

ADMINISTRATIVE PANEL DECISION

Chicago Tribune Company v. Alan Maass
Case No. D2012-1076

1. The Parties

Complainant is Chicago Tribune Company of Chicago, Illinois, United States of America, represented by Loeb & Loeb, LLP, United States.

Respondent is Alan Maass of Chicago, Illinois, United States, represented by The People's Law Office, United States.

2. The Domain Names and Registrars

The disputed domain names <occupiedchicagotribune.org> and <occupychicagotribune.org> (collectively, the "Domain Names") are registered with Gandi SARL.

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on May 22, 2012. On May 23, 2012, the Center transmitted by email to Gandi SARL a request for registrar verification in connection with the Domain Names. On May 23, 2012, Gandi SARL transmitted by email to the Center its verification response 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 May 24, 2012 providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. Complainant filed an amended Complaint on May 30, 2012.

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 on May 31, 2012. In accordance with the Rules, paragraph 5(a), the due date for Response was June 20, 2012. The Response was filed with the Center on June 18, 2012.

The Center appointed Michael A. Albert as the sole panelist in this matter on June 22, 2012. 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

Complainant is the owner and operator of the “Chicago Tribune” newspaper. The “Chicago Tribune” has been in print for over 160 years and is the most widely read newspaper in the Chicago metropolitan area and the Great Lakes region of the United States. Complainant is the owner of a United States Trademark registration no. 771,167 for the CHICAGO TRIBUNE mark, which was registered on June 9, 1964. Complainant also owns and operates the websites located at the Domain Names “www.chicagotribune.com” and “www.mobile.chicagotribune.com” (the “Chicago Tribune Sites”).

Respondent is a volunteer, not-for-profit organization that periodically publishes stories both in print and online at the <occupiedchicagotribune.org> Domain Name (the “Active Site”). Respondent has no affiliation with Complainant. Respondent publishes stories that are aimed at members of the Occupy Movement. The <occupychicagotribune.org> Domain Name (the “Passive Site”) is a landing page that simply states that the Domain Name is reserved, parked, and unused. See Annex 4 of Complaint. Respondent registered the Passive Site on November 2, 2011 and the Active Site on November 3, 2011. The contact information for Respondent on the Whois database appears to be that of the domain name registrar, based in France.

The Active Site includes a disclaimer that reads: “We are proud to have no affiliation whatsoever with the 1% Chicago Tribune or the Tribune Company.” The Active Site also includes a section soliciting donations. See Annex 3 of Complaint. The donations section reads:

“The Occupied Chicago Tribune is an entirely volunteer-run project, and the paper is distributed for free throughout Chicago. However, printing isn’t cheap. As a paper of the 99 percent, we certainly won’t be getting any help from corporate sponsors or billionaire media moguls. If you like what you’ve read and want to support our work, please write us at shout @ occupiedchicagotribune.org.”

5. Parties’ Contentions

A. Complainant

Complainant contends that it owns all rights in the famous CHICAGO TRIBUNE trademark. Complainant provides a copy of its United States Trademark Registration for the CHICAGO TRIBUNE mark in Annex 6 of the Complaint. Complainant asserts that it is well known by the name “Chicago Tribune” and that it displays the mark prominently in the “Chicago Tribune” newspaper and on the Chicago Tribune Sites. Complainant notes that it often presents the CHICAGO TRIBUNE mark in the form of a stylized logo. See Annex 5 of Complaint.

With respect to paragraph 4(a)(i) of the Policy, Complainant contends that the Domain Names are confusingly similar to Complainant’s CHICAGO TRIBUNE mark. Complainant notes that the Domain Names fully incorporate the entire CHICAGO TRIBUNE mark, and argues that the addition of the non-distinctive terms “occupied” and “occupy” do not diminish the confusing similarity with Complainant’s mark. Complainant further argues that the presence of the disclaimer on the Active Site demonstrates that Respondent understands that a likelihood of confusion exists.

