

NO. 09-17625

**IN THE UNITED STATES COURT OF APPEALS
FOR THE NINTH CIRCUIT**

DANIEL L. BALSAM,
Plaintiff / Appellant / Petitioner

vs.

TUCOWS INC., a Pennsylvania corporation, TUCOWS CORP., a Mississippi
corporation, ELLIOT NOSS, an individual, PAUL KARKAS, an individual, and
DOES 1-100,
Defendants – Respondents

On Appeal from the United States District Court for the
Northern District of California, No. 3:09-CV-03585 CRB
Honorable Charles R. Breyer

**PLAINTIFF / APPELLANT / PETITIONER'S PETITION FOR
REHEARING EN BANC**

Timothy J. Walton (State Bar No. 184292)
LAW OFFICES OF TIMOTHY WALTON
9505 Soquel Drive, Suite 207
Aptos, CA 95003
Phone (831) 685-9800, Fax: (650) 618-8687

Daniel L. Balsam (State Bar No. 260423)
THE LAW OFFICES OF DANIEL BALSAM
3145 Geary Blvd. #225
San Francisco, CA 94118
Phone: (415) 869-2873, Fax: (415) 869-2873

Attorneys for Petitioner

I. TABLE OF CONTENTS

	Page
I. TABLE OF CONTENTS	i
II. TABLE OF AUTHORITIES.....	ii
III. STATEMENT OF COUNSEL	1
IV. INTRODUCTION	3
V. DISCUSSION.....	5
A. This Lawsuit is Not Merely About Annoying Spam	5
B. Tucows Profits by Conspiring With Tortfeasors so That Both Can Escape Liability for Wrongful Acts.....	8
C. Tucows Agreed to ¶ 3.7.7.3 Because It Cannot Contract With Itself; Tucows is Liable to Balsam for its Breach of the RAA	9
D. Balsam Should Be Given Leave To Amend	12
E. Public Policy Requires That This Court Hold Tucows Liable. The Panel’s Decision Will Create Chaos in the Internet Space	13
F. ICANN States That Those Harmed By Wrongful Use of Domain Names Can Enforce ¶ 3.7.7.3 of the RAA	16
G. Administrative Rulings Support Liability for Tucows as the Proxy Registration Service	17
VI. CONCLUSION	18
VII. ATTACHMENTS.....	21
VIII. CERTIFICATE OF COMPLIANCE.....	39

II. TABLE OF AUTHORITIES

	<u>Page</u>
<u>Federal Cases</u>	
<i>Silverstein v. E360Insight.com et al</i> , No. CV 07-2835 CAS (VBKx) (C.D. Cal. Oct. 1, 2007) (order denying defendant Moniker Online Services LLC’s motion to dismiss)	10
<i>Solid Host NL v. NameCheap Inc.</i> , 652 F. Supp. 2d 1092 (C.D. Cal. May 19, 2009) (order denying defendant NameCheap’s motion to dismiss).....	<i>passim</i>
<i>U.S.A v. Kilbride</i> , 584 F.3d 1240 (9th Cir. 2009)	4
<i>Verizon California Inc. v. OnlineNIC Inc.</i> , No. C-08-2832 JF (RS), 2008 U.S. Dist. LEXIS 104516 (N.D. Cal. Dec. 19, 2008), <i>aff’d</i> 2009 U.S. Dist. LEXIS 84235 (N.D. Cal. Aug. 25, 2009).....	1, 7
<u>California Cases</u>	
<i>Moyer v. Workmen’s Comp. Appeals Board</i> , 10 Cal. 3d 222 (1973)	14
<i>The Ratcliff Architects v. Vanir Construction Management Inc.</i> , 88 Cal. App. 4th 595 (1st Dist. 2001).....	19
<u>Administrative Cases</u>	
<i>Siemens AG v. Joseph Wunsch/Contactprivacy.com</i> , WIPO Case No. D2006-1248 at ¶ 6 (Dec. 6, 2006), <i>available at</i> http://www.wipo.int/amc/en/domains/decisions/html/2006/d2006-1248.html	17
<i>The John Hopkins Health System Corporation, The John Hopkins University v. Domain Administrator</i> , WIPO Case No. D2009- 1958 at ¶ 6B (Feb. 27, 2009), <i>available at</i> http://www.wipo.int/amc/en/domains/decisions/html/2008/d2008-1958.html	17
<u>California Statutes</u>	
Civ. Code § 1550	11
Civ. Code § 1638	14
Civ. Code § 1643	14
Civ. Code § 1798.92 <i>et seq.</i>	8

**III. STATEMENT OF COUNSEL PURSUANT TO F.R.A.P. RULE 35
AND NINTH CIRCUIT RULE 35-1**

I, the undersigned counsel for Petitioner, express a belief, based on reasoned and studied professional judgment, that the Panel in *Balsam v. Tucows Inc.*, No. 09-17625, erred when it failed to consider public policy and ruled that millions of people and businesses are not protected by the Registrar Accreditation Agreement (“RAA”).

The RAA allows “Proxy Registration Services” to take legal title to Internet domain names and license them back to the actual users, enabling domain name operators to avoid having their identities included in the public Whois database. However, Proxy Registration Services must agree, pursuant to the RAA, to promptly identify their licensees upon presentation of reasonable evidence of actual harm caused by unlawful use of domain names.

The Panel’s decision ignores public policy by allowing bad actors to remain hidden while denying remedies to those harmed, as to *both* the actual bad actor/licensee and the Proxy Registration Service that is the legal owner of the wrongfully-used domain name.

Moreover, the Panel’s decision conflicts with *Verizon California Inc. v. OnlineNIC Inc.*, No. C-08-2832 JF (RS), 2008 U.S. Dist. LEXIS 104516 (N.D. Cal. Dec. 19, 2008), *aff’d* 2009 U.S. Dist. LEXIS 84235 (N.D. Cal. Aug. 25, 2009)

and *Solid Host NL v. NameCheap, Inc.*, 652 F. Supp. 2d 1092 (C.D. Cal. May 19, 2009).

Finally, the Panel seemed to believe that the case was *only* about “annoying spam.” In fact, the Panel’s decision has far broader implications, ranging from cybersquatting, to copyright and trademark infringement, to defamation, to fraud and identity theft. The implications of the Panel’s decision in this case are wide-ranging and will affect millions of people and businesses. This case should be heard by a full panel of judges who would consider the impact of a decision in favor of a Proxy Registration Service that conspires with its customers so that both can avoid liability for unlawful actions.

THE LAW OFFICES OF DANIEL BALSAM

Dated: December 30, 2010

By /s/ Daniel L. Balsam
Daniel L. Balsam
Attorneys for Plaintiff/Appellant/Petitioner

IV. INTRODUCTION

The Internet Corporation for Assigned Names and Numbers (“ICANN”) created the Registrar Accreditation Agreement (“RAA”) – which allows entities such as Respondent Tucows Inc. (“Tucows”) to become Registrars for Internet domain names – to protect people and businesses harmed by the wrongful use of Internet domain names, such as Petitioner Daniel Balsam (“Balsam”). Pursuant to ¶ 3.7.7 of the RAA, Registrars must require their Registered Name Holders (“RNHs”) to agree to ¶ 3.7.7.3. And ¶ 3.7.7.3 expressly requires that RNHs that license their domain names to third parties, such as Tucows has done in this case, accept liability for harm caused by wrongful use of their domain names, unless they promptly identify their licensees.

