eco-friendly mission required it. Respondent has had, and continues to have, a legitimate right and interest in the domain under the First Amendment. Moreover, this is the most logical domain at which he can express his views and inform the public about the damage that he believes Complainant is waging upon the environment. The public has come to expect critical sites at "sucks" domains and considering his primary use of the domain over the years, Respondent has a legitimate interest in retaining it, so long as he continues to use it to protest and comment on the Complainant.

c. ***Respondent Did Not Register or Used the Domain in Bad Faith.*** ICANN Rule 3(b)(ix)(3); ICANN Policy ¶4(a)(iii).

Under ICANN Policy ¶4(a)(iii) Respondent must have *registered* and *used* <homedepotsucks.com> in "bad faith." Complainant must show *both* bad faith in registration and bad faith in use of the domain at issue. Complainant has failed to show either element, let

alone both elements. Complainant must prove both prongs, but has only alleged that Respondent acted in bad faith in the use of the <**homedepotsucks.com**> domain name. Complainant has not proffered any evidence at all that Respondent *registered* <**homedepotsucks.com**> in bad faith. *See Graman USA Inc. v. Shenzhen Graman Indus. Co.*, FA 133676 (Nat. Arb. Forum Jan. 16, 2003) (finding that general allegations of bad faith without supporting facts or specific examples do not supply a sufficient basis upon which the panel may conclude that the Respondent acted in bad faith); *see also White Pine Software, Inc. v. Desktop Consulting, Inc.*, D2000-0539 (WIPO Aug. 31, 2000) (declining to transfer the domain name where a full factual record has not been presented to the panel such that a conclusive determination can be made regarding the parties' respective claims to the contested domain name).

Respondent registered <**homedepotsucks.com**>, in good faith, with the intent of launching a protest site, on August 28, 1998. Respondent created and posted the legitimate protest site at least as early as January 1999. Complainant has not made a single allegation that Respondent registered the domain and operated the protest site located at <**homedepotsucks.com**> in bad faith. Complainant has only alleged that the redirection of the URL to <greenpeople.org> was evidence of bad faith. *See* Complaint ¶11(h). This redirection was made in April of 2005, a full 7 years after the registration and launch of the legitimate protest site. Respondent did not register <**homedepotsucks.com**> in 1998 with the intention of running a commercially damaging site directed at Home Depot a full 7 years later. And when the Respondent redirected the URL, he redirected it to <greenpeople.org>, a site which provides little revenue to the Respondent.

The Respondent's good faith intentions are further evidenced by this redirection. The Respondent registered <**homedepotsucks.com**> with the intention of providing information on eco-friendly products and information about the very eco-unfriendly products that Home Depot sells. Respondent operated the protest site until 2005 when at that time he was contacted by RAN. RAN informed the Respondent that they were in final negotiations with Home Depot with regards to Home Depot's decision to phase out the sale of wood culled from old growth endangered forests. RAN convinced the Respondent that the removal of the protest site was key to the negotiations.

Respondent only removed the protest site because he believed that Home Depot was serious about their intentions. Respondent registered <**homedepotsucks.com**> with the intention of convincing Home Depot to institute eco-friendly policies. The end of old growth forest destruction was central to this purpose. Respondent, again acting in good faith, redirected the URL to his own <greenpeople.org> with the intention of informing the public of eco-friendly products. Respondent did not intend to compete with Home Depot or to harm Complainant's business. If Respondent, in bad faith, intended to harm Home Depot he would not have removed the protest site. The protest site is certainly damaging to Home Depot as it informs the public of the destructive and harmful policies that Home Depot engages in. The Respondent has always hoped that public pressure would force Home Depot to abandon their eco-unfriendly policies and that does not amount to bad faith as intended under the UDRP.

Respondent has never wished to compete with or to economically harm Home Depot, as he has only intended to inform the public. Because of this Respondent has reinstated the protest

site located at **<homedepotsucks.com>**. Respondent believes that Home Depot has not fulfilled its promises made to RAN when he took the protest site down. Respondent believes the original purpose of the protest site is unfilled and wishes to maintain the pressure on Home Depot to abandon its policies.

Respondent believes this Response demonstrates that he has acted in good faith at all times. Respondent registered the domain name in good faith. Respondent operated a legitimate protest site for 7 years. Respondent only removed the protest site for four months when he believed it would help accomplish his original objectives. Respondent has reactivated the protest in good faith with the intention of furthering his environmental goals.

Respondent would also like to point out that **<homedepotsucks.com>** was never registered with the intent to selling, renting or transferring the domain name to the Complainant. Complainant has not made any allegations that Respondent intended to sell, rent or transfer the domain name at any time. The allegations of bad faith use simply do not bear up under scrutiny.

In sum, Complainant has failed to prove either prong of ICANN Policy ¶4(a)(iii) requiring a showing of bad faith use and registration. Further, Complainant has not shown that there is a likelihood of confusion between THE HOME DEPOT or HOME DEPOT and **<homedepotsucks.com>** and Respondent has demonstrated that it has a legitimate right and interest in the domain. Accordingly, the Complaint should be denied, and Respondent should be permitted to retain its domain and protest website at **<homedepotsucks.com>**.

C. Additional Submissions

Complainant's Burden of Proof of Demonstrate Confusing Similarity Is Low

Respondent argues that the addition of “sucks” to HOME DEPOT creates a domain name that no reasonable person could confuse with Complainant. The threshold of proof of confusing similarity under the Policy is low. *Yahoo! Inc. v. Fato*, FA286410 (NAF July 26, 2004). Complainant is required to show “confusing similarity”² between the domain name and Complainant's THE HOME DEPOT and HOME DEPOT trademarks (collectively “the HOME DEPOT Marks”); however, under the Policy, Complainant is not required to show “likelihood of confusion” as defined by United States case law. *Nikon v. Technilab, Inc.*, D2000-1774 (WIPO February 26, 2001); *see also Nicole Kidman v. Zuccarini*, D2000-1415 (WIPO January 23, 2001) (holding that confusingly similarity under the Policy is based upon the inclusion of a trademark in the domain name, and not upon the likelihood of confusion test). “Numerous” ICANN panels have specifically held that “when a domain name wholly incorporates a complainant's registered mark, that is sufficient to establish identity or confusing similarity for purposes of the Policy.” *Magnum Piering v. The Mudjackers*, D2000-1525 (WIPO January 29, 2001); *see also Diners Club Int'l Ltd. v. SPS*, FA149414 (NAF April 21, 2003); *Nikon*, D2000-1774. The domain name **<homedepotsucks.com>** wholly incorporates Complainant's registered famous trademark

² The pertinent portion of the Policy reads as follows “[the] domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights.” Policy ¶ 4(a)(i).