With respect to paragraph 4(a)(ii) of the Policy, Complainant contends that Respondent has no rights or legitimate interests in respect of the Domain Names. Complainant argues that Respondent is neither using the Domain Names to make a *bona fide* offering of goods or services, nor is it making a legitimate noncommercial or fair use of the Domain Names. Complainant asserts that because any unauthorized use

of its mark, including Respondent's use, would constitute an infringement, it would therefore preclude any possibility of a *bona fide* offering of goods and services.

Regarding the Active Site, Complainant argues that Respondent's use of a stylized logo similar to the one used by Complainant in the "Chicago Tribune" newspaper and on the Chicago Tribune Sites demonstrates a lack of rights or legitimate interests. Complainant further argues that Respondent's selection and use of the Active Site establishes that Respondent's goal is to divert traffic from the Chicago Tribune Sites by trading in on the fame of the CHICAGO TRIBUNE mark in order to attract Internet users and achieve commercial gain. Complainant lastly asserts that the Active Site is not being used to parody or criticize Complainant, and even if it were, Respondent's general right to free expression does not entitle Respondent to appropriate the CHICAGO TRIBUNE mark in connection with such expression.

Regarding the Passive Site, Complainant contends that because Respondent has not made use of the Passive Site for any purpose, such behavior demonstrates Respondent's lack of rights or legitimate interests. Complainant also argues that Respondent's failure to use the Passive Site for any purpose demonstrates that Respondent is not commonly known by the Passive Site.

Finally, with respect to paragraph 4(a)(iii) of the Policy, Complainant contends that Respondent registered and is using the Domain Names in bad faith. Complainant asserts that several factors are evidence of Respondent's bad faith, including: (1) that Respondent knew of the existence of Complainant's mark at the time when the Domain Names were registered; (2) that Respondent registered multiple domain names incorporating Complainant's mark; (3) that Respondent could have selected any number of alternatives for the Domain Names; and (4) that Respondent had intentionally hidden its contact information through an off-shore privacy protection service.

Complainant contends that Respondent's use of the CHICAGO TRIBUNE mark in connection with the solicitation for donations on the Active Site demonstrates that Respondent is intentionally attempting to attract Internet users for commercial gain by creating a likelihood of confusion with the CHICAGO TRIBUNE mark as to the source, sponsorship, affiliation or endorsement of its website. Complainant asserts that bad faith exists regardless of whether or not Respondent actually profits from the Active Site. Complainant also asserts that bad faith exists irrespective of whether or not the Active Site parodies or criticizes Complainant. Complainant argues that Respondent's failure to provide an "active" use of the Passive Site is strong evidence of bad faith given: (1) the fame of the CHICAGO TRIBUNE mark; (2) the lack of evidence of Respondent's good faith; (3) the lack of any plausible good faith use of the Passive Site by Respondent; (4) Respondent's efforts to conceal its identity; and (5) Respondent's existing use of the Active Site.

B. Respondent

Respondent asserts that it is a community-based, volunteer, non-incorporated, not-for-profit organization that criticizes the biased, corporate news of Complainant. Respondent states that it is a noncommercial publication distributed for free that does not compete with the Chicago Tribune, and that its staff consists of volunteer, activist journalists who are not compensated for their work. Respondent asserts that it seeks to provide information about the activities of Occupy Chicago, a group protesting income inequality and other injustices of the United States political system. Respondent avers that by covering issues that are often ignored or reported with a conservative bias by Complainant (e.g., issues of concern to the poor and working people of Chicago), Respondent is implicitly critiquing Complainant and mainstream corporate media in general.

