

ADMINISTRATIVE PANEL DECISION

St. Louis University d/b/a Saint Louis University v.
SLUCOMPLIANCEPROJECT.ORG c/o Privacy Protect, LLC / Domain Admin,
Privacy Protect, LLC (PrivacyProtect.org) / Micheal Todd Rice
Case No. D2017-1759

1. The Parties

The Complainant is St. Louis University d/b/a Saint Louis University of Saint Louis, Webster Groves, Missouri, United States of America (“U.S.” or “United States”), represented by Lewis Rice, LLC, United States.

The Respondent is SLUCOMPLIANCEPROJECT.ORG c/o Privacy Protect, LLC / Domain Admin, Privacy Protect, LLC (PrivacyProtect.org), Burlington, Massachusetts, United States / Micheal Todd Rice of Missouri, United States, self-represented.

2. The Domain Names and Registrar

The disputed domain names <anewslu.org>, <makeslucompliant.org>, and <slucomplianceproject.org> are registered with Launchpad.com Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) in connection with the disputed domain name <slucomplianceproject.org> on September 13, 2017. On September 13, 2017, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On September 13, 2017, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain name <slucomplianceproject.org>, which differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to the Complainant on September 15, 2017, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint by September 20, 2017.

The Complainant filed an amended Complaint, received by the Center on September 21, 2017. The amended Complaint identified two further disputed domain names, <anewslu.org> and <makeslucompliant.org>, in addition to the disputed domain name <slucomplianceproject.org>.

On September 22, 2017, the Center transmitted by email to the Registrar a request for registrar verification in connection with the additional disputed domain names identified in the amended Complaint. On September 25, 2017, the Registrar transmitted by email to the Center its verification that the additional disputed domain names were registered on September 18, 2017, and that the Respondent was the registrant of each of the disputed domain names. The Center thereafter verified that the amended Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the "Policy" or "UDRP"), the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules"), and the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the "Supplemental Rules").

The Respondent contacted the Center by email on September 23, 2017, advising that the Complainant had commenced litigation against the Respondent "within the last week or two" in respect of "the domain name in question". The Respondent further informed the Center that the Complainant had sought a temporary restraining order, which the court had denied. On September 24, 2017, the Complainant also advised the Center of the lawsuit, pending in the United States District Court for the Eastern District of Missouri ("federal district court"), challenging the Respondent's use of the Complainant's trademarks with the "www.slucomplianceproject.org" website.

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on September 27, 2017. In accordance with the Rules, paragraph 5, the due date for Response was October 17, 2017. The Response was filed with the Center October 10, 2017. On October 16, 2017, the Complainant by email to the Center sought leave to file a further submission, to which the Respondent objected, suggesting that the best venue for additional issues would be the Complainant's federal court lawsuit. The Complainant submitted its unsolicited supplemental filing to the Center on October 25, 2017.

The Center appointed William R. Towns, Richard G. Lyon, and David H. Bernstein as panelists in this matter on November 1, 2017. The Panel finds that it was properly constituted. Each member of the Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Center to ensure compliance with the Rules, paragraph 7.

4. Factual Background

The Complainant is a Jesuit University founded almost two centuries ago in St. Louis, Missouri. The Complainant is the owner of United States trademark registrations for SAINT LOUIS UNIVERSITY, U.S. Reg. No. 1,729,449, registered on November 3, 1992; SLU, U.S. Reg. No. 1,731,196, registered on November 10, 1992; and SLUCARE, U.S. Reg. No. 2,039,441, registered on February 18, 1997 (hereinafter collectively referred to as "Complainant's marks"). The Complainant has used the SAINT LOUIS UNIVERSITY and SLU marks in connection with educational services since as early as 1832 and 1950, respectively.

The Respondent is a board-certified anesthesiologist and an assistant professor at Washington University School of Medicine in St. Louis, Missouri. The precursor of this dispute appears to have been a determination by the Complainant that Dr. Mandy Rice, a physician resident and the Respondent's spouse, would be required to repeat her fourth year of the Complainant's five-year graduate surgical residence program. Ms. Rice's appeal of the decision within the Complainant's university channels was unsuccessful. The Respondent on June 22, 2017, registered the disputed domain name <slucomplianceproject.org> using a privacy protection service. The disputed domain name resolves to the "St. Louis University Medical School Compliance Project (SLUCP)" website, on which the Respondent has posted content critical of the Complainant. The Respondent also created a Facebook page at "www.facebook.com/slucomplianceproject", including content critical of the Complainant.

