

ADMINISTRATIVE PANEL DECISION

The Honorable Ron Paul v. Whois Privacy Services Pty Ltd / JNR Corp
Case No. D2013-0278

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 Whois Privacy Services Pty Ltd of Fortitude Valley, Australia / JNR Corp of Panama, Panama, represented by Booth Sweet LLP, United States of America.

2. The Domain Name and Registrar

The disputed domain name <ronpaul.com> (the "Domain Name") is registered with Fabulous.com (the "Registrar").

3. Procedural History

The Complaint concerning the domain names <ronpaul.com> and <ronpaul.org> was filed with the WIPO Arbitration and Mediation Center (the "Center") on February 8, 2013. On February 8, 2013, the Center transmitted by email to the concerned registrars a request for registrar verification in connection with the domain names <ronpaul.com> and <ronpaul.org>. On February 8 and 10, 2013, the concerned registrars transmitted by email to the Center their verification responses, disclosing registrant and contact information for the domain names which differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to Complainant on February 14, 2013, providing the registrant and contact information disclosed by the concerned registrars, and inviting Complainant to file a separate Complaint for one of the domain names, and file a short amendment to drop said separately-filed domain name from the Complaint; or to provide the Center with a brief amendment to the Complaint, adding the names of both registrar-disclosed registrants as formal Respondents and demonstrating that both registrants are the same entity. Complainant filed a "Request to Amend Complaint" on February 19, 2013 requesting to remove the domain name <ronpaul.org> from the proceeding, and subsequently an Amended Complaint on February 25, 2013.

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

The Center acknowledged receipt of an Amicus Curiae submission on February 14, 2013 from L. Johnstone, noting that any consideration of this submission would be solely in the discretion of the Panel. In accordance with the Rules, paragraph 10(d), it is the responsibility of the Panel to determine the admissibility, relevance, materiality and weight of any evidence. The Panel has determined that it will not include consideration of this Amicus Curiae submission in its assessment of the instant case, because the submission does not possess sufficient relevance to the issues in dispute.

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.

In February 2008, Respondent obtained from a third-party company, WKF Corp., a lease of the Domain Name with an option to purchase it. In May 2008, after Senator McCain clinched the Republican nomination, Respondent launched its own website using the Domain Name. Respondent exercised the option to purchase the Domain Name in May 2011.

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 ".com". 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. Moreover, bad faith can be shown under the Policy where a respondent registers a domain name primarily for the purpose of selling it to the trademark owner or to be a competitor for consideration in excess of respondent's out-of-pocket expenses. Here, Complainant alleges that Respondent offered to sell the Domain Name to Complainant for USD 848,000. In response to an email from Complainant's representative inquiring whether Respondent would sell the Domain Name, the response stated in relevant part, "Yes, it's currently for sale for \$848,000. This is for the domain name only and does not include the website or other content..." According to Complainant, Respondent later offered to sell the Domain Name to Complainant for USD 250,000 and to provide the domain name <ronpaul.org> as a "free gift" with the purchase of the Domain Name. Complainant states that the demanded sale price was exorbitant, far in excess of Respondent's out-of-pocket registration costs and the Domain Name's 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.org>) 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 three 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; and (iii) Respondent is selling "Ron Paul" merchandise on the website, including bumper stickers, t-shirts, posters, mugs, speakers, mousepads, shoes, ties, and other gear, as well as advertising on the site. 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 used to sell Ron Paul merchandise by third-party vendors competing directly with Complainant. It is well-established under the UDRP that registration of a domain name that is confusingly similar to a famous trademark by an entity that has no relationship to that mark is itself sufficient evidence of bad faith registration and use. 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 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

Respondent, JNR Corp., describes itself as a group of dedicated activists and independent grassroots supporters of Complainant’s political ideals. Respondent claims that over the last five years, using the Domain Name, it expended over USD 120,000 and thousands of hours to build a political fan site to promote Complainant, his electoral campaigns, his political ideals, and a forum to develop a community of thousands of Ron Paul supporters.