Paragraph 5.10 of the RAA *only* immunizes ICANN and Registrars from liability to harmed third parties. *Nothing* in ¶ 5.10 – or anywhere else – says that Proxy Registration Services, which become the legal owners of domain names, enjoy such immunity. In fact, ¶ 3.7.7.3 expressly creates liability for RNHs that license use of their domain names to third parties and refuse to promptly identify their licensees upon presentation of actionable harm.

Respondents offer “Proxy Registration Services” (also known as “Private Registration Services”), the sole purpose of which is to hide the identity of the true operator of a domain name. By doing so, Tucows – acting as a Proxy Registration

Service, *not* as a Registrar – became the RNH (the legal owner) of the domain name *AdultActionCam.com*, a pornographic website promoting random sexual encounters that advertises through unlawful spam.¹ Tucows then licensed use of the domain name back to its spammer-customer. Tucows is essentially wearing two distinct hats – one as the Registrar, and the other as the Proxy Registration Service/RNH, which is *not* a Registrar function.

Although Tucows *is* a Registrar, Balsam did not sue Tucows *as* a Registrar. Rather, Balsam sued Tucows because it acted in a *non*-Registrar capacity by taking legal title to the domain name *AdultActionCam.com*, and because Tucows neither identified its licensee nor accepted liability for damages caused by wrongful use of *AdultActionCam.com*.

Respondents could have easily avoided liability simply by identifying their licensee when Balsam provided them with reasonable evidence of actual harm – an actual judgment from the District Court. (Excerpts of Record 187, 192, 223-225.) It would have cost Respondents nothing to provide Balsam with the information, but they refused to do so, demonstrating intent to be a “spammer-friendly” Proxy Registration Service and profit by protecting customers who use domain names for unlawful purposes.

¹ “Spam” is the commonly accepted term to describe “unsolicited commercial email.” *See, e.g., U.S.A v. Kilbride*, 584 F.3d 1240, 1244 (9th Cir. 2009).

The Panel's decision allows both RNHs *and* their licensees to avoid liability for undisputed harm, which will likely lead to more wrongful acts on the Internet by scofflaws and their conspiring Proxy Registration Services.

The Panel also denied Balsam leave to amend, despite the fact that ICANN modified the RAA since Balsam filed his Complaint in this matter. The amendments further demonstrate ICANN's intent that those harmed by wrongful use of Internet domain names can learn who the actual users are, or will have recourse against the RNHs/Proxy Registration Services. Balsam could amend the Complaint to set forth additional factual allegations and legal theories.

V. DISCUSSION

A. This Lawsuit is Not Merely About Annoying Spam

The Panel acknowledged that spam is annoying, and no email user would doubt such a conclusion. But the Panel seemed to believe that this lawsuit was *only* about spam. It is not.

Paragraphs 3.7.7 and 3.7.7.3 of the RAA refer to "actionable harm," not just spam. Such harm could include intellectual property violations (e.g., trademark and copyright infringement), defamation, fraud, and identity theft. The following examples are merely illustrative and not intended to be comprehensive, but they demonstrate the wide variety of harms that the Panel's decision effectively encourages, or at least permits.

1. Trademark Infringement

Suppose someone set up a website *RealRolexWatches.com* and sold counterfeit watches, infringing on Rolex's registered trademark. Of course, the scofflaw would not want to be easily identified, so he might choose to use Tucows' Proxy Registration Services to keep his identity out of the Whois database,² believing that Tucows would protect him despite actual knowledge of the wrongful acts. Rolex might well want to sue the counterfeiter. By the Panel's logic, Rolex would not be able to identify the counterfeiter *and* would have no recourse against Tucows, the legal owner of the domain name associated with the counterfeit goods.

On May 14, 2010, ICANN issued a News Alert announcing that it had posted a [Draft] Advisory as to ¶ 3.7.7.3 on its website for public comment. *See Attachment A*. ICANN's Draft Advisory on the Effect of Registrar Accreditation Agreement (RAA) Subsection 3.7.7.3, *available at* <http://www.icann.org/en/compliance/reports/draft-advisory-raa-3773-14may10-en.pdf> (last visited May 18, 2010) is included as *Attachment B*. In the Advisory, ICANN expressly set forth trademark infringement as an example of actionable harm. But infringement of Rolex's trademark harms neither the Registrar nor ICANN. Therefore, since trademark infringement *does* trigger disclosure/liability, that demonstrates

² The publicly-accessible Whois database contains identity/contact information for legal owners of domain names – either the original Registrants or, as in this case, the Proxy Registration Service. *See Solid Host*, 652 F. Supp. 2d at 1095.

ICANN's intent in the RAA (and the Proxy Registration Service's acceptance of that intent), that the harmed party – here, Rolex as the trademark owner – should be able to enforce ¶ 3.7.7.3.

Following this logic, the federal court in the Northern District of California held OnlineNIC – a Registrar – liable because it acted *as a RNH*, not as a Registrar, when it cybersquatted on Verizon's domain names. *Verizon, supra*. Similarly, the federal court in the Central District of California did *not* dismiss the complaint against Namecheap, because it was not *acting* as a Registrar when it became the RNH of the (allegedly) cybersquatting domain name. *Solid Host, supra*.

2. Fraud

Suppose someone created a “phishing” website *CharlesSchwab.com* designed to trick people into providing their account numbers and passwords. Aside from cybersquatting on Charles Schwab's domain name, this fraudulent website could easily create damages in the millions of dollars and harm millions of people. And if the domain name were proxy-registered through Tucows, the Panel's decision would give those harmed no recourse against the fraudster or against Tucows, who refuses to identify its licensee of a domain name for which it is the legal owner, even in the face of an actual judgment from a federal court.

3. Identity Theft

California Civil Code § 1798.92 *et seq.* outlaws identity theft, but the Panel's decision undermines state law by preventing the victim of identity theft involving a proxy-registered domain name from ever finding out who was responsible, and similarly denying the victim a remedy against the legal owner of the domain name.

Suppose someone created *9thCircuitOpinions.org* – someone who has nothing to do with this Court – and posted edited opinions that stated the exact opposite of the true rulings. Of course, the person would choose to use Tucows' Proxy Registration Services to hide his identity, because other Proxy Registration Services adhere to the intent and plain language of the RAA by identifying their licensees engaged in wrongful acts, without requiring a lawsuit or a subpoena. (Excerpts of Record 72, 80.) Presumably, this Court would want to find out who was impersonating its identity by creating such a website. By the Panel's logic, this Court would not be able to do so.