HOME DEPOT. Accordingly, the domain name is confusingly similar to the HOME DEPOT Marks.

The addition of “sucks” to Complainant’s HOME DEPOT mark does not prevent a finding of “confusing similarity”

Respondent erroneously alleges in its Response that the addition of the term “sucks” to the HOME DEPOT mark prevents any likelihood of confusion between the domain name <homedepotsucks.com> and the HOME DEPOT marks and that, therefore, the two are not confusingly similar under the Policy. *See Response* at 2-3. As Complainant demonstrated in its Complaint, ICANN panels have long held that the addition of “sucks” to a well-known trademark does not prevent a finding of confusing similarity. *See Complaint* at 4; *see also The Royal Bank of Scotland Group v. Lopez*, D2003-0166 (WIPO May 9, 2003) (finding that “a majority of cases” presented with a similar question found that the addition of “sucks” does not alleviate confusing similarity).³

Contrary to Respondent’s assertions, numerous ICANN panels have held that the addition of “sucks” to a well-known trademark does not create a distinction sufficient to overcome “confusing similarity” under the Policy. *See e.g., The Stop & Shop Supermarket Co. v. Anderson*, FA133637 (NAF January 8, 2003). In *Stop & Shop*, the panel reasoned “the Internet is a forum that reaches a worldwide audience, many of which do not speak the English language; for those Internet users, the word ‘sucks’ would not sufficiently eliminate any confusion between Complainant’s mark and the disputed domain name.” *Stop & Shop*, FA133637.⁴

Complainant is an international company with a strong worldwide reputation. It is highly possible, even probable, that Internet users in non-English speaking areas of the world will use the Internet to find Complainant, will not understand the pejorative nature of the word “sucks,” and will be confused. Regardless of language, when Internet users perform searches for Complainant on Internet search engines, the addition of “sucks” to HOME DEPOT will not prevent <homedepotsucks.com> from appearing in the search results. This possibility adds to the risk of confusion. *See Royal Bank of Scotland*, D2003-0166 (finding “search engines would probably retrieve a domain name consisting of the search term with the addition of any suffix, including ‘sucks’ and therefore be likely to confuse the average Internet user who might not necessarily be able to immediately exclude any relationship with Complainants.”). Internet users may not read the domain name before clicking on the link and being directed to Respondent’s

³ In addition to the UDRP decisions Complainant cited in its Complaint, the following UDRP decisions have also held that the addition of “sucks” to a famous or well known trademark does not prevent a finding of confusing similarity: *Freeserve PLC v. Purge I.T Ltd*, D2000-0585 (WIPO August 13, 2003); *Dixons Group PLC v. Purge I.T. Ltd.*, D2000-0584 (August 13, 2003); *Bayer Aktiengesellschaft v. Dangos*, D2002-1115 (WIPO February 3, 2003); *Quilogy, Inc. v. Ruddick*, FA134653 (NAF January 9, 2003); *Stop & Shop*, FA133637; *Vivendi Universal v. Sallen*, D2001-1121 (WIPO November 7, 2001); *Diageo PLC v. Zuccarini*, D2000-0996 (WIPO October 22, 2000); *Wal-Mart Stores, Inc. v. MacLeod*, D2000-0662 (WIPO September 19, 2000); *Cabela’s Inc. v. Cupcake Patrol*, FA095080 (NAF August 29, 2000).

⁴ *See also The Royal Bank*, D2003-0166; *Bayer*, D2002-1115; *Quilogy*, FA134653; *Vivendi*, D2001-1121; *Societe Accor v. Hartmann*, D2001-0007 (WIPO March 15, 2001).

website. However, once the user makes that click, the damage is done and actual confusion has occurred.

Respondent's use of "HOME DEPOT SUCKS" in the body of its webpage is irrelevant

Respondent spends a significant portion of its Response arguing that because the domain name <homedepotsucks.com> leads to a "protest" website against Complainant and utilizes the text HOME DEPOT SUCKS on the website, this prevents any likelihood of confusion between the domain name and Complainant. *Response* at 3. As noted above, likelihood of confusion is not the threshold of proof for finding confusingly similarity under the Policy. Rather, under the Policy, ICANN panels look to compare the text of the actual domain name and the Complainant's marks. As the panel noted in *Magnum Piering*, "Under the Policy, the question of identity and confusing similarity is evaluated based solely on a comparison between a complainant's word mark and the alphanumeric string constituting the domain name at issue." *Magnum Piering*, D2000-1525. A panel does not consider the content of Respondent's website in this analysis and the website content is, therefore, irrelevant. Even if the content of the website were relevant to this analysis, the fact remains that at the time Complainant filed its Complaint, the domain name <homedepotsucks.com> did not lead to the website Respondent refers to in its Response. It pointed instead to the website found at <greenpeople.org> and did not display the text HOME DEPOT SUCKS.

Respondent Does Not Have Rights or Legitimate Interest in the Domain Name

Respondent has not demonstrated a legitimate interest or right in the domain name <homedepotsucks.com>. Respondent argues that it is making a "fair use" of the domain name through its "protest" of Complainant. However, to have a "legitimate" fair use under the Policy, Respondent cannot have either an intent for commercial gain, or to tarnish the HOME DEPOT Marks.⁵ Respondent cannot meet either of these requirements for legitimate fair use.

