



WIPO Arbitration and Mediation Center

ADMINISTRATIVE PANEL DECISION

Southern California Regional Rail Authority v. Robert Arkow

Case No. D2008-0430

1. The Parties

The Complainant is Southern California Regional Rail Authority, Los Angeles, California, United States of America, represented by Los Angeles County Counsel, United States of America.

The Respondent is Robert Arkow, Valencia, California, United States of America, appearing pro se.

2. The Domain Name and Registrar

The disputed Domain Names <metrolinkrider.com> and <metrolinksucks.com> are registered with Direct Information Pvt. Ltd. d/b/a PublicDomainRegistry.com.

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on March 19, 2008. On March 20, 2008, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Names. On March 21, 2008, the Registrar transmitted by email to the Center its verification response confirming that the 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”), the Rules for Uniform Domain Name Dispute Resolution Policy (the “Rules”), and the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the “Supplemental Rules”).

In accordance with the Rules, paragraphs 2(a) and 4(a), the Center formally notified the Respondent of the Complaint, and the proceedings commenced on March 27, 2008. In accordance with the Rules, paragraph 5(a), the due date for Response was April 16, 2008.

The Response was filed with the Center on April 16, 2008.

The Center appointed W. Scott Blackmer as the sole panelist in this matter on April 28, 2008. 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.

The Respondent on April 11, 2008 requested a suspension of the proceeding. The Complainant opposed this request in a letter dated April 16, 2008.

4. Factual Background

The Complainant is a governmental Joint Powers Authority established under California law. The Complainant owns and operates the METROLINK regional commuter railway service in six Southern California counties. The Complainant reports some 43,000 daily passenger boardings and gross passenger revenues in 2007 of USD 62 million.

The METROLINK service has operated continuously under that name since 1992. The Complainant's METROLINK service mark is registered in the United States of America (Registration No. 1979101, issued June 11, 1996, showing first use in commerce on October 26, 1992). The Complainant advertises the METROLINK service in Southern California media, promotes discount fares for transportation to and from certain sporting and theatrical events, and sponsors annual charitable activities, all featuring the METROLINK mark. The Complainant operates an informational website at "www.metroinktrains.com".

The Respondent is an individual residing in Southern California. He is an electronic technician employed by the City of Los Angeles and states that he has regularly used METROLINK to commute to and from work since 1999.

The Respondent is also a self-styled "consumer advocate." He reports that he has been a victim of identity theft, and he has campaigned for consumer privacy and against telemarketing practices. He and his wife sued Bank of America in 1995 over its telemarketing activities, and he currently operates an anti-telemarketing website at "www.telemarketingwatch.org", in the name of Californians Against Telephone Solicitation.

In April 2006, the Respondent completed a "Passenger Comment Card" on METROLINK and was then surprised when a market research firm called him on his unlisted telephone number to ask further questions. The Respondent was unhappy that the Complainant had furnished his telephone number to a third party and called the Complainant to complain. He also took the occasion to object to the requirement that passengers sign their monthly passes, as those passes must be turned in at the end of the month to collect a public transit subsidy. The Respondent was concerned that the collection of his signature created a risk of identity theft. The Complainant's reply letter, dated May 30, 2006, is attached to the Response. The letter explained that the Complainant contracts with third parties to conduct market research, but that these contractors are obliged to maintain the confidentiality of passenger information. The letter also defended the Complainant's practice of requiring a

signature on monthly passes, since those passes are non-transferable.

The Respondent decided to “protest” the signature requirement by variously signing his pass with the name “Adolph Hitler” or leaving the pass unsigned. In August 2006, he was cited for a fare violation (an infraction under the California Penal Code) because his pass was not signed.

Shortly after receiving this citation, the Respondent registered the Domain Name <metrolinkrider.com> on August 10, 2006 and thereafter published a commentary website associated with that Domain Name, headed as follows:

“Welcome to Metrolinkrider.com

‘Keeping L.A.’s Metrolink system on the right track.’ (NOTE: This is NOT an official web site of Metrolink or the SCRRA)”.