B. Tucows Profits by Conspiring With Tortfeasors so That Both Can Escape Liability for Wrongful Acts

Tucows seeks to profit and actually profits by acting as a Registrar, and it makes more money by providing Proxy Registration Services to those wishing to hide their identities. There are legitimate reasons for a domain name registrant to want to keep personal information private (and avoiding annoying spam is just one

of such reasons). But Tucows should not be allowed to conspire with tortfeasors by operating a Proxy Registration Service that guarantees anonymity for persons who are using domain names for unlawful purposes, while simultaneously avoiding liability as the legal owner of those domain names. Such a result flies in the face of ICANN's clearly stated intent.

The Panel gave no indication how an Internet user could determine the true identity of a bad actor that Respondents protect with their Proxy Registration Services. Instead, the Panel simply suggests that Balsam – and by extension *all* persons harmed by *any* sort of misuse of Internet domain names – are out of luck, and tortfeasors who use Tucows' Proxy Registration Services may continue their unlawful activities without fear of ever being held accountable.

C. Tucows Agreed to ¶ 3.7.7.3 Because It Cannot Contract With Itself; Tucows is Liable to Balsam for its Breach of the RAA

1. Tucows Operates its Own Privacy Service

As the Panel noted, ¶ 3.7.7 of the RAA requires Registrars to in turn require their RNHs to agree to ¶ 3.7.7.3, so if the RNH licenses the domain name to a third party, the RNH is liable for the wrongful acts of the licensee unless the RNH promptly identifies the licensee.

But Tucows operates its *own* Proxy Registration Service (*ContactPrivacy.com*) and becomes the RNH itself. This distinguishes the instant dispute from *Solid Host*, where there were two separate companies involved –

Enom the Registrar and Namecheap the Proxy Registration Service. *Solid Host*, 642 F. Supp. 2d at 1119.

2. Tucows Cannot Enter Into a Contract With Itself

In *Solid Host*, the court said that Solid Host was not a third party beneficiary of ¶ 3.7.7.3, relying merely on ¶ 5.10 that says that there are no third party beneficiaries as to ICANN and Registrars, and ignoring the fact that Namecheap was not acting as a Registrar. But notably, the court expressly stated that Solid Host adequately alleged a breach of ¶ 3.7.7 between Enom (the Registrar) and Namecheap (the Proxy Registration Service) as a third party beneficiary, and *denied* Namecheap's motion to dismiss. *Id.*

Similarly, the District Court for the Central District of California denied Moniker Online Services LLC's motion to dismiss on similar underlying facts – Moniker is a Proxy Registration Service and RNH of domain names used for unlawful spamming. *Silverstein v. E360Insight.com et al*, No. CV 07-2835 CAS (VBKx) at *6 (C.D. Cal. Oct. 1, 2007) (order denying Moniker's motion to dismiss). (Excerpts of Record 90-92, 99.)

Unless Tucows entered into the sort of contract required by ¶ 3.7.7 – i.e., requiring RNHs to agree to ¶ 3.7.7.3 – then Tucows breached the RAA. The Panel noted that there is no evidence in the record whether Tucows complied with the RAA by creating a contract with itself, but if it did – if it *could* – Balsam would be

a third party beneficiary of *that* contract, pursuant to *Solid Host*... a result Tucows wishes to avoid. Balsam expressly requested leave to amend to allege that he is a third party beneficiary of ¶ 3.7.7.

Unlike *Solid Host*, where Enom and Namecheap were both involved in the registration of the domain name at issue, here it's *all* Tucows, wearing *both* hats as Registrar *and* Proxy Registration Service/Registered Name Holder. It is true that Tucows signed the RAA as the Registrar, but that proves that Tucows knew the requirements of ¶ 3.7.7.3. Moreover, ¶ 3.7.7 requires Registrars to require RNHs to agree to ¶ 3.7.7.3, and Tucows could not have complied with ¶ 3.7.7, because Tucows cannot enter into a contract with itself – by definition, a contract needs (at least) two parties. *See, e.g.*, Cal. Civ. Code § 1550 (requiring “parties” *plural* as an essential element of any contract).

Even *without* the RAA, Tucows should be held liable for conspiring with tortfeasors to shield their identities, and Tucows should be held liable as the actual legal owner of the domain names. But Tucows' voluntary acceptance of the RAA's obligations makes this even more clear. By agreeing to ¶ 3.7.7, Tucows agreed to require its RNHs to agree to the terms of ¶ 3.7.7.3. And if Tucows *is* the RNH, then Tucows is bound by ¶ 3.7.7.3.

When a Registrar assumes an additional *non-Registrar* role by taking legal title to a domain name, as Tucows did here, then: 1) the Registrar loses its

immunity as to third parties, and 2) Since a party cannot contract with itself, ¶ 3.7.7.3 rolls up into ¶ 3.7.7. Or, put another way, ¶ 3.7.7.3 binds Tucows because here Tucows is acting as the RNH, and ¶ 3.7.7.3 is incorporated into the RAA by ¶ 3.7.7, and Tucows is a signatory to the RAA. And ¶ 3.7.7.3 should apply to the benefit of the harmed third parties.

D. Balsam Should Be Given Leave To Amend

Given that the *Solid Host* court refused to dismiss Namecheap, holding that Solid Host stated a valid claim for breach of ¶ 3.7.7, 652 F. Supp. 2d at 1119, the District Court below and the Panel should have given Balsam leave to amend the Complaint to make the same allegations.

Solid Host also noted that third party beneficiary claims are not appropriate for resolution by motion to dismiss because they involve factual questions of intent. *Id.*

The Panel glossed over the issue of whether any person harmed by a bad actor using Tucows' Proxy Registration Services could state a cause of action, giving short shrift to Balsam's argument that he could amend to add additional factual allegations about ICANN activities since the filing of the original complaint and additional legal theories based upon those facts. The issue of Proxy Registration Services/RNHs' liability for *any* kind of harm caused by wrongful use

of Internet domain names affects millions of people and businesses, and the parties should litigate the question fully.

ICANN intended the RAA to protect Internet users, among others. The requirement in ¶ 3.7.7 that RNHs must create a separate agreement pursuant to ¶ 3.7.7.3 shows intent to benefit the public. To the extent that Tucows failed to – could not – create an agreement with itself when it operated as a Proxy Registration Service, it breached the RAA. Therefore, Balsam is a either third party beneficiary of the agreement between Tucows and itself (which does not and cannot exist) or he is a third party beneficiary of the requirement that Tucows create such an agreement, which it failed to do.

E. Public Policy Requires That This Court Hold Tucows Liable. The Panel's Decision Will Create Chaos in the Internet Space

Temporarily setting aside the issue of third party beneficiary standing, ICANN clearly stated in ¶¶ 3.7.7 and 3.7.7.3 that RNHs cannot license their domain names to their customers, and shield their customers' identities with impunity when they engage in wrongful acts. In fact, just the opposite is true. The language of the RAA makes it clear that Registrars must require their RNHs to accept liability for harm caused by wrongful use of their domain names, unless the RNHs promptly identify their licensees upon reasonable presentation of evidence of actionable harm.

