



WIPO Arbitration and Mediation Center

ADMINISTRATIVE PANEL DECISION

Newell Operating Company v. HostMonster.Com and Andrew Shalaby

Case No. D2008-1805

1. The Parties

The Complainant is Newell Operating Company of Freeport, Illinois, United States of America, represented by Frost Brown Todd LLC, United States.

The Respondents are HostMonster.Com of Orem, Utah, United States of America and Andrew Shalaby / Bernzomatic Litigation Support, of El Cerrito, California, United States, represented by Alan J. Gould, of United States (from February 27, 2009).

2. The Domain Name and Registrar

The disputed Domain Name <bernzomaticinjuries.com> is registered with FastDomain Inc.

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on November 21, 2008. On November 24, 2008, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On December 3 and 12, 2008, the Registrar transmitted by email to the Center its verification response confirming that the Respondent HostMonster.Com is an affiliate or alter ego of the Registrar and is listed as the registrant. The Registrar also furnished information on the "customers contact" for the Domain Name, the Respondent Andrew Shalaby. The Center sent an email communication to the Complainant on December 15, 2008 providing the registrant and additional contact information furnished by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed the amended Complaint on December 22, 2008. 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 Respondents of the Complaint, and the proceedings commenced on December 30, 2008. In accordance with the Rules, paragraph 5(a), the due date for Response was January 19, 2009. The Respondent Andrew Shalaby filed a number of submissions with the Center between January 15 and February 9, 2009 regarding a concurrent legal proceeding between the parties before the federal court in San Francisco, California, United States.

On February 28, 2009, the Respondent advised that he would be represented in the matter by Alan J. Gould.

The Center appointed W. Scott Blackmer as the sole panelist in this matter on January 22, 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

The Complainant is a corporation organized under the laws of the state of Delaware and based in Freeport, Illinois, United States. The Complainant’s affiliates manufacture handheld propane torches and gas cylinders, fire extinguishers, charcoal grills, hand tools, and other devices.

Otto Bernz founded one of the Complainant’s predecessor companies in 1876. The record indicates that the Complainant, or its affiliates and predecessors, have advertised and sold gas torches and cylinders throughout North America under the BERNZ O MATIC mark since 1954. The Complainant holds United States of America trademark registration number 759059 for the standard-character BERNZ O MATIC mark (registered October 29, 1963), as well as several registered design marks prominently featuring the name “Bernz O Matic”. The Complainant operates a website concerning its products at “www.bernzomatic.com”.

According to the Registrar’s communications with the Center, the Respondent HostMonster.Com is an affiliate or alter ego of the Registrar:

“We are the host and registrar. . . we are Hostmonster.com and Fastdomain.com as well as Bluehost.com.”

The online business entities database operated by the Utah Department of Commerce shows both the Registrar and Hostmonster Inc. as registered Utah corporations. The Registrar offers a domain privacy service, apparently listing the name and contact details for HostMonster.Com in its WHOIS database in those cases where customers avail themselves of the Registrar’s domain privacy service.

In response to the Center’s request for registrar verification, the Registrar offered the following information in addition to the name and contact information for HostMonster.Com:

“The customers contact is as follows:

Name Andrew Shalaby
Company Bernzomatic Litigation Support [sic]”.

The Registrar also provided Mr. Shalaby’s postal address in El Cerrito, California, United States.

Thus, it appears that the Respondent HostMonster.Com is listed as the registrant only to provide anonymity in the WHOIS database for the beneficial owner of the Domain Name, the Respondent Andrew Shalaby. The Respondent HostMonster.Com has not submitted a Response or communicated with the Center. Accordingly, Mr. Shalaby will be referred to henceforth as “the Respondent”.

The Respondent Andrew Shalaby is a California lawyer. He has sued an affiliate of the Complainant, as well as other parties, for personal injuries he sustained when a gas cylinder exploded during a family camping trip, allegedly due to product defects (*Shalaby et al v. Newell Rubbermaid Inc et al*, No. 3:07-cv-02107 (USDC SD California)).

The Domain Name was registered on November 3, 2008. It resolves to a website displaying text and photographs relating to hand torch and gas cylinder injuries. The home page is headed as follows:

“MAPP Gas Cylinder and Torch Injury Database
(Bernzomatic, Worthington, Lenox, Ace, Sears, Thermadyne, etc.)”.

