

ADMINISTRATIVE PANEL DECISION

The Honorable Ron Paul v. DN Capital Inc., Martha Roberts
Case No. D2013-0371

1. The Parties

Complainant is the Honorable Ron Paul of Lake Jackson, Texas, United States of America, represented by LeClairRyan, United States of America.

Respondent is DN Capital Inc., Martha Roberts of Panama, Panama, represented by Booth Sweet LLP, United States of America.

2. The Domain Name and Registrar

The disputed domain name <ronpaul.org> (the “Domain Name”) is registered with TierraNet d/b/a DomainDiscover (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on February 25, 2013. On February 26, 2013, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On February 26, 2013, the Registrar transmitted by email to the Center its verification response confirming that Respondent is listed as the registrant and providing the contact details.

The Center verified that the 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 Respondent of the Complaint, and the proceedings commenced February 28, 2013. In accordance with the Rules, paragraph 5(a), the due date for Response March 20, 2013. The Response was filed with the Center March 21, 2013.

The Center appointed Christopher S. Gibson, Jeffrey M. Samuels and Frederick M. Abbott as panelists in this matter on April 23, 2013. The Panel finds that it was properly constituted. Each member of 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

Complainant Ron Paul is a former United States of America (hereafter "U.S." or "United States") Congressman and well-known political commentator, serving in the House of Representatives during different periods for the 14th and 22nd Congressional Districts of Texas. He is also a three-time candidate for President of the United States, and a leading spokesperson, in the political field, for issues such as limited government, low taxes, free markets, and monetary policies such as a return to the gold standard for the U.S. currency. Complainant has authored seven books, three of which have been New York Times Best Sellers.

The Domain Name was registered on July 28, 1999.

5. Parties' Contentions

A. Complainant

(1) The Domain Name is Identical to Complainant's Trademark: Complainant contends that he is the owner in the United States of the trademark, RON PAUL. His alleged common law rights in this trademark have arisen by virtue of its use in the United States, including a large volume of sales of his books. In promoting these books, Complainant's publishers have gone to great lengths to emphasize that Complainant is the author, with his name appearing prominently on the cover of each book, and his likeness appearing on the cover of several of them. His success in books sales is evidenced by three of his books being placed on The New York Times Best Seller List. Complainant further contends that an Internet search of the words, "Ron Paul," reveals that Complainant has had substantial amounts of unsolicited media coverage relating to his political campaigns, speeches and articles, as well as television appearances. Complainant argues that the RON PAUL mark has achieved secondary meaning associated with Complainant sufficient to establish common law trademark rights, and that such rights have been recognized in other similarly situated UDRP cases. Complainant further asserts that the Domain Name is identical to the RON PAUL trademark, as it incorporates the mark in its entirety, with the only difference being the addition of the suffix ".org". Complainant thus contends that the requirements of paragraph 4(a)(i) of the Policy are satisfied.

(2) Respondent has No Rights or Legitimate Interest in the Domain Name: Complainant states that Respondent can demonstrate no legitimate purposes for registering the Domain Name. Complainant's alleged RON PAUL trademark has become synonymous with Complainant and his books, articles, public appearances and political commentary. Complainant has no relationship with Respondent and has not authorized Respondent to use the RON PAUL name or mark. There is no suggestion that Respondent is commonly referred to by the name Ron Paul. Correspondence at different times with Respondent identified him as "George R" (his email address) or "Tim Martin". Complainant argues that when a domain name is an individual's full name, evidence that the respondent has a different name is enough to make a *prima facie* showing that the respondent is not commonly known by the domain name. Moreover, there is ample authority in UDRP cases to the effect that registration of a mark by an entity that has no relationship to the mark itself creates a strong presumption that the respondent lacks a legitimate interest in the domain name.

Complainant further states that there is no evidence that Respondent has used the Domain Name in connection with a *bona fide* offering of goods or services. The analysis of this element overlaps with that of the element of bad faith. Complainant notes that when Internet users attempt to access the website linked to the Domain Name <ronpaul.org>, they are directed to the website associated with the domain name <ronpaul.com>. The content posted at the <ronpaul.com> website is identical to that posted at the website linked to the Domain Name. Indeed, both domain names appear to map to the same website. Accordingly, Complainant believes there is a unity of control as well as an agency relationship between the registrant of the <ronpaul.com> domain name and Respondent who is controlling the Domain Name.