This Court should consider what purpose ¶ 3.7.7.3 could possibly have if harmed parties cannot enforce the paragraph. As demonstrated above in the Rolex example, neither ICANN nor a Registrar can enforce ¶ 3.7.7.3, because neither is harmed when some person receives unlawful spam, or suffers defamation, intellectual property infringement, fraud, or identity theft.

Who benefits from ¶ 3.7.7 and ¶ 3.7.7.3, if not the person who suffers the harm?

The fact that the Panel never answered that question suggests that it ignored a basic rule of law: contractual terms cannot be interpreted in a manner that make those terms superfluous. *See* Cal. Civil Code § 1638 (“The language of a contract is to govern its interpretation, if the language is clear and explicit, and does not involve an absurdity”); *Moyer v. Workmen’s Comp. Appeals Board*, 10 Cal. 3d 222, 230 (1973) (courts must avoid a statutory construction that makes some words surplusage); Cal. Civil Code § 1643 (“A contract must receive such an interpretation as will make it . . . operative . . . and capable of being carried into effect []”).

The potential liability for Proxy Registration Services – the legal owners of Internet domain names – is the only thing that prevents them from categorically refusing to identify their licensees engaged in wrongful actions using their domain names. This is why – at least up until the Panel’s decision – most Proxy

Registration Services *will* identify their licensees engaged in wrongful acts, to avoid the liability. Tucows stands alone as a Proxy Registration Service that refuses to identify its tortfeasor-licensees even in response to valid subpoenas. (Excerpts of Record 90-92.)

The Panel's decision opens the door to a flood of harms without remedies, including untraceable spam, and at the same time, the decision will create chaos in the industry. This is because – even as ICANN created rules to ensure that RNHs accept liability for harm unless they identify their licensees engaged in wrongful acts – ICANN also gave the RNHs an easy way to avoid liability. All the Proxy Registration Services have to do is identify their licensees who cause actionable harm. The Panel's decision eliminates Proxy Registration Services' incentive to identify their customers who are acting unlawfully.

Following the Panel's decision, Proxy Registration Services are left without guidance about whether they need to disclose information at all. Some Proxy Registration Services may decide that they can profit by allowing scofflaws to remain anonymous, while other others may decide that the Panel's decision only gave blanket immunity to those Registrars (such as Tucows) that never created the contract required by ¶ 3.7.7. Rather than stating a straightforward rule of law, the Panel made a decision without considering public policy implications, focusing

only on whether a particular plaintiff should be able to recover damages based on mere “annoying spam.”

F. ICANN States That Those Harmed By Wrongful Use of Domain Names Can Enforce ¶ 3.7.7.3 of the RAA

ICANN’s Director of Contractual Compliance indicated that Balsam had the right to seek a remedy from the Proxy Registration Service, and never suggested that Balsam needed a subpoena to do so. This evidence was before the Court (Excerpts of Record 71, 79, 89), but the Panel did not address the issue.

As discussed above, ICANN expressly noted that trademark infringement is actionable harm triggering disclosure/liability, Exhibit B, ICANN Draft Advisory at *3, which must mean that the entity who owns the trademark can enforce ¶ 3.7.7.3.

Moreover, the new RAA (May 2009) added language to ¶ 3.7.7.3 to require that RNHs not just *identify* their licensees, but also provide the harmed parties with the licensees’ *contact information*. *Id.* ICANN is apparently requiring more transparency in order to prevent Proxy Registration Services from shielding their scofflaw customers, and to help give harmed parties recourse against the bad actors.

Finally, in the May 2010 Draft Advisory, ICANN expressly rejected a subpoena requirement as part of enforcing ¶ 3.7.7.3. “Reasonable evidence of

actionable harm’ does not imply a requirement of the filing of a formal process (such as a UDRP complaint, civil lawsuit, or the issuance of a subpoena.” *Id.*

G. Administrative Rulings Support Liability for Tucows as the Proxy Registration Service

The World Intellectual Property Organization (“WIPO”) has held that Proxy Registration Services are proper respondents as to claims of a wrongful use of a domain name. In *Siemens AG v. Joseph Wunsch/Contactprivacy.com*, WIPO Case No. D2006-1248 at ¶ 6 (Dec. 6, 2006), available at <http://www.wipo.int/amc/en/domains/decisions/html/2006/d2006-1248.html>, Exhibit C, WIPO held that Tucows – acting as *ContactPrivacy.com*, the Proxy Registration Service – was the proper respondent to the dispute since it was the legal owner of the wrongfully-used domain name.

Similarly, in *The John Hopkins Health System Corporation, The John Hopkins University v. Domain Administrator*, WIPO Case No. D2009-1958 at ¶ 6B (Feb. 27, 2009), available at <http://www.wipo.int/amc/en/domains/decisions/html/2008/d2008-1958.html>, Exhibit D, WIPO held that “it was appropriate for the Complainants to have proceeded against the proxy service company as the nominated Respondent.”

Although WIPO decisions are not binding on this Court, these decisions are persuasive authority that an international body charged with adjudicating Internet-

related disputes to ensure consistency worldwide interpreted the RAA to hold Proxy Registration Services liable for the actions of their licensees.

VI. CONCLUSION

The real-world implications of the Panel's decision are immense. The issue of scofflaws hiding behind proxy-registered domain names, and the Services that conspire with them, affects millions of people and businesses. The Registrar Accreditation Agreement between ICANN and Tucows, the contract that enabled Tucows to become a Registrar, includes language that requires the Registered Name Holder of a domain name (which includes Proxy Registration Services) to accept liability for wrongful use of domain names that it chooses to license to third parties, unless it promptly identifies the licensees.

ICANN has stated that wronged parties (e.g., trademark owners) – and not just Registrars and ICANN (the signatory parties to the RAA) – are third-party beneficiaries of ¶ 3.7.7.3 and can enforce it. ICANN also makes it clear that RNHs are required to identify their licensees *without* subpoenas, not that Tucows responds to subpoenas anyway.

In the end, Respondents are seeking to have their cake and eat it too. Respondents seek to profit and actually profit by acting as a RNH – outside the scope of a Registrar – and providing Proxy Registration Services to tortfeasors, even as they claim immunity from all liability.

Public policy dictates that trademark and copyright infringers, fraudsters and identity thieves, and annoying spammers too, should not be allowed to go scot-free when the legal owners of wrongfully-used domain names *happen* to be Registrars too. ICANN – an entity chartered in the public interest – did not intend such an outcome. ICANN acknowledged public policy by requiring liability for RNHs who choose to hide their licensees’ identities. RNHs have the choice – accept the liability, or disclose the identities of their licensees engaged in wrongful acts. These are the terms that ICANN intended, and that Respondents accepted when they agreed to the RAA.

The Panel read language into ¶ 5.10 of the RAA that does not exist – the idea that ¶ 5.10 also immunizes Registered Name Holders of domain names from liability. But even if that language did exist, *The Ratcliff Architects v. Vanir Construction Management* held that “public policy may dictate the existence of a duty to third parties,” even if a contract “specifically excluded third party beneficiaries from having any rights under the contract.” 88 Cal. App. 4th 595, 605 (1st Dist. 2001). Here, the Panel’s decision had the effect of denying Balsam a remedy for the harm that the District Court found, even as Tucows avoids liability associated with the domain name for which it is the legal owner.