A. Respondent's use of the domain name constitutes commercial activity
Respondent's use of the domain name at the time this Complaint was filed was commercial

Respondent's alleged "fair use" of the domain name <homedepotsucks.com> as a "protest" site became moot once it redirected the website to the commercial activity site at greenpeople.org. Respondent does not deny that it directed the <homedepotsucks.com> domain name to the GreenPeople website. In fact, it admits that it directed the domain name there for over four months. *Response* at 4 and 7. Respondent alleges that it directed the domain name <homedepotsucks.com> to the greenpeople.org website in response to communications it had with Rainforest Action Network ("RAN") and that it rerouted it to assist RAN in some negotiations with Complainant. *Response* at 5. Complainant did not have an agreement with RAN or with Respondent regarding the domain name <homedepotsucks.com>. Regardless of Respondent's motives for rerouting the domain name, the fact remains that it chose to reroute the domain name to a site containing definite commercial activity. If its purpose in rerouting the domain name was to allegedly facilitate negotiations with RAN and Complainant, it could have

⁵ The pertinent portion of the Policy reads: "[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 the trademark or service mark at issue." Policy ¶ 4(c)(iii).

chosen a variety of options other than redirecting the domain name to its related commercial web site. For example, it could have let the domain name sit idle. Further, Respondent only ceased redirecting the <**homedepotsucks.com**> domain name to the <greenpeople.org> site after the Complaint was filed. There is no indication that Respondent would not have continued to use the <**homedepotsucks.com**> domain name in a commercial manner were it not for the fact that Complainant filed this action.

Respondent's argument that the <greenpeople.org> website does not engage in commercial activity is false. The site is a listing of commercially available "eco-friendly" products, and by Respondent's own admission, Respondent receives compensation from the businesses listed on the site. Respondent's claim that it received only "nominal" compensation through the listings is no defense. *Response* at 5 and 6. Even "nominal" compensation creates commercial activity.

Further, even if Respondent did not itself achieve commercial gain from its websites, ICANN panels have held that their only needs to be commercial gain sought by **some** party for the use to be commercial. *See Focus Do It All Group v. Athanasios Sermbizis*, D2000-0923 (WIPO October 6, 2000) (finding that Respondent's domain name which linked visitors to a directory of regional competitors was not a legitimate use). Accordingly, even if Respondent received zero compensation from the <greenpeople.org> website, Respondent's use of the domain name to direct users to greenpeople.org constitutes commercial activity because the various companies linked to the greenpeople.org directory site benefit from the subsequent interest and purchases of those searchers who locate the entities' products through greenpeople.org. *See id.* (finding that "[I]t is enough that commercial gain is being sought for someone" for a use to be commercial).

In *Athanasios*, the respondent registered the domain name focus-do-it-all.com which the ICANN Panel found to be identical to the complainant's mark FOCUS DO IT ALL. *Id.* The respondent's website offered travel information to tourists through an on-line trade directory and provided a link to a website to help people find homes in London. *Id.* The respondent listed the phrase "contact George for prices" on the bottom of the website to offer the services of one George Ismiris (who was not the respondent). *Id.* The panel found that such listing of services constituted commercial gain, reasoning that although the respondent may not have personally gained in a commercial sense, it was enough that commercial gain was sought for someone else (i.e., George Ismiris). *Id.*

Similar to the facts in *Athanasios*, Respondent's use of the <**homedepotsucks.com**> domain name to direct to the <greenpeople.org> website results in a commercial gain for others by placing links to competitors of Complainant and other individuals, groups or entities on its website. Respondent alleges that the products sold through the links at <greenpeople.org> are not competitive products to those sold by Complainant because they are "eco friendly" or "green." *Response* at 5. Complainant contests Respondent's allegation that it does not sell "eco friendly" products. Nevertheless, the point is irrelevant; the website at <greenpeople.org> directs consumers to products that are alternatives to the standard household products sold by Complainant. The fact remains that consumers purchasing items through <greenpeople.org> (directed there by the confusingly similar domain name <**homedepotsucks.com**>) could have

purchased an alternative product at one of Complainant's stores. Providing an alternative product is the whole point of greenpeople.org. *See Complaint* at 6 for examples of GreenPeople's competitive products.

Regardless of whether the products linked through greenpeople.org are competitive to those sold at Complainant's stores, the standard does not require the Respondent's activity to be competitive, but merely commercial. The activity on the <greenpeople.org> site is clearly commercial. Respondent and the linked third parties could be selling products completely unrelated to Complainant and that would not change the fact that the sale of products or services results in commercial activity. Just as commercial gain was sought for George Ismiris in *Athanasios*, commercial gain was sought by Respondent for the various website owners who were linked to the greenpeople.org web page. Therefore, Respondent's use of the domain name <homedepotsucks.com> to redirect to <greenpeople.org> constitutes intent for commercial gain and cannot constitute a legitimate fair use under the Policy.

Respondent's use of the domain name for its alleged "protest" website also contains commercial activity

Respondent alleges that its current website at <homedepotsucks.com> is only an informational website and is not for commercial gain when, in reality, portions of Respondent's <homedepotsucks.com> website contain commercial activity. Attached to this Reply is a print out of a page of the <homedepotsucks.com> website that provides links to other environmental organizations. Included on that page is a link GreenPeople's website (discussed above) and a link to "GreenISP," a sponsoring organization run by GreenPeople that reportedly offers an ISP product for \$9.95 per month. The page also contains a link to <ecoroomates.com> an organization run by GreenPeople. The ecoroomates.com website includes advertisements and links to the companies supplying the advertisements. Furthermore, many of the environmental organizations linked to this portion of <homedepotsucks.com> solicit contributions or sell products through their websites. By linking to these websites, Respondent is assisting those organizations in their commercial gain (even if the organizations are not-for-profit organizations, the exchange of money constitutes commercial activity). Under the reasoning in *Athanasios*, Respondent's <homedepotsucks.com> "protest" website therefore has an element of commercial gain and commercial activity and Respondent's use of the domain name cannot constitute a legitimate fair use.