A “Litigation” page on the website associated with the Domain Name includes documents and links concerning more than a dozen product liability lawsuits, including the Respondent’s, against the Complainant’s affiliates and other manufacturers and distributors of gas cylinders and torches. The “Contact” page of the website shows an email address in the domain <eastbaylaw.com> as the “primary contact” and the Respondent’s law offices as the “secondary contact”.

It appears that the Respondent maintains a separate website describing his law practice at “www.shalabylaw.net”, which is not linked from the website associated with the Domain Name. The home page of the Respondent’s law office website lists several practice areas, including “product liability”. The website does not further describe the Respondent’s product liability practice or refer to claims against the Complainant.

After the current Complaint was filed, the Respondent commenced a judicial proceeding in San Francisco, petitioning to “remove” this administrative proceeding under the Policy to a federal court. *Newell Operating Company v. Andrew Shalaby*, Case No. C09-00185 JCS (USDC ND California) (Petition and Notice of Removal, January 14, 2009).

5. Parties’ Contentions

A. Complainant

The Complainant asserts that the Domain Name is confusingly similar to its registered BERNZ O MATIC trademark and that the Respondent has no rights or legitimate interests in so using the mark.

The Complainant infers that the Respondent registered the Domain Name to capitalize on misdirected Internet traffic, to sell the Domain Name, or to prevent the Complainant from having it. The Complainant cites UDRP decisions for the proposition that using a trademark as part of a domain name for a “gripe site” represents bad faith registration and use, especially where the registrant has “ulterior motives for commercial gain or the disruption of the Complainant’s business”.

B. Respondent

The Respondent did not submit a Response. The Respondent asked the Center to terminate this proceeding after the Respondent filed a petition to “remove” the dispute to the federal court in San Francisco.

6. Discussion and Findings

Paragraph 4(a) of the Policy provides that in order to divest the Respondent of a disputed domain name, the Complainant must demonstrate each of the following:

- (i) the Domain Name is identical or confusingly similar to a trademark 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.

Under paragraph 15(a) of the Rules,

“A Panel shall decide a complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable.”

A. Termination, Suspension, or Extension

The Respondent Andrew Shalaby commenced a judicial action in the United States, petitioning to “remove” this UDRP proceeding to a federal court and citing 28 United States Code, section 1441(b). That section concerns the removal to a federal court of actions filed in a state court, where there is a federal question or diversity of citizenship. There is no state court proceeding here, and the Respondent cites no statutory authority for “removing” to federal courts administrative proceedings under the UDRP.

In emails to the Center, Andrew Shalaby urges that this proceeding should be terminated because of his pending judicial petition. He also requests a further opportunity to submit a substantive Response if the UDRP proceeding is allowed to continue.

Several supplemental filings have been submitted on behalf of both Mr. Shalaby and the Complainant with reference to the judicial proceeding. The Panel has reviewed these filings for the limited purpose of taking a decision on Mr. Shalaby’s request for termination of the UDRP proceeding.

The UDRP is a mandatory administrative dispute resolution procedure, which complainants may choose to invoke in place of, or in addition to, a judicial complaint

(see Policy, para. 4). The Policy is binding on registrants, as it is incorporated in the domain name registration agreements of ICANN-approved registrars. The Policy does not prevent respondents from seeking judicial redress, however, as provided in paragraph 4(k):

“Availability of Court Proceedings. The mandatory administrative proceeding requirements set forth in Paragraph 4 shall not prevent either you or the complainant from submitting the dispute to a court of competent jurisdiction for independent resolution before such mandatory administrative proceeding is commenced or after such proceeding is concluded. If an Administrative Panel decides that your domain name registration should be canceled or transferred, we will wait ten (10) business days (as observed in the location of our principal office) after we are informed by the applicable Provider of the Administrative Panel’s decision before implementing that decision. We will then implement the decision unless we have received from you during that ten (10) business day period official documentation (such as a copy of a complaint, file-stamped by the clerk of the court) that you have commenced a lawsuit against the complainant in a jurisdiction to which the complainant has submitted under Paragraph 3(b)(xiii) of the Rules of Procedure. . . . If we receive such documentation within the ten (10) business day period, we will not implement the Administrative Panel’s decision, and we will take no further action, until we receive (i) evidence satisfactory to us of a resolution between the parties; (ii) evidence satisfactory to us that your lawsuit has been dismissed or withdrawn; or (iii) a copy of an order from such court dismissing your lawsuit or ordering that you do not have the right to continue to use your domain name.”

