

ADMINISTRATIVE PANEL DECISION

Axiom Global Inc. v. Michael Flanagan

Case No. D2013-1673

1. The Parties

Complainant is Axiom Global Inc. of New York, New York, United States of America (“US”) represented by Wilmer Cutler Pickering Hale and Dorr LLP, US.

Respondent is Michael Flanagan of Staten Island, New York, US, self-represented.

2. The Domain Name and Registrar

The disputed domain name <axiomlawunregisteredattorneys.com> (the “Domain Name”) is registered with GoDaddy.com, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on September 24, 2013. On September 25, 2013, the Center transmitted by e-mail to the Registrar a request for registrar verification in connection with the Domain Name. On the same day, the Registrar transmitted by e-mail to the Center its verification response confirming Respondent as the registrant and provided contact details.

The Center verified that the 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”).

In accordance with paragraphs 2(a) and 4(a) of the Rules, the Center formally notified Respondent of the Complaint, and the proceedings commenced October 2, 2013. In accordance with paragraph 5(a) of the Rules, the due date for Response October 22, 2013. The Response was filed with the Center on October 11, 2013.

The Center appointed Robert A. Badgley, Peter L. Michaelson and Richard G. Lyon as panelists in this matter on November 8, 2013. 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 paragraph 7 of the Rules.

4. Factual Background

The record in this case includes numerous actual or asserted facts which have little or no relevance to a dispute under the Policy. The Panel makes this observation here simply to adumbrate and underscore its ultimate disposition of this case. In a word, the dispute over the Domain Name apparently constitutes but a small part of a broader dispute between the parties, which would have to be fought out in another forum.

Complainant describes itself as a legal services company that places licensed attorneys and other professionals with the in-house legal departments of client companies on a contract basis. Complainant claims to have been engaged in this business since 2001 and claims to have 1,200 employees.

Complainant holds various trademark registrations, including: (1) the mark AXIOM registered with the United States Patent and Trademark Office (USPTO) in April 2008; (2) the mark AXIOM registered in the United Kingdom in August 2007; (3) the mark AXIOM registered in Hong Kong in February 2010; (4) the mark AXIOM LEGAL registered with the USPTO in August 2007; and (5) the mark AXIOM LAW REDEFINED registered with the USPTO in March 2011. Complainant operates a website at the domain name <axiomlegal.com>. The AXIOM LEGAL mark is subject to the disclaimer of any right to the exclusive use of the word "legal" apart from the mark as shown.

Respondent claims to be a provider of attorney licensing compliance services since 2011.

On February 15, 2013, Respondent approached Complainant to offer such services to Complainant. Complainant did not respond to this offer, and on February 21, 2013, Respondent registered the Domain Name. The next day, Respondent again offered its services to Complainant. Again, Complainant did not respond.

Respondent made a third attempt on February 25, 2013. This time, Complainant contends, it perceived within Respondent's offer a threat by Respondent to accuse Complainant publicly of non-compliance with legal profession regulations if Complainant did not hire Respondent's consultancy service. Respondent's message to Complainant's chief executive officer stated: "I am offering to conduct a full licensing compliance audit of all of your attorneys and in so doing help your company avoid embarrassment." Complainant affirmatively declined Respondent's offer and warned him not to use "the Axiom trade name in a negative and inaccurate way."

Respondent began posting content at the website to which the Domain Name resolves. Among other things, the website content alleges that Complainant is improperly characterizing itself as a "law firm" (or acquiescing in such a characterization by others), that Complainant cannot be called a "law firm" since it is partially owned by non-attorneys, and that Complainant "does not take licensing compliance seriously." For example, one post relates to the issue: "How many other 'foreign' Axiom employees are working for the company and what do the applications for their Visas state?" Respondent also posted at the website the August 29, 2013 cease-and-desist letter from Complainant, and its response thereto.

At Respondent's site there also appears the hyperlink: "Visit our sister site: www.multijurisdictionalpractice.com." At this other site, Respondent states: "This site mainly assists attorneys in three situations: 1. Pro hac vice admission in state courts. (...) 2. Attorneys who will be practicing in states where they are not admitted. 3. In-house counsel who are not admitted in the states where they are employed." This website then carries on Respondent's tirade against Complainant. A phone number, apparently for Respondent's business, appears on the web page.