In this case, Complainant alleges that Respondent offered to sell the <ronpaul.com> domain name to Complainant for USD 848,000. In response to an email from Complainant's representative inquiring whether

Respondent would sell the <ronpaul.com> domain name, the response stated in relevant part, "Yes, it's currently for sale for USD 848,000. This is for the domain name only and does not include the website or other content..." According to Complainant, Respondent later offered the Domain Name as a "free gift" if Complainant purchased the <ronpaul.com> domain name for USD 250,000. Complainant states that the demanded sale price was exorbitant, far in excess of Respondent's out-of-pocket registration costs and the fair market value, which Complainant appraised at USD 50,000. Complainant alleges that apart from registering the Domain Name, Respondent's only action in regard to the Domain Name was leasing it to a third party for a fee. This shows that Respondent registered the Domain Name (and the related domain name <ronpaul.com>) with the intention of selling them to Complainant for more than out-of-pocket costs.

Complainant also alleges that Respondent is using the Domain Name commercially and thus, is not making legitimate noncommercial or fair use of the domain name. In this case, Respondent is using the Domain Name commercially in four ways: (i) Respondent is leasing the Domain Name to a third-party for a fee; (ii) Respondent has offered to sell the Domain Name for exorbitant prices; (iii) Respondent is selling "Ron Paul" merchandise on the website, including bumper stickers, t-shirts, posters, mugs, speakers, mousepads, shoes, ties, and other gear; and (iv) Respondent is engaged in commercial activity by collecting revenue from third-party advertising displayed on the website. Here, Respondent is not only advertising through the site, but also directly profiting from the Domain Name by selling ownership interests in the Domain Name.

(3) Respondent Registered and is Using the Domain Name in Bad Faith: Complainant contends that Respondent registered and is using the Domain Name in bad faith. Respondent registered the Domain Name in an attempt to force Complainant to pay an amount far in excess of registration costs to obtain the Domain Name. Thus, the Domain Name was registered primarily for the purpose of renting or selling it to Complainant or Complainant's competitors. The asking price of USD 848,000 (now USD 250,000) is far in excess of any out-of-pocket costs related to the Domain Name.

Further, although the Domain Name purports to be linked to a non-commercial fan site, it is clearly a pretext for commercial advantage. The Domain Name is being leased to a third-party who is using it to compete directly with Complainant's merchandise sales. Evidence of bad faith comes from Respondent's registration and use of the Domain Name to intentionally attract Internet users for commercial gain by creating a likelihood of confusion with Complainant's RON PAUL mark. In this case, Respondent must have known of Complainant's famous mark prior to registering the Domain Name. Respondent registered the Domain Name, using Complainant's RON PAUL mark, in order to suggest a connection between the Domain Name and Complainant.

Respondent is also exploiting the Domain Name by leasing it to a third-party for profit that also wishes to commercially gain from the name. Internet users frequently look for a particular product or famous person by entering the name of that product followed by ".com". In this case, such a practice would lead users to Respondent's site, where they would find photos and videos of Complainant, as well as merchandise that is virtually identical to what Complainant sells. There is a high likelihood that users will be confused and believe that Complainant is the website's source, sponsor, or is some way affiliated with, or endorses, the site. If not for the likelihood of confusion, the rental value of the Domain Name would be significantly decreased.

In sum, Complainant urges it would be difficult to imagine a more compelling example of cybersquatting as that represented by Respondent's conduct in this case.

B. Respondent

By way of background, Respondent explains that the original registration for the Domain Name on July 28, 1999, by Donny McIveron on behalf of Complainant, expired on July 28, 2012. On September 13, 2012, the Domain Name was purchased by Customer 13725, who resold it to the Respondent DN Capital Inc. Respondent claims it received the Domain Name on October 30, 2012 and resold it on November 4, 2012 to JNR Corp. ("JNR"), which is stated to be a group of dedicated activists and independent grassroots supporters of Complainant's political ideals. When the Complaint was filed in this case, JNR still had one payment left to make to Respondent to complete its purchase of the Domain Name, so the Whois records for

the Domain Name still listed Respondent as owner. Respondent states that both Respondent and JNR, the current owner of the Domain Name, are joining in the Response in this case.

