

Does ‘.sucks’ really suck?

So far, disputes involving the controversial top level domain have remained quite rare. **Roberta Horton** offers advice on what brand owners should do in anticipation of such registrations



Surprisingly few cases have answered the question of whether “.sucks” really does suck. Whether trademark owners are reluctant to test the waters, whether disputes involving the top level domain name (“TLD”) “.sucks” are settled, or for other reasons, it remains a mystery why “.sucks” cases are so rare. This article discusses ‘sucks’ cases pursuant to the Uniform Domain Name Dispute Resolution Policy (the “UDRP”), as administered by the World Intellectual Property Organization (“WIPO”) and the National Arbitration Forum (“NAF”). We also suggest strategies for trademark owners to strengthen their brands in anticipation of third party “.sucks” registrations incorporating those brands.

To prevail under the UDRP, a complainant must establish:

- The domain name at issue is “identical or confusingly similar” to the complainant’s trademark.
- The domain name registrant has no rights or legitimate interests in the domain name.
- The registrant registered, and is using, the domain name in bad faith.¹

Decisions entailing “sucks” or other pejorative terms as second level domains (“Trademarksucks”.TLD”), as well as WIPO commentary, offer insight into how a specific “.sucks” name would fare when put to the test.

Use of “Sucks” is “confusingly similar” when combined with a trademark owner’s mark

UDRP cases generally find confusing similarity when a respondent misappropriates a complainant’s trademark, combining it with “sucks” in a second level domain. WIPO Overview 3.0² agrees: “A domain name consisting of a trademark and a negative or pejorative term (such as [trademark]sucks.com... or even trademark.sucks) is considered confusingly similar to the complainant’s trademark for the purpose of satisfying standing under the first element.” (Emphasis added.)

Cases as far back as 2000 reflect this principle, some emphasizing that the “confusing similarity” analysis in “sucks” cases differs from that in other situations. See, eg, *Wal-Mart Stores, Inc v Richard MacLeod d/b/a For Sale*,³ (ordering transfer of “wal-martsucks.com” to complainant, and emphasizing the “phrase ‘identical or confusingly similar’ [is] greater than the sum of its parts”).

The policy was adopted to prevent the extortionate behaviour commonly known as ‘cybersquatting’, see *Red Bull GmbH v Carl Gamel*,⁴

(“[t]he ‘sucks’ cases are better regarded as examples of how the object of the Policy informs the meaning of confusing similarity... Shoe-horning ‘sucks’ cases into a traditional trademark infringement analysis is unconstructive. The question is whether, in the abstract, which among other things means

putting to one side the reputational value of the trademark in question might enjoy, the domain name and the trademark have confusing similarity.”).

Other panels have found the inclusion of “sucks” in second level domains to be confusing on more concrete theories, because the “sucks” domain name diverts internet users to the respondent’s site; confuses internet users into thinking the respondent’s site is an official site of complainant; tarnishes complainant’s mark; or misleads non-English speakers, who would not recognise the term “sucks”, see *Full Sail, Inc v Ryan Spevack*.⁵

To a much lesser extent, some cases have found “sucks” in a second level domain to be a distinguishing factor, see *Lockheed Martin Corp v Dan Parisi*.⁶ This denied transfer of two “lockheedsucks” domain names, opining “a domain name combining a trademark with the word ‘sucks’ or other language clearly indicating that the domain name is not affiliated with the trademark owner cannot be considered confusingly similar to the trademark.”

Lockheed’s reasoning seems misplaced. It would be all too easy for a cybersquatter to misappropriate a trademark owner’s rights, simply by registering its mark with “sucks” appended. Instead, *Wal-mart’s* “gestalt” theory seems apt – the notion that something is not quite right when anyone can register and use an established trademark by adding “sucks” under the guise that “sucks” is a distinguishing factor.

“Rights or legitimate interests”

Resolution of the second UDRP element, showing a respondent lacks rights or legitimate interests in the disputed domain name, might well depend on *whether* and *how* the respondent is using the “sucks” domain name.⁷

For instance, mere registration of a “sucks” domain name, without any active use, should violate the UDRP. See, eg, *Deutsche Telekom AG v AdlImagination*,⁸ (ordering transfer of “tmobilesucks.ws”, which the respondent offered for sale, as “obvious cybersquatting”). Likewise, use of “sucks” by a complainant’s competitor is not a legitimate interest. See, eg, *Wachovia Corp v Alton Flanders*⁹ (respondent’s use of “wachoviasucks” domain names pointing to sites competitive with complainant’s sites not legitimate).

On the other hand, a respondent using “Trademark + ‘sucks’” in a domain name for a site critical of the trademark owner (a “gripe site”), may fare better. While not addressed in the context of a top level domain, several UDRP decisions have concluded that such respondents have cognisable rights in their domain names for gripe sites. See, eg, *Full Sail, supra* (respondent had legitimate interest in “fullsailsucks.com”, incorporating complainant’s FULL SAILS mark, where the respondent used mark for protest site about complainant’s educational

institution). WIPO Overview, 3.0, §2.6.3 is in accord:

"Where the domain name is not identical to the complainant's trademark, but it comprises the mark plus a derogatory term (eg, trademarksucks.tld), panels tend to find that the respondent has a legitimate interest in using the trademark as part of the domain name of a criticism site if such use is prima facie noncommercial, genuinely fair, and not misleading or false."