According to Respondent, the Domain Name was first registered on November 13, 2000 by a third-party named Ron Paul (not the Complainant). When Complainant announced his candidacy for President in 2007, this third-party offered to sell the Domain Name to Complainant. Complainant’s campaign asked the third-party to “donate” it instead. The third-party sold the Domain Name on eBay on January 30, 2008 to WKF Corp. for USD 25,000. Respondent asserts that Complainant was aware of the auction but chose not to bid. In February 2008, Respondent obtained from WKF Corp. a lease with an option to purchase the Domain Name. On taking control of the Domain Name, Respondent directed all Internet traffic to Complainant’s official campaign website at <ronpaul2008.com>. In May 2008, after Senator McCain clinched the Republican nomination, Respondent launched its own website, providing blog posts and political discussions, focused primarily on interviews with, writings by, and articles about Complainant. Respondent states that it has taken the Domain Name from an empty domain to a website that includes 2,187 blog posts (including videos, articles, columns and commentaries), and more than 325,000 comments (forum posts) by users. It has significant user traffic, averaging 390,000 page loads and 248,000 unique visitors per month. Respondent exercised its option to purchase the Domain Name in May 2011. In 2013, Complainant solicited and rejected an offer to purchase the Domain Name from Respondent, instead initiating this proceeding.

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 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 states that it is a group of committed activists and independent grassroots supporters of Complainant’s political ideals. Respondent’s use of the Domain Name is grounded in its rights and legitimate interests therein. Respondent used the Domain Name in connection with a *bona fide* offering of services long before receiving notice of this dispute. In February 2008, when Respondent began leasing the Domain Name, Respondent immediately redirected its traffic to Complainant’s official Presidential campaign website. In May 2008, after Senator John McCain clinched the Republican nomination, Respondent launched its own website as an independent fan site, and ever since has offered 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 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 associated with the Domain Name 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 both Respondent 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 Respondent’s site 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 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 is using the trademark to refer to the trademarked goods and services, and Respondent needs to use the mark in order for Internet users to understand the goods to which Respondent is 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. However, Respondent argues the fact that it may profit from use of the Domain Name 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. Any "commercial" component to the 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.

Respondent's use clearly meets the criteria for a nominative fair use as stated in a number of UDRP cases. First, Respondent 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 has attempted to "corner the market" of domain names to prevent Complainant from reflecting his alleged mark in a domain name. To the contrary, in 2008, Respondent offered to relinquish its option to buy the Domain Name. In 2013, Respondent offered to give Complainant the <ronpaul.org> domain for free. Respondent never offered either domain name for sale to anyone other than Complainant, and never offered them to Complainant until Complainant's associates and family members solicited Respondent to make an offer.

Respondent has put significant investments of labor, time and money into the site associated with the Domain Name. Nonetheless, Respondent offered the Domain Name to Complainant for almost USD 600,000 less than the prior owner's offer. In a classic bait-and-switch, after Complainant's associates asked Respondent to offer to sell the Domain Name, the Complaint construes the offer as evidence of bad faith. Respondent has made repeated good faith efforts to facilitate or negotiate an agreement to transfer the Domain Name to Complainant. No contrary evidence suggests that Respondent has attempted to prevent Complainant from reflecting his alleged mark in a domain name.

Respondent has never intended to misleadingly divert consumers. As discussed above, Respondent's

website offers multiple prominent disclaimers. Nor did Respondent, a devoted supporter despite this proceeding, intend to “tarnish” Complainant or his alleged trademark. To the contrary, Complainant’s inner circle showed gratitude for the benefits Respondent’s political fan site bestowed.

(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. Respondent’s consistent use of the Domain Name since February 2008 to broaden the reach of Complainant’s message does not suggest that Respondent’s purpose (primary or otherwise) was to profit from its sale. As Complainant admits, Respondent did not initiate contact with Complainant to sell the Domain Name. Complainant’s intermediaries contacted Respondent at least three times before Complainant made an offer. The first solicitation came in May 2008 from Jeff Frazee, national youth coordinator for Complainant’s 2008 presidential campaign. Respondent informed Frazee of its lease and purchase option arrangement and stated, “we will gladly step back from our option and you could work out a deal with WKF Corp.” On April 16, 2010, Complainant’s political director and grandson-in-law solicited another offer. Again, Respondent informed Complainant’s operative that Respondent did not (then) own the Domain Name. Respondent checked with the owner WKF, and offered to forward WKF’s response to Complainant’s operative. On January 11, 2011, Complainant’s representative Chris Younce emailed WKF to ask for an offer. WKF offered the domain for USD 848,000. Younce declined, citing “a GoDaddy appraisal that puts [the price] significantly less than that.”

In May 2011, Respondent exercised its option to purchase the Domain Name from WKF. Nearly two years later and five years after Respondent began operating the 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. Between January 9 and 12, 2013, several of Complainant’s associates asked Respondent to make an offer to sell. Respondent offered to sell the Domain Name, plus a mailing list of 170,000 names, to Complainant for USD 250,000. Alternatively, Respondent offered to give Complainant another domain name, <ronpaul.org>, for free. Complainant’s only counteroffer was this proceeding, in which he depicts Respondent’s solicited, genuine offer as evidence of bad faith.