Upon purchasing the Domain Name, Respondent asserts that JNR redirected its traffic to the site linked to the <ronpaul.com> domain name, which JNR also owns and operates and is a political fan site to promote Complainant, his electoral campaigns and political ideals, and a forum to develop a community of thousands of Ron Paul supporters. The domain name <ronpaul.com> fosters a strong relationship to Complainant and the name Ron Paul among its users.

According to Respondent, in January 2013 Complainant's associates solicited from JNR an offer to purchase <ronpaul.com>. In response, JNR sent Complainant (via his son) a letter offering to sell <ronpaul.com>. JNR alternatively offered to give Complainant the Domain Name, <ronpaul.org>, at no charge:

"[W]e'd like to offer you an alternative domain name, RonPaul.org, for your new website at no cost whatsoever. Please don't use a monstrosity such as "RonPaulsHomePage.com" as is being speculated on the forums. RonPaul.org is an attractive, high quality alternative, and it won't cost you anything. (Other than the annual renewal fee; all domains have to be renewed each year and that costs about \$10 per year.) ... If you'd like to accept RonPaul.org as our free gift please ask your domain manager to contact us for the "AUTH" code for easy transfer. (And kindly inform us through Ronnie who that person is going to be so we can safely transfer the domain.)"

Respondent contends that instead of accepting this gift, Complainant initiated a proceeding on February 9, 2013

Respondent urges that Complainant bears the burden of proof on each element under paragraphs 4(a)(i), (ii), and (iii) of the Policy and that Complainant has failed to satisfy this burden.

(1) Complainant Failed to Establish Rights in a Trademark that is Identical or Confusingly Similar to the Domain Name: Respondent contends that the Domain Name is effectively identical to Complainant's personal name, but Complainant has no registered trademark for his name. Without a registered trademark, Complainant can only satisfy paragraph 4(a)(i) by providing evidence of the accrual of common law trademark rights. However, the name in question needs to be used in trade or commerce as an identifier of goods or services to establish unregistered trademark rights for the purposes of the Policy.

Respondent asserts that merely having a famous name, such as Ron Paul, would not necessarily be sufficient to show common law trademark rights. To successfully assert such rights, the complainant must show that the name has become a distinctive identifier associated with the complainant or its goods or services. Relevant evidence of such "secondary meaning" includes length and amount of sales under the mark, the nature and extent of advertising, consumer surveys and media recognition. Here, Respondent argues that Complainant has not shown secondary meaning. The name "Ron Paul" designates a politician, not a source of goods or commercial services. Complainant presents no evidence of trademark use distinct from its use as the personal name of a politician. A politician's works are not consumer goods or services in the trademark sense. Most politicians do not use their names as source indicators, as trademark law requires; rather, they use their names to raise public awareness about particular issues and often in the context of a political campaign. Thus, according to Respondent, an elected official may claim trademark rights only for works outside his or her elected duties.

Respondent states that Complainant describes himself as "a well-known physician, author, political commentator and public speaker" and that "Ron Paul enjoys a national reputation in the United States as the premier advocate for liberty in American politics today." Respondent agrees with these points, but urges that Complainant has not shown, outside the political sphere, that his name has accrued secondary meaning in commerce for any specific goods or services. While Complainant contends, citing his own affidavit, that "the words 'Ron Paul' have become synonymous with Dr. Paul's political writings and discourse," Respondent responds that no favorable inference can be drawn from a naked allegation of a legal conclusion. Complainant has had substantial amounts of unsolicited media coverage relating to his political campaigns, speeches, articles, and television appearances, and, indeed, some of that coverage has come from

Respondent's website. However, no evidence was furnished with the Complaint indicating that the name was used in these broadcasts or articles, or in any advertising, in a trade or service mark sense.

