



## **WIPO Arbitration and Mediation Center**

### **ADMINISTRATIVE PANEL DECISION**

#### **Ahmanson Land Company v. Save Open Space and Electronic Imaging Systems**

**Case No. D2000-0858**

#### **1. The Parties**

Complainant is Ahmanson Land Company, a corporation organized under the laws of the State of California, U.S.A. (“Complainant”). Respondents are Save Open Space, a non-profit corporation organized under the laws of the State of California, U.S.A., and Electronic Imaging Systems, a corporation organized under the laws of the State of California, U.S.A. (“Respondents”).

#### **2. The Domain Name and Registrar**

The domain name which is the subject of this proceeding is “ahmanson.org” owned by Electronic Imaging Systems, transferred to Save Open Space. The domain name is registered with Network Solutions, Inc., Herndon, Virginia, USA.

#### **3. Procedural History**

- 3.1 Complaint was received by e-mail on July 25, 2000; on July 27, 2000, one original and four hard copies with Annexes.
- 3.2 E-mail acknowledging receipt of Complaint from Center to Complainant was sent on August 1, 2000.
- 3.3 Center’s Request for Registrar (Network Solutions, Inc.) Verification was sent August 1, 2000. Registrar Verification was received from NSI on August 9, 2000.
- 3.4 E-mail correspondence was exchanged between Respondents’ attorney and the Center on August 8-9, 2000.
- 3.5 Center’s Formal Requirements Compliance Checklist was completed on August 10, 2000.

- 3.6 Notification of Complaint and Commencement of Administrative Proceeding was issued on August 11, 2000.
- 3.7 E-mail from Respondents' Representative attaching Application for Extension; Center's e-mails to Complainant's attorney; e-mail responses and Complainant's Response to Application for Extension; Center's e-mail reply to Respondent granting extension until September 20, 2000 were exchanged from August 17 through August 22, 2000.
- 3.8 Response was received by e-mail on September 20, 2000 and in hard copy on September 25, 2000.
- 3.9 Acknowledgment of Receipt of Response was sent on September 27, 2000.
- 3.10 Notifications of Panelist Appointment and Presiding Panelist Selection List were sent on October 13, 2000.
- 3.11 Notification of Appointment of Administrative Panel and projected decision date was sent on November 13, 2000.

#### **4. Factual Background**

- 4.1 The Complainant alleges trademark rights in the term AHMANSON through use of AHMANSON and AHMANSON RANCH in connection with its business activities.
- 4.2 The Respondent registered the domain name on November 18, 1999, and denies that Complainant owns such trademark rights. Respondents assert fair use and noncommercial use of the term AHMANSON for their website, which is critical of the Complainant's development plans for the Ahmanson Ranch. Respondents further deny any bad faith.

#### **5. Parties' Contentions**

##### **A. Complainant**

##### **5.1 Summary of Complainant's Marks**

Complainant Ahmanson is a member of the Ahmanson family of companies, and is authorized to use the Ahmanson trade name in commerce. The Ahmanson name is protectible and famous under United States trademark laws. The Ahmanson name is famous as a result of decades of continuous use.

Ahmanson is also the owner of the Ahmanson Ranch common law mark. Ahmanson presently uses the mark in commerce in connection with its real estate development services. The Ahmanson Ranch mark has become famous in Southern California.

As the Ahmanson Ranch project development proceeds, Ahmanson or its assignees will also use the Ahmanson and Ahmanson Ranch marks in

connection with residential, commercial and industrial real estate development, management, sales and leasing, operation of various recreational facilities and golf courses, hotel and resort services, educational services, telecommunications and cable services, and retail services, among others.

## 5.2. The Ahmanson Trade Name and Mark

In 1927, Howard F. Ahmanson formed H.F. Ahmanson & Company, which for the next twenty years dealt primarily in insurance and real estate foreclosures. Then, in 1947, H.F. Ahmanson & Company purchased Home Savings of America (“Home Savings”), a modest savings and loan. In the years that followed, H.F. Ahmanson & Company and Home Savings experienced rapid growth, and in 1961 became the first savings and loan to hold over \$1 billion in assets.

As H.F. Ahmanson & Company and Home Savings grew, they created numerous affiliated companies which used the Ahmanson trade name, including Ahmanson Developments, Inc., Ahmanson Residential Development, Ahmanson Commercial Development Company, Ahmanson Insurance, Inc., Ahmanson Marketing, Inc., Ahmanson Obligation Company, Ahmanson Ranch, Inc., and Ahmanson Residential 2 (collectively referred to as the “Ahmanson Companies”). Since at least the mid-1960's, these companies have provided financial products and services, and real estate development and management services, nationwide.

Over the seventy-three years since H.F. Ahmanson & Company opened its doors, the Ahmanson Companies have continuously used the Ahmanson trade name in commerce in Southern California and throughout much of the United States. As a result, millions of Americans have come to associate the Ahmanson trade name with the Ahmanson family of companies. In fact, although Mr. Ahmanson died in 1968, the *Los Angeles Times* recently named him one of the fifty most influential business leaders of the 20<sup>th</sup> Century because of the business empire he created -- the Ahmanson Companies.

In October 1998, H.F. Ahmanson & Company, Home Savings and the Ahmanson Companies became wholly-owned subsidiaries of the Washington Mutual family of companies (collectively referred to as “Washington Mutual”).

## 5.3 The Ahmanson Ranch Project and Mark

In 1963, H. F. Ahmanson & Company purchased a roughly 6,200 acre property in southeastern Ventura County known as “Crummer Ranch.” A portion of the Crummer Ranch was later sold. After a brief attempt to construct a residential project (dubbed the “Ahmanson Ranch™” project) on a portion of the site in the mid-1960's, the property was primarily used as private residence.

In the mid-1980's, H.F. Ahmanson & Company and Home Savings created a new development project for the site. When completed, this new Ahmanson Ranch project will be a master planned community including 3,050 homes, commercial and retail uses, public facilities, two golf courses, and 900 acres of dedicated open space. Complainant Ahmanson Land Company was formed in 1989 to develop the Ahmanson Ranch project.

The Ahmanson Ranch project has been in the public spotlight almost since its inception. In 1986, H.F. Ahmanson & Company and Home Savings initiated public proceedings to develop the Ahmanson Ranch project and requested a preliminary approval from Ventura County to process the development. The Ventura County Board of Supervisors (the "Board of Supervisors") held public hearings on Ahmanson's proposed development and gathered input from homeowners' associations, environmental organizations, several parkland agencies, numerous individuals and other local agencies such as the cities of Los Angeles, Agoura Hills, Thousand Oaks and Simi Valley. In July 1988, the Board of Supervisors approved Ahmanson's request.

From 1990 through 1992, Ventura County conducted numerous public hearings on the Ahmanson Ranch project before the Environmental Report Review Committee, the Planning Commission and the Board of Supervisors. During this review period, Ventura County received extensive oral and written comments from federal, state and local agencies, homeowners' associations, business and community organizations, environmental groups, parkland agencies and interested individuals.