On August 25, 2017, Ms. Rice filed a civil lawsuit against the Complainant in Missouri state court, asserting claims for damages for breach of contract, promissory estoppel, and defamation, and seeking injunctive relief. Subsequently, on September 12, 2017, the Complainant filed a civil lawsuit in federal district court naming the Respondent and Ms. Rice as defendants. The Complainant's lawsuit as originally filed alleged

dilution of the Complainant's marks under the federal Lanham Act and state law, cyberpiracy under the federal Anticybersquatting Consumer Protection Act (ACPA), and misuse of a benevolent society's name under state law. In addition to seeking compensatory damages, statutory damages and attorney's fees, the Complainant seeks to enjoin the Defendants' (including the Respondent in this case) use of the Complainant's marks and to obtain the transfer of the disputed domain name <slucomplianceproject.org>. The Complainant also submitted on September 12, 2017, the UDRP Complaint in this proceeding, received by the Center on September 13, 2017.

The Complainant filed a motion for a temporary restraining order (TRO) in its federal court lawsuit on September 12, 2017. The federal district court held a hearing on the Complainant's TRO motion on September 14, 2017, and thereafter issued an Opinion, Memorandum and Order ("Order") on September 22, 2017, denying the Complainant's TRO motion. The federal district court concluded at least for purposes of the TRO that the Defendants' use of the Complainant's SLU mark appeared to be within the "fair use" exception of the ACPA.¹

On or about September 18, 2017, several days after the filing of the Complainant's federal court lawsuit, the Respondent registered the disputed domain names <anewslu.org> and <makeslucompliant.org>. The Complainant on October 3, 2017, amended its federal court lawsuit to request the transfer of any domain names registered by the Respondent incorporating the Complainant's SLU mark.

5. Parties' Contentions

A. Complainant

The Complainant submits that the disputed domain names incorporate the Complainant's SLU mark and are identical or confusingly similar to the Complainant's SLU, SAINT LOUIS UNIVERSITY, and SLUCARE marks. According to the Complainant, the addition of descriptive terms such as "compliance project", "a new" and "make compliant" does not dispel the confusing similarity of the disputed domain names to the Complainant's marks. The Complainant further observes that its educational services website at "www.slu.edu" contains website pages concerning the Complainant's policies, oversight and compliance regulations and efforts, which may be found for example at "www.slu.edu/services/compliance".

The Complainant maintains that the Respondent has no rights or legitimate interests in respect of the disputed domain names. The Complainant avers that it has not licensed or otherwise authorized the Respondent to use the Complainant's marks, and that the Respondent has no business or other relationship with the Complainant. The Complainant further asserts that the Respondent has not been commonly known by the disputed domain names or by any name or mark similar to the Complainant's marks.

According to the Complainant, the Respondent is using the disputed domain names with the intent to disparage the Complainant, and is making an unauthorized use of the Complainant's marks to divert Internet traffic to the Respondent's websites for purposes of personal gain related to Ms. Rice's lawsuit, including the disparagement of the Complainant. The Complainant submits that such use does not constitute a *bona fide* offering of services, and accordingly is distinguishable from cases where a website is used for legitimate criticism.

The Complainant maintains that the disputed domain names incorporate the Complainant's marks without including a further indicator alerting Internet users that they are not being directed to the trademark owner's website. The Complainant contends that the Respondent's use of the disputed domain names creates initial interest confusion, is misleading as to source, gives rise to no rights or legitimate interests, is intended only to promote the lawsuit against Complainant, and consequently does not constitute a legitimate noncommercial or fair use of the disputed domain names under the Policy. The Complainant further contends that the Respondent's use of the Complainant's marks and copyrighted photographs of the

¹ Following a meeting of the Parties' counsel on September 13, 2017, the Respondent added disclaimers to his website and Facebook page. The federal district court considered the disclaimers in reaching a decision.

Complainant's campus, combined with generic terms that call to mind universities or academia, creates or lends to an impression that the websites are sponsored by or affiliated with the Complainant.

In light of the foregoing, the Complainant contends that the disputed domain names were registered and are being used by the Respondent in bad faith. The Complainant further submits that the Respondent was aware of the Complainant's rights in its well-known SAINT LOUIS UNIVERSITY and SLU names and marks when registering the disputed domain names. The Complainant contends that the Respondent's purported fair use of the disputed domain names is pretextual, and the Respondent is using the disputed domain names' websites solely to disparage the Complainant and promote Ms. Rice's lawsuit for personal or commercial gain.

B. Respondent

The Respondent questions whether the Complainant has rights in the SLU mark, and takes issue with the Complainant's assertion that the disputed domain names are identical or confusingly similar to the Complainant's marks. The Respondent submits a "non-exhaustive" list of 11 "slu"-formative domain names used by third parties. Further, the Respondent observes Southeastern Louisiana University uses SLU as a trademark for its athletic teams. The Respondent also provides examples of additional third-party use of the acronym "SLU".