Respondent's use of the domain name as a "protest" site in this case is not without intent to tarnish the HOME DEPOT Marks

Under the Policy, to have a legitimate non-commercial fair use, Respondent must also operate its website without intention to tarnish the HOME DEPOT marks. Complainant finds it hard to believe that Respondent does not have an intention to tarnish Complainant's HOME DEPOT marks or name. On its "protest" website, Respondent shows a skeleton wearing a trademark Home Depot orange apron prominently showing Complainant's registered THE HOME DEPOT design mark. Respondent also prominently displays on the site the federally registered THE HOME DEPOT design mark with a "NO" slash design through it containing the word "sucks" stamped on the cross bar. Complainant fails to see how these uses do not constitute an intentional attempt by Respondent to tarnish Complainant's HOME DEPOT marks. Respondent's website also encourages viewers to protest Complainant by bolting their necks to

the shelving at a The Home Depot store. Finally, the title of Respondent's website uses the domain name in text by stating "Home Depot sucks for sourcing and selling old growth lumber." Such a statement certainly disparages and tarnishes the HOME DEPOT marks.

Respondent's use of the HOME DEPOT marks to further its alleged "free speech" cause has tarnished the HOME DEPOT marks. *See Royal Bank*, D2003-0166 ("Respondents have used domain names that are identical and substantially similar to Complainants' trademarks to exercise their freedom of expression and this has the direct consequence of tarnishing Complainants' trademarks. Respondents can very well achieve their objective of criticism by adopting a domain name that is not identical or substantially similar to Complainants' marks.") (quoting and agreeing with *The Royal Bank of Scotland v. Lopez*, D2002-0823 (WIPO December 3, 2002)). Respondent did not have to use <homedepotsucks.com> to achieve its "free speech" purpose. As the panel in *Royal Bank* held, "in order to fully exercise free speech rights, it is not indispensable to use someone else's identical or confusingly similar trademark." *Id.* Respondent used the HOME DEPOT marks on purpose and its use of the Marks in this way "has the direct consequence of tarnishing them." *Id.* In fact, Respondent admitted that its use of the domain name damages Complainant. *See Response* at 7 (stating "The protest site is certainly damaging to Home Depot . . .").

Respondent Registered and is Using the Domain Name in Bad Faith

B. Respondent's constructive and actual knowledge of the HOME DEPOT Marks is sufficient to establish bad faith registration of homedepotsucks.com

Respondent is charged with constructive knowledge of Complainant's rights in the HOME DEPOT Marks through Complainant's registration of those marks with the United States Patent and Trademark Office. *Kohler Co. v. Jackson*, FA545184 (NAF September 30, 2005). The HOME DEPOT Marks have been used since at least as early as 1979 and registered with the United States Patent and Trademark Office since at least as early as 1981. The domain name was registered in 1998, well after Complainant's use and registration of the HOME DEPOT Marks. Further, Respondent's use of the domain name demonstrates that Respondent had actual knowledge of Complainant's rights in the marks. Yet, despite Respondent's knowledge of Complainant's rights in the HOME DEPOT Marks, Respondent registered the <homedepotsucks.com> domain name. Under the Policy, the fact that Respondent had knowledge of Complainant's rights in the HOME DEPOT marks and registered a domain name containing the HOME DEPOT mark is sufficient to show bad faith registration. *See Diners Club*, FA149414 ("Respondent's registration of <aboutdinersclub.com> and <dinersclubsucks.com>, despite knowledge of Complainant's rights, constitutes bad faith registration under Policy ¶4(a)(iii).")⁶

C. Respondent is using the domain name in bad faith by operating a website for commercial gain

Complainant discussed Respondent's commercial activity in detail in its Complaint and demonstrated Respondent's intention to disrupt Complainant's business. Complainant expanded on that activity above and will not repeat the information here. However, Complainant

⁶ *See also Dell Inc. v. Innervision Web Solutions*, FA445601 (NAF May 23, 2005); *Fato*, FA286410; *Royal Bank*, D2003-0166; *Quilogy*, FA134653.

emphasizes to the panel Respondent's own admissions involving this point. On page 5 of its Response, Respondent admits that it directed the <homedepotsucks.com> website to its greenpeople.org website (a website with commercial activity under the Policy) because it "believe[s] that consumers wishing to obtain information on Home Depot's ecological buying practices would benefit from information on eco-friendly products as well." Complainant continues to contend that the products sold through greenpeople.org are competitive to the products Complainant sells in its stores. Respondent wants consumers to buy "eco-friendly" products they cannot find at Complainant's stores and is encouraging consumers who visit the confusingly similar <homedepotsucks.com> domain name to reach greenpeople.org to buy products from the greenpeople.org businesses and not from Complainant. Thus, Respondent is intentionally disrupting Complainant's business by misdirecting consumers to greenpeople.org and diverting business from Complainant to Respondent's favored organizations.

I. The <homedepotsucks.com> Domain Name Is Not Confusingly Similar to Complainants Trademarks.

A. Complainant Fails to Show There is a Low Threshold for Confusing Similarity.

Complainant posits there is a "low threshold" for meeting the first element of the Uniform Dispute Resolution Policy 4(a)(i) which states: "your domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights."

Complainant relies on *Yahoo! Inc. v. Fato*, FA 286410 (NAF July 26, 2004) to establish a new standard for trademark holders to show the requisite confusing similarity under the Policy. Complainant neglects to mention a few key facts from *Yahoo!*: the Respondent failed to respond to the complaint, and the domain at issue was used to derive revenue from pornography sites.

The lack of a response in the *Yahoo!* case forced the panel to rely solely on the Complainants' allegations. The panel noted, "In view of Respondent's failure to submit a Response, the Panel shall decide this administrative proceeding on the basis of Complainant's undisputed representations". See *Yahoo! Inc. v. Fato*. The panel did cite the proposition that "both common sense and a reading of the plain language of the Policy support the view that a domain name combining a trademark with the words 'sucks' . . . cannot be considered confusingly similar." See *Yahoo! Inc. v. Fato*, citing *Lockheed Martin Corp. v. Parisi*, D2000-1015. "[i]n claims where Respondent had not responded, Panels have accepted Complainants' assertions of confusing similarity under the Policy. See *Yahoo! Inc. v. Fato*.