The home page of the Respondent’s website announces its purpose as follows:

“Metrolinkrider.com provides an on-line forum where users and employees of the Los Angeles Metrolink rail system can post and share their comments (good or bad) about Metrolink on our Bulletin Board.”

According to statistics displayed on the website, 11 “members” have posted some 36 comments on the bulletin board to date. Most of them appear to be authored by the Respondent himself. Most of the postings are in some way critical of the Complainant or its personnel. There is no commercial advertising on the website.

On January 14, 2008, the Complainant sent the Respondent a cease-and-desist letter “applauding” his creation of a forum concerning METROLINK but objecting to his use of the METROLINK trademark in the Domain Name <metrolinkrider.com>. At least two telephone conversations between the parties followed. The Respondent sent the Complainant a written response by e-mail dated February 11, 2008, arguing that the “clear disclaimers” on his website avoided confusion. The letter went on as follows:

“Should you wish to go to court, please be my guest. That action, on your part, will generate publicity, something that my website could certainly use. As I told you during our conversations, I will not offer an aggressive legal fight over the issue. . . . If a court decides that ‘MetrolinkRider.com’ is trademark infringement, then I have an alternate name for the site, MetrolinkSucks.com. I have purchased this URL in preparation of your possible legal action(s).”

Indeed, the Respondent registered the second Domain Name, <metrolinksucks.com>, on January 24, 2008, shortly after receiving the Complainant’s cease-and-desist letter. That Domain Name briefly redirected Internet users to the Respondent’s criticism website associated with the first Domain Name at “www.metrolinkrider.com”, as evidenced by a cached copy dated February 25, 2008 and furnished with the Complaint. Subsequently, it appears that the Domain Name <metrolinksucks.com> has not been operational. It does not currently resolve to a website.

According to the Complaint, counsel for the Complainant contacted the Respondent

following the Respondent's February 11, 2008 email and offered to reimburse the Respondent for his costs if he would transfer "the domain name" to the Complainant. The Respondent declined, and this proceeding followed.

5. Parties' Contentions

A. Complainant

The Complainant asserts that both Domain Names are confusingly similar to its registered METROLINK mark, and that the Respondent has no rights or legitimate interests in the Domain Names. The Complainant does not contest the noncommercial nature of the website associated with the Domain Name <metrolinkrider.com> but contends that the Respondent does not have the right to use a domain name that implies an affiliation with the Complainant. The Complainant argues that this potential confusion applies as well to the Domain Name <metrolinksucks.com>, particularly given the numbers of non-native English speakers interested in the METROLINK transit system.

The Complainant argues that the Respondent, who was clearly aware of the Complainant's METROLINK mark, intentionally created a likelihood of confusion with the mark in order to divert Internet users to his website associated with the Domain Name <metrolinkrider.com>. The Complainant further contends that the Respondent registered the Domain Name <metrolinksucks.com> in bad-faith after being apprised of the Complainant's trademark concerns, with no intent to use it for a legitimate criticism website. The Complainant also concludes that the Respondent registered both Domain Names primarily in a bad-faith attempt to disrupt the Complainant's business.

B. Respondent

The Respondent, who is not represented by counsel, argues that the Domain Names are readily distinguished from the METROLINK mark and that the term "metrolink" is used in domain names associated with websites operated by other governmental and commercial entities.

The Respondent asserts that he is not a competitor of the Complainant and that his purposes involve only constitutionally protected free speech. He uses the Domain Name <metrolinkrider.com> for these purposes and, if necessary, "will fall back on Metrolinksucks.com". Since the Complainant is an intergovernmental authority that provides commuter rail service without competition, the Respondent rejects the notion that his commentary website "disrupts" the Complainant's business. The Respondent observes that his website is noncommercial and that the Domain Names are not for sale.