This Court should order an *en banc* rehearing to address this question of exceptional importance that may literally shape the future of the Internet, and the address the actions of scofflaws that violate the law with their online activities.

THE LAW OFFICES OF DANIEL BALSAM

Dated: December 30, 2010

By /s/ Daniel L. Balsam
Daniel L. Balsam
Attorneys for Plaintiff/Appellant/Petitioner

Attachment A
ICANN News Alert (May 14, 2010)

From: ICANN News Alert [mailto:communications@icann.org]
Sent: Monday, May 17, 2010 1:53 PM
To: [REDACTED]
Subject: ICANN News Alert -- Public Comment: Draft Advisory on the Effect of Registrar Accreditation Agreement (RAA) Subsection 3.7.7.3



News Alert

<http://www.icann.org/en/announcements/announcement-14may10-en.htm>

Public Comment: Draft Advisory on the Effect of Registrar Accreditation Agreement (RAA) Subsection 3.7.7.3

14 May 2010

ICANN has observed community comment concerning the interpretation of RAA Subsection 3.7.7.3. In order to provide clarity, ICANN is posting for public comment the following draft advisory <http://www.icann.org/en/compliance/reports/draft-advisory-raa-3773-14may10-en.pdf> [PDF, 216 KB]. The forum will be open through 9 July 2010.

One central clarification: if a Registered Name Holder licenses the use of a domain name to a third party, a licensee, the third party is not the Registered Name Holder of record (or "registrant"). This advisory also describes under what conditions that a Registered Name Holder is to identify the licensee and to whom.

Community members are invited to review the draft advisory and comment on all aspects of the document. At the end of this Public Comment period, ICANN Staff will review the comments submitted, prepare a summary analysis of the various submissions, and post the final version of the advisory.

The Public Comment Forum is located here: <http://www.icann.org/en/public-comment/public-comment-201007-en.htm#raa-3773>

[Sign up for ICANN's Monthly Magazine](#)

This message was sent from ICANN News Alert to [REDACTED]. It was sent from: ICANN, 4676 Admiralty Way, Suite 330 , Marina del Rey, CA 90292-6601. You can modify/update your subscription via the link below.



 [Manage your subscription](#)

Attachment B

ICANN's Draft Advisory on the Effect of Registrar Accreditation Agreement (RAA) Subsection 3.7.7.3 (May 14, 2010), available at <http://www.icann.org/en/compliance/reports/draft-advisory-raa-3773-14may10-en.pdf>



[Draft] Advisory 2010

[DRAFT] Advisory re: RAA Subsection 3.7.7.3

Summary and Purpose

The purpose of this advisory is to clarify that if a Registered Name Holder licenses the use of a domain name to a third party, that third party is a licensee, and is not the Registered Name Holder of record (also referred to as the "registrant" or "domain-name holder" in the ICANN [RAA](#), [UDRP](#), and other ICANN [policies](#) and [agreements](#)). This advisory also will clarify that a Registered Name Holder licensing the use of a domain is liable for harm caused by the wrongful use of the domain unless the Registered Name Holder promptly identifies the licensee to a party providing the Registered Name Holder with reasonable evidence of actionable harm.

Definition of Registered Name Holder

[RAA Section 3.7.7](#) requires a registrar to enter into a registration agreement with a Registered Name Holder for each registration sponsored by the registrar. [RAA Section 3.3.1](#) requires a registrar to provide the name and postal address of that Registered Name Holder in response to any queries to the registrar's Whois service.

At times, a Registered Name Holder allows another person or organization to use the domain name. For example, a website designer might be the Registered Name Holder of record for a domain name used by a client, or a "proxy service" might be the Registered Name Holder of record for a domain name used by a client that prefers not to disclose its identity/contact information. In either of these situations, the Registered Name Holder is the person or entity

[DRAFT] Advisory re: RAA Subsection 3.7.7.3

14 May 2010

Page 2 of 3

listed as the registrant/Registered Name Holder by the applicable Whois service (in the examples above, the website designer or the proxy service, not the client of the website designer or the proxy service).

Such circumstances are addressed by [RAA Subsection 3.7.7.3](#). Subsection 3.7.7.3 requires a registrar to include in its registration agreement a provision under which the Registered Name Holder agrees that if the Registered Name Holder licenses the use of the domain name to a third party, the Registered Name Holder is still the registrant of record. The Registered Name Holder has to provide its own full contact information, and provide and update accurate technical and administrative contact information adequate to facilitate timely resolution of any problems that arise in connection with the registration. These technical and administrative contacts include the addresses where complaints should be sent regarding such problems.

Acceptance of Liability under RAA Section 3.7.7.3

RAA Section 3.7.7.3 also provides that the Registered Name Holder shall accept liability for harm caused by the wrongful use of the registered name unless the Registered Name Holder promptly identifies the licensee to a party that has provided the Registered Name Holder with reasonable evidence of actionable harm.

Exactly what constitutes "reasonable evidence of actionable harm" or "prompt" identification is not specified in the RAA, and might vary depending on the circumstances. Under the arrangement provided for in RAA 3.7.7.3, if a court (or arbitrator) determines that the Registered Name Holder was presented with what the court considers to be "reasonable evidence of actionable harm" and the court finds that the Registered Name Holder's identification of the licensee was not "prompt," then the court could assign the Registered Name Holder with liability for the harm caused by the wrongful use. It would ultimately be up to a court or arbitrator to assess and apportion liability in light of the promptness of a Registered Name Holder's identification of a licensee. However, by way of guidance, ICANN notes that any delay over five business days in the Registered Name Holder identifying the

[DRAFT] Advisory re: RAA Subsection 3.7.7.3

14 May 2010

Page 3 of 3

licensee would not be "prompt" as that term is used in the RAA. A court (or arbitrator) will also decide whether the documentation presented to the Registered Name Holder met the "reasonable evidence of actionable harm" standard provided for in the RAA, but by way of guidance ICANN notes that, for example, with respect to claims of intellectual property infringement, documentation of ownership of a trademark or copyright, along with documentation showing alleged infringement, should generally constitute reasonable evidence of actionable harm. Also by way of guidance, "reasonable evidence of actionable harm" does not imply a requirement of the filing of a formal process (such as a UDRP complaint, civil lawsuit, or the issuance of a subpoena), but again it will be up to a court or arbitrator to decide whether the evidence presented constitutes "reasonable" evidence.

Conclusion

In summary, if a Registered Name Holder licenses the use of the domain name to a third party, that third party is a licensee, and is not the registrant/Registered Name Holder. A Registered Name Holder that licenses the use of a domain to a third party still has to provide its own contact information (and keep it updated), and also accepts liability for harm caused by the wrongful use of the name unless the Registered Name Holder promptly identifies the licensee to a party providing the Registered Name Holder with reasonable evidence of actionable harm.

