



DECISION

Richard O'Barry v. Private Registrant / A Happy DreamHost Customer

Claim Number: FA1509001639391

PARTIES

Complainant is **Richard O'Barry** ("Complainant"), represented by **Henry L. Self III** of **Self & Powers**, California, USA. Respondent is **Private Registrant / A Happy DreamHost Customer** ("Respondent"), represented by **Zak Muscovitch** of **The Muscovitch Law Firm**, Canada.

REGISTRAR AND DISPUTED DOMAIN NAME

The domain name at issue is <dolphinproject.org>, registered with **New Dream Network, LLC dba DreamHost Web Hosting**.

PANEL

The undersigned certify that they have acted independently and impartially and to the best of their knowledge have no known conflict in serving as Panelists in this proceeding.

Roberto A. Bianchi, **Houston Putnam Lowry**, Chartered Arbitrator, **Ho-Hyun Nahm**, Chair, as Panelists.

PROCEDURAL HISTORY

Complainant submitted a Complaint to the FORUM electronically on September 24, 2015; the FORUM received payment on September 24, 2015.

On October 12, 2015, New Dream Network, LLC dba DreamHost Web Hosting confirmed by e-mail to the FORUM that the <dolphinproject.org> domain name is registered with New Dream Network, LLC dba DreamHost Web Hosting and that Respondent is the current registrant of the name. New Dream Network, LLC dba DreamHost Web Hosting has verified that Respondent is bound by the New Dream Network, LLC dba DreamHost Web Hosting registration agreement and has thereby agreed to resolve domain disputes brought by third parties in accordance with ICANN's Uniform Domain Name Dispute Resolution Policy (the "Policy").

On October 5, 2015, the FORUM served the Complaint and all Annexes, including a Written Notice of the Complaint, setting a deadline of October 30, 2015 by which Respondent could file a Response to the Complaint, via e-mail to all entities and persons listed on Respondent's registration as technical, administrative, and billing contacts, and to postmaster@dolphinproject.org. Also on October 5, 2015, the Written Notice of the Complaint, notifying Respondent of the e-mail addresses served and the deadline for a Response, was transmitted to Respondent via post and fax, to all entities and persons listed on Respondent's registration as technical, administrative and billing contacts.

A timely Response was received and determined to be complete on October 29, 2015.

Complainant's Additional Submission was received and determined to be complete on November 3, 2015. Respondent's Additional Submission was received and determined to be complete on November 5, 2015.

On November 5, 2015, pursuant to Complainant's request to have the dispute decided by a three-member Panel, the FORUM appointed Roberto A. Bianchi,

Houston Putnam Lowry, Chartered Arbitrator, Ho-Hyun Nahm, Chair, as Panelists.

Having reviewed the communications records, the Administrative Panel (the "Panel") finds that the FORUM has discharged its responsibility under Paragraph 2(a) of the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules") "to employ reasonably available means calculated to achieve actual notice to Respondent" through submission of Electronic and Written Notices, as defined in Rule 1 and Rule 2.

RELIEF SOUGHT

Complainant requests the domain name be transferred from Respondent to Complainant.

PARTIES' CONTENTIONS

A. Complainant

i) Complainant owns rights in the trademark and service mark DOLPHIN PROJECT. Complainant is Richard O'Barry, a highly regarded and internationally recognized animal rights activist who founded the DOLPHIN PROJECT in 1970. Complainant has acquired secondary meaning and common law rights in its DOLPHIN PROJECT mark, as Complainant has continuously used the mark in commerce, in fundraising materials, and on clothing to promote and support his animal rights endeavors. Respondent's <dolphinproject.org> domain name is identical to Complainant's DOLPHIN PROJECT mark. The domain name incorporates Complainant's entire mark, eliminates the space between components of the mark, and simply adds the generic top-level domain ("gTLD") ".org" to the mark.

ii) Respondent does not have any rights or legitimate interests in the <dolphinproject.org> domain name. Although Complainant and Respondent

were formerly associated, Complainant and Respondent have no continuing relationship and Respondent does not have authorization or license from Complainant to use the DOLPHIN PROJECT mark. Further, Respondent is not using the disputed domain name in connection with a *bona fide* offering of goods or services, or a legitimate noncommercial or fair use. Respondent uses the disputed domain name to confuse and misleadingly divert the public to Respondent's site rather than Complainant's.

iii) Respondent registered and used the disputed domain name in bad faith. Respondent has sought to create a likelihood of confusion with Complainant's mark as to source, sponsorship, affiliation, or endorsement of the website and in a manner that could harm the goodwill represented by the mark, in violation of Policy ¶ 4(b)(iv). Respondent is continuing to reap many thousands of dollars in crucial donations every month which donors intend to fund to Complainant's organization.