During this same period, entertainer Bob Hope and his wife Delores Hope proposed a residential and golf course project on another site in Ventura County located one canyon over from the Ahmanson Ranch project site. Rather than develop both projects, Ventura County negotiated with the Hopes and Ahmanson to develop only the Ahmanson Ranch property and to preserve the Hopes' site as open space. Ultimately, Ahmanson agreed, as a condition of approving the Ahmanson Ranch project, to effect the transfer of nearly 10,000 acres of undeveloped property, including the Hopes' site, to a governmental parkland agency to be permanently preserved as public open space. Ventura County approved the Ahmanson Ranch project in December 1992. Since Ventura County's approval of the Ahmanson Ranch project, Ahmanson has continued to develop the Ahmanson Ranch project and obtain land use approvals from other government agencies. This process has included a multitude of well-attended public hearings.

In addition to the prolonged and extensive public approval and permitting process, the Ahmanson Ranch project has received intense interest from the surrounding communities. The project has received widespread support from community organizations such as the Ventura County Economic Development Association, the Valley Industry and Commerce Association, and the Central City Association. It has also been recognized for its superior design, winning the Building Industry Association of America's Best New Town Award in 1993 and the California Chapter of the American

Planning Association's Comprehensive Planning Award in 1995. The project has also encountered significant opposition. Some organizations, including Respondent SOS, have filed numerous lawsuits seeking to stop the Ahmanson Ranch project, staged demonstrations, coordinated letter-writing campaigns, and even run television and radio advertising spots opposing the Ahmanson Ranch project.

The very public permitting and approval process for, community recognition of, extensive litigation over, and intense public interest (both pro and con) in the Ahmanson Ranch project has generated extensive media coverage of the Ahmanson Ranch project. Since 1986, the *Los Angeles Times* alone has run articles on the development of the Ahmanson Ranch project over 600 times in three different editions. The *Ventura County Star* has run approximately 150 articles on the Ahmanson Ranch project since July 1, 1997. The *Daily News*, the *Conejo Valley Daily News*, several smaller local newspapers, and local radio and television stations have also extensively covered the Ahmanson Ranch project. The story behind the approval of the Ahmanson Ranch project was even featured in a 1997 book "The Reluctant Metropolis: The Politics of Urban Growth in Los Angeles," written by William Fulton and published by Solano Press Books. As a result of this widespread public interest and extensive press coverage, the Ahmanson Ranch mark has become a household word in Ventura and Los Angeles Counties, and synonymous with the Ahmanson Ranch project.

#### 5.4. Respondents' Usurpation of the Ahmanson Trade Name and Ahmanson Ranch Mark

As part of its efforts to provide the public with information on the Ahmanson Ranch project even in advance of ground breaking, Ahmanson is developing a website to provide up-to-date information on the progress of and plans for the project. In order to make that site readily accessible to Internet users, Ahmanson desires to host that website at the most logical addresses: domain names that comprise its trade name and mark. However, Respondent EIS registered the <ahmanson.org> domain name and, along with Respondent SOS, has erected a website at that address that solicits donations to and membership in SOS, encourages visitors to oppose the Ahmanson Ranch project, and disparages Ahmanson and its parent company, Washington Mutual. Defendants' usurpation of this unique domain name prevents Ahmanson from capitalizing on the public recognition and goodwill associated with its Ahmanson trade name and Ahmanson Ranch mark, and uses such recognition and goodwill to harm Ahmanson.

#### 5.5 Complainant's Trade Name and Marks: Ahmanson Holds Protectible Rights in the Ahmanson Trade Name and Marks

##### Ahmanson Trade Name

The Ahmanson trade name is protected under §43(a) of the Lanham Act, 15 U.S.C. § 1125(a). To be protected under the Lanham Act, a trade name or

mark must be capable of distinguishing the user's services from those of others. Two Pesos, Inc. v. Taco Cabana, Inc., 505 U.S. 763, 768, 112 S.Ct. 2753, 2757 (1992). Thus, marks that are inherently distinctive are protectible under §43(a), as well as marks that have, through usage, become distinctive of the user's goods or services in commerce. Id. at 768-769, 112 S.Ct. at 2757. This acquired distinctiveness is referred to as "secondary meaning." Id.

Personal names used as marks are treated as strong marks upon a showing of secondary meaning. Adray v. Adry-Mart, 76 F.3d 984, 990 (9<sup>th</sup> Cir. 1995), citing E. & J. Gallo Winery v. Gallo Cattle Co., 967 F.2d 1280, 1291 (9<sup>th</sup> Cir. 1992). A mark comprising a personal name has acquired secondary meaning if a substantial segment of the public understand the designation, when used in connection with services or a business, not as a personal name, but as referring to a particular source or organization. Cf. California Western School of Law v. California Western University, 125 Cal.App.3d 1002, 1009, 178 Cal.Rptr. 685, (1982) (applying California law). Put otherwise,

"Secondary meaning grows out of long association of the name with the business, and thereby becomes the name of the business as such; is acquired when the name and the business become synonymous in the public mind; and submerges the primary meaning of the name as a word identifying a person, in favor of its meaning as a word identifying that business."

2 McCarthy, McCarthy on Trademarks and Unfair Competition, §13:2, p. 13-5 (quoting Visser v. Macres, 214 Cal.App.2d 249, 29 Cal.Rptr. 367 (1963)). In finding secondary meaning, courts consider factors such as the owner's long, continued use of the mark and its widespread public recognition, the size of the company, the number of customers, advertising expenditures, and unsolicited media coverage of the services and the mark. See Jews for Jesus v. Brodsky, 993 F.Supp. 282, 298 (D.N.J. 1998) (partial list); Gallo at 1291. Evidence of deliberate copying is also relevant to a determination of secondary meaning and, in appropriate circumstances, may be sufficient in and of itself to support an inference of secondary meaning. Fuddrucker, Inc. v. Doc's B.R. Others, Inc., 826 F.2d 837, 844 (9<sup>th</sup> Cir. 1987).

Consideration of these factors demonstrates the strong secondary meaning of the Ahmanson marks, and their indelible association with the Ahmanson Companies. Over the seven decades since H. F. Ahmanson & Company was founded, the Ahmanson trade name has been used by that company and a number of affiliated Ahmanson Companies, including Complainants. During this time the Ahmanson Companies have employed thousands, spent millions of dollars in advertising and public relations, and done business with tens of thousands of individuals and companies in over a dozen states. Through this long and extensive use, the word "Ahmanson" has acquired strong secondary meaning as a trade name and as an indication that the associated company, product, or service is part of or offered by the

Ahmanson family of companies. This secondary meaning was recognized by the United States Patent and Trademark Office (“PTO”) when it listed the Ahmanson Mortgage mark, Reg. No. 1,454,613, (owned by another of the Ahmanson Companies) on the Principal Register. It is further evidenced by Defendants’ intentional copying of the Ahmanson name. And, it is demonstrably apparent in the headlines of hundreds of news stories on the Ahmanson Ranch project, which repeatedly refer to Ahmanson as the entity developing the Ahmanson Ranch project.