The Complainant also overlooked the key fact that the Respondent in the *Yahoo!* case was selling pornography at the domain at issue. "Respondent is using the disputed domain to peddle pornography. Appropriating someone else's mark within a domain name to promote pornography is bad faith use and registration pursuant to Policy ¶4(a)(iii)." These key facts distinguish the use of <fuckyahoo.com> and <homedepotsucks.com>: Respondent's use of <homedepotsucks.com> and, indeed, the domain itself, simply does not rise to the unsavory levels of indecent speech of the unresponsive defendant in the *Yahoo!* case.

Complainant relies on *Magnum Piering v. The Mudjackers*, D2000-1525 (WIPO January 29, 2001) to support its claim that "when a domain name wholly incorporates a complainant's

registered mark, that is sufficient to establish identity or confusing similarity' ...” *Magnum Piering* addressed several websites wholly and systematically incorporating Magnum Piering, Inc.’s mark: *magnumpiering.com* and *.net*, *magnumpieringinc.com* and *.net*, *magnumpier.net*, *magnumpiers.com* and *.net*, *magnum-piering.com* and *.net*. None of sites contained “sucks”, or any distinctive words in addition to the trademark at issue. *Magnum Piering* does not stand for the proposition that the mere inclusion of a Complainants’ mark demonstrates confusing similarity. If the Panel adopts Complainant’s broad-sweeping proposition, it would be impermissible to incorporate a trademark holder’s name in *any* domain, irrespective of intent or use. Such a blanket prohibition would prevent registration of domains incorporating trademarks for purposes of criticism of the trademark holder, or to provide noncommercial information about the trademark holder, (e.g. fan sites), consumer product information, and the domain could not be used to provide information that is wholly unrelated to the trademark owner. Under Complainant’s theory, registration and use of <apple.com> for information about produce would be considered confusingly similar to the trademark of Apple the computer company. This is not a common sense reading of the language of the Policy, is not in agreement with accepted principles of U.S. trademark law, is not in the public interest, nor is it in line with the original intentions of the Policy— which is intended to provide quick resolutions to clear cases of cybersquatting, not to resolve complex allegations of trademark dilution and political speech.

In sum, Complainant has not demonstrated that the mere inclusion of a trademark in a domain is sufficient to show confusing similarity. In fact, the cited *Yahoo!* case contains language in support of Respondent’s position that no reasonable person could be confused between the critical <homedepotsucks.com> and THE HOME DEPOT, and the *Magnum Piering* case addressed domains that were identical to the trademarks at issue, but for a few letters.

B. Complainant Fails to Show the Domains Are Confusingly Similar.

Complainant relies on *The Royal Bank of Scotland Group v Lopez*, D2003-0166 (WIPO May 9, 2003) to persuade the Panel that the formula of *Trademark* + “sucks” + .com creates a domain that is confusingly similar to the trademark at issue.

Numerous other cases have held the opposite of *The Royal Bank of Scotland Group*. In *Lockheed Martin Corp. v Parisi*, D2000-1015 (WIPO Jan. 26, 2001), the Panel held that <lockheedsucks.com> and <lockheedmartinsucks.com> were *not* confusingly similar to the Complainants’ marks. *Id.* The Panel relied on the reasoning of the United States federal courts in *Bally Total Fitness v Faber*, 29 F. Supp.2d 1161 (C.D. Cal. 1998) and *Lucent Technologies, Inc. v. LucentSucks.com*, 95 F. Supp.2d 528 (E.D. Va. 2000). The panel agreed with the U.S. federal courts that the test for confusion must rely on common sense reasoning and that any Internet user “will be able readily to distinguish the Respondent’s site for criticism from Complainant’s sites”. *Lockheed Martin Corp. v Parisi*. A common sense view of Complainants’ assertion, that non-English speakers and search engine users will be confused as to the source, sponsorship, and endorsement of <homedepotsucks.com>, is tenuous at best. Complainant has submitted no evidence that the majority of visitors to <homedepotsucks.com> are non-English speakers, nor has Complainant submitted any evidence that <homedepotsucks.com> will be retrieved in a search engine query. In fact, Respondent has queried the popular search engine “Google” for the words Home Depot and has not found its site listed in the first 15 pages (150 listings) of search

results, from a query for HOME DEPOT, which retrieved about 29,000,000 results. Based on this, Respondent believes it unlikely that unsuspecting internet surfers will happen across the <homedepotsucks.com> site while searching for Complainant, and it is even more unlikely that, once there, visitors will be confused as to the source of the site. In fact, it may be difficult for those searching for <homedepotsucks.com> to find it using a search engine: a Google query for HOME DEPOT SUCKS retrieved 375,000 results and Respondent's site was not listed in the first 150 or 15 pages of results. The <homedepotsucks.org> domain name (<http://www.HomeDepotSucks.org>, registered to a Sam Lewit, Oakland, CA) is listed in page three of the results, and <home-depot-sucks.dansoft.co.nz> (<http://www.Home-Depot-Sucks.Dansoft.co.nz>) is listed, but Respondent's site is not retrieved in the top 150 results of this query.

The word "sucks" has long since entered the common English lexicon for use as a negative reference of cultural icons and people. Respondent urges the panel to consider the reasonable reactions of common Internet users when considering the similarity of Home Depot and <homedepotsucks.com>. Moreover, unlike the complainant and respondent in *The Royal Bank of Scotland* case, both Complainant and Respondent are located in the U.S., where "sucks" sites are commonly tolerated by trademark holders and protected by U.S. law. It follows that the visitors to the <homedepotsucks.com> site will be fluent in English and will be well aware of the meaning of the word "sucks." Complainant is asking the Panel to stretch its imagination to envision that <homedepotsucks.com> is confusingly similar to THE HOME DEPOT.

Thus, the Complainant fails to show, in either its Complainant or in its extensive supplemental filing, that the <homedepotsucks.com> domain, which is, on its face critical of Complainant, is "identical or confusingly similar" to the Complainant's marks. Accordingly, this primary element of the UDRP is not satisfied, and the Complaint should be denied.

II. Respondent Has Demonstrated A Legitimate Interest in the Domain Name.

Complainant argues in section II(b) of its Reply Brief that the Respondent lacks legitimate interests in the Domain Name because 1) the use of <homedepotsucks.com> tarnishes the Complainants' trademarks and because 2) Respondent's use of the domain is "commercial."

