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### *Domain Name Dispute Resolution: Proving Bad Faith*

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Those who intend to violate the rights of universities through domain name abuse should be forewarned by a recent decision under the Uniform Domain Name Dispute Resolution Policy (“UDRP”) involving a leading university’s trademark. The National Arbitration Forum panel’s recent decision involving the domain name [sundevils.com](http://sundevils.com) reaffirmed that forwarding Internet users to an unaffiliated third-party website (particularly a competitor site or an adult-oriented site) and using a domain name for a pay-per-click advertising site are not legitimate good-faith uses of a domain name. *See Arizona Board of Regents, For and Behalf of Arizona State University v. Canweb Internet*, Claim No. FA1393853, <http://www.adrforum.com/domaindecisions/1393853.htm>.

Since the 1950s, Arizona State University has used “Sun Devils” as a mark to identify its athletic, entertainment, and educational programs. As a result, Sun Devils became a famous mark associated with ASU. Naturally, one looking for a website associated with the university might be likely to access the domain name [sundevils.com](http://sundevils.com) to find information about these programs. However for years, the University did not have ownership of that particular domain. Despite the lack of ownership by the University, that domain name in fact did resolve to ASU’s main athletic home page as one might expect. Hence the lack of ownership as to [sundevils.com](http://sundevils.com) wasn’t high on the radar.

Although [sundevils.com](http://sundevils.com) was registered in the name of Domains by Proxy, a domain name privacy service, Canweb Internet Canada was later revealed to be the true owner. Canweb Internet and prior registrants had begun to use the domain in connection with a click-through advertising website for golf and travel. Also, for a brief period in 2010, those who accessed [sundevils.com](http://sundevils.com) were forwarded to the athletic home page of ASU’s principal rival, the University of Arizona Wildcats. On that site, Internet users could purchase tickets to U of A football games.

After this came to the attention of ASU, and it complained to the domain owner, the redirecting took on a more offensive nature. Thereafter, unsuspecting visitors who accessed that domain were in for a shock—they were immediately redirected to an adult-oriented nudist website containing explicit photographs and adult products.

ASU initiated a UDRP proceeding. The UDRP decision that followed expounded on prior UDRP case law regarding illegitimate uses of domain names for bad faith purposes.

After recognizing ASU's rights in the Sun Devils mark, the UDRP Panel concluded that Canweb Internet had no rights or legitimate interest in [sundevils.com](http://sundevils.com). The Panel analyzed each of Canweb Internet's uses of the domain name—forwarding to a competitor's athletic site, forwarding to an unaffiliated adult-oriented site, and pointing to a website with click-through advertising links. Relying on prior UDRP decisions, the Panel found that each of these uses of the domain name were neither a bona fide offering of goods or services nor a legitimate non-commercial or fair use of a domain name under the UDRP.

The Panel likewise found that Canweb Internet's registration and use of the domain name was in bad faith. The Panel found that a domain name registrant "may not register and use domain names that disrupt a complainant's business." Forwarding unsuspecting users to ASU's main competitor's website which sells competing football tickets was disruptive of ASU's business. Further, based on Canweb Internet's prior use of the domain name for a website displaying advertising links to unrelated third parties, the Panel presumed that Canweb Internet "likely received compensation for displaying and redirecting Internet traffic." Finally, relying on prior UDRP decisions involving tarnishment of a mark, the Panel found that using a domain name to redirect Internet users to an adult-oriented website itself constituted bad faith. As a result, the Panel ordered that [sundevils.com](http://sundevils.com) be transferred from Canweb Internet to ASU.

The [sundevils.com](http://sundevils.com) decision should refocus trademark owners on the tools available for fighting off illegitimate and bad faith uses of domain names. UDRP panels following this decision are not likely to tolerate such misuse of well-known and long-standing marks. Redirecting a domain name to an adult-oriented website also is not a legitimate use and may itself constitute sufficient evidence to support a finding of bad-faith registration and use. Further, domain name registrants cannot avoid a finding of bad faith by simply forwarding Internet users to unaffiliated third-party websites. UDRP Panels relying on this decision might also presume that registrants are profiting from a domain name if the affiliated website contains click-through advertising links.

For colleges and universities and other trademark owners faced with domain name issues, the [www.sundevils.com](http://www.sundevils.com) decision should constitute a welcome development. This decision is likely to be cited to in a large variety of settings.

***Bacal Law Group was counsel for Arizona State University in the [sundevils.com](http://sundevils.com) matter. Bacal Law Group regularly represents clients in Internet disputes, including domain name disputes, and provides legal services with respect to various other Internet issues.***