#### The Ahmanson Ranch Mark

The Ahmanson Ranch mark is also clearly protectible. Preliminarily, the Ahmanson Ranch mark is suggestive, requiring a mental leap from the mark to the services offered, and therefore inherently distinctive. The Ahmanson Ranch mark has also accumulated strong secondary meaning as a result of the prolonged and well-publicized public approval and permitting process for the project, Ahmanson’s extensive public relations efforts, intense public interest in the project and extensive unsolicited media coverage, such that the Ahmanson Ranch mark has become synonymous with the development project. This fact is evidenced (and reinforced) by numerous headlines of news articles that repeatedly refer to the project as “Ahmanson Ranch” (e.g. “Land Deal Clears Way For Ahmanson Ranch Homes” and “Judge rejects Challenge By Ahmanson Ranch Foes”). Under such circumstances, names of planned developments, like Ahmanson Ranch, have been held to be protectible marks. See e.g., *In re Pebble Beach Co.*, 19 U.S.P.Q.2d (BNA) 1687 (T.T.A.B. 1991) (“17 Mile Drive” mark coined by applicant’s predecessor to describe services offered and location at which they were offered found to be registerable mark).

#### 5.6. The Ahmanson and Ahmanson Ranch Marks are “Famous”

The Federal Trademark Dilution Act, 15 U.S.C. § 1125(c), provides a non-exclusive list of factors courts may consider in determining whether a mark is distinctive and famous. These factors include: the degree of secondary meaning of the mark; the duration and extent of the owner’s use of the mark; the duration and extent of advertising and publicity of the mark; the degree of recognition of the mark in the trading areas and channels of trade used by the mark’s owner and the person against whom the injunction is sought; whether the mark was registered; the nature and extent of use of the same or similar marks by third parties; and the geographical extent of the trading area in which the mark is used. *Id.*

As developed in detail above, the Ahmanson trade name and the Ahmanson Ranch mark carry a very high level of secondary meaning. The Ahmanson Companies have used the Ahmanson trade name for over seventy years, throughout California and nationwide, to provide an array of financial products and services and real estate development and management services to thousands of customers. Indeed, the operations of the Ahmanson Companies have been so extensive that in 1999, the *Los Angeles Times* named their founder, Howard F. Ahmanson, one of the fifty most

influential business leaders of the 20<sup>th</sup> Century.

The distinctiveness and fame of the Ahmanson trade name and Ahmanson Ranch mark have also been strengthened through years of advertising. Several of the Ahmanson Companies have engaged in extensive advertising and public relations campaigns, including Ahmanson Land (over \$1.5 million spent on public relations to promote goodwill associated with the Ahmanson Ranch project), Ahmanson Mortgage (over \$2 million spent in advertising from 1983 through 1986 alone), Ahmanson Developments (\$70,000 spent in March 2000 alone to promote residential housing developments in Sacramento, California) and Ahmanson Residential Development (advertising for residential developments).

Further, the Ahmanson name and marks have been indelibly etched into the consciousness of the residents of Southern California. As detailed above, Ahmanson and the Ahmanson Ranch project have been through numerous public approval proceedings and lawsuits; have garnered tremendous public interest; have been the subject of hundreds of articles over the last fifteen years; and have been the targets of a very public campaign to stop the Ahmanson Ranch project. The “local” fame that has developed as a result is in itself enough to prove Ahmanson’s name and mark famous, for a mark that is locally well-known can be a “famous” mark protected by §1125(c) even though it is unknown in other parts of the country. E.g., WAWA, Inc. v. Haaf, 1996 U.S. Dist. LEXIS 11494, 40 U.S.P.Q.2d (BNA) 1629 (E.D.Pa. 1996) (“Wawa” service mark used by regional convenience store chain found to be “famous” and protectible under FTDA).

5.7 The <ahmanson.org> Domain Name Is Confusingly Similar to Complainant’s Marks and Trade Name

The only difference between the <ahmanson.org> domain name and the Ahmanson trade name and mark is the addition of the “.org” generic top level domain name (“gTLD”). As noted by numerous WIPO Panels, the addition of a gTLD such as “.org” to a mark is “without legal significance.” E.g., Monty and Pat Roberts, Inc. v. J. Bartell, WIPO Case No. D2000-0300, p. 9. Accordingly, the domain name is identical to the Ahmanson trade name and marks. The <ahmanson.org> domain name is also confusingly similar to the Ahmanson Ranch mark. See, Finter Bank Zurich, supra, (<finter.com> and <finter.org> held to be confusingly similar to complainant’s “Finter Bank Zuerich” trade name and mark, and ordered transferred to complainant).

5.8. Respondents Have No Rights or Legitimate Interests In Respect of the <ahmanson.org> Domain Name

Paragraph 4(a)(ii) of the Policy provides that a Respondent may establish rights or a legitimate interest in a domain name if it can show that:

1. Before any notice of the dispute, Respondent used, or made

demonstrable preparations to use, the domain name in connection with a bona fide offering of goods or services; or

2. Respondent has been commonly known by the domain name; or
3. Respondent is 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.

Respondents here can make no such claims.

Respondents operate under the names Save Open Space and Electronic Imaging Systems; they have never done business as, or been commonly known as, Ahmanson or Ahmanson Ranch. Nor could they. Complainant and other members of the Ahmanson Companies have filed Articles of Incorporation under Section 200 of the California Corporations Code containing their respective corporate and trade names (e.g., H.F. Ahmanson & Company, Ahmanson Land Company, Ahmanson Mortgage Company, Ahmanson Developments, Inc., Ahmanson Residential Development, Ahmanson Commercial Development Company, Ahmanson Insurance, Inc., Ahmanson Marketing, Inc., Ahmanson Obligation Company, Ahmanson Ranch, Inc., and Ahmanson Residential and, pursuant to California Business and Professions Code Section 14415, those companies have a presumptively exclusive right to use such trade names, as well as any confusingly similar names. Therefore SOS and EIS, both California-based entities, simply could not operate under the Ahmanson banner. Cf., Finter Bank Zurich (applying similar provision under Swiss law).

Nor can Respondents claim they are making a “fair use” of Ahmanson’s trade name and marks. To the contrary, they are using the Ahmanson trade name and mark to misleadingly identify the source of their website.

In the WIPO decision regarding the <montyroberts.org> domain name -- a case on all fours with the instant matter -- the Respondent argued that its use of the domain name was a fair use because it operated a website at that domain name dedicated to the “dissemination of legitimate news-worthy information about the pre-existing controversy surrounding Monty Roberts and his horse training techniques from various sources.” Monty Roberts, supra at p. 10. The Panel in that case noted “there is nothing in the domain name to indicate that the site is devoted to criticism of Complainant, even though this criticism is apparent upon visiting Respondent’s site.” Id. Finding that “Respondent is using Complainant’s famous mark to attract Internet users to its own website,” the Panel concluded Respondent’s use of Complainant’s mark was neither legitimate noncommercial nor fair use of the mark, and ordered the domain name transferred to Complainant.