Complainant and Respondent also accuse each other of all sorts of improper conduct, which lies beyond the scope of this proceeding.

5. Parties' Contentions

A. Complainant

Complainant contends that Respondent is using a domain name confusingly similar to Complainant's marks for the purpose of tarnishing Complainant's marks and promoting Respondent's commercial enterprise. According to Complainant, it is entitled to a transfer of the Domain Name pursuant to the three elements of the Policy.

B. Respondent

Respondent contends that it is engaged in the legitimate exercise of free speech, namely, the provision of information to the public about Complainant's allegedly illegal activities and unauthorized practice of law, and thus Respondent asserts that it has a legitimate interest in respect of the Domain Name. Respondent also contends that the Domain Name is not confusingly similar to any mark in which Complainant has rights.

6. Discussion and Findings

Paragraph 4(a) of the Policy lists the three elements which Complainant must satisfy with respect to the Domain Name:

- (i) the Domain Name is identical or confusingly similar to a trademark or service mark in which Complainant has rights; and
- (ii) Respondent has 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.

A. Identical or Confusingly Similar

In view of the Panel's resolution of element 4(a)(ii) below, the Panel does not need to decide whether the Domain Name is confusingly similar to any of Complainant's marks.

B. Rights or Legitimate Interests

Pursuant to paragraph 4(c) of the Policy, Respondent may establish its rights or legitimate interests in a Domain Name, among other circumstances, by showing any of the following elements:

- (i) before any notice to you [Respondent] of the dispute, your use of, or demonstrable preparations to use, the Domain Name or a name corresponding to the Domain Name in connection with a *bona fide* offering of goods or services; or
- (ii) you [Respondent] (as an individual, business, or other organization) have been commonly known by the Domain Name, even if you have acquired no trademark or service mark rights; or
- (iii) you [Respondent] 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.

The Panel concludes, on the record before it, that Complainant has not carried its burden to prove that Respondent lacks rights or legitimate interests in respect of the Domain Name. First, the record indicates that Respondent's website is primarily devoted to criticizing Complainant and its activities. Whether Respondent's allegations about Complainant's activities are true is not before the Panel. The site presents itself as a genuine site for the expression of Respondent's views, whether true or false or somewhere in between, about Complainant. The Domain Name, containing as it does the uncomplimentary words *unauthorized lawyers*, should not itself lure Internet users seeking Complainant. This suggests a legitimate interest pursuant to paragraph 4(b)(iii) of the Policy.

Second, as respects Complainant's argument that Respondent's hyperlink to its other website divests Respondent of a legitimate interest, the Panel does not accept this argument. It is true that Respondent's site located at the Domain Name invites users to visit Respondent's other site, but that other site (as presently constituted) does not actually offer any goods or services. Rather, it describes in the most basic

sense Respondent's own business, and then reverts to an onslaught of criticism about Complainant. On this record, it appears that Respondent's commercial use of the Domain Name is minimal and incidental to the site's main purpose, *viz.*, criticizing Complainant.

Third, the Panel views the dispute over this Domain Name as a side show in the larger dispute brewing between the parties. It would appear that the parties are poised for conflict, and such conflict must take place in another forum, where discovery, live testimony, and cross-examination may be employed to test the veracity and relevance of the parties' respective harangues against each other. The ultimate legal or equitable relief to be achieved lies well beyond the scope of the Policy, which is designed to deal with clear cases of cybersquatting that can be determined in the setting of a streamlined record and a streamlined proceeding. The Policy is not designed to deal with larger disputes merely because a domain name happens to fit somewhere in the picture. As the Shakespeare-heeding Panel put it in *Rudy Rojas v. Gary Davis*, WIPO Case No. D2004-1081, "a plague o' both your houses."

Accordingly, the Panel finds that Complainant has failed to prove that Respondent lacks rights or legitimate interests in respect of the Domain Name.

C. Registered and Used in Bad Faith

In view of the Panel's disposition of the previous issue, there is no need to address the issue of bad faith registration and use of the Domain Name.

7. Decision

For the foregoing reasons, the Complaint is denied.

Robert A. Badgley
Presiding Panelist

Peter L. Michaelson
Panelist

Richard G. Lyon
Panelist
Date: November 22, 2013