In general, therefore, where a respondent has initiated a judicial proceeding concerning a UDRP dispute in a court of competent jurisdiction (either *before* or *after* the UDRP complaint is filed), any Panel order to transfer the Domain Name to the Complainant would not be implemented until the issue is resolved in the judicial proceeding, or alternatively until the judicial claim is settled or dismissed.

This does not mean that the UDRP proceeding is automatically suspended or terminated, however. Paragraph 18(a) of the Rules gives the Panel discretion to suspend or terminate a UDRP proceeding where the Domain Name is the subject of other legal proceedings:

“(a) In the event of any legal proceedings initiated prior to or during an administrative proceeding in respect of a domain-name dispute that is the subject of the complaint, the Panel shall have the discretion to decide whether to suspend or terminate the administrative proceeding, or to proceed to a decision.”

In this case, the Panel is not persuaded that the UDRP proceeding should be suspended or terminated. The Complainant does not consent to termination or suspension. A decision in this proceeding may conceivably spare the parties some of the time and expense of contesting a more protracted judicial proceeding. Moreover, the Respondent’s “removal” theory underlying his judicial petition does not appear to the Panel to be well grounded in law. Accordingly, the Panel will proceed to a decision on the elements of the UDRP Complaint.

The Respondent’s request for an additional opportunity to submit a Response in this proceeding is not consistent with the Rules or the aims of the Policy. The Policy is designed to afford economical and expeditious relief in appropriate cases, with a

narrow set of issues and only two available remedies: transfer or cancellation of the disputed domain name. There is no routine discovery or motions practice as in American civil litigation. There are no hearings. The Rules and Supplemental Rules impose strict time limits and word limits for the Complaint and Response, which are normally the only filings accepted. The Respondent chose not to submit a timely Response on the merits but rather sought to have the present proceedings removed to another forum, perhaps gambling that the Panel would permit a substantially delayed Response to the Complaint if the proceeding was not terminated. The Panel does not.

B. Identical or Confusingly Similar

The Complainant holds registered BERNZ O MATIC trademarks. The mark is a coined term and is incorporated in its entirety in the Domain Name. The addition of the generic English word “injuries” in the Domain Name does not suffice to avoid confusing similarity with the mark for the purpose of the Policy.

The Panel concludes that the Domain Name is confusingly similar to the Complainant’s mark for purposes of the first element of the Complaint.

C. Rights or Legitimate Interests

It is undisputed that the Complainant has not authorized the Respondent’s use of the BERNZ O MATIC mark in the Domain Name.

The Policy, paragraph 4(c), provides a non-exhaustive list of other circumstances in which a respondent could demonstrate rights or legitimate interests in a contested domain name, including the following:

“(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.”

This appears to be an apt description of the use to which the Domain Name has been put. The website associated with the Domain Name is not commercial but reports (inaccurately, according to the Complainant) on injuries associated with the Complainant’s products and resulting litigation.

Some UDRP decisions in proceedings involving “criticism” websites (or “gripe sites”) hold that fair use and free speech principles do not justify labeling such a website with a domain name confusingly similar to a trademark, because of the potential for misleading the public as to source or affiliation. See, e.g., *The Royal Bank of Scotland Group plc, National Westminster Bank plc A/K/A NatWest Bank v. Personal and Pedro Lopez*, WIPO Case No. D2003-0166; *Myer Stores Limited v. Mr. David John Singh*, WIPO Case No. D2001-0763. This is a particularly compelling argument where there is some substantial commercial use of the website and it appears that the respondent is capitalizing on the complainant’s mark for commercial gain, as described in the Policy, paragraph 4(c)(iii). See, e.g., *Wal-Mart Stores, Inc. v. Walsucks and Walmarket Puerto Rico*, WIPO Case No. D2000-0477.

Other UDRP decisions, particularly those involving parties in the United States (where both free speech and trademark jurisprudence may offer greater leeway to make nominative use of a trademark), countenance using trademarks in domain names associated with criticism websites in at least some circumstances. This may be viewed as a fair use, for example, where the likelihood of initial interest confusion is relatively

small and there are no other indicia of bad faith. See, e.g., *Covance, Inc. and Covance Laboratories Ltd. v. The Covance Campaign*, WIPO Case No. D2004-0206; *Howard Jarvis Taxpayers Association v. Paul McCauley*, WIPO Case No. D2004-0014.