The Respondent points to the several fare violation citations he has received since objecting to the Complainant's policy requiring signed passes. He also alleges that the Complainant's personnel or counsel have made "threatening", "unprofessional", and "perjured" statements. He concludes that the Complainant intends to harass him to prevent further embarrassment, and he accuses the Complainant of "abusing the WIPO process."

6. Discussion and Findings

Paragraph 4(a) of the Policy provides that in order to divest a Respondent of a disputed domain name, a 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. Request for Suspension

The Respondent is currently opposing the Complainant’s latest fare violation citation for riding METROLINK without signing his monthly pass. He has filed a Freedom of Information Act request for documents relating to this charge, in the belief that the Complainant is “withholding information” that might have a bearing on the penal proceeding and also possibly on this UDRP proceeding. The Respondent asks the Panel to suspend this proceeding until he has obtained documents from the Complainant in response to his request and can demonstrate how the Complainant is “abusing the WIPO process.”

The Policy was designed to provide a narrow remedy – transfer or cancellation of domain names – following an expedited procedure to determine if a complainant had established the grounds for relief under the Policy. All other disputes between the parties are to be resolved through a court, arbitration, or other proceeding that may be available (see Policy, paragraph 5).

The Panel has discretion to suspend or terminate a UDRP proceeding, or alternatively proceed to a decision, in the event that there are pending “legal proceedings” concerning “a domain-name dispute that is the subject of the complaint” (Rules, paragraph 18). Here, the pending legal proceeding concerns an alleged fare violation and the Respondent’s challenge to the validity of the Complainant’s policy requiring signed monthly passes. There is no indication that the Domain Names are in any way at issue in the penal proceeding.

Moreover, the Complainant’s alleged hostility toward the Respondent is not an issue in determining whether the Complainant has established grounds under the Policy for transfer of the Domain Names. The Complainant has the burden of persuasion in this proceeding, and its Complaint must stand or fall on its own merits.

Thus, the Panel concludes that there is no merit in delaying the current proceeding and

rejects the Respondent's request for suspension.

B. Identical or Confusingly Similar

The Complainant indisputably has rights in the registered METROLINK service mark. The mark is included in its entirety in both Domain Names.

The addition of the generic word "rider" to the first Domain Name, <metrolinkrider.com>, does not avoid confusion. Rather, it tends to increase the likelihood of confusion, since the METROLINK commuter trains carry tens of thousands of riders daily. For purposes of the first element of the Complaint, the disclaimer of affiliation on the Respondent's website associated with this Domain Name does not avoid the initial confusion of an Internet user seeking online information from the Complainant.

The Respondent argues that the second Domain Name, <metrolinksucks.com>, "clearly" reveals by the name itself that it is not affiliated with the Complainant. Numerous Policy decisions (and several judicial precedents in the United States of America, where both parties are located) have addressed the question of whether adding a derogatory word such as "sucks" to a domain name makes it unlikely that Internet users would be confused as to source or affiliation. The American Heritage Dictionary of the English Language (4th ed. 2000) defines "sucks" as a "vulgar slang" term meaning, "to be disgustingly disagreeable or offensive." Merriam-Webster's Online Dictionary ("www.m-w.com") similarly includes the "slang" definition of "sucks" as "to be objectionable or inadequate". Presumably, most organizations would not publish a website with such a self-denigrating domain name, and some UDRP panels have concluded that such a domain name is not, therefore, "confusingly similar" to a mark included in the domain name. See, e.g., *Lockheed Martin Corporation v. Dan Parisi*, WIPO Case No. D2000-1015.