With respect to paragraph 4(a)(i) of the Policy, Respondent contends that the Domain Names are not confusingly similar to Complainant's CHICAGO TRIBUNE mark. Respondent avers that the words "occupy" and "occupied" have become synonymous with drawing attention to corruption or other oligarchical misdeeds within an institution, and therefore that no reasonable person would confuse the Chicago Tribune daily publication with Respondent's free, periodic paper publication and website. Respondent argues that it seeks no commercial gain from its website and that Complainant has provided no evidence to the contrary. Respondent further argues that rather than seeking to trade on the goodwill of Complainant's mark for

commercial gain, it is seeking to criticize and differentiate itself from Complainant and its interests. Respondent lastly contends that the presence of the disclaimer on the Active Site is not evidence that Respondent understands that a likelihood of confusion exists with Complainant's mark, but rather that the disclaimer was inserted as a response to the threat of a lawsuit by Complainant.

With respect to paragraph 4(a)(ii) of the Policy, Respondent contends that it has rights or legitimate interests in respect of the Domain Names. Respondent argues that its use of the Active Site to critique the content and subjects addressed in the Chicago Tribune constitutes a legitimate noncommercial and fair use of the Domain Names, and therefore meets Paragraph 4(c)(iii) of the Policy in demonstrating rights and legitimate interests.

With respect to paragraph 4(a)(iii) of the Policy, Respondent contends that it did not register and is not using the Domain Names in bad faith. Respondent avers that in choosing the Domain Names and publishing its articles, it is merely exercising its First Amendment rights. Respondent argues that it is exercising its fundamental political right to contrast, critique, and criticize the news reporting of Complainant. Respondent provides several examples of articles in which it has criticized Complainant. See Annex 1 of Response. Respondent contends that UDRP complaints involving Americans whose websites criticize or offer commentary about complainants are routinely denied.

6. Discussion and Findings

Paragraph 15(a) of the Rules instructs the Panel to "decide a complaint on the basis of the statements and documents submitted in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable."

Paragraph 4(a) of the Policy requires Complainant to prove each of the following three elements to obtain an order that the Domain Names should be transferred:

- (i) the Domain Names registered by Respondent are identical or confusingly similar to a trademark or service mark in which Complainant has rights;
- (ii) Respondent has no rights or legitimate interests in respect of the Domain Names; and
- (iii) the Domain Names have been registered and are being used in bad faith.

Complainant has the burden to prove each of these elements by a preponderance of the evidence. See *Madonna Ciccone, p/k/a Madonna v. Dan Parisi and "Madonna.com"*, WIPO Case No. D2000-0847.

A. Complainant's Supplemental Filing

Before turning to the merits, the Panel will address the matter of Complainant's supplemental filing, which was submitted on June 26, 2012. The Policy and the Rules do not afford any Party a right to submit supplemental filings, but the Panel can consider such filings at its discretion under paragraph 10 of the Rules. In exercising its discretion, the Panel is guided by the goal of promoting equality between the Parties and ensuring an expedient resolution of the dispute.

The Panel has reviewed Complainant's supplemental filing and notes that Complainant provides additional arguments with respect to the issues of rights and legitimate interests and bad faith. For reasons discussed below, the contents of Complainant's supplemental filing have been considered by the Panel but do not ultimately affect the Panel's decision.

B. Identical or Confusingly Similar

As an initial matter, the Panel finds that Complainant has established its rights in the CHICAGO TRIBUNE

mark under paragraph 4(a)(i) of the Policy through its United States Trademark Registration. See *Trip.com, Inc. v. Daniel Deamone*, WIPO Case No. D2001-1066 (“[R]egistration of a mark is *prima facie* evidence of validity [...] Respondent has the burden of refuting this assumption).

Under Paragraph 4(a)(i) of the Policy, Complainant must prove that the Domain Names are identical or confusingly similar to a mark in which Complainant has rights. The Domain Names are not identical to Complainant’s mark. The Domain Names include Complainant’s entire CHICAGO TRIBUNE mark, while adding either the words “occupy” or “occupied”. The Domain Names also add the generic top-level domain (“gTLD”) “.com.” The addition of the gTLD “.com” need not be considered in the determination of confusing similarity. *Playboy Enterprises International, Inc. v. John Taxiarchos*, WIPO Case No. D2006-0561.