Similarly, in DFO v. Christian Williams, WIPO Administrative Panel Decision, Case No. D2000-0181, the respondent claimed he was making “fair use” of the name and mark of the Denny’s restaurant chain because he had registered <dennys.net> in order to run a “chat group” of Denny’s

restaurant habitués. The Panel found that respondent had not chosen a domain name that made fair use of the Denny's name to identify his website for what it was, noting that "[a]ny number of ways of styling such a fair use domain name come readily to mind." Accord, Compagnie de Saint Gobain v. Com-Union Corp., WIPO Administrative Panel Decision, Case No. D2000-0020 (respondent's registration and use of <saintgobain.net> for the purpose of discussing matters relevant to shareholders of Compagnie de Saint Gobain was not "fair use"; respondent could easily have chosen domain name that more adequately reflected the nature of its site).

Several federal courts have, under similar circumstances, also found that use of a mark as a domain name serves as a source identifier, not communicative speech, and rejected registrants' "fair use" arguments. E.g., Planned Parenthood v. Bucci, 1997 U.S. Dist. LEXIS 3338, \*34-35, 42 U.S.P.Q.2d (BNA) 1430 (S.D.N.Y. 1997) (Annex 29); OBH, Inc. v. Spotlight Magazine, 86 F.Supp.2d 176, 185 (W.D.N.Y. 2000); Cf., Cardservice International, Inc. v. McGee, 950 F.Supp. 737, 741 (E.D.Va. 1997) *aff'd*, 129 F.3d 1258 (4<sup>th</sup> Cir. 1997) ("[A] domain name is much more than a mere Internet address. It also identifies the Internet site to those who reach it, much like . . . a company's name identifies a specific company."); Virtual Works, Inc. v. Network Solutions, Inc., 2000 U.S. Dist. LEXIS 2670, \*5, 54 U.S.P.Q.2d (BNA) 1126 (E.D.Va. 2000).

The same circumstances that drove the Monty Roberts, DFO and Compagnie de Saint Gobain decisions (and corresponding federal court decisions) are evident here. First, Respondents are using the <ahmanson.org> domain name as an identifier of their website, not a criticism of Ahmanson or the Ahmanson Ranch project. As in the Monty Roberts, DFO and Compagnie de Saint Gobain cases, there is nothing in the <ahmanson.org> domain name to indicate Respondents' site is devoted to criticism of Ahmanson, or of the Ahmanson Ranch project. The fact that such criticism (and an appeal for financial support) is apparent once an Internet user reaches Respondents' site does not change the fact that Respondents have used Ahmanson's name and mark to divert Internet traffic to their site.

It should be noted that Complainants are in no way seeking to constrain Respondents' criticism of Ahmanson Land, its parent company, or the Ahmanson Ranch project. Respondents are free to express their views on a website that does not infringe on Complainant's trademark rights, such as the website SOS operates at its <saveopenspace.com> domain name. Rather, Complainants seek only to protect their trade name and marks, and to ensure Respondents do not use the fame and recognition of the Ahmanson name and marks to misleadingly divert Internet users to their own website or to tarnish the goodwill associated with such name and marks.

#### 5.9. Respondents Have Registered and Used the <ahmanson.org> Domain Name In Bad Faith

Paragraph 4(b) of the Policy provides a non-exhaustive list of circumstances that constitute evidence of bad faith registration and use of a domain name, several of which are present here. In particular, it is abundantly clear that Respondents registered the <ahmanson.org> domain name in order to (1) prevent Ahmanson from reflecting its trade name and mark in a corresponding domain name, (2) disrupt Ahmanson Land's development of the Ahmanson Ranch project, and (3) misdirect Internet users to their web site for financial gain and to further their anti-Ahmanson purpose.

As long-time opponents of the Ahmanson Ranch project, Respondents have been well aware of the Ahmanson and Ahmanson Ranch trade name and marks for years. Yet, they registered Ahmanson's name as their domain name anyway, even though Respondent SOS already operated a website at its <saveopenspace.com> domain name which contained the same information as it now posts at the <ahmanson.org> site. Respondents' purposes in doing so are clear: to prevent Ahmanson from using its name and mark as a domain name, and to lure Internet users seeking information on Ahmanson or the Ahmanson Ranch project onto their website instead, where SOS asks those users for donations to support its anti-Ahmanson cause and encourages them to boycott Ahmanson's parent company. These purposes are prototypical examples of bad faith registration and use under Paragraph 4.b. of the Policy, and are more than sufficient to justify transference of the <ahmanson.org> domain name to Ahmanson. See Monty and Pat Roberts, supra, at 11 (noting that respondent's claim that financial gains from deceptive registration are used for charitable purposes does not negate finding of bad faith); DFO, supra (holding respondent's registration of <dennys.net> with full knowledge the name belonged to Complainant and subsequent use of name as "chat group" of Denny's restaurant patrons was strong evidence of bad faith; and rejecting respondent's argument that his use of a prominent disclaimer on his website eliminated any likelihood of confusion among Internet users as to the source or sponsorship of the website). Cf. The Chicago Tribune Company v. Jose P. Varkey, WIPO Administrative Panel Decision, Case No. D2000-0133 (respondent's registration and use of domain name identical to complainant's mark to attract Internet users to his site for the purpose of soliciting them to "join LOVE-OF-GOD-JESUS" fell within "commercial gain" element of paragraph 4(b)(iv) of the Policy and demonstrated bad faith registration and use.)

## B. Respondents

5.10 Complainant Ahmanson Land Company ("Complainant") has the impossible burden of demonstrating Respondents Save Open Space ("SOS") and Electronic Imaging Systems ("EIS") (collectively "Respondents") have infringed upon Complainant's trademark. In order to meet its burden, Complainant must prove each of the following three elements:

1. Respondents' domain name "ahmanson.org" is identical or confusingly similar to Complainant's trade-mark or service name in which Complainant has a right; *and*

2. Respondents have no rights or legitimate interest in respect to their domain name; *and*
3. Respondents' domain name was registered and is being used in bad faith.

Uniform Domain Name Dispute Resolution Policy (“UDNDRP”).

Respondents will demonstrate that Complainant has failed to meet its heavy burden and has commenced this proceeding in bad faith.

5.11 Complainant Ahmanson Land Company does not have a valid trademark in the name “AHMANSON”. Complainant concedes that it does not have a registered trademark in either the name “Ahmanson” or “Ahmanson Ranch”. This is evidenced by Complainant's recent filing of twenty Intent to Use applications on June 7, 2000--seven months after Respondents first registered their domain name. This clearly demonstrates that Complainant has never used the name “Ahmanson” by itself to reflect any of its goods or services. Complainant cannot even demonstrate that it has a valid trademark in the name “Ahmanson”, let alone that its alleged mark is being diluted or infringed.