1. Respondent's Use of <homedepotsucks.com> Does Not Tarnish.

Complainant asks the Panel to let it have its cake and eat it, too. Complainant argues that the content of Respondent's website is irrelevant for purposes of determining confusing similarity⁷, then immediately turns about-face and argues that the content of the website is highly relevant because it demonstrates Respondent's bad faith intent to tarnish Complainant's marks. While Respondent believes these arguments are in serious conflict, and notes that Complainant is only raising this issue for the first time now, it will address the tarnishment allegation.

In order to show tarnishment under the Federal Trademark Dilution Act ("FTDA"), 15 USC§1023(c), Section 43(c) of the Lanham Act of the United States, the law of the country where both Parties reside, the Complainant must show:

⁷ See Response, ¶I(C), entitled "Respondent's Use of 'HOME DEPOT SUCKS'" in the body of its webpage is irrelevant."

- 1) it is the owner of a famous mark;
- 2) Respondent is using the famous mark for a “commercial use” in commerce;
- 3) after the mark has become famous;
- 4) that Respondent’s use “causes dilution of the distinctive quality of the mark.”

The FTDA provides that “the following shall not be actionable under this section:

(A) Fair use of a famous mark by another person in comparative commercial advertising or promotion to identify the competing goods or services of the owner of the famous mark.”

(B) Noncommercial use of the mark.

(C) All forms of news reporting and news commentary.”⁸

Complainant has not specifically alleged in its Complaint that its mark is “famous,” nor has it offered any proof that the Respondent’s use of <**homedepotsucks.com**> is used for commercial purpose, nor has it shown that Respondent’s use of the words HOME DEPOT causes a dilution of the distinctive quality of the mark at issue. Tarnishment occurs when a famous mark is linked to products of poor quality or is portrayed in an unwholesome manner. “The anti-dilution statute does not, however, permit a trademark owner to enjoin the use of his mark in a noncommercial context found merely to be negative or offensive, and does not encompass the unauthorized use of a trademark in a noncommercial setting such as an editorial context.” *L.L. Bean, Inc. v. Drake Publishers, Inc.*, 811 F.2d 26, 31-33 (1st Cir.), cert. denied, 483 U.S. 1013 (1987). In this case, viewers are likely to see the website for what it is intended: a criticism of Complainant’s business practices that impact the environment. Respondent believes it has not overstepped the bounds of free speech into tarnishment such that Complainant’s marks will be diluted by Respondent’s use. Respondent has used a negative image on its site to attract attention and it has stated facts that portray Complainant in a negative light, but this message is protected means of expression and free speech rights trump the commercial rights of the trademark holder in the U.S. courts. Accordingly, Respondent believes that its use is not actionable as *tarnishment* and even if the Panel finds that it does, such use is permitted under the safe harbor provisions of the FTDA.

2. Respondent’s Use of <homedepotsucks.com> Is Not For Commercial Purpose.

Respondent has stated in its Response, and restates here, that the domain <**homedepotsucks.com**> was not registered for, and is not used for, a commercial purpose.

Complainant cites *The Royal Bank of Scotland v Lopez*, D2002-0823 (WIPO December 3, 2002), to support its tenuous allegation that a protest site cannot contain the trademarks of the trademark holder whose products or services are at the center of the debate. Complainant’s proposition would effectively permit trademark holders to stifle any speech that they find objectionable simply because they believe the speech may harm their brand. The most logical place for a disgruntled consumer or a concerned consumer to learn about the dirty laundry of a trademark holder is at the “sucks” version of the “.com” domain. While trademark owners

⁸ Federal Trademark Dilution Act (“FTDA”), 15 USC§ 1023(c), Section 43(c) of the Lanham Act.

dislike this easy access to criticism, non-commercial speech, such as “HomeDepotSucks” is protected under the laws of the country of the Parties. Respondent has a legitimate right to use the most logical domain name to express its views about the policies and procedures, goods and services, of the Complainant at the <**homedepotsucks.com**> site. The Respondent also has a right to offer, and legitimate interest in offering, customer’s information about alternatives to the Complainant that are in furtherance of Respondent’s political purpose. Non-commercial speech is afforded the highest levels of protection from the courts in the U.S., and Complainant should not be allowed to stifle truth in the name of brand protection.

The Complainant has not shown the commercial use necessary under the UDRP. Complainant’s Reply Brief shows the membership form for joining the *non-profit organization*, Action Resource Center (ARC). ARC provided some of the content and organized demonstrations against Home Depot. Certainly non-profits may collection donations under their 401(c)(3) charter. This only supports Respondent’s statement that <**homedepotsucks.com**> is a protest site working with nonprofit organizations and not a commercial site. The Respondent derives no income from the <**homedepotsucks.com**> site.

Complainant’s Reply Brief shows the links page of <**homedepotsucks.com**> with these links:

- 1) People’s Action for Threatened Habitat is non-profit.
- 2) Living Jungle Alliance is non-profit.
- 3) Rainforest Action Network is non-profit.
- 4) Forest Action Network is non-profit.
- 5) Sprawl Busters “Sprawl-Busters Consultants help local community coalitions on-site to design and implement successful campaigns against megastores and other undesirable large-scale developments.”
- 6) Julia Butterfly is individual whom tree sat almost 2 years to save 500-year-old tree.
- 7) Wetlands Action Group is non-profit.
- 8) GreenPeople.org, a directory of eco-friendly products and services is already addressed in the Response. It was a certified nonprofit at the time of linking and provides free listings and free searching, receives no commissions from any products sold, but does offer optional “membership type” nominal listing fees priced like membership in a non-profit of \$10-\$30 per year and optional banner advertising similar to what is allowed in nonprofits newsletter. This supports site maintenance and hosting.
- 9) EcoRoommates.com is a FREE roommate service.
- 10) 9.95 GreenISP was an attempt to help fund the HomeDepotSucks.com site and build links for better search engine results. It was intended to be likened to nonprofit membership donations or the selling of t-shirts or mugs and it never made any money and was shortly discontinued.

The above links page clearly shows the nature of <**homedepotsucks.com**> as being a protest site. Listing coalition member organizations and resources is not “commercial activity.”