Respondent recognizes that Complainant has written seven books, each published while he was in Congress, and each adding to Complainant's political renown. But writing books does not make one's name a trademark as the source of those books. According to Respondent, an instructive UDRP case involved the complaint of the late Dr. Turkan Saylan, which was denied in relation to a domain name employing her personal name. Her renown did not come from use in commerce; instead, like Complainant, Dr. Saylan was an esteemed political, medical and humanitarian figure who won numerous prizes and other accolades, and also published numerous books, articles and other scholarly works. Dr. Saylan was not shown to be known for her writings as opposed to her humanitarian works. Likewise, Complainant has not shown that his books' success has accrued to his reputation and name as a commercial, rather than political, source. Because Complainant's name has not demonstrated accrued trademark rights, the Policy does not support transfer of the Domain Name.

(2) Complainant Failed to Make a *Prima Facie* Showing that Respondent Lacks Rights or Legitimate Interests in the Domain Name: Complainant has not disproved Respondent's rights or legitimate interests in the Domain Name. Respondent used the Domain Name in connection with a *bona fide* offering of services since acquiring it in October 2012, promptly selling the Domain Name to JNR, which redirected its traffic to the website linked to <RonPaul.com>, an independent fan site that offers constantly updated news, commentary, and discussions about Ron Paul.

Complainant asserts that Respondent has no legitimate interest in the Domain Name because Complainant has not authorized Respondent to use the RON PAUL name. However, expressing support and devotion to Ron Paul's political ideals, which Respondent shares, is a legitimate interest that does not require Complainant's personal approval. In response to Complainant's contention that registration of a mark by an entity with no relationship to the mark creates a strong presumption of lack of legitimate interest, Respondent urges it is well established that fan sites satisfy the "legitimate interest" prong under the Policy. Respondent's and JNR's fan site fosters a strong relationship to Complainant. Respondent's legitimate interest in the Domain Name is even stronger than the interest supporting fan pages for cultural icons, because Ron Paul's importance is not just cultural but political and ideological. In expounding on that importance, the site to which the Domain Name links contributes to America's political discourse. Political speech is at the core of what the First Amendment is designed to protect. Respondent's website is a public service that receives the highest deference under U.S. constitutional standards. Because of that status, and the significant investment that Respondent, JNR and the public have made in developing the political discourse at Respondent's site, Respondent's rights override the minimal commercial value of the Domain Name in a case like this. Complainant mischaracterizes the site to which the Domain Name links as "primarily a pretext for commercial advantage." Nothing but Complainant's rhetoric supports that false claim.

Respondent asserts that it not only offers *bona fide* services as indicated above; it also uses the Domain Name in connection with a *bona fide* offering of merchandise that promotes Ron Paul, his candidacy for public office, and his message since April 2009. Items available for purchase at the site associated with the Domain Name contain supportive messages such as: "RON PAUL REVOLUTION"; "RON PAUL FOR PRESIDENT 2012"; and "I SUPPORT RON PAUL." The forum is primarily a noncommercial service and the products advertised and sold are ancillary to the website's primary purpose as a political forum. Some UDRP panels have recognized that a degree of incidental commercial activity may be permissible in certain circumstances (*e.g.*, where such activity is of an ancillary or limited nature or bears some relationship to the site's subject). Complainant has an interest in such publicity and his agents have expressed gratitude for the Respondent's exposure and support. Thus, Respondent has established a legitimate interest in the Domain Name by its connection with a *bona fide* offering of goods.

Respondent contends that legitimate interests are also demonstrated by Respondent and JNR making a legitimate noncommercial or fair use of the Domain Name, without intent for commercial gain to misleadingly divert customers or to tarnish the trademark. The question of fair use is "in the alternative" to a noncommercial use. Thus, even a commercial use that is also "fair" will satisfy paragraph 4(c)(iii) of the Policy. Respondent uses the Domain Name for a forum for political discourse about Ron Paul. Even if

Complainant had rights in a RON PAUL trademark, Respondent asserts its use is a nominative fair use because Respondent and JNR are using the trademark to refer to the trademarked goods and services, and they need to use the mark in order for Internet users to understand the goods to which they are referring. In addition to a political forum, the website has a store that features accessories and apparel that voice a political message promoting Ron Paul.