5.12 Respondents' domain name is not identical or confusingly similar to Complainant's mark. In order to prevail on its claim, Complainant must prove that Respondents' domain name--<ahmanson.org>--is identical or confusingly similar to its alleged trade or service mark of which Complainant has rights. Complainant's sparse analysis on this point underscores its inability to meet its burden of proof. In order for a mark to receive protection, it must be more than distinctive--*it must be truly famous* (i.e. truly prominent and renowned). See Avery Dennison Corp. v. Sumpton, 189 F.3d 868, 875 (9th Cir. 1999); Carnival Corp. Seaescape Casino Cruises, Inc., 74 F.Supp. 2d 1261, 1269 (S.D. Florida 1999). “Thus, to be capable of being diluted, a mark must have a degree of distinctiveness and ‘strength’ beyond that needed to serve as a trademark.” Avery Dennison, 189 F.3d at 876 [quoting 3 McCarthy, Trademarks and Unfair Competition, § 24:109]. The Trademark Review Commission intentionally limited the class of trademarks eligible for protection, stating: “We believe that a limited category of trademarks, those which are truly famous and registered, are deserving of national protection from dilution.” Trademark Review Commission, Report & Recommendations, 77 Trademark Rep. 375, 455 (Sept-Oct. 1987). Courts generally consider a non-exclusive list of factors to determine whether a mark is truly famous and distinct. See 15 U.S.C. § 1125(c)(1). The following analysis of the relevant factors clearly indicates the name “Ahmanson” is not a famous mark deserving of protection.

- (a) Complainant does not have a registered trademark. As addressed above, Complainant does not have a registered trademark of the names “Ahmanson” or “Ahmanson Ranch”. Rather, as Complainant concedes, it only recently filed intent to use applications for the names

“Ahmanson” and “Ahmanson Ranch” on June 7, 2000. (*Id.*). Hence, Complainant has not even established a valid trademark in the name "Ahmanson", let alone a showing of famousness.

- (b) Surnames are not protected trademarks. Complainant has no exclusive right to the surname “Ahmanson”. A mark that is “primarily merely a surname” is not protectable unless it acquires a secondary meaning. Avery Dennison, 189 F.3d at 877; 15 U.S.C. §1052(e) & (f); Abraham Zion Corp. v. Lebow, 761 F.2d 93, 104 (2d Cir. 1985). In Avery Dennison, 189 F.3d at 877, the court denied a claim of trademark infringement and dilution because the name “Avery” and “Dennison” were surnames--widely used by a number of businesses, on and off the Internet. “Ahmanson” is merely a surname derived from the late Howard F. Ahmanson. A “Lexis” search has yielded over 125 persons with the name "Ahmanson". The term "Ahmanson" is not famous. It is a widely used name that has acquired no secondary meaning.
- (c) The word “Ahmanson” is widely used by third parties. The name “Ahmanson” is not protected because it is widely used by businesses, both on and off the Internet. The name is so widespread that a recent “Yahoo!” search engine uncovered over 3900 references. When “a mark is in widespread use, it may not be famous for the goods and services of one business.” *Id.* at 878 [citing Report & Recommendation, 77 Trademark Rep. at 461; Accuride International, Inc. v. Accuride Corporation, 871 F.2d 1531, 1539 (9th Cir. 1989); Carnival Corp., 74 F.Supp. 2d at 1271. Numerous persons and entities have registered domain names that include the name “Ahmanson”. For example, <ahmanson.com> is a web site owned by Robert Ahmanson, an individual. The “Ahmanson Theater”, trademarked since 1978 and perhaps the most prevalent use of the “Ahmanson” name in Southern California, is renowned in Los Angeles for theatrical productions. In Southern California alone, there are numerous other businesses and organizations that commonly use the name “Ahmanson”, for example: Ahmanson Pediatric Center; Ahmanson Foundation; Ahmanson Biological Imaging Center; Ahmanson Dining Commons; Ahmanson Radio Listening Room; and Ahmanson-UCLA Cardiomyopathy Clinic. Although these businesses and organizations share the namesake of the late Howard F. Ahmanson, these companies have no association with Complainant or any of the so-called “Ahmanson family of companies”. The evidence clearly shows the name “Ahmanson” is in such widespread use that it cannot be famous for the goods and services provided by just one business. See Avery Dennison, 189 F.3d at 878. Hence, the mark is not famous because it is commonly used by third parties.
- (d) “Ahmanson” has not acquired secondary meaning. Complainant has failed to show that the name “Ahmanson”--by itself--has acquired secondary meaning. The Trademark Office did not grant a mark to the surname “Ahmanson”--only to the term “Ahmanson Mortgage.” Ahmanson Mortgage merely arranged real estate loans and is now

defunct. Complainant cannot demonstrate that the name “Ahmanson” is solely associated in the minds of the public with the products and services of the Ahmanson Land Company. As illustrated above in Section (c), the name Ahmanson is associated with a wide array of businesses and organizations that have no relationship to the Complainant. Complainant attempts to mislead the Panel into believing that all companies that bear the name Ahmanson are somehow related to it. This is not true. The companies listed above in section (c) are not associated with Complainant. Complainant has shown no secondary meaning.

- (e) No confusion is created by Respondents' web site. Complainant claims Respondents' domain name is confusingly similar, but offers no proof that confusion actually or is likely to exist. See Carnival Corp., 74 F.Supp at 1264 [““Likelihood of confusion” means probable confusion rather than mere possible confusion.”]. Complainant cannot “matter-of-factly” state that confusion exists and provide no conclusive data to support its claim. See Bally Total Fitness v. Faber, 29 F.Supp. 2d 1161, 1164 (C.D. Cal. 1998). The mere fact that a mark incorporates a form of a common word does not render marks similar. See Michael Caruso, 994 F.Supp. 1454, 1460 (S.D. Florida 1998); Amstar Corp. v. Domino's Pizza, Inc., 615 F.2d 252, 260 (5th Cir. 1980) (“Domino's Pizza” not similar to “Domino” sugar). As illustrated above, “Ahmanson” is widely used by numerous business and organizations. Respondents only use the term “Ahmanson” in their domain name--not “Ranch” or “Land Company”. Hence, no confusion exists because Respondents' domain name is not similar to Complainant's mark. Complainant's reliance on Monty Roberts, Inc. v. J. Bartell, WIPO Case No. D2000-0300 and Finter Bank Zurich v. Ginluca Olivieri, WIPO Case No. D2000-0091, for the proposition that Respondents' domain name is confusingly similar to Complainant's mark is misplaced. In both Monty Roberts and Finter, the names used had acquired secondary meaning because of their distinctiveness. As illustrated above, the “Ahmanson” name lacks distinctiveness because it is commonly used by numerous businesses in the Southern California area which are not related to Complainant. In addition, Respondents merely employ the <.org> designation--not the popular <.com> designation. In the recent WIPO decision of Bridgestone Firestone Inc. v. Jack Myers, WIPO Case No. D2000-0190 (July 6, 2000), the Panel specifically recognized that appropriation of other gTLD designations does not usurp the trademark holder from utilizing the customary <.com> commercial designation or other permutations of the mark for its “official site”. Bridgestone, p. 6-8; Avery Dennison, 189 F.3d at 880-81. Complainant can still seek the popular <.com> designation or any permutation of the name “Ahmanson”. Complainant's recitation to newspaper articles concerning the Ahmanson Ranch project is also of no avail. Given the widespread use of the name “Ahmanson” in Southern California alone, Complainant cannot show the public associates “Ahmanson” solely with its products or services. In