B. Respondent

i) This dispute is a business dispute involving competing claims of employment and contractual relations, intellectual property rights, and other complex issues. Such business disputes involving the determination of competing claims, including claims to a business domain name, are clearly outside the limited and narrow scope of the UDRP. Complainant has attempted to mischaracterize this claim as a mere cybersquatting dispute, but the facts clearly show otherwise. Furthermore, the UDRP procedure is not well suited to the resolution of the kinds of complicated factual disputes that are presented in this proceeding.

ii) Respondent, Earth Island Institute, is a non-profit, public interest organization dedicated to conservation and ecosystem protection. Complainant offered to give the disputed domain name to Respondent so it could launch its new dolphin welfare website at that address, and Respondent accepted. Control of the

domain name was given to Respondent on or about July 30, 2010 and registration of the domain name was formally changed on or about July 21, 2012.

iii) Complainant has not established trademark rights in the DOLPHIN PROJECT name. Complainant's pending trademark application is non-dispositive, because if anyone is entitled to a trademark registration for the DOPHIN PROJECT mark in connection with merchandise, it is Respondent. Further, the term "dolphin project" is merely descriptive of efforts to save dolphins and cannot be monopolized by any one person.

iv) Respondent has rights and legitimate interests in the disputed domain name. Complainant conveyed a domain name consisting of a descriptive phrase to his employer with the express purpose of the employer's using it to build its own site to promote a project which Complainant worked on in the normal course of his duties as an employee. Since 2011, Respondent has operated a robust website at the disputed domain name for its major dolphin protection project. In that time, Respondent has invested substantial resources in developing and promoting the site, and it has become a successful vehicle for educating the public about dolphin welfare issues, promoting Respondent's dolphin work, and raising funds to support that work. Respondent used the disputed domain name in connection with *bona fide* dolphin protection services before any notice of the dispute. Respondent has made legitimate non-commercial use of the disputed domain name without any intention to divert users consumers or to tarnish the alleged trademark at issue.

v) Respondent did not register or use the disputed domain name in bad faith. Respondent understood that Complainant conveyed ownership of the disputed domain name to Respondent irrevocably and unconditionally. Respondent took ownership and registration of the disputed domain name openly and successfully, building a website that continues to serve Respondent's mission

and the public good. Donations that come in through the disputed domain name are donations from Respondent's donors and visitors, representing relationships and reputation built through years of Respondent's investment of resources and effort.

C. Additional Submissions

(1) Complainant's Additional Submission

i) Respondent falsely claims that Complainant freely gave up ownership of the disputed domain name to Respondent in or around 2010. Complainant never agreed to sell or otherwise transfer its ownership to Respondent.

ii) Respondent disingenuously attempts to dismiss the quality of the disputed domain name website.

iii) Respondent claims that Complainant's Dolphin Project organization was largely dormant while Complainant worked with Respondent company is demonstrably false.

iv) Complainant had merely allowed Respondent permission to use the disputed domain name while Complainant worked there, and it should rightfully have been returned to Complainant when Complainant resigned.

v) Respondent feigns ignorance as to any actual confusion due to its continuing unauthorized use of his DOLPHIN PROJECT mark and the disputed domain name. Complainant submits actual examples of confusion.

vi) Respondent claims to be unaware of any DOLPHIN PROJECT merchandise having been offered for sale by Complainant's organization or Complainant from 2010 through Complainant resignation from Respondent company in 2014. However, this claim is not true.

(2) Respondent's Additional Submission

i) Great caution should be exercised by the Panel in determining the admissibility of an unsolicited additional submission. The Panel should not allow Complainant's purported additional submission.

ii) Complainant implicitly admitted in its additional submission that this dispute is outside the scope of the UDRP. Complainant further demonstrated that the facts are in dispute and without cross-examinations, etc., the Panel is unable to make a determination. Respondent fully addresses each of the numerous false allegations that were made in Complainant's additional submission.

FINDINGS

1. Additional Submissions respectively filed by both Complainant and Respondent are admissible.
2. The dispute that is the subject of the Complaint is outside the scope of the Policy and the Complaint should, therefore, be dismissed.
3. In view of the decision of the Panel on that issue and on the outcome of this proceeding, the Panel is of the opinion that it is neither necessary nor appropriate to express an opinion on the issues arising under the Policy.

DISCUSSION

Paragraph 15(a) of the Rules instructs this 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 that Complainant must prove each of the following three elements to obtain an order that a domain name should be cancelled or transferred:

- (1) the domain name registered by Respondent is identical or confusingly similar to a trademark or service mark in which Complainant has rights; and
- (2) Respondent has no rights or legitimate interests in respect of the domain name; and
- (3) the domain name has been registered and is being used in bad faith.

Preliminary Issue: Business/Contractual Dispute Outside the Scope of the UDRP

Respondent claims that this dispute is a business dispute involving competing claims of employment and contractual relations, intellectual property rights, and other complex issues. Respondent asserts that such business disputes involving the determination of competing claims, including claims to a business domain name, are clearly outside the limited and narrow scope of the UDRP.