Respondent asserts that Complainant offers no evidence to substantiate its allegations that Respondent has made any commercial use of the Domain Name, based on either non-party offers or advertising or merchandise on a third-party website. To the contrary: JNR (not Respondent) offered to give (not sell) the Domain Name, <ronpaul.org>, to Complainant with no strings attached. Respondent redirects its traffic to <ronpaul.com> but has no share in any profits from advertising or merchandise sales generated by the website linked to that domain name. Respondent argues the even if it did profit from use of the Domain Name, this does not prevent establishing a nominative fair use defense, as that defense is not dependent on whether Respondent profits. Even if sales of political accessories and apparel constitute "commercial" activity, those offerings are ancillary to the active and widely used political forum on the website linked to <ronpaul.com>. Any "commercial" component to that website does not diminish Respondent's legitimate interest. But even assuming the offerings are both "commercial" and more than ancillary to the primary function of the website as a forum for political discourse, the sale of merchandise is nonetheless a nominative fair use under the Policy and meets the criteria for a nominative fair use as stated in a number of UDRP cases. First, the website to which the Domain Name links is offering goods and services that promote Ron Paul. Second, the site sells only goods that promote Ron Paul. Third, the site goes far to dispel any confusion that Complainant might have a relationship to the website, including, among other distinguishing features, (1) a header graphic atop every page that explicitly identifies <ronpaul.com> as a "Fan Site"; (2) an express disclaimer at every page's footer that declares, "This website is maintained by independent grassroots supporters. It is not paid for, approved or endorsed by Ron Paul."; (3) another express disclaimer in the sidebar on every page; (4) a contact page, which reiterates in bold letters, "RonPaul.com is a grassroots-run 'Fan Site'--we have no direct contact with Ron Paul"; and (5) several means to contact Complainant through his campaign website, with repeated emphasis that Respondent's website "is not paid for, affiliated with, or endorsed by Ron Paul."

Finally, there is no evidence that Respondent or JNR has attempted to "corner the market" of domain names to prevent Complainant from reflecting his alleged mark in a domain name. Respondent acquired the Domain Name when a prior owner's rights lapsed, then immediately sold <ronpaul.org> to JNR, which offered to give Complainant this Domain Name unconditionally. Only Complainant's willful misreading of that offer suggests that anyone "offered <RonPaul.org> as a 'free gift' to Complainant if Complainant purchased <RonPaul.com> for \$250,000." No contrary evidence suggests that Respondent has attempted to prevent Complainant from reflecting his alleged mark in a domain name, despite the Complaint's wholly unsupported allegations. Complainant has alleged that "Respondent's agent offered to sell <RonPaul.com> to Complainant for \$848,000." Apparently the prior owner of <ronpaul.com>, unrelated non-party WKF Corp., offered to sell that domain name to Complainant in January 2011 -- at which time Complainant still controlled <ronpaul.org>. WKF Corp. is not the agent of Respondent or JNR. Respondent never owned the domain name <ronpaul.com> or purported to offer to sell it (or the Domain Name <ronpaul.org>) to Complainant.

Respondent has never intended to misleadingly divert consumers. As discussed above, the website offers multiple prominent disclaimers. Nor did Respondent or JNR intend to "tarnish" Complainant or his alleged trademark.

(3) The Domain Name was Not Registered, and is not Being Used, in Bad Faith: Complainant has not shown that Respondent acquired the Domain Name primarily for the purpose of selling it. Upon acquiring the Domain Name, Respondent immediately sold it to JNR, which directed the Domain Name's traffic to its <ronpaul.com> website supporting and promoting Complainant. Three months later JNR offered to give the Domain Name to Complainant, for free, without being asked. This generosity does not suggest that Respondent or JNR had any bad faith in registering or using the Domain Name.

After JNR acquired the Domain Name and the <ronpaul.com> domain name, Complainant stated in a radio interview on January 9, 2013, "Unfortunately, I didn't have RonPaul.com, so I'm going to have to have

RonPaulsHomepage.com.” Soon after, several supporters and agents of Complainant emailed Respondent to urge some sort of sale or transfer of the domain name <ronpaul.com>. When JNR offered to sell that domain name to Complainant, it alternatively offered to give Complainant the <ronpaul.org> Domain Name for free. Complainant then initiated this proceeding, which perversely depicts JNR’s genuine gift offering as evidence of bad faith.