addition, no confusion exists because persons that reach Respondents' web site are immediately informed that they have reached a web site that opposes the proposed Ahmanson Ranch development. When an individual enters <ahmanson.org>, the user is first greeted by the words on the top of the page that read, "Save Ahmanson Ranch from Washington Mutual Development". This allows the Internet user to immediately determine the content of the web site before the home page actually loads into the computer. See Planned Parenthood, 1997 U.S. Dist. LEXIS 3338, [\*27]. Hence, it is highly unlikely that the reasonable Internet user will be confused as to the content of Respondents' site. Moreover, Complainant's claim that <ahmanson.org> is confusing is wholly disingenuous for one simple, yet compelling, reason: Complainant has filed no action against the registrant of the <ahmanson.com> web site. Complainant cannot reasonably argue the <ahmanson.org> web site causes confusion, but the <ahmanson.com> web site does not. Both web sites use the "Ahmanson" surname. It is axiomatic that if <ahmanson.com> causes no confusion, then <ahmanson.org> causes no confusion either. Complainant's failure to pursue a claim against <ahmanson.com> should signal a red flag indicating its only purpose for commencing this action is to quash Respondents' Constitutional Right of Free Speech. Moreover, Complainant offers no polls or surveys indicating confusion actually or is likely to exist. Complainant has simply failed to prove Respondents' domain name is confusingly similar to its alleged mark.

- (f) Respondents' web site has no commercial purpose. Contrary to Complainant's assertion, Respondents' web site has no commercial purpose. "Commercial use under the Federal Trademark Dilution Act requires the defendant to be using the trademark, capitalizing on its trademark status". Panavision Int'l, L.P. v. Toeppen, 141 F.3d 1316, 1325 (9th Cir. 1998). As Complainant concedes, Respondents are a non-profit organization. Respondents do not sell goods or services, but merely provide commentary with regard to environmental issues. See Bally, 29 F.Supp. 2d at 1164 [consumer commentary not commercial purpose]; Bridgestone, p. 8 [use of mark for consumer commentary does not infringe or dilute a trademark]. Accordingly, Respondents do not charge a membership fee to access their web site. In addition, Respondents distribute a newsletter (via e-mail) with regard to environmental issues concerning "Ahmanson Ranch" absolutely free. Hence, no confusion exists because Respondents' web site is devoid of any commercial purpose.
- (g) Complainant's "local" fame claim is unavailing. Complainant claims that the "local" fame of the name "Ahmanson Ranch" is sufficient to prove famousness. Complainant is mistaken. The evidence overwhelmingly illustrates the name "Ahmanson" is widely used by numerous businesses and organizations in the Southern California area. See above § 1(c)). Complainant has produced no evidence proving the general public associates the surname "Ahmanson" solely

with its goods and services. Complainant has failed to show localized fame.

- (h) Advertising expenditures do not create a famous mark. The only token Complainant offers to show that “Ahmanson” is a famous mark is alleged advertising expenses. But the mere fact that a plaintiff has participated in extensive advertising is not sufficient to establish fame. Carnival Corp., 74 F.Supp. 2d at 1270; Avery Dennison, 189 F.3d at 878-879 [extensive advertising and volume of sales does not establish fame]; Kellogg Co. v. National Biscuit Co., 305 U.S. 111 (1938) [no secondary meaning found even though over 17 million dollars spent in advertising and used the term “shredded wheat” exclusively for over 35 years]. Complainant's advertising expenditures are not enough to show famousness. As the foregoing analysis proves, Complainant has simply failed to prove the surname “Ahmanson” is a truly famous mark deserving of trademark protection or that Respondents’ domain name is identical or similarly confusing to its alleged mark.

5.13 Respondents possess a right and legitimate interest in the <ahmanson.org> domain name. A respondent can show a right or legitimate interest in a domain name by demonstrating any of the following circumstances:

1. Before any notice to you of the dispute, your use of, or demonstrable preparations to use, the domain name or a name, in connection with a bona fide offering of goods or services; or
2. 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.

UDNDRP ¶ 4(c), Respondents can show that they have a right and legitimate interest to the <ahmanson.org> domain name via each circumstance listed above.

- (a) Respondents properly used the domain name in connection with a legitimate noncommercial purpose before the dispute arose. The use of a mark for purposes of consumer commentary and criticism does not infringe or dilute a trademark. Bally, 29 F.Supp.2d at 1166; Bridgestone, p. 8. Accordingly, Respondents' use of the domain name <ahmanson.org> falls within the protection provided by both Paragraphs 4(c)(i) and (iii) of the UDNDRP, *supra*. Given that the elements of the defenses in Paragraphs 4(c)(i) and (iii) are so intertwined, Respondents address both as follows:
- (b) Respondents’ use predates any notice of dispute. Respondents registered and used their domain name on November 18, 1999--prior to receiving any notice of Complainant’s dispute. Respondents first received notice of Complainant’s dispute on June 22, 2000. Hence, the first prong of 4(c)(i) is easily met.

- (c) Respondents' use is in connection with a bona fide noncommercial service. Respondents are using their domain name in connection with a bona fide purpose: for the purely noncommercial purpose of providing criticism and commentary with regard to environmental issues concerning the "Ahmanson Ranch" project. See Bally, 29 F.Supp.2d 1161, 1167-68 [use of a mark for purposes of First Amendment commentary and criticism is protected].; Bridgestone, p. 7 [use of domain name for criticism and commentary is a right or legitimate interest under Paragraph 4 (c)(iii)]. It has long been held that an individual's First Amendment right of free speech in connection with consumer commentary and criticism is protected. See Bally, at 1167; See L.L. Bean, Inc. v. Drake Publishers, Inc., 811 F.2d 26, 29 (1st Cir.), cert denied, 483 U.S. 1013, 97 L. Ed. 2d 753, 107 S. Ct. 3254 (1987); See 4 McCarthy § 24:105 at 24-191. Courts have rejected the notion that trademark rights may eclipse First Amendment protection. Id. The Bally and Bridgestone actions are identical to the present facts at hand. There, the defendants were not selling or promoting a product, but merely using the plaintiff's mark for criticism and consumer commentary. In Bridgestone, the WIPO Panel denied the complainant's claim for transfer and expressly recognized the Constitutional Right of Free Speech as a legitimate defense to a trademark claim, stating:

The Internet is above all a framework for global communication, and the right to free speech should be one of the foundations of Internet law. The Respondents principal purpose in using the domain name appears not to be commercial, but rather to exercise his First Amendment right to criticize the Complainants. Bridgestone, p. 7-8.