III. Respondent Did Not Register and Use the Domain Name in Bad Faith.

Complainant’s Reply Brief struggles to find “commercial use” of Respondent’s domain and attempts to paint the Respondent as a purveyor of products competitive to those of Home

Depot. Despite its lengthy submissions, Complainant has still failed to prove the requisite elements of bad faith in use and registration of the domain name. To recap:

A. The Respondent has not registered the domain for the purpose of selling, renting or transferring the domain for a profit.⁹ The Respondent registered the domain for the purpose of using the most logical address to post criticism of Home Depot, and posted a protest site there for seven years: this does not meet the requirements of bad faith use and registration. Respondent sincerely believes its short-term redirection of the domain to GreenPeople.org was known by, and not objected to by, Complainant. Respondent had a good faith belief that the redirection was in furtherance of improving the negotiations with Respondent to cease using old growth lumber, and GreenPeople.org is a *non-commercial, non-profit* operation. Again, these facts do not support a finding of bad faith use and registration.

B. The Respondent has not registered the domain to prevent the Complainant from reflecting the mark in a corresponding domain:¹⁰ it is simply not logical that Complainant would want to advertise its goods and services at a pejorative domain.

C. The Respondent has not registered the domain primarily for the purpose of disrupting the business of a competitor.¹¹ Home Depot is, as indicated in the Complaint and Reply brief, a very large corporation and Respondent is not selling products, and cannot be called a “competitor” of Home Depot; Respondent does not have a commercial business as such.

D. The Respondent has not registered or used the domain to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the Complainant.¹² Respondent has a good faith belief that no one could confuse, nor are they likely to confuse, a pejorative domain like <**homedepotsucks.com**> with Complainant.

E. Finally, Respondent has used the domain as a “legitimate noncommercial site, without an intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.”¹³ The primary purpose of Respondent in registering and using the domain at issue is to exercise its First Amendment free speech rights by providing criticism of Home Depot and to provide the public with information that will have an impact on the environment. Respondent posted information on its website that it thought reasonably necessary to deliver its message most effectively and, when it thought Home Depot intended to finally take the requested action, it temporarily redirected traffic to <greenpeople.org>. After seven years of inaction, Complainant finally saw its opportunity to make a case against Respondent and brought this action on the grounds that the redirection to <greenpeople.org> is a “commercial use,” even though the redirect was instituted in good faith reliance upon Complainant’s promise to RAN to stop use of old growth forests.

⁹ See Policy ¶4(b)(i).

¹⁰ See Policy ¶4(b)(ii).

¹¹ See Policy ¶4(b)(iii).

¹² See Policy ¶4(b)(iv).

¹³ See Policy ¶4(c)(iii).

The mere fact that the Respondents' Domain Name contains a trademarked word cannot impute bad faith motives on the part of the Respondent. ("It has long been held that an individual's First Amendment right of free speech in connection with consumer commentary and criticism is protected." See *Ahmanson Land Company v. Save Open Space and Electronic Imaging Systems*, D200-0858 (December 4, 2000, WIPO). Complainant has still not proffered any evidence that demonstrates that at the time the Respondent registered the Domain Name, he did so with a bad faith intention to violate the Policy and Complainant *had no bad faith intent* in registering, or using, the domain.

Respondent notes that Complainant's Reply Brief, ¶II. (A)(1), misstates the facts. Complainant says, "Complainant did not have an agreement with RAN or with Respondent regarding the domain name homedepotsucks.com." Attached is an email demonstrating there *was* an agreement between RAN and Home Depot, in contradiction to Home Depot's statement. Furthermore an emailed statement showing Home Depot's full knowledge, awareness, and approval for the redirection to greenpeople.org. Respondent has never received any request to take action other than that which was taken. Upon receipt of this Complaint and learning that Home Depot was failing to meet its commitments, Respondent resumed direction of the domain back to the Protest Site, as was its original purpose. Complainant should not be permitted to use ploys such as the one evidenced in this case to achieve its legal objectives.

Claimants Reply Brief does not add further evidence to support its claim of registration and use in bad faith nor its claim of confusing similarity. The contested site natwestbanksucks.com contained unsubstantiated accusations against the Royal Bank of Scotland. This is not the case with homedepotsucks.com. Secondly, the Panel deemed that the Respondent, Pedro Lopez showed bad faith by a "pattern of behavior in providing false address information for the purposes of the domain name registrations, conduct that is in breach of the Respondent's warranty." Again this is not the case for homedepotsucks.com. Thirdly, natwestbanksucks.com used "a sign confusingly similar to the Complainants registered trademarks and is therefore likely to tarnish and damage those marks irreparably". Again there is no mistaking the homedepotsucks.com site for homedepot.com, and Respondent asks the Panel to balance its rights and interests in the exercise of its First Amendment rights in the most appropriate forum, homedepotsucks.com, with the protection of Complainant's commercial interests in protecting its trademark rights. According to the court in *Bally Total Fitness v. Faber*, "Courts have rejected the notion that trademark rights may eclipse First Amendment protection." (See *Bally Total Fitness Holding Corp. v. Faber*, 29 F. Supp. 2d 1161, 50 U.S.P.Q.2d (BNA) 1840) Thus, Respondent's right to continue to utilize the homedepotsucks.com domain as a protest site should weigh heavily here.

IV. Complainant's Response Amends Its Complaint In Violation of NAF Supp. Rule. 7(d).

The Complaint's substantial filing, styled as a "Reply Brief" is a thinly disguised attempt to amend its original Complaint, in violation of the National Arbitration Supplemental Rule 7(d), which provides: "Additional submissions and responses to additional submissions may not amend the original Complaint or Response."

The original Complaint made no allegation that Respondent's protest site at <homedepotsucks.com> tarnished Complainant's trademarks. Now, at the eleventh hour, Complainant raises this issue in ¶II(B), at 7, in its Response. Respondent respectfully submits to the Panel that this is further evidence of Complainant's bad faith in bringing this entire action against Respondent *after* inducing Respondent to remove the protest site at <homedepotsucks.com>. Complainant has elected to submit substantive legal argument and legal research, not in its initial Complaint—which it had seven years to draft—but in its “supplement” to Respondent's reply. Now Respondent is faced with five days to research and prepare its defense to Complainant's new allegations and legal research in support of its tenuous claims. Respondent requests that, when rendering its decision in this case, the Panel consider the actions of Complainant and its legal counsel in submitting substantive legal research and arguments and new allegations in its “supplemental filing.”