However, it is not self-evident that Internet users would always take notice of the slang word following the trademark in the Domain Name and recognize its negative import. Moreover, as in a number of other Policy proceedings, many Internet users potentially interested in the Complainant's services are not fluent English-speakers. The record establishes that the Complainant's METROLINK system serves ethnically diverse counties in Southern California and attracts tourists and business travelers from around the world. See, e.g., *Wachovia Corporation v. Alton Flanders*, WIPO Case No. D2003-0596; *Koninklijke Philips Electronics N.V. v. In Seo Kim*, WIPO Case No. D2001-1195 (non-native English speakers may not recognize the negative connotations of a pejorative slang term included in a domain name). It is also by no means improbable that a trademark holder would use a domain name with such a suffix wryly, perhaps deliberately seeking an opportunity to communicate with younger or disaffected consumers.

It is for such reasons that most panels have tended to find that a domain name consisting of a trademark and a negative term are "confusingly similar" to the complainant's mark for the threshold purpose of establishing the first element of a UDRP complaint. See, e.g. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, paragraph 1.3, and cases cited therein. As the *Wachovia* and *Philips* panels observed, a finding of confusing similarity does not deprive a legitimate protest website from protection under the second and third elements of a Policy complaint.

The Panel concludes, therefore, that both Domain Names are confusingly similar to the

Complainant's METROLINK service mark for purposes of the first Policy element.

C. Rights or Legitimate Interests

The Policy, paragraph 4(c), provides a non-exhaustive list of circumstances in which a respondent could demonstrate rights or legitimate interests in a contested domain name. These include one on which the Respondent relies:

“(iii) you are making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.”

The Complainant does not contend that the Respondent's website is commercial. Rather, the Complainant argues that while the Respondent may legitimately criticize the Complainant online, it may not use its trademark in the Domain Names, because these mislead the public as to the nature of the associated website. The Complainant cites *Hollenbeck Youth Center, Inc. v. Stephen Rowland*, WIPO Case No. D2004-0032:

“... it is the Panel's belief that protest disseminated through the powerful tools of the Internet is only legitimate if the protest is transparent. Transparency starts with choosing a domain name which reflects the protest as opposed to a domain name which implies an affiliation to the trademark holder.”

This argument for “transparency” as a hallmark of legitimacy would actually seem to justify the second Domain Name here, <metrolinksucks.com>, since it probably implies criticism to most English-speaking Americans. And even the first Domain Name, <metrolinkrider.com>, at least hints that it is concerned with the riders' perspective rather than the operator's. By contrast, the respondent in *Hollenbeck* registered the complainant's exact name – and former domain name – <hollenbeckyouthcenter.org>, when the complainant's domain name registration expired. This was much more likely to lead to misdirection than the present Domain Names.

There is admittedly a split in UDRP decisions as to whether it can be legitimate to use a domain name incorporating a trademark for a noncommercial criticism website. Some panels hold that it is not legitimate to do so; others that it is legitimate only if the domain name clearly conveys protest or criticism. However, panels in proceedings with parties in the United States of America, where judicial decisions tend to support criticism websites against trademark infringement and cybersquatting claims on constitutional First Amendment grounds, have been more likely to find a legitimate interest as long as the use is fair and noncommercial. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, paragraph 2.4, and cases cited therein.

The Panel is inclined toward the latter view in the present case, as it involves parties in the United States of America and the Respondent unquestionably operates a noncommercial comment and criticism website. Such use could not be considered legitimate, however, if the record indicated that the Respondent selected and used the Domain Names fundamentally in a bad-faith effort to tarnish the Complainant's mark and disrupt its business, as the Complainant asserts. That possibility is better addressed below, in connection with the bad-faith element of the Complaint.

The Complainant advances a different argument against the Respondent's legitimate interest in the second Domain Name, <metrolinksucks.com>: the Complainant contends that it was registered not for a criticism website but only as a "retaliatory or preemptive measure to any legal proceedings that SCRRA would take", citing the Respondent's February 11, 2008 letter. This argument is unpersuasive. The Domain Name pointed, at least for a time, to the same comment and criticism website associated with the first Domain Name, <metrolinkrider.com>. The Respondent plausibly claims that he registered the second Domain Name, with a more explicitly critical connotation, as a "fall back" for his website in case the first Domain Name was taken away from him. This does not undercut the legitimacy of using, or planning to use, the second Domain Name for the same or similar website. That appears to be a legitimate use, unless it represents a bad-faith effort to tarnish and disrupt, as discussed below.