In the current proceeding, the Domain Name incorporates a generic word that is not especially suggestive of affiliation with the Complainant. Manufacturers are unlikely to encourage consumers to associate “injuries” with their products, even though they publish required safety directives.

With specific reference to the conditions laid down in paragraph 4(c)(iii), the website associated with the Domain Name does not obviously reflect an intent for commercial gain or an intent to tarnish the Complainant’s mark. On the latter issue, the Panel subscribes to the analysis found in *Britannia Building Society v. Britannia Fraud Prevention*, WIPO Case No. D2001-0505, as quoted in *Covance Laboratories Ltd.*, *supra*:

“Tarnishment in this context refers to such unseemly conduct as linking unrelated pornographic, violent or drug-related images or information to an otherwise wholesome mark. See, e.g., *Nicole Kidman v. John Zuccarini d/b/a Cupcake Party*, WIPO Case No. D2000-1415 (January 23, 2001); cf. *Etam, plc v. Alberta Hot Rods*, WIPO Case No. D2000-1654 (January 31, 2001). In contrast, fair-use criticism, even if libelous, does not constitute tarnishment and is not prohibited by the Policy, the primary concern of which is cybersquatting. Cf. *Wal-Mart Stores, Inc. v. Richard MacLeod d/b/a For Sale*, WIPO Case No. D2000-0662 (September 19, 2000) (protection for genuine criticism sites is provided by Policy’s legitimate interest and bad faith prongs). Claims sounding in commercial libel must be brought in other legal venues.”

Thus, the Panel is inclined to find that the Respondent is making a legitimate noncommercial or fair use of the Domain Name, absent persuasive evidence of bad faith casting doubt on the Respondent’s legitimate interests in the Domain Name. The Complainant’s assertions of bad faith are better addressed in the following section.

D. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy gives a non-exhaustive list of instances of bad faith, including the following to which the Complainant alludes without citation:

- “(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;

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

Paragraph 4(b)(ii) is inapposite here. The Complainant uses the BERNZ O MATIC mark in its own domain name <bernzomatic.com>, and there is no evidence in the record of the Respondent engaging in a pattern of cybersquatting.

The Complainant contends that the Respondent is “capitalizing” on the BERNZ O MATIC mark “with the intention of profiting from the resulting confused traffic”. It is not clear how this would be accomplished, since there is no commercial advertising or linking on the website associated with the Domain Name.

The Complainant also suggests that the Respondent is using the Domain Name in bad faith to disrupt the Complainant’s business, “to pressure Complainant’s affiliates into settling litigation”, or “to drum litigation work and legal fees” for the Respondent. These inferences of bad faith are not persuasive on the current record. The Respondent is not a competitor seeking to disrupt the Complainant’s business for his competitive gain (an instance of bad faith under the Policy, paragraph 4(b)(iii)). The Respondent has actually sued the Complainant’s affiliates over his own personal injuries, and it is not necessarily a sign of bad faith to discuss his product liability claims, or those of similarly injured parties, on a website naming these products and the brands under which they are sold – of which the Complainant’s is putatively the market leader. (If there are factual inaccuracies in the content of the website, the Complainant can consider seeking judicial redress, but no such remedies are available in this proceeding.) The lawsuits cited on the website are in a variety of jurisdictions, with plaintiffs represented by a variety of lawyers. The Complainant does not establish that the Respondent is representing clients other than himself and his immediate family in such litigation or actively soliciting such clients, nor does the Complainant demonstrate that the Respondent is associated with counsel representing plaintiffs in the other lawsuits. One can imagine a scenario in which a lawyer abused a trademark to solicit legal business against the owner of the mark, but the Complainant has not established such conduct on this record.

The Panel concludes that the Complaint does not establish the requisite element of bad faith in the registration and use of the Domain Name. Moreover, the lack of persuasive evidence of bad faith leaves intact the conclusion under the second element of the Complaint that the Respondent has a legitimate noncommercial or fair use interest in the Domain Name.

7. Decision

For all the foregoing reasons, the Complaint is denied.

W. Scott Blackmer
Sole Panelist

Dated: March 3, 2009