Even evidence of offering to sell a domain name is insufficient to amount to bad faith under the Policy, because the domain name must be registered primarily for the purposes of selling it to the owner of trademark for an amount in excess of out-of-pocket expenses. Similarly, there is no evidence that Respondent has engaged in a pattern of preventing Complainant from using his alleged mark in a domain name. Indeed, JNR offered to give Complainant the Domain Name free of charge, and attempted to facilitate Complainant’s acquisition of <ronpaul.com>, having secured the domain names to keep them within the Ron Paul community when Complainant showed no interest in doing so for himself. Complainant asserts that “Respondents’ agent offered to sell the domain name to Complainant for an exorbitant amount of money.” Zero is not exorbitant. An offer to give the Domain Name to Complainant for free negates any possible inference of bad faith, as does the use of a *bona fide* free speech website. As a general proposition, the same facts establishing fair use and the exercise of free speech negate a finding of bad faith intent. By submitting evidence that the Domain Name is being used in connection with a free speech website, Respondent has effectively foreclosed Complainant’s ability to prove bad faith. For the foregoing reasons, Respondent has established its good faith use.

Respondent and JNR are not competitors with Complainant. Complainant offers no support for its contention that the Domain Name may lead Internet users to merchandise that is virtually identical to what Complainant sells. Complainant only supplies evidence that he sells books, while JNR’s <ronpaul.com> store offers accessories and apparel. No evidence suggests that Respondent or JNR acquired the Domain Name primarily to disrupt Complainant’s campaigns or causes. Complainant’s misperception that he is competing with Respondent is not evidence of bad faith.

UDRP panels have frequently found good faith use where the respondent used the domain name for a fan site. Complainant worries that some individuals may browse to the Domain Name and “find photos and videos of Complainant [producing] a high likelihood that users will be confused and believe that Complainant is the website’s source, sponsor, or is some way affiliated with or endorses the website.” This argument is overboard, sweeps against all fan sites generally, and has been rightly rejected. The prominent disclaimers on every page of the <ronpaul.com> website make Complainant’s claims of potential confusion unsustainable. Redirecting traffic to an unendorsed site does not show bad faith.

Finally, Respondent urges that the Complaint should be dismissed because this dispute is beyond the scope of the UDRP. UDRP proceedings are limited in scope and dismissal is appropriate where the complaint does not address the narrow area of abusive domain name registrations. By contrast, Respondent contends that the real reason for the filing of this Complaint is that Complainant would now like to force Respondent to give up the fan site so that Complainant can use it himself. That is not the purpose of the UDRP.

Complainant concluded his argument saying, “[I]t would be difficult to imagine a more compelling example of cybersquatting as that represented by Respondent’s conduct here.” However, Respondent is not a cybersquatter, but a spurned supporter. In this UDRP proceeding, Ron Paul has acted much like the people he routinely condemns in political speeches and interviews. He launched an unprovoked, unilateral action against his supporters instead of engaging in diplomacy and free-market negotiations. He availed himself of WIPO, a United Nations agency, after condemning, opposing, and working against the international body throughout his career. He misappropriated and misrepresented Respondent’s confidential letter, instead of respecting the sanctity of private communications and encouraging voluntary interaction between individuals. The Panel should reject Complainant’s misuse of the Policy.

(4) Reverse Domain Name Hijacking: Respondent requests, based on the evidence presented, that the Panel make a finding of Reverse Domain Name Hijacking. Complainant was offered the Domain Name for no charge, with no strings attached, as shown in a letter annexed to its own Complaint. Instead of accepting graciously, Complainant brought this proceeding in bad faith. A finding of Reverse Domain Name Hijacking is appropriate to redress this abuse of the administrative proceeding.