Evidence that Respondent offered the Domain Name for sale is not compelling because Respondent only considered selling the Domain Name after being contacted by Complainant, who requested an offer from Respondent. Furthermore, 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 purpose of selling it to the owner of trademark for an amount in excess of out-of-pocket expenses. Respondent’s use of the Domain Name since February 2008 demonstrates Respondent neither leased nor purchased it primarily to transfer it. Therefore, Complainant cannot show that Respondent registered the Domain Name in bad faith. Similarly, there is no evidence that Respondent has engaged in a pattern of preventing Complainant from using his alleged mark in a domain name. Respondent offered to give Complainant <ronpaul.org> free of charge, and attempted to facilitate Complainant’s acquisition of the Domain Name, 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 “the domain name is being leased to a third party who is in competition with Complainant.” Respondent and Complainant are not competitors; Complainant supplies no evidence that he sells anything but books, while Respondent’s store offers accessories and apparel. All evidence suggests that Respondent acquired the Domain Name primarily to aid, not disrupt, Complainant’s campaign and causes. Complainant’s misperception that he is competing with Respondent is not evidence of bad faith.

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 Respondent’s website make Complainant’s claims of potential confusion unsustainable.

Redirecting traffic to an unendorsed site does not show bad faith. In fact, the evidence indicates that Complainant did endorse Respondent's website. At least twice, Complainant's confederates sent Respondent accolades for his contribution to the campaign. UDRP panels generally consider this as strong evidence against a finding of bad faith. The evidence against bad faith is especially strong when Complainant acquiesced in Respondent's use of the Domain Name for five years.

Respondent's free speech website has never shown bad faith. 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 the Complainant's ability to prove bad faith." For the foregoing reasons, Respondent has established its good faith use.

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

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 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 three ways, by leasing the Domain Name to a third-party for a fee, by offering to sell it for exorbitant prices, and by selling "Ron Paul" merchandise on the website linked to the Domain Name.

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 paragraphs (i) and (iii) above to successfully rebut Complainant's submissions and to establish its rights or legitimate interests in the Domain Name. Respondent first explains that although it initially leased the Domain Name from a third-party commencing in 2008, it has owned the Domain Name since May 2011. There is no other evidence in relation to the issue of leasing the Domain Name to any third-party, as alleged by Complainant.

At the core of Respondent's arguments is that, well before the dispute arose, Respondent has been operating an independent and legitimate fan site linked to the Domain Name. At least from May 2008, when Respondent launched its fan site, the evidence indicates that Respondent has offered updated news, commentary, and discussions about Ron Paul, while serving as a forum for his followers. 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 its website to indicate that the site is not Complainant's official site. In regards to Complainant's arguments that Respondent's site is actually a "pretext for commercial advantage", the Panel finds Respondent's website 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 *Okidata Americas, Inc. v. ASD, Inc.*, WIPO Case No. D2001-0903). Respondent 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 might have a relationship to Complainant, including use of multiple, prominently placed disclaimers. Finally, 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 2008, Respondent offered to relinquish its option to buy the Domain Name. More recently, in 2013 Respondent offered to give Complainant the <ronpaul.org> domain name for free.

Complainant has alleged 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. However, the evidence of use of the Domain Name from May 2008 as a legitimate fan site indicates otherwise. It is clear that Complainant solicited the offer, which it finally received from Respondent in January 2013, through repeated entreaties over the years. While finally offering the Domain Name (plus a mailing list of 170,000 names) to Complainant for USD 250,000, Respondent also offered, alternatively, to provide Complainant with the <ronpaul.org> domain name for free. Finally, it is evident that Respondent has never attempted to sell the Domain Name to any third party, but instead has invested a good deal of time and energy to develop the website linked to the Domain Name.

On the whole, the Panel views Respondent's website as a legitimate fan site that does not seek to take unfair advantage of Complainant. 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. While there is evidence that Respondent may have earned income on sales of apparel and accessories promoting Ron Paul, the Panel does not believe this is sufficient commercial activity to change the balance of interests already addressed. See *Mercury Radio Arts, Inc. and Glenn Beck v. Isaac Eiland-Hall*, WIPO Case No. D2009-1182.

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 and the

substantial lack of commercial intent 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. Decision

For all the foregoing reasons, the Complaint is denied.

Christopher S. Gibson
Presiding Panelist

Jeffrey M. Samuels
Panelist

Frederick M. Abbott
Panelist
Date: May 8, 2013