Respondent alleges that Complainant has attempted to mischaracterize this claim as a mere cybersquatting dispute, but the facts clearly show otherwise. Furthermore, Respondent urges that the UDRP procedure is not well suited to the resolution of the kinds of complicated factual disputes that are presented in this proceeding.

Complainant has not at this time filed an additional submission explaining why this Complaint is properly within the scope of the UDRP.

The Panel notes that following the establishment of the relationship between Respondent and Complainant, the latter transferred control over the disputed domain name and operation of the corresponding website to Respondent. While Complainant contends that such transfer did not include the ownership of the disputed domain name Respondent argues that it legitimately understood it did, and that this understanding was reasonable, otherwise it would not have made such an important investment in human resources, efforts and money in developing an active website. The Panel, having examined the existing

evidence, in not in a position to clarify this issue, which includes establishing the exact nature of the relationship between Complainant (first contractor and later employee) and Respondent, and the real extent and nature of the transfer of control over the disputed domain name to Respondent, and of fiduciary duties linked to the relationship, if any. The Panel believes this can better be done by a court of competent jurisdiction, where witnesses would declare under oath and would be subject to cross examination.

Accordingly, the Panel finds this is a business and/or contractual dispute that falls outside the scope of the UDRP. In *Love v. Barnett*, FA 944826 (Nat. Arb. Forum May 14, 2007), the panel stated:

A dispute, such as the present one, between parties who each have at least a *prima facie* case for rights in the disputed domain names is outside the scope of the Policy ... the present case appears to hinge mostly on a business or civil dispute between the parties, with possible causes of action for breach of contract or fiduciary duty. Thus, the Panel holds that the subject matter is outside the scope of the UDRP and dismisses the Complaint.

In *Love*, the panel was concerned with *possible* causes of action for breach of contract. In this case, however, Respondent points out that these causes of action are currently active cases that are pending with the courts. According to the panel in *Love*, complex cases such as the one presented here may be better decided by the courts than by a UDRP panel:

When the parties differ markedly with respect to the basic facts, and there is no clear and conclusive written evidence, it is difficult for a Panel operating under the Rules to determine which presentation of the facts is

more credible. National courts are better equipped to take evidence and to evaluate its credibility.

The panel in *Luvilon Indus. NV v. Top Serve Tennis Pty Ltd.*, DAU2005-0004 (WIPO Sept. 6, 2005) concurred with this reasoning:

[The Policy's purpose is to] combat abusive domain name registrations and not to provide a prescriptive code for resolving more complex trade mark disputes The issues between the parties are not limited to the law of trade marks. There are other intellectual property issues. There are serious contractual issues. There are questions of governing law and proper forum if the matter were litigated. Were all the issues fully ventilated before a Court of competent jurisdiction, there may be findings of implied contractual terms, minimum termination period, breach of contract, estoppels or other equitable defenses. So far as the facts fit within trade mark law, there may be arguments of infringement, validity of the registrations, ownership of goodwill, local reputation, consent, acquiescence, and so on.

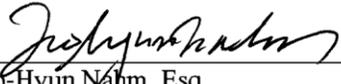
Based upon the reasoning outlined in the aforementioned cases and the record, the Panel concludes that the instant dispute contains a question of contractual interpretation, and thus falls outside the scope of the UDRP. Therefore, the Panel dismisses the Complaint. *See Everingham Bros. Bait Co. v. Contigo Visual*, FA 440219 (Nat. Arb. Forum Apr. 27, 2005) ("The Panel finds that this matter is outside the scope of the Policy because it involves a business dispute between two parties. The UDRP was implemented to address abusive cybersquatting, not contractual or legitimate business disputes."); *see also Fuze Beverage, LLC v. CGEYE, Inc.*, FA 844252 (Nat. Arb. Forum Jan. 8, 2007) ("The

Complaint before us describes what appears to be a common-form claim of breach of contract or breach of fiduciary duty. It is not the kind of controversy, grounded exclusively in abusive cyber-squatting, that the Policy was designed to address.”); *see also Frazier Winery LLC v. Hernandez*, FA 841081 (Nat. Arb. Forum Dec. 27, 2006) (holding that disputes arising out of a business relationship between the complainant and respondent regarding control over the domain name registration are outside the scope of the UDRP Policy).

DECISION

For the reasons presented above, the Panel concludes that relief shall be **DENIED**.

Accordingly, it is Ordered that the <dolphinproject.org> domain name **REMAIN WITH** Respondent.



Ho-Hyun Nahm, Esq.
Arbitrator

Roberto A. Bianchi, Houston Putnam Lowry, Chartered Arbitrator,
Ho-Hyun Nahm, Chair, as Panelists

Dated: November 17, 2015