6. Discussion and Findings

As has been recited in many UDRP decisions, in order to succeed in its claim, Complainant must demonstrate that the three elements enumerated in paragraph 4(a) of the Policy have been satisfied. These elements are that:

- (i) the Domain Name registered by Respondent is identical or confusingly similar to a trademark or service mark in which Complainant has rights;
- (ii) Respondent has no rights to or legitimate interests in respect of the Domain Name; and
- (iii) Respondent has registered and is using the Domain Name in bad faith.

A. Identical or Confusingly Similar

Complainant claims common law trademark rights in his name, RON PAUL, and that the Domain Name is identical to this mark. Respondent acknowledges that the Domain Name is effectively identical to Complainant's name, but contests whether Complainant has acquired unregistered trademark rights.

In order to establish common law trademark or service mark rights in a personal name, it is necessary for the party asserting such rights to demonstrate that the name has been used to identify goods or services in commerce, and that the public associates the personal name with a good or service provided by the person identified by the name. See *Mercury Radio Arts, Inc. and Glenn Beck v. Isaac Eiland-Hall*, WIPO Case No. D2009-1182. Complainant has provided evidence of sales of his seven books, three of which made The New York Times Best Seller List. In promoting these books, Complainant asserts that his publishers emphasized that Complainant was the author, with his name appearing prominently on the cover of each book and his likeness appearing on several of them. Complainant has also received substantial amounts of unsolicited media coverage relating to his political campaigns, speeches and articles, as well as television appearances. There is also some evidence that he is currently doing a radio show. By virtue of these activities, Complainant contends that the RON PAUL mark has achieved secondary meaning associated with Complainant sufficient to establish common law trademark rights.

As discussed above, Respondent asserts that being famous is not necessarily sufficient to demonstrate common law trademark rights. Moreover, Complainant has not shown, outside the political sphere, that his name has acquired secondary meaning in commerce for any specific goods or services. While Respondent recognizes that Complainant has written seven books, each of which was published while he was in Congress, Complainant has not shown that his books' success has accrued to his reputation and name as a commercial, rather than political, source. Hence, Respondent maintains that the name "Ron Paul" designates a politician, not a source of goods or commercial services. See, e.g., *Convergència Democràtica de Catalunya v. ar mas*, WIPO Case No. DTV2003-0005 (denying complaint where the complainant's personal name "is used in a political context, but not in commerce to distinguish goods or services").

The Panel considers that it is not necessary to reach the question of whether Complainant has acquired common law trademark rights in his personal name. The Panel recognizes that Complainant very recently retired from his position as a Congressman and signed with the speakers' bureau, the Greater Talent Network. Thus, this question of common law rights in his name might further evolve over time. However, the Panel determines that it is appropriate to decide this case on other grounds, as discussed below.

B. Rights or Legitimate Interests

The overall burden of proof on this element rests with Complainant. However, it is well established that once a complainant establishes a *prima facie* case that a respondent lacks rights or legitimate interests in a domain name, the burden shifts to respondent to rebut complainant's contentions.

Here, Complainant's *prima facie* showing included the following submissions: (i) confirming that

Complainant has no relationship with Respondent, did not authorize Respondent to use the “Ron Paul” name or mark, and that Respondent is not commonly referred to by the name “Ron Paul”; (ii) contending that Respondent registered the Domain Name primarily for the purpose of selling it to Complainant for consideration in excess of Respondent’s out-of-pocket expenses, supported by evidence that Respondent offered to sell the <ronpaul.com> domain name to Complainant for a very high price; and (iii) evidence that Respondent is using the Domain Name commercially and thus, is not making legitimate noncommercial or fair use of it. In particular, that Respondent uses the Domain Name commercially in four ways, by leasing the Domain Name to a third-party for a fee, by offering to sell it for exorbitant prices, by selling “Ron Paul” merchandise on the website linked to the Domain Name, and by collecting revenue from third-party advertising.

The Policy enumerates several ways in which a respondent may rebut a complainant’s *prima facie* showing and demonstrate rights or legitimate interests. 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 Respondent’s rights or legitimate interests in the 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.” (Policy, paragraph 4(c))

Respondent relies on a number of grounds included paragraphs (i) and (iii) above to successfully rebut Complainant’s submissions and to establish its rights or legitimate interests in the Domain Name. Respondent explains that it used the Domain Name in connection with a *bona fide* offering of services since acquiring it in October 2012, promptly selling the Domain Name to JNR, which redirected its traffic to the website linked to <ronpaul.com>, an independent fan site that offers constantly updated news, commentary, and discussions about Ron Paul.