RAA 3.7.7.3 Any Registered Name Holder that intends to license use of a domain name to a third party is nonetheless the Registered Name Holder of record and is responsible for providing its own full contact information and for providing and updating accurate technical and administrative contact information adequate to facilitate timely resolution of any problems that arise in connection with the Registered Name. A Registered Name Holder licensing use of a Registered Name according to this provision shall accept liability for harm caused by wrongful use of the Registered Name, unless it promptly discloses the current contact information provided by the licensee and the identity of the licensee to a party providing the Registered Name Holder reasonable evidence of actionable harm.

<http://www.icann.org/en/registrars/ra-agreement-21may09-en.htm> - 3.7.7.3

Attachment C

***Siemens AG v. Joseph Wunsch/Contactprivacy.com*, WIPO Case No. D2006-1248 (Dec. 6, 2006), available at <http://www.wipo.int/amc/en/domains/decisions/html/2006/d2006-1248.html>**



WIPO Arbitration and Mediation Center

ADMINISTRATIVE PANEL DECISION

Siemens AG v. Joseph Wunsch/Contactprivacy.com

Case No. D2006-1248

1. The Parties

The Complainant is Siemens AG, Munich, Germany, represented by Müller Fottner Steinecke, Munich, Germany.

The Respondent is Joseph Wunsch, Panama City Beach, United States of America, and Contactprivacy.com, Toronto, Canada.

2. The Domain Name and Registrar

The disputed domain name <nokia-siemens-networks.com> is registered with Tucows, Inc.

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") by Siemens AG on September 27, 2006, duly authorized by Nokia Corporation against Contactprivacy.com. On September 29, 2006 the Center transmitted by email to Tucows, Inc. a request for registrar verification in connection with the domain name at issue. On October 3, 2006, Tucows, Inc. transmitted by email to the Center its verification response informing that the Respondent was not the current registrant of the domain name and providing the contact details for the administrative, billing, and technical contact. On October 9, 2006, the Center requested the Complainant by email to file an Amendment to the Complaint identifying both the privacy services provider and the individual/entity identified by the Registrar as Respondent. On October 17, 2006 the Complainant sent by email the requested Amendment. The Center verified that the Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the "Policy"), the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules"), and the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the "Supplemental Rules").

In accordance with the Rules, paragraphs 2(a) and 4(a), the Center formally notified the Respondent of the Complaint, and the proceedings commenced on October 24, 2006. In accordance with the Rules, paragraph 5(a), the due date for Response was November 9, 2006. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on November 17, 2006.

The Center appointed Eduardo Machado as the Sole Panelist in this matter on November 23, 2006. The Panel finds that it was properly constituted. The Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Center to ensure compliance with the Rules, paragraph 7.

4. Factual Background

The Complaint is based on the SIEMENS German Registrations No. 2077533, No. 30075283 and No. 39946996, on the SIEMENS International Registration No. 504324, on behalf of Siemens AG, as well as on the NOKIA Community Registrations No. 000323386, No. 002398022 and No. 004035663, on the trademark NOKIA Canadian Registration No. TMA569939, on the trademark NOKIA United States Registration No. 269020, on the trademark NOKIA Finnish Registrations No. 224906 and No. 220980, on behalf of Nokia Corporation.

Siemens AG was established more than 150 years ago, is headquartered in Germany and is one of the world's largest electrical engineering and electronic companies. It provides innovative technologies and comprehensive know-how to customers in 190 countries. The reputation associated with the Complainant's mark is excellent by virtue of the quality of the Complainant's goods and services.

Nokia Corporation was established around 140 years ago, is headquartered in Finland and is the world's largest manufacturer of mobile telephones and. It is active in the areas of telecommunications, multimedia and mobile networks, and operates in more than 50 countries. The reputation associated with this company is excellent by virtue of the quality of its goods and services.

The Respondent registered the domain name <nokia-siemens-networks.com> on June 19, 2006. The domain name was registered on the exact day on which the joint venture between Siemens AG and Nokia Corporation was publicly and officially announced by the two companies.

On June 21, 2006, a warning letter was sent to the Respondent requesting that the domain name <nokia-siemens.networks.com> be cancelled or transferred to the Complainant. The Respondent did not answer to the warning letter. Instead, the Respondent used a domain Whois privacy service, so that the Whois database indicates "Contactprivacy.com" as Registrant of the disputed domain name. On August 9, 2006, a second warning letter was sent by the Complainant to Contactprivacy.com and forwarded by Contactprivacy.com to Joseph Wunsch. The Respondent did not answer the second warning letter.

Instead of responding to the warning letter, the Respondent added on the left hand of the top of the website the notice ("Want to purchase this domain??? Send me an offer") in an attempt to force the two companies to make an offer for purchasing the domain name.

The Nokia Corporation's authorization to the Complaint also includes an authorization to request the transfer of the contested domain name to the Complainant.

Documents attesting the allegations made by the Complainant are attached to the Complaint.

5. Parties' Contentions

A. Complainant

(i) The Complainant argues that Siemens AG is the exclusive owner of the SIEMENS famous trademark and that NOKIA is the exclusive owner of the NOKIA famous trademark.

(ii) The Complainant argues that the disputed domain name <nokia-siemens-networks.com> is identical to its famous trademark SIEMENS, as well as to the Nokia Corporation's famous trademark NOKIA. The addition of the word "networks" to the domain name has a descriptive character, as it merely refers to the future field of business in which Siemens AG and Nokia Corporation will cooperate.

(iii) The Complainant argues that the Respondent has never been one of the representatives or licensees of the companies Nokia and/or Siemens AG. Moreover, the Respondent does not own any mark similar to SIEMENS or NOKIA.

(iv) The Complainant argues finally that the Respondent act in bad faith because the Respondent must have been aware of the famous trademarks NOKIA and SIEMENS. The domain name <nokia-siemens.networks.com> was registered on the exact day the joint venture of SIEMENS AG and NOKIA CORPORATION was publicly and officially announced by the two companies. The Complainant asserts that it is clear that the Respondent has sought to take advantage of Internet users typing the address "www.nokia-siemens-networks.com", when seeking to access information relating to the recently announced joint venture company between Siemens AG and Nokia Corporation.

B. Respondent

The Respondent did not reply to the Complainant's contentions.

6. Discussion and Findings

Although the Respondent did not reply, it is proper for the Panel to examine the Complainant's contentions having regard to both the Policy and the Rules.

The Panel notes that according to the Whois database, Contactprivacy.com is the current registrant of record. The Registrar indicated that Contactprivacy.com corresponds to a Whois privacy shield, and that the actual owner of the domain name is Joseph Wunsch. For this reason, the Panel finds it appropriate for Joseph Wunsch and Contactprivacy.com to both be named as the Respondent in this proceeding.

A. Identical or Confusingly Similar

The Panel finds that the Complainant is correct that the domain name <nokia-siemens.networks.com> is confusingly similar to the Complainant's famous trademark SIEMENS, as well as to Nokia Corporation's famous trademark NOKIA. The addition of the word "networks" to the domain name with the words "Nokia Siemens" is not sufficient to avoid a likelihood of confusion, mainly because "networks" indicates products of the Complainant's field of business in which Siemens AG and Nokia Corporation will cooperate.