Similarly, here, Respondent SOS is a non-profit organization dedicated to the expression of environmental issues. Respondents do not sell products or merchandise. Nor do Respondents charge a fee to access any part of their web site. The sole purpose of Respondents' web site is to exercise their First Amendment right of free speech by providing the public with environmental information that may have an impact on various communities. See Id.

Complainant's reliance on Planned Parenthood, Monty Roberts, DFO, Inc. v. Christian Williams, Case No. D2000-0181, and Finter Bank Zurich for the proposition that Respondents have no legitimate interest in their domain name is misplaced. These cases are wholly inapposite because in each instance the mark was found to be famous. As analyzed above, Complainant simply has not, and cannot, show that its alleged mark is famous which is deserving of trademark protection.

Moreover, Complainant's reference to DFO and Compagnie de Saint Gobain v. Com-Union Corp., Case No. D2000-0020, is equally unavailing. In both DFO and Saint Gobain the domain names were identical to the complainant's mark. Here, Respondents' domain name is not identical to Complainant's mark. Second, the complainants in

both DFO and Saint Gobain had registered trademarks. Here, Complainant does not even have a registered trademark of the name “Ahmanson”. Third, in both DFO and Saint Gobain, the defendants decided not to use the domain names for their original purpose. See DFO, at p. 4; Saint Gobain, at p. 4. Here, Respondents have at all times maintained, operated, and intend to use their domain name for commentary.

Both recent WIPO and Federal Court decisions have recognized that the use of a mark for criticism and consumer commentary is a legitimate interest--even when it is identical or similar to a complainant's mark. Hence, Respondents are protected by the defenses provided in Paragraphs 4(c)(i) and (iii)

- (d) Respondents' domain name does not misleadingly divert consumers or tarnish complainant's alleged mark. The WIPO Panel in Bridgestone also concluded that the defendant had not misled consumers or tarnished the complainant's mark. The Bridgestone Panel recognized that the defendant had not used the <.com> designation, had posted disclaimers on the web site homepage, and had included criticism and commentary on the site so that a “reasonably prudent Internet user” could tell that the site was not the trademark holders “official” site. Bridgestone, p. 7-8. As in Bridgestone, Respondents' <ahmanson.org> domain name does not misleadingly divert consumers or tarnish Complainant's alleged mark. First, Respondents have not used the popular <.com> designation in their domain name. Id., p. 8 [users not misleadingly diverted because <.com> designation not utilized]; Avery Dennison, 189 F.3d at 868, 880-81 [noting distinction between <.com> versus <.net> designations and that a fact finder could infer dilution does not occur with <.net> registration]. In addition, Respondents have posted a disclaimer on the web site home page (“Save Ahmanson Ranch from Washington Mutual Development”) which allows the Internet user to immediately determine the content of the web site before the home page actually loads into the computer. See Id.; See also Planned Parenthood, 1997 U.S. Dist. LEXIS 3338, [\*27]. In Bridgestone, the Panel expressly recognized that a domain name need not indicate that it is critical of a Complainant, stating:

The Panel sees no reason to require domain name registrants to utilize circumlocutions like <trademarksucks.com> to designate a website for criticism or consumer commentary.

We must be acutely aware of excessive rigidity when applying the law in the Internet context; emerging technologies require a flexible approach. (citations omitted). Bridgestone, at p. 6.

Moreover, Respondents have included criticism and commentary so that a reasonably prudent Internet user can tell the site is not an official "Ahmanson Ranch" site. See Bridgestone, p. 7-8: “Save

Ahmanson Ranch from Washington Mutual Development”;  
“Washington Mutual, America's Environmental Enemy”).

Respondents are protected by the express defenses provided in Paragraphs 4(c)(i) and (iii) the right and interest in their domain name because it is used to provide criticism and commentary--well before Complainant issued notice of the underlying dispute. Complainant has provided no evidence to indicate its consumers have been mistakenly diverted to Respondents' web site or that its alleged mark has been tarnished. Complainant's action must fail.

5.14 Respondents have registered <ahmanson.org> in good faith. Lastly, in order to meet its burden of proof, Complainant must also show that Respondents acted in bad faith when registering their domain name. In order to evidence registration of a domain name in bad faith, Complainant must show:

1. The domain name was registered for the purpose of selling, renting, or otherwise transferring it to the complainant; or
2. The domain name was registered in order to prevent the owner of a mark from reflecting the mark in a corresponding domain name; or
3. The domain name was registered primarily for the purpose of disrupting the business of a competitor; or
4. The domain name was registered to intentionally attract, for commercial gain,
5. Internet users by creating a likelihood of confusion with the complainant's mark.

UDNDRP, Paragraph 4(b).

Complainant has failed to prove bad faith.

- (a) Respondents are not trying to sell the domain name. Respondents are clearly not cybersquatting. In a typical cybersquatting case, a defendant registers a mark with the intent to sell the domain name to an owner of a mark for a profit. Avery Dennison, 189 F.3d at 880-81; Intermatic, Inc. v. Toeppen, 947 F.Supp. 1227, 1239 (1996); Panavision, 945 F.Supp. at 1303. Complainant has not, and cannot, allege that Respondents are offering the <ahmanson.org> domain name for sale. This alone shows that Respondents have acted in good faith.
- (b) Complainant is not prevented from reflecting its mark in a corresponding domain name. The evidence clearly shows Respondents did not intend to prevent--nor have they prevented--Complainant from registering a permutation of the “Ahmanson” surname. First, Respondents did not deprive Complainant of the

<.com> designation because they merely registered the less popular <.org>. Id. Second, Respondents only registered <ahmanson.org> -- they did not attempt to register any other permutation of the term "Ahmanson". Id. Bridgestone, at p. 8 [domain registration other than <.com> is legitimate fair use]. Third, Complainant recently filed domain name registrations of over 115 permutations of the name "Ahmanson". Complainant's registration of nearly every conceivable permutation of the name "Ahmanson" demonstrates Complainant has not been prevented from reflecting its mark in a corresponding domain name.