Given that the Domain Names are not identical to Complainant’s mark, Complainant must show that the Domain Names are confusingly similar to Complainant’s mark. Complainant correctly notes that prior UDRP Panels have held that the addition of non-distinctive generic or slang terms to a well-known mark is not sufficient to reduce the confusing similarity between a disputed domain name and a mark. See *The California Milk Processor Board v. Mattia Fraulini*, WIPO Case No. D2011-1077 (<gotmilkband.com>); *The Coca-Cola Company v. Masud Osman*, WIPO Case No. D2001-0618 (<winatcoke.com> and <cokerules.com>); *Yahoo! Inc. v. David Ashby*, WIPO Case No. D2000-0241 (<yahooventures.com>). Confusing similarity is particularly strong where the additional generic terms are likely to be associated with Complainant and its mark. See *Ansell Healthcare Products Inc. v. Australian Therapeutics Supplies Pty, Ltd.*, WIPO Case No. D2001-0110 (<ansellcondoms.com>); *Harrods Limited v. Peter Pierre*, WIPO Case No. D2001-0456 (<harrodsdepartmentstores.com> and <harrodsstores.com>); *Dr. Ing. H.c. F. Porsche v. Vasily Terkin*, WIPO Case No. D2003-0888 (<porsche-autoparts.com>); *AT&T Corp. v. William Gormally*, WIPO Case No. D2005-0758 (<atttelephone.com>). Respondent counters that the terms “occupy” and “occupied” are not merely generic terms, but rather have taken on a distinctive meaning associated with the Occupy Movement. Respondent contends that no reasonable person would confuse the Domain Names with Complainant or Complainant’s publication.

The Occupy Movement is an international protest movement with a wide range of goals, one of which is to protest against the political and economic inequities that exist between the small fraction of highest-earning individuals in a society and its remaining members. The movement has spawned the popular political slogan “We are the 99%.” The Occupy Movement has been particularly strong in the United States, and protests have taken on the names of the several major cities and locations across the country at which they have occurred (e.g., Occupy Wall Street, Occupy San Francisco). A number of independent news sources have also developed that cater to the Occupy Movement, such as “Occupied Washington Post”, “Occupied Los Angeles Times”, and “Occupied Wall Street Journal”. The Occupy Movement has attracted significant media attention throughout the course of its short history, and the word “occupy” was voted as 2011’s word of the year by the American Dialect Society.

Given the circumstances of this case and in particular the heavy and nearly universal coverage of the Occupy Movement within the national and local media, the Panel holds that the Occupy Movement is so well known within the relevant area (both parties being from Chicago, Illinois, in the United States) that the Domain Names are not confusingly similar to Complainant’s mark. The Panel agrees with Respondent’s assertion that no reasonable person in the Chicago area would confuse the Domain Names with Complainant or Complainant’s publication. The instant case can be distinguished from the abundance of UDRP precedent in which Panels have found confusing similarity when a domain name incorporates a well-known mark and “merely adds a generic or slang term.” *Wachovia Corporation v. Alton Flanders*, WIPO Case No. D2003-0596. Here, the added words are not simply generic terms or terms that are likely to be associated with Complainant, but instead are terms that have a very distinctive meaning connected to the activities of the Respondent in this case, and in particular a meaning that connotes disassociation with Complainant.

Although the Panel recognizes Complainant’s rights in its CHICAGO TRIBUNE mark, Complainant must satisfy each of the three elements of paragraph 4(a) to obtain an order that a domain name be cancelled or transferred. Because Complainant has not shown that the Domain Names are identical or confusingly

similar to its CHICAGO TRIBUNE mark, it has not satisfied paragraph 4(a)(i) of the Policy. Accordingly, this Panel need not address whether Complainant has satisfied paragraphs 4(a)(ii) and 4(a)(iii) of the Policy.

7. Decision

For the foregoing reasons, the Complaint is denied.

Michael A. Albert
Sole Panelist
Dated: July 5, 2012