The Respondent argues that the disputed domain names can be no more confusingly similar than the examples he has provided, and urges the Panel to consider the "pre-existing weakness" of the Complainant's SLU mark in assessing whether the Complainant has standing to file a UDRP complaint. Further, the Respondent maintains that the use of "SLU" in the disputed domain names is purely for identification of the "target", and that the descriptive terms denoting reform, change and action upon the "target" are the "dominant" and "distinguishing" elements.

The Respondent submits that he has rights and legitimate interests in the disputed domain names by virtue of their use in connection with websites providing legitimate criticism of what the Respondent describes as irregularities and procedural violations with the Complainant's surgical residency program. The Respondent explains that as he was otherwise unsuccessful in drawing the Complainant's attention to violations and non-compliances at SLU, he registered the disputed domain name <slucomplianceproject.org> and launched his website as a means of addressing the violations and non-compliances he attributes to the Complainant.

The Respondent denies any bad faith, and denies that he is attempting for personal gain to support his spouse's lawsuit against the Complainant, or to recruit participants to his spouse's litigation. The Respondent asserts that the disputed domain names are being utilized for *bona fide* criticism and education on matters of significance to physicians. The Respondent insists that he has acted in good faith and made concessions regarding his websites as requested by the Complainant's attorney, including providing a prominent and clear disclaimer of non-affiliation below the main heading of each page of the website, and adding a link to the Complainant's official compliance department site. The Respondent submits he registered the additional disputed domain names <anewslu.org> and <makeslucompliant.org> on September 18, 2017, out of concern that the Complainant would attempt to obstruct his free speech.

The Respondent alleges that the Complainant has engaged in Reverse Domain Name Hijacking (RDNH). According to the Respondent, the Complainant should have known it would not succeed on the merits, and proceeded in an effort to intimidate, harass, and silence the Respondent's *bona fide* criticism of the Complainant.

6. Suspension or Termination of Administrative Proceeding under Rule 18(a)

Pursuant to paragraph 18(a) of the Rules, when notified of "any legal proceedings initiated prior to or during an administrative proceeding in respect of a domain-name dispute that is the subject of the complaint, the Panel shall have the discretion to decide whether to suspend or terminate the administrative proceeding, or

to proceed to a decision.” This is a matter that a panel may raise on its own initiative.

The Policy was adopted to deal with the problem of cybersquatting – that is, the abusive registration of domain names consisting of, including, or confusingly similar to marks belonging to another for the purpose of profiting from the goodwill associated with the mark. The questions that the Panel has jurisdiction to address under the Policy are relatively simple and straightforward. Such proceedings are summary in nature, without the benefit of confrontation of the witnesses, or of a hearing. *Jason Crouch and Virginia McNeill v. Clement Stein*, WIPO Case No. D2005-1201.

The pending, simultaneously-commenced litigation in federal district court between the Complainant, the Respondent, and the Respondent's spouse goes well beyond the question of entitlement to the disputed domain names. The domain name dispute is part of and generally ancillary to broader disputes between the Parties encompassing pending litigation in both state and federal court, with the federal court litigation primarily concerning the Complainant's efforts to enjoin the Respondent's use of the Complainant's marks on the Respondent's websites, which the Respondent asserts are criticism sites. While it is not altogether clear to the Panel why the Complainant chose to institute parallel proceedings by filing a UDRP complaint in tandem with its federal court lawsuit, it is evident to the Panel that the disputed domain names are tied up in a larger and more complex dispute than the issue of cybersquatting that the UDRP is designed to address. See *Paul McMann v. J McEachern*, WIPO Case No. D2007-1597.

The Complainant seems to have acknowledged as much in its unsolicited submission. In several passages, the Complainant has asserted that the Respondent intends to continue registering domain names reflecting the Complainant's mark should the UDRP proceeding result in a transfer of the three specific domain names currently at issue. The Complainant observed that only an injunction issued by a federal court would prevent this, as such relief could not be provided by a UDRP panel. Similarly, the Complainant noted that other relief the Complainant might seek regarding website content would not be available in a UDRP proceeding. The Respondent for his part has in several communications with the Center expressed a preference for this dispute to be resolved in the courts.

Accordingly, the Panel has determined that the Complaint should be terminated without prejudice to refile once the broader issues between the Parties have been resolved in an appropriate forum, but with prejudice so long as the Complainant's federal court case remains pending.

7. Decision

For the foregoing reasons, the Complaint is terminated without prejudice to refile under the UDRP once the broader issues between the Parties have been resolved in an appropriate forum, but with prejudice so long as the Complainant's federal court case remains pending.

William R. Towns
Presiding Panelist

Richard G. Lyon
Panelist

David H. Bernstein
Panelist

Date: November 15, 2017