- (c) Respondents are not business competitors. Complainant and Respondents are not business competitors. Respondents do not sell goods or services or use their web site for any commercial purpose. In Bally, supra, the court held that a site for commentary and criticism does not compete with another. Bally, 29 F.Supp.2d at 1164. As demonstrated above, Respondents' web site is merely used to criticize and comment on the "Ahmanson Ranch" project; a legitimate First Amendment Right. Complainant argues Respondents' site is commercial because SOS accepts donations. This argument is unavailing. In Los Angeles Times v. Free Republic, 2000 U.S. Dist. Lexis 5669 [\*43-44] (C.D. Cal. 2000), the court ruled that an organization that accepted donations was not a commercial entity because it had non-profit characteristics. The court opined that infringement is permissible when the use fosters debate and discussion regarding the issues of the day. Id.; Hustler Magazine, Inc. v. Moral Majority, Inc., 796 F.2d 1148, 1153 (9th Cir. 1986). The facts of Los Angeles Times are analogous to the present action. Like the defendant in Los Angeles Times, Respondent SOS's web site is not commercial because it does not sell goods or services or generate revenue. Furthermore, Respondents' web site fosters debate with regard to the Ahmanson Ranch project--an environmental issue of the day. The fact that Respondents accept donations does not make them a commercial entity. Hence, Respondents are not commercial competitors. Respondents' First Amendment right permits and encourages speech on issues of public concern. In California, the right of an individual to speak freely and publicly *without persecution* has been codified by California Code of Civil Procedure § 425.16. The California Legislature specifically enacted this statute to protect an individual's first amendment rights when participating in public matters, stating:

The legislature finds and declares that there has been a disturbing increase in lawsuits brought primarily to chill the valid exercise of the constitutional rights of freedom of speech and petition for the redress of grievances. The Legislature finds and declares that it is in the public interest to encourage continued participation in matters of public significance, and that this participation should not be chilled through abuse of the judicial process. C.C.P. § 425.16.

By filing this proceeding, Complainant has attempted an "end-run" to avoid the clear force and effect of this powerful statute and to subvert Respondents' right of free speech. Respondents have not interfered with Complainant's business activities. It is their Constitutional right to criticize and comment on matters of public concern. A housing project as ominous as Ahmanson Ranch is clearly such a matter.

- (d) Respondents are not acting for commercial gain. As demonstrated above, Respondents are not acting for any commercial gain. Respondents are a non-profit organization and do not generate revenue in the traditional sense. See Los Angeles Times, *supra*. Respondents do not market or sell goods, nor do they compete with Complainant as a business competitor. Moreover, none of the board members of SOS receive a salary or any economic benefit. Neither is Respondents' web site creating a likelihood of confusion with the product or services of Complainant Ahmanson Land Company. As demonstrated above in Section 1 Complainant does not have a valid registered trademark of the name "Ahmanson." Moreover, the surname "Ahmanson" does not have the requisite famousness to receive trademark protection because it is a widely used term. Complainant has failed to provide any evidence of confusion. Because Respondents are not using their domain name for commercial gain, nor creating confusion with Complainant's goods or services, Respondents' domain name has been registered in good faith.

- 5.15 Complainant has acted in bad faith. Complainant has alleged that Respondents acted in bad faith when registering the domain name <ahmanson.org>. In reality, Complainant has acted in bad faith. Complainant's sole purpose for commencing this action is to quash Respondents' First Amendment right to criticize and comment on the Ahmanson Ranch project. Indeed, Complainant has a significant motive in shutting down Respondents' web site. Complainant does not want the public to become aware of the detrimental impact that its proposed development poses to the surrounding communities. Complainant is attempting to stifle free speech for its own gain. Complainant's malevolent intent is illustrated by a number of factors: First, Complainant did not commence a proceeding against the web site registrant of <ahmanson.com>-which, according to Complainant's reasoning, would be highly confusing. Complainant has not pursued <ahmanson.com> because it does not comment on the proposed Ahmanson Ranch project. Complainant has cast itself in the role of "Internet God." Complainant cannot choose which web sites it doesn't like and then attack them. If <ahmanson.com> is not confusing, then neither is <ahmanson.org>. Respondent is confident that the Panel will see this action for what it truly is: a blatant attempt to repress Respondents' First Amendment Rights. Second, Complainant's bad faith is further demonstrated by its registration of numerous web sites--none of which it is likely to use. For instance, Complainant has registered the domain name <stopahmansonranch.com>. Complainant's only purpose in registering this domain name is to prevent others from speaking out about its proposed development and to discourage public participation. It is highly

unlikely that Complainant will ever use the domain name <stopahmansonranch.com> to provide information about its proposed development. Complainant has registered these domain names in bad faith.

- 5.16 Complainant Ahmanson Land Company has failed to meet its burden of proof. Complainant has failed to demonstrate a valid registered trademark deserving of trademark protection in the name “Ahmanson”. Moreover, Complainant has made no showing of famousness. More importantly, Respondents have illustrated that their use of the name “Ahmanson” is a legitimate noncommercial fair use that is protected by the First Amendment of the United States Constitution. Respondents have at all times acted in good faith and are protected by the express defenses provided by Rule 4(c)(i) and (iii) of the Policy. Complainant's action has been brought in bad faith and must fail.

## **6. Discussion and Findings**

- 6.1 Complainant must prove each of the following three elements set forth in the Uniform Domain Name Dispute Resolution Policy Paragraph 4(a), namely (i) the domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; (ii) Respondents have 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. The Panel will now look at each one of the elements to determine if Complainant has met its burden of proof. The Panelists have reviewed the various factual and legal arguments proffered by the parties but have focused their consideration and based this decision on a determination of whether the evidence is sufficient to support the elements of a claim or defense under the ICANN Policy and Rules.
- 6.2 The Panel has reviewed the evidence submitted by the Complainant concerning ownership of the term AHMANSON and is not satisfied that the Complainant has proven trademark rights in such term. Accordingly, the Panel finds that the domain name “ahmanson.org” is not identical or confusingly similar to a trademark in which the Complainant has rights.
- 6.3 The record does show legitimate noncommercial use or fair use by Respondents since the purpose of Respondents’ website is to serve as a noncommercial platform to criticize the development activities of Complainant. Determinations regarding legitimate noncommercial and fair use under the Policy require a balancing of trademark holder and other public interests. Respondent Save Open Space solicits contributions to a cause as a non-profit organization. This distinguishes its activities from those of the respondent in *Monty and Pat Roberts, Inc. v. J. Bartell*, Case No. D2000-0300, decided by Panelist Abbott on June 13, 2000. The respondent in *Monty and Pat Roberts* was engaged in direct and indirect profit-making activities. The activities of the Respondents in this case are closer to those of the cybergriper in *Bridgestone/Firestone, Inc. v. Jack Myers*, WIPO Case No. D2000-0190 (July 9, 2000), wherein the respondent was determined to be protected under Paragraph (4)(c)(iii) of the Policy. The Panel hereby finds that Respondents have shown legitimate noncommercial and fair use in the domain name in that Respondents are using AHMANSON for protest against development of the Ahmanson Ranch site.

6.4 Finally, the Panel has examined the issue of bad faith. The record has no evidence of Respondents' bad faith under Policy 4(b)(i) through (iv). Accordingly, the Panel finds that Complainant has not met its burden of proof as to Policy 4(a)(iii), which requires a showing that the domain name was registered and is being used in bad faith.

**7. Decision**

7.1 The Panel decides that the domain name "ahmanson.org" is not identical or confusingly similar to the mark of Complainant, that Respondents have shown noncommercial and fair use of the term in such domain name, and that the domain name in issue has not been registered and is not being used in bad faith.

7.2 The Panel hereby denies the Complaint.

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Clark W. Lackert  
Presiding Panelist

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Frederick M. Abbott  
Panelist

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Dana Haviland  
Panelist

Dated: December 4, 2000