Thus, the Panel finds that the first element of the Policy has been met.

B. Rights or Legitimate Interests

The Complainant alleges that the Respondent has no rights or legitimate interest in the domain name at issue as enumerated in paragraph 4(c) of the Policy. The Complainant has made out a *prima facie* case that the Respondent lacks rights and legitimate interests in the domain name <nokia-siemens.networks.com>. The Respondent, by failing to file a Response, did nothing to dispute this contention nor to provide information as to its interests in using the disputed domain name. The fact that the Respondent has made every effort to divert consumers from the Complainant's website by using a confusingly similar domain name, and the Respondent's failure to point to any good faith use, leaves the Panel with the conclusion that the Respondent has no rights or legitimate interests in the disputed domain name.

Thus, the Panel finds that the second element of the Policy has been met.

C. Registered and Used in Bad Faith

The Panel notes the following particular circumstances of this case:

- (i) the Complainant's trademark has a strong reputation and is widely known;
- (ii) the Respondent has provided no evidence whatsoever of any good faith use by it of the disputed domain name, and has not participated in this proceeding even though properly notified thereof;
- (iii) the disputed domain name resolves to a commercial website, through which, the Respondent is misleading Internet users, and improperly capitalizing on the reputation and goodwill established by the Complainant over its history.

In light of these circumstances, the Panel makes the reasonable inference that the Respondent was aware of the Complainant's famous trademark and trade name. The Panel finds that in registering the domain name, the Respondent

likely intended to use the fact that the trademarks SIEMENS and NOKIA have a strong reputation throughout the world and had just announced a joint venture, in order to confuse consumers and to profit from such confusion. The Panel finds that the Respondent has registered and used the disputed domain name within the meaning of paragraph 4(b)(iv) of the Policy.

Thus, the Panel finds that the third element of the Policy has been met.

7. Decision

For all the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the domain name <nokia-siemens-networks.com> be transferred to the Complainant.

Eduardo Machado
Sole Panelist

Dated: December 6, 2006

Attachment D

The John Hopkins Health System Corporation, The John Hopkins University v. Domain Administrator, WIPO Case No. D2009-1958 (Feb. 27, 2009), available at <http://www.wipo.int/amc/en/domains/decisions/html/2008/d2008-1958.html>



WIPO Arbitration and Mediation Center

ADMINISTRATIVE PANEL DECISION

The John Hopkins Health System Corporation, The John Hopkins University v. Domain Administrator

Case No. D2008-1958

1. The Parties

The Complainants are The John Hopkins Health System Corporation and The John Hopkins University, both Baltimore, Maryland, United States of America, represented by Vorys, Sater, Seymour and Pease, LLP, United States of America.

The Respondent is Domain Administrator, Hong Kong, SAR of China.

2. The Domain Name and Registrar

The disputed domain name <johnshopkinsmedicine.com> is registered with Moniker Online Services, LLC.

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on December 19, 2008. On December 23, 2008, the Center transmitted by email to Moniker Online Services, LLC a request for registrar verification in connection with the disputed domain name. On December 23, 2008, Moniker Online Services, LLC transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain name which differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to the Complainants on January 12, 2009 providing the registrant and contact information disclosed by the Registrar, and inviting the Complainants to submit an amendment to the Complaint. The Complainants filed an amended Complaint on January 13, 2009. The Center verified that the Complaint together with the amended Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the "Policy" or "UDRP"), the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules"), and the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the "Supplemental Rules").

In accordance with the Rules, paragraphs 2(a) and 4(a), the Center formally notified the Respondent of the Complaint, and the proceedings commenced on January 15, 2009. In accordance with the Rules, paragraph 5(a), the due date for

Response was February 4, 2009. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on February 9, 2009.

The Center appointed Debrett G. Lyons as the sole panelist in this matter on February 18, 2009. The Panel finds that it was properly constituted. The Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Center to ensure compliance with the Rules, paragraph 7.

4. Factual Background

1. The John Hopkins University was founded in 1876 in Baltimore, Maryland, United States of America.
2. The University's School of Medicine was established in 1893 and the John Hopkins Hospital opened in 1889.
3. Today the University is a leading institution in the teaching of medicine and the training of doctors.
4. The Complainants jointly own the trade mark JOHN HOPKINS which has been registered in a number of jurisdictions.
5. The Complainants jointly claim unregistered trade mark rights in the words JOHN HOPKINS MEDICINE through use and reputation.
6. The Complainants have not authorised the Respondent to use either trade mark, nor to register any domain name incorporating either trade mark.
7. The Respondent is a domain name proxy service company.
8. The disputed domain name was registered on September 6, 2003.
9. A portal website corresponding with the disputed domain name carries links to medical and health care services unconnected with the Complainants.
10. The Complainants petition the Panel to order transfer of the disputed domain name from the Respondent to the Complainants.

5. Parties' Contentions

A. Complainants

The Complainants assert trade mark rights and state that the disputed domain name is legally identical to the common law trade mark JOHN HOPKINS MEDICINE and confusingly similar to the registered trade mark JOHN HOPKINS.

The Complainants allege that the Respondent has no rights or legitimate interests in the disputed domain name.

The Complainants allege that the Respondent registered and used the disputed domain name in bad faith.

The detail of the Complaint is included where necessary in Part 6 of this Decision.

B. Respondent

The Respondent did not reply to the Complainants' contentions.

6. Discussion and Findings

According to paragraph 4(a) of the Policy, a complainant must prove that:

- (i) the domain name is identical or confusingly similar to a trade mark or service mark in which the complainant has rights; and
- (ii) the respondent has no rights or legitimate interests in respect of the domain name; and
- (iii) the domain name has been registered and is being used in bad faith.

A. Identical or Confusingly Similar

On the evidence, there is no doubt that the Complainants have trade mark rights in the words JOHN HOPKINS acquired through both use¹ and registration².

Moreover, applying the principles developed under the Policy which now have wide support, the disputed domain name is confusingly similar to the Complainants' trade mark JOHN HOPKINS. In particular, the gTLD is a trivial; in context with this trade mark, the word "medicine" is descriptive and non-distinctive; and the omission of spaces between the words is inconsequential³.

The Panel accordingly finds that the Complainants have satisfied the first element of the Policy on the basis of rights in the trade mark JOHN HOPKINS and so there is no need to consider what unregistered rights might exist in the trade mark JOHN HOPKINS MEDICINE.

B. Rights or Legitimate Interests

There is no evidence that the Complainants were aware of, or could have reasonably discovered, the identity of the beneficial owner of the disputed domain name. The current consensus of opinion of other panels applying the Policy is that in these circumstances it was appropriate for the Complainants to have proceeded against the proxy service company as the nominated Respondent⁴.

