THE ARBITRATION OF CELEBRITY DOMAIN NAME DISPUTES

BY

THE HONOURABLE NEIL BROWN QC[1]

The Problem

You would think that celebrities, being what they are, would be keen to register their names as domain names, set up their own websites and use the websites to promote themselves.

Some do, but others seem to have been slow off the mark, only to find that someone else has got up earlier and in effect stolen their name, registered it as a domain name and used the domain name to set up an unauthorized website.

Of course, it can be worse than that: the domain name is sometimes linked directly to a pornography website or used as a bait to attract internet users who are then switched to a website selling anything form Viagra to Pacific cruises[2]. This, of course, can give the celebrity a bad name or even a worse name than he or she had previously.

Or he or she could just be made a figure of fun: see for instance the unfortunate events recounted in ***David Pecker v. Mr. Ferris***, WIPO Case No. D2006-1514. Mr. David Pecker, apart from having an interesting surname, is Chairman and CEO of American Media, Inc (AMI) the publisher of several prominent lifestyle magazines. One can readily understand Mr. Pecker's concern about not only having his name used as domain name without his permission, but more particularly about its being linked to a pornography site and hence linked in the public mind with pornography itself. It actually became worse in Mr. Pecker's case than for other

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[2] See, as a recent example of this practice, ***Nick Cannon v. Nikolay Zuyev***, WIPO Case No. D2007-0870.

celebrities, for he attracted a lot of media attention when he brought the claim to retrieve the name, but lost the case.

There are other problems that arise in the case of celebrity domain names and they vary from case to case, depending on the celebrity, how the celebrity's name came to used in a domain name, the use to which the domain name is being put and the various defences or excuses used by the party who registered the name to try to hold onto the name and defeat the celebrity's claim.

Let me give a few examples of the categories of problem that arise before we look in more detail at the issues that arise and how they have been resolved.

Madonna, The Rolling Stones and Pele

One of the early cases was ***Madonna's Case, Madonna Ciccone, p/k/a Madonna v. Dan Parisi and "Madonna.com"***, WIPO Case No. D2000-0847, where <madonna.com>[3] was registered by a cybersquatter and linked initially to a pornographic site, although it was later used to advance the Respondent, Mr. Parisi's, dispute with Madonna. This is an early illustration of the problems facing celebrities and the unauthorised use of their names in domain names and websites: the celebrity does not have access to the domain name or the opportunity to use the domain name as he or she wants and, moreover, if the domain name is then linked to a pornography site, it undoubtedly disparages the celebrity's name, even where, in **Madonna's Case** itself, the respondent argued that Madonna did not have much of a name to disparage. However, Madonna was successful and had the domain name transferred to her.

In ***Mick Jagger's Case***, ***Mick Jagger v. Denny Hammerton***, NAF Case No: FA0007000095261, the domain name <mickjagger.com> was also linked to a pornography site, enabling the panelist[4] to find in Mr. Jagger's favour and say:

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[3] In this article, domain names are identified in this fashion as that is the way they are set out in decisions given by arbitrators or panelists under the Uniform Domain Name Dispute Resolution Policy (UDRP).

[4] The arbitrators under the UDRP are known as panelists as they are drawn from a panel or list of arbitrators maintained by each of the providers of dispute resolution services under the UDRP.

> "…By typing in Complainant's mark with the ".com" suffix, Internet users are taken to a pornographic site, which is in no way associated with Complainant. See *Youtv, Inc. v. Alemdar*, FA 94243 (Nat. Arb. Forum Apr. 25, 2000) (finding bad faith where Respondent attracted users to his website for commercial gain and linked his website to pornographic websites)."

In other cases, it is not only the linking of the domain name to a pornography site that concerns the celebrity, but the fact that the domain name is being used for commercial purposes, or, to put it bluntly, to make money on which the celebrity is missing out.

In a recent example of this[5], the Brazilian footballer Pele had had three domain names registered that incorporated his name without his permission. One of them, <peletv.com>, went to a website that opened up to a series of websites offering goods and services on football paraphernalia, treatment of football injuries, games, clothing and suchlike, but which then went on to promote Music Downloads, Insurance, Credit Cards, Online Dating and then onto some far more salacious offerings. Pele's company, as well as being affronted by these indiscretions, was of course missing out on the click-thorough revenue being earned by the site whenever anyone perused it and successfully brought a claim to have the domain name transferred.

These three examples are just that, examples of where a prominent name has been taken without authority, used as a domain name for a website associating the celebrity's name with an activity which reflects adversely on the celebrity, namely pornography, or purely money making through advertising goods and services with the impression that the celebrity is endorsing them. The latter activity is particularly pernicious, as it is not just making the money that is at issue, but the fact that the celebrity is not making it.