FINDINGS

In light of the evidence considered, this Panel determines:

- (1) the domain name registered by the Respondent is not identical or confusingly similar to a trademark or service mark in which the Complainant has rights;
- (2) the Respondent has rights or legitimate interests in respect of the domain name; and
- (3) the domain name has not been registered and is not being used in bad faith.

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.

In addition, the standard of scrutiny in a contested UDRP case is higher than a case proceeding on a default.

Identical and/or Confusingly Similar

The term “sucks” is sufficient to distinguish the disputed domain name from Complainant's THE HOME DEPOT mark. *See Entrepreneur Media, Inc. v. Smith*, 279 F.3d 1135, 1147 (9th Cir. Feb. 11, 2002) (“Similarity of marks or lack thereof are context-specific concepts. In the Internet context, consumers are aware that domain names for different Web sites are quite often similar,

because of the need for language economy, and that very small differences matter."); *see also Lockheed Martin Corp. v. Parisi*, D2000-1015 (WIPO Jan. 26, 2001) (finding that common sense and a reading of the plain language of the Policy support the view that a domain name combining a trademark with the word "sucks" or other language clearly indicates that the domain name is not affiliated with the trademark owner and therefore <lockheedmartinsucks.com> and <lockheedsucks.com> cannot be considered confusingly similar to LOCKHEED MARTIN); *see also McLane Co., Inc. v. Craig*, D2000-1455 (WIPO Jan. 11, 2001) ("While often the inclusion of a generic term will not serve to distinguish a domain name from a trademark, in the case of the term 'sucks,' the addition of the generic term does reduce the likelihood of confusion.").

The logic of panels who feel non-English speakers will misunderstand the meaning of the word "sucks" escapes this Panel. "Sucks" is a pretty short word and it isn't a compliment. Considering most beginning linguists learn curse words first, it is likely anyone with any command of the English language knows "sucks" doesn't have a good connotation.

Rights or Legitimate Interests

Complainant has failed to allege facts sufficient to create a *prima facie* case for lack of rights or legitimate interests pursuant to Policy ¶4(a)(ii). *See Lush LTD v. Lush Environs*, FA 96217 (Nat. Arb. Forum Jan. 13, 2001) (finding that even when the respondent does file a response, the complainant must allege facts, which if true, would establish that the respondent does not have any rights or legitimate interests in the disputed domain name); *see also Graman USA Inc. v. Shenzhen Graman Indus. Co.* FA 133676 (Nat. Arb. Forum Jan. 16, 2003) (finding that absent a showing of any facts by the complainant that establish the respondent lacks rights or legitimate interests in the disputed domain name, the panel may decline to transfer the disputed domain name).

Respondent's use of the <homedepotsucks.com> domain name as a protest site is a legitimate noncommercial or fair use under Policy ¶4(c)(iii). *See Baja Marine Corp. v. Wheeler Techs., Inc.*, FA 96954 (Nat. Arb. Forum May 17, 2001) (finding that the respondent has rights and legitimate interests in the domain name where the respondent made a non-commercial use of <bajaboats.com> and received no funds from users of the site connected to the domain name); *see also Lockheed Martin Corp. v. Etheridge*, D2000-0906 (WIPO Sept. 24, 2000) (finding that the respondent has rights in the <missionsuccess.net> domain name where she was using the domain name in connection with a noncommercial purpose); *see also Pensacola Christian Coll. v. Gage*, FA 101314 (Nat. Arb. Forum Dec. 12, 2001) (finding that the respondent has rights and legitimate interests in a domain name incorporating the complainant's name at which commentary and criticism of the complainant are offered, and at which users are free to post messages about the complainant).

Complaining has long been a favorite pastime of humanity and the Internet has not changed that. Respondent is actually using Complainant's trademark correctly because Respondent is referring to Complainant and its business.

While the Panel is very concerned about Respondent's commercial use of the domain, the evidence shows Respondent used the domain name in a non-commercial fashion in 1999, 2000, 2001, 2002, 2003 and 2004. The domain name was used for commercial purposes for a couple of months in 2005 (and Respondent thought he was doing it at Complainant's request). Respondent's rights should not be forfeit over such a small lapse; *de minimus non curat lex*.

Registration and Use in Bad Faith

Complainant failed to meet the burden of proof of bad faith registration and use under Policy ¶4(a)(iii). See *Starwood Hotels & Resorts Worldwide, Inc. v. Samjo CellTech.Ltd*, FA 406512 (Nat. Arb. Forum Mar. 9, 2005) (finding that the complainant failed to establish that respondent registered and used the disputed domain name in bad faith because mere assertions of bad faith are insufficient for a complainant to establish Policy ¶4(a)(iii)); see also *Graman USA Inc. v. Shenzhen Graman Indus. Co.* FA 133676 (Nat. Arb. Forum Jan. 16, 2003) (finding that general allegations of bad faith without supporting facts or specific examples do not supply a sufficient basis upon which the panel may conclude that the respondent acted in bad faith).

Respondent's website, which is used to voice concerns and complaints about Complainant's practices, does not amount to bad faith registration and use pursuant to Policy ¶4(a)(iii). See *Elm Grove Dodge Chrysler Jeep, Inc. v. Schedule Star*, FA 352423 (Nat. Arb. Forum Dec. 27, 2004) (finding no bad faith registration or use where the respondent "only registered the disputed domain names to voice concerns and complaints about Complainant" and "[n]o one reading the web site would be confused as to sponsorship"); see also *Legal & Gen. Group Plc v. Image Plus*, D2002-1019 (WIPO Dec. 30, 2002) ("[T]he goals of the Policy are limited and do not extend to insulating trademark holders from contrary and critical views when such views are legitimately expressed without an intention for commercial gain.").

DECISION

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

Houston Putnam Lowry, Chartered Arbitrator, Panelist
Dated: Sunday, October 25, 2005