The Complainants have the burden to establish that the Respondent has no rights or legitimate interests in the domain name. Nevertheless, it is well settled that the Complainants need only make out a *prima facie* case, after which the onus shifts to the Respondent to demonstrate rights or legitimate interests⁵.

Notwithstanding the lack of a response to the Complaint, paragraph 4(c) of the Policy states that any of the following circumstances, in particular but without limitation, if found by the Panel to be proved based on its evaluation of all evidence presented, shall demonstrate rights or legitimate interests to a domain name for purposes of paragraph 4(a)(ii) of the Policy:

- (i) before any notice to you of the dispute, your use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a *bona fide* offering of goods or services; or
- (ii) you (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or
- (iii) you are 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.

The Whois data does not support any argument that the Respondent might be commonly known by the disputed domain name. There is no evidence that the Respondent has any trade mark rights in the name, registered or not. The Complainants have stated there to be no relationship between them and the Respondent.

The Respondent does not appear to be using, nor has it presented evidence of any demonstrable preparations to use the disputed domain name in connection with a *bona fide* offering of goods or services. Rather, the Respondent appears to be using the disputed domain name to re-direct Internet users to commercial websites that promote the goods of competitors in the same business as the Complainants. It is established by former decisions under the Policy that such action is not a *bona fide* offering of goods or services, nor is it a legitimate noncommercial or fair use of the domain name⁶.

The Panel finds that the Complainants have established a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name, and that the Respondent in failing to reply has not discharged the onus which fell to

it as a result.

The Panel finds that the Respondent has no rights or legitimate interests in the domain name and so the Complainants have satisfied the second limb of the Policy.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy sets out circumstances which shall be evidence of the registration and use of a domain name in bad faith. They are:

(i) circumstances indicating that you have registered or you have acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of your documented out of pocket costs directly related to the domain name; or

(ii) you have registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that you have engaged in a pattern of such conduct; or

(iii) you have registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your website or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of your website or location or of a product or service on your website or location.

What is noteworthy about paragraphs 4(b)(i)-(iv) of the Policy is that they are cases of both registration and use in bad faith. The Complainants have, *inter alia*, relied specifically on paragraph 4(b)(iv) of the Policy and it is logical to first test the Respondent's actions against that aspect of the Policy.

The Panel has already found the domain name to be confusingly similar to the trade mark JOHN HOPKINS. The Panel finds that the likelihood of confusion as to source is therefore highly likely.

Paragraph 4(b)(iv) also requires an intention for commercial gain. What is required is a finding that it is more likely than not such an intention existed; absolute proof is not required and the Panel is entitled to accept reasonable allegations and inferences set forth in the Complaint as true unless the evidence is clearly contradictory⁷.

The links in question are principally to medical and healthcare services unconnected with the Complainants' services. The Complainants allege that the Respondent was most likely benefitting from pay-per-click revenue resulting from the likely confusion.

On the facts, the Panel finds it more likely than not that the Respondent had the requisite intention for commercial gain. It is abundantly clear that use of a domain name in this same manner is very frequently for commercial gain⁸.

The Panel finds that the Complainants have shown the Respondent's use of the disputed domain name falls under paragraph 4(b)(iv) of the Policy and was therefore used and registered in bad faith.

Accordingly, the Panel finds that the Complainants have satisfied the third and final limb of the Policy.

7. Decision

For all the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the domain name, <johnshopkinsmedicine.com> be transferred to the Complainants.

Debrett G. Lyons

Sole Panelist

Dated: February 27, 2009

¹The University has been responsible for many of the great breakthroughs in modern medicine. Over the years, nineteen of its scientists have been Nobel Prize winners.

²See *State Farm Mutual Automobile Insurance Company v. Periasami Malain*, NAF Case No. FA705262 (“Complainant’s registrations with the United States Patent and Trademark Office of the trademark STATE FARM establishes its rights in the STATE FARM mark pursuant to Policy paragraph 4(a)(i).”); see also *Mothers Against Drunk Driving v. phix*, NAF Case No. FA174052 (finding that the complainant’s registration of the MADD mark with the United States Patent and Trademark Office establishes the complainant’s rights in the mark for purposes of Policy paragraph 4(a)(i)).

³See *Vin Diesel v. LMN a/k/a L.M. Nordell*, NAF Case No. FA804924 finding <vindiesel.com> to be identical to complainant’s mark because “simply eliminat[ing] the space between terms and add[ing] the generic top-level domain (.gTLD) .com’ [is] insufficient to differentiate the disputed domain name from Complainant’s VIN DIESEL mark under Policy 4(a)(i)”.

⁴See, for example, *Mrs. Eva Padberg v. Eurobox Ltd.*, [WIPO Case No. D2007-1886](#) (March 10, 2008); see also *Baylor University v. Domains By Proxy Inc., a/k/a Mark Felton a/k/a Thomas Bassett a/k/a William Bunn a/k/a Fertility Specialists of Dallas a/k/a Becky Chatham a/k/a Amanda Scott a/k/a Nathan Flaga a/k/a Lisa Payne a/k/a Victor Weir III*, NAF Case No. FA1145651 (May 26, 2008).

⁵See *Do The Hustle, LLC v. Tropic Web*, [WIPO Case No. D2000-0624](#); *Hanna-Barbera Productions, Inc. v. Entertainment Commentaries*, NAF Case No. 741828; *AOL LLC v. Jordan Gerberg*, NAF Case No. FA780200.

⁶See, for example, *Bank of America Corporation v. Azra Khan*, NAF Case No. FA124515 (finding that the respondent’s diversionary use of the domain name to <magazines.com> was not a *bona fide* offering of goods or services, was not noncommercial use, and was not fair use); see also *Oki Data Americas, Inc. v. ASD, Inc.*, [WIPO Case No. D2001-0903](#).

⁷See *Vertical Solutions Management, Inc. v. webnet-marketing, inc.*, NAF Case No. FA95095 (holding that the respondent’s failure to respond allows all reasonable inferences of fact in the allegations of the complaint to be deemed true); see also *Talk City, Inc. v. Michael Robertson*, [WIPO Case No. D2000-0009](#) (“In the absence of a response, it is appropriate to accept as true all allegations of the complaint.”).

⁸See *The Vanguard Group, Inc. v. Lorna Kang*, [WIPO Case No. D2002-1064](#) (finding that redirecting users to the website “www.magazines.com” was for commercial gain and was bad faith registration and use); *Ticketmaster Corporation v. Amjad Kausar*, [WIPO Case No. D2002-1018](#) (holding that “[t]he Respondent is clearly acting in bad faith by using the Complainant’s mark to profit in the form of commissions by linking of the Ticketsnow.com Affiliate Program”); *Yahoo! Inc. v. DFI Inc.*, NAF Case No. FA147313 (holding that, because respondent participated in an affiliate program whereby it earned a commission for each user redirected from its infringing site, its ultimate goal was commercial gain and thus it was using the name in bad faith); and *Showboat, Inc. v. Azra Khan*, NAF Case No. FA125227 (redirecting users for a commission is using a confusingly similar domain name for commercial benefit, which is evidence of bad faith).