At the core of Respondent’s arguments are two points: First, Respondent has used the Domain Name to link it to an independent and legitimate fan site. As Respondent puts it, expressing support and devotion to Ron Paul’s political ideals is a legitimate interest that does not require Complainant’s authorization or approval. Moreover, Respondent’s legitimate interest in the Domain Name is strong because the site provides a place for political speech, which is at the heart of what the United States Constitution’s First Amendment is designed to protect. In this way, the Panel is persuaded by Respondent’s arguments and evidence that Respondent is making a legitimate noncommercial or fair use of the Domain Name, without intent for commercial gain to misleadingly divert consumers or to tarnish any trademark at issue. Moreover, Respondent has submitted evidence that there are multiple, very clear disclaimers on the website to which the Domain Name links, indicating that the site is not Complainant’s official site. In regards to Complainant’s arguments that the website is actually a “pretext for commercial advantage”, the Panel finds the website linked to the Domain Name is primarily a noncommercial service, while the products advertised and sold are ancillary to the site’s primary purpose as a source of news and information about Ron Paul, and serving as political forum. Moreover, Respondent’s use meets the criteria for a nominative fair use, as stated in a number of UDRP cases. See *National Association for Stock Car Auto Racing, Inc. v. Racing Connection / The Racin’ Connection, Inc.*, WIPO Case No. D2007-1524 (applying the factors set out in *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. D2001-0903). The website is offering goods and services that promote Ron Paul and sells only goods that promote Ron Paul. The site goes far to dispel any confusion that Respondent or JNR might have a relationship to Complainant, including use of multiple, prominently placed disclaimers. Finally, related to Respondent’s second main point, there is no evidence that Respondent has attempted to corner the market of domain names to prevent Complainant from reflecting his alleged RON PAUL mark in a domain name. To the contrary, the evidence indicates that in 2013 Respondent offered to give Complainant the <ronpaul.org> Domain Name for free. As discussed above,

Respondent and JNR made the following offer:

“[W]e’d like to offer you an alternative domain name, RonPaul.org, for your new website at no cost whatsoever.... RonPaul.org is an attractive, high quality alternative, and it won’t cost you anything. (Other than the annual renewal fee; all domains have to be renewed each year and that costs about \$10 per year.) ... If you’d like to accept RonPaul.org as our free gift please ask your domain manager to contact us for the “AUTH” code for easy transfer. (And kindly inform us through Ronnie who that person is going to be so we can safely transfer the domain.)”

The Panel thus determines that Respondent has, in the present circumstances, established that it is engaged in legitimate noncommercial or fair use of Complainant’s personal name in the Domain Name.

Because Complainant necessarily fails to prove that Respondent’s conduct runs afoul of all three required elements under the Policy, the Panel need not further address the element of bad faith registration and use. The Panel notes, however, that the combination of political speech engaged in by Respondent, the substantial lack of commercial intent, and the offer by Respondent to provide the Domain Name to Complainant for free, makes it unlikely to this Panel that Complainant would have succeeded in demonstrating bad faith registration and use (*Mercury Radio Arts, Inc. and Glenn Beck v. Isaac Eiland-Hall*, WIPO Case No. D2009-1182).

7. Reverse Domain Name Hijacking

Respondent has requested, based on the evidence presented, that the Panel make a finding of Reverse Domain Name Hijacking. In view of the unique facts of this case, in which the evidence demonstrates that Respondent offered to give the Domain Name <ronpaul.org> to Complainant for no charge, with no strings attached, the Panel is inclined to agree. Instead of accepting the Domain Name, Complainant brought this proceeding. A finding of Reverse Domain Name Hijacking seems to this Panel to be appropriate in the circumstances.

8. Decision

For the foregoing reasons, the Complaint is denied.

Christopher S. Gibson
Presiding Panelist

Jeffrey M. Samuels
Panelist

Frederick M. Abbott
Panelist
Date: May 11, 2013