D. Registered and Used in Bad Faith

The Policy, paragraph 4(b), gives illustrations of bad-faith registration and use, including the following:

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

These examples are not truly apposite in the present case, and the Complainant does not cite them, although the Complaint borrows language from both paragraphs. The Respondent is not a competitor of the Complainant, and there are no facts indicating that the Respondent diverted Internet users for "commercial gain", as his website is entirely noncommercial.

The illustrations in paragraph 4(b) are expressly non-exhaustive, however, and it is possible to conceive of circumstances – such as those in *Hollenbeck* – where a domain name was designed to mislead, or used primarily to disrupt a trademark holder's business, and such conduct might be taken as evidence of bad-faith registration and use.

The Complainant argues that the first Domain Name, <metrolinkrider.com>, was selected to mislead and divert Internet users. But that name is ambiguous; it might be linked to the Complainant, but it could suggest a different, consumer's perspective. The Respondent denies any intent to mislead Internet users and points out that his website is replete with prominent disclaimers of affiliation. He claims he was motivated by a desire to give METROLINK passengers and employees a forum where they could speak without "censorship", and the contents of his website are consistent with such an intent to distinguish the website emphatically from any affiliation with the Complainant. Some Internet users could be confused initially by this Domain Name, but the Panel is not persuaded on the present record that this is why the Respondent registered and used the Domain Name <metrolinkrider.com> for a comment and criticism website.

The Complainant's inference of bad-faith with respect to the second Domain Name, <metrolinksucks.com> reprises the argument from the second element of the Complaint. This argument is to the effect that since the Domain Name was registered after notice of the Complainant's trademark concerns, it was motivated simply by a desire to frustrate the Complainant's efforts to obtain the transfer of a domain name. The Complainant cites *CBS Broadcasting, Inc., f/k/a CBS, Inc. v. Nabil Z. aghloul*, WIPO Case No. D2004-0988. In that case, however, the panel found that there was no credible evidence that the respondent ever intended to use the domain name for a criticism website. Here, the Domain Name <metrolinksucks.com> was pointed to the Respondent's comment and criticism website for some time, and the Respondent credibly claims he would use the second Domain Name for that website if the first Domain Name became unavailable to him. Thus, the Panel does not find bad-faith established on this theory.

The Complainant contends, finally, that both Domain Names were registered "primarily to disrupt" its business. There is no evidence in the record demonstrating how the handful of diverse comments posted on the Respondent's website have interfered with the Complainant's business. From the record and a perusal of the Respondent's website, it appears rather that the Domain Names were registered for precisely the reason stated by the Respondent – to provide a forum for airing comments about the Complainant's transit service. Many of these comments are critical, but something more than criticism is required to establish illegitimacy and bad-faith for purposes of the Policy. See *La Quinta Worldwide L.L.C. v. Heartland Times LLC, MD Sullivan*, WIPO Case No. D2007-1660. For example, in *Covance, Inc. and Covance Laboratories Ltd. v. The Covance Campaign*, WIPO Case No. D2004-0206, articles and posts on the respondent's protest website threatened to publish the complainants' confidential client lists, encouraged readers to harass the complainants' suppliers, and made defamatory remarks about employees of the complainants. There is no similar evidence here of a concerted attempt to interfere with the Complainant's business. The Panel does not find, therefore, that the Respondent registered the Domain Names "primarily to disrupt" the Complainant's business.

In sum, the Complainant has not met its burden of persuasion to establish the second and third elements of the Complaint with respect to illegitimacy and bad-faith.

7. Decision

For all the foregoing reasons, the Complaint is denied.

W. Scott Blackmer
Sole Panelist

Dated: May 12, 2008