This is not, however, a universal rule. Some UDRP panelists have envisioned a schism between a US and European view, with the US view according more credence to use of "sucks" in a domain name pointing to a criticism website than the European view. In *WIZZ Air Hungary Airlines Ltd Liability Company v Holden Thomas*,¹⁰ for example, the panel observed a divergence in "sucks" cases reflecting a differences in national free speech laws. While cases with a US tie have supported websites critical of trademark owners, referring to "constitutional right of US citizens to free speech", non-US cases have found gripe sites do not constitute a legitimate fair use.

Despite this perceived schism, strong arguments persist that use of "sucks" does not merit First Amendment protection – regardless of the respondent's locale. See *Philip Morris USA Inc v Lori Wagner/ David Delman*,¹¹ (in a case involving US parties, dismissing notion that domain names containing terms such as "violations" is protected by First Amendment, and explaining that the global bodies protecting the internet are not US state actors, and thus not bound by the First Amendment)¹² *1066 Housing Association Ltd v Morgan*,¹³ (applying local law to UDRP "risks the UDRP fragmenting into a series of different systems, where the outcome to each case would depend upon where exactly the parties happened to reside.").

The few ".sucks" cases

The handful of ".sucks" UDRP cases (indeed, we found none decided by the US federal courts) involve straightforward cybersquatting situations, and thus shed little light on how a respondent using ".sucks" might fare in more complex contexts. In *Lockheed Martin Corp v Sam Kadosh*,¹⁴ the panel ordered transfer of "lockheedmartin.sucks", which pointed to a pay-per-click site. In finding confusing similarity between the disputed domain name and the complainant's LOCKHEED MARTIN marks, the panel analogised to a case holding ".com" generic -- thus implying that ".sucks" is also generic.

F5 Networks, Inc v Bohdan Artemchuk,¹⁵ addressed the top level domain "wtf", arguably analogous to ".sucks" as a derogatory term, because "wtf" is sometimes understood to mean "what the" + the swear word "F**K". In that case, the respondent used the domain name "F5.wtf" to compete with the complainant's services offered under its F5 mark. The panel found confusing similarity, noting "The generic top level domain (gTLD) name '.wtf' is marketed as the new gTLD that indicates" (putting a more genteel spin on it) "you won't believe this!" Similarly to Kadosh, the panel found that ".wtf" does not serve to distinguish the domain name from the F5 mark, which is the distinctive component of the domain name."

A recent case under NAF's Uniform Rapid Suspension System ("URS") provides less guidance, as that system departs from the UDRP, see *Pinterest Inc v Confidential Contact et al.*¹⁶ The respondent had posted a site at "pinterest.sucks" where internet users could share their Pinterest experiences. The panelist ordered suspension of "pinterest.sucks", rejecting the respondent's argument that it had legitimate rights in the domain name, and engaged in fair use, because it used the name to criticise the complainant. Under the URS, the respondent's argument only provided an affirmative defence to a bad faith claim, and could not establish the respondent's legitimate interests in the domain name.

Practice tips in dealing with .sucks

What lies ahead for ".sucks" registrants and the trademark owners whose marks they appropriate? Thus far, the few cases addressing ".sucks" have treated this TLD as generic, indistinguishable from ".com". But future panels may regard this TLD as a distinguishing factor in the confusingly similar analysis. And, arbitrators may view ".sucks", when combined with a trademark that also happens to be a commonplace term, as a legitimate forum for a gripe site. Take "weather.sucks" or "drizzlymist.sucks". While these domain names currently resolve to inactive sites, internet users might reasonably expect to visit a forum at either site on which they could complain about their local weather conditions.

To protect its rights, a trademark owner, particularly when launching a new brand, should register that brand combined with ".sucks" and like TLDs, such as "wtf". The mark owner may park the domain name, or point it to a site receiving public comments about its products or services. Apple computer's use of "apple.sucks", which resolves to an apple.com page soliciting feedback on the company's products, is a prime example. A company should also avoid choosing a brand name that, when combined with ".sucks", appears particularly suited for a forum or gripe site on commonplace issues.

Footnotes

1. See <http://www.icann.org/en/help/dndr/udrp/policy>
2. The overview, which addresses questions that commonly arises in WIPO proceedings, is posted at <http://www.wipo.int/amc/en/domains/search/overview3.0/#item113>. While not binding authority, Overview 3.0 "include[s] express references to almost 1,000 representative [UDRP] decisions."
3. WIPO Case No D2000-0662 (19 Sept 2000).
4. D2008-0253 (14 April 2008).
5. Case No D2003- 0502 (3 October 2003) (collecting cases).
6. Case No D2000-1015 (31 Jan 2001).
7. A finding of bad faith generally follows satisfaction of the first two UDRP prongs. See, eg, *Dr Martens International Trading GmbH and Dr Maertens Marketing GmbH v MCPS, Timothy Marten*, Case No D2011-1728 (15 December 2011) ("the use of the word 'sucks' by respondent appears to this panel to be also an indication that respondent is willing to create an association of its website with complainant's products.").
8. Case No DWS2006-0001 (4 Jan 2007).
9. Case No D2003-0596 (19 Sept 2003).
10. Case No D2009-1105 (22 Sept 2009).
11. FA No 1610001700123 (5 Dec 2015).
12. The author was counsel to complainant in this case.
13. WIPO Case No D2007-1461 (18 Jan 2008).
14. Claim No FA1710001751762 (2 November 2017).
15. Case No 2017-0752 (21 May 2017).
16. Claim No FA1706001736709 (11 July 2017).

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Roberta Horton focuses her practice on trademark, domain name, and copyright law. She handled one of the first cases challenging domain name infringers, and assisted in writing the statute protecting trademark owners against domain name infringers. She litigates both before the federal courts and the Trademark Trial and Appeal Board.

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