

You Can Win a UDRP for a .SUCKS Domain . . . Sometimes

October 19, 2021 – The TMCA

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A recent Uniform Domain Name Dispute Resolution Policy (“UDRP”) decision provided long-awaited guidance for challenging .SUCKS domain names. *Sanofi v. Privacy Hero Inc./Honey Salt, Ltd.* which was decided by a three arbitrator panel of the World Intellectual Property Office (“WIPO”), was the first in a line of decisions to hold that use of the generic top-level domain (“gTLD”) .SUCKS in combination with another party’s

trademark can be confusingly similar, and thus, can infringe the trademark holder's rights. Given the unique circumstances of these cases, however, trademark owners should not count on future panels applying the results of these decisions broadly.

Why It .Sucks to be Honey Salt. While the Respondent, Honey Salt, Inc. claimed its site was an open forum for the public to discuss complaints protected under the First Amendment, the Panel instead agreed with Complainant that because the complaints were anonymous and undated and did not mention Complainant by name, they were more likely to be a pretext for Respondent's real purpose for the site than they were to be protected speech. Based on the existence of multiple links to third-party sites from the website and Respondent's admission that the sanofi.sucks domain name was for sale, the Panel instead found Respondent's real purpose for the site was to drive traffic to the site and raise the purchase price for the underlying domain name. Given these circumstances, the Panel ordered sanofi.sucks to be transferred to Complainant.

To succeed in a UDRP, the Complainant must pass this three-pronged test:

1. The manner in which the domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights;
2. Why the respondent should be considered as having no rights or legitimate interests regarding the domain name subject of the complaint; and
3. Why the domain name should be considered as having been registered and used in bad faith.

For the first prong, the Respondent argued that the <SANOFI.SUCKS> domain name was not identical or confusingly similar to the SANOFI trademark because ".sucks" is pejorative, clarifying that the website was not affiliated with the Complainant, but instead contained criticism protected by free speech. The panel rejected this argument, concluding the domain name incorporated the registered SANOFI trademark in its entirety and merely added to it the generic ".sucks" gTLD. The panel did not find this addition precluded a finding of confusing similarity.

For the second prong, the Respondent asserted that it had rights or legitimate interests in the domain name because it was used to host a criticism website allowing users to exercise their free speech rights. After noting that the Respondent was a third party with no direct relationship with any person who might have a genuine gripe, the Panel accepted Complainant's contention that the supposed complaints were unverified and general and likely a pretense to create the impression that the registration and use of the domain name were legitimate. The Panel also agreed with Complainant's argument that the actual intent is more likely to increase the price it could receive from the sale of the disputed domain name.

For the third and final prong, the Respondent denied that it used the domain name in bad faith because of the legitimate purpose of providing an open forum for the free exchange of criticism. Respondent added that allowing brand owners to claim bad faith merely because a <BrandX.SUCKS> domain name is not associated with the underlying brand would undermine the purpose of the .sucks gTLD for criticism and commentary. Here too

the Panel agreed with the Complainant and ruled that the domain name was registered in bad faith because it was part of the Respondent's intention to take unfair advantage of the Complainant's trademark by increasing Internet traffic to the associated website and to other websites owned by the Respondent using the .SUCKS domain name. The Respondent admitted that it had put many domain names with .SUCKS domain names on the market. The Panel also noted that the Respondent's pattern of abusive registrations supported a finding of bad faith. The Panel ordered that the domain name be transferred to the Complainant.

Rubbing Salt in the Proverbial Wound. Since the <SANOFI.SUCKS> decision was issued, WIPO has followed suit and has ordered domain name transfers or cancellations in thirteen other cases. See, e.g., *Digicel Caribbean v. Domains By Proxy, LLC / Jamie McCullan*; *Alsace Croisieres SA v. John Livingstone / Write Place Publications Inc.*; and *FirstMerit Corporation v. Registration Private, DomainsByProxy.com / Jon Murrell*. All the domain names were owned by Honey Salt on behalf of Everything.Sucks for similar websites. Because of this, trademark owners may wish to determine if Honey Salt or other platforms with a similar business model have acquired their marks as part of .SUCKS domain names. Given the number of transfers, and pending cases for .SUCKS domain names, now may be a sweet time to rub more salt in the Honey Salt .SUCKS wound.

Limits on How this Decision .Sucks. The *Sanofi* panel was careful to distinguish this case from prior decisions where the websites in question contained genuine criticism targeted at specific trademark owners and were not selling anything, including the domain name itself, or otherwise trying to achieve commercial gain. In such cases, panels have typically rejected complaints on the grounds they did not establish the second prong (no legitimate interest in the domain name) or the third prong (that the domain name was registered in bad faith) needed to prevail in a UDRP. The *Sanofi* decision does not call into question these precedents. Thus, while it .SUCKS to be Honey Salt, trademark owners should not count on future panels ruling that it .SUCKS to operate a genuine gripe site.