Sometimes, unauthorized celebrity domain names are linked to websites to which the celebrity simply objects because of the content of the unauthorized website, for example a particularly strident form of animal welfare or conservation.

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[5] ***Glory Establishment v. Futbolmasters Ltd***, WIPO Case D2007-0439.

As celebrities generally do not like their names being used in any of these ways and associated with goods, services or causes that they do not approve of, or being used at all in a way that the celebrity cannot control, the following questions arise, which go to the substance of the issue with which we are concerned.

Do celebrities have a right to protection of their own name? What can they do to retrieve a domain name if they find it has been taken? Can they sue? Is there any other sort of claim they can bring? What do they have to prove? Will they win?

The same questions arise with respect to other unauthorized websites that are simply offensive and expose less salubrious aspects of the celebrities that they would rather remained secret; other websites are just clingingly and embarrassingly sycophantic[6].

Then again, although some websites may be sycophantic, the celebrity, despite the disclaimer on the website, is clearly happy to be promoted in the way he or she is presented on the website and does nothing to stop it. For example, you would have to be very naive to believe that www.algore.org, which generously extols the virtues of the former Vice President Gore, was anything other than an official site designed to promote him as a Presidential candidate. Presumably he agrees with it all, as similar promotions are contained on his official website, www.algore.com, although one wonders what he thinks of the low interest loans being promoted on www.algore.net.

Other celebrity websites are fairly straightforward, like the English soccer player Wayne Rooney's site at www.waynerooneyonline.com, which is laudatory without being sycophantic. Likewise, a site put up by one of David Beckham's fans at www.davidbeckham.ws[7] seems to be tolerated, despite the alarming headline that was on it at one stage, namely: "Posh and Becks Pregnant /Get news & pics of the pregnancy first with our Free Gossip Toolbar!www.Starware.com/Gossip."

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[6] See, as one on many examples, the eulogy in the unofficial website of the actor Gary Raymond at www.garyraymond.com describing him as "divinely gifted".

[7] 'WS' is the internet country code for Western Samoa and is said to be valuable because some viewers think the letters stand for Web Site.

Sooner or later, however, money rears its ugly head and one comes across yet another case where a celebrity's name has been used to make money by pushing one blandishment or another. Thus, in ***Morgan Freeman v. Mighty LLC***, WIPO Case No. D2005-0263, Morgan Freeman's name was used in a domain name and linked to an entertainment site, apparently not pornographic, but which sold viagra and a few other offerings.

Still other celebrity domain names and the websites to which they lead, are what you might call normal deception, where the domain name incorporating the celebrity's name diverts internet users to a straight out commercial website in the same area of interest as the celebrity whose name has been used, particularly music. For example, in the ***Rolling Stones Case***[8], the domain name <rollingstones.com> was linked to a music retailing website. The domain name was transferred to the management of the Rolling Stones as a result of the proceedings, but I notice that <rollingstones.info> is still rolling along gathering no moss and offering dating services and other blandishments.

This illustrates another problem, of course, which is how many domain names do you have to register and pay for, or lock up, to stop the unauthorized use of your name? Celebrities find that they retrieve one domain name and close down the corresponding website only to find that another has sprung up with a slightly different spelling.

But all of these problem cases have the same major defect, which is that their contents cannot be controlled by the celebrity; either that, or they are dormant or unused domain names, buried like unexploded bombs, with the person who has registered them, sometimes a professional cybersquatter, just waiting for some potential new owner to come along and buy the name and start using the site to sell soap powder or anything else.

So the essential question arises again: can the celebrity do anything about this and, if the website is up and running and the full horror of its contents have been released on the public, can the celebrity really do anything about it?

The solutions

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[8] *Musidor B.V. v. Jung Hochul,* NAF, Claim Number: FA0112000103053

Get in first

One way for celebrities to avoid these problems is to register their own names and all conceivable variations of them first, before anyone else gets in on the act and steals them. So, as with other aspects of the internet, the best advice is to get in first.

The problem with putting this advice into practice is that budding celebrities do not know that they are celebrities until the public or the media decree it and anoint them into the hall of fame and by that time the camp followers, eccentrics, fanatics and cybersquatters who have followed the careers of their incipient heroes have already registered one or all of the domain names available in the celebrities' names. This is happening more frequently and faster as the time period in the public eye that is necessary to qualify as a celebrity becomes shorter and shorter: a moment of fame is now certainly less than Andy Warhol's suggested 15 minutes.

Some celebrities are a wake-up to the necessity to register domain name early and at least they try to beat the cybersquatters at their own game. Thus, when the actors Angelina Jolie and Brad Pitt welcomed the arrival of their daughter Shiloh Nouvel Jolie-Pitt (as if her name itself were not enough of a burden with which to start her life), instead of buying her a Bunnykin mug or another more regular gift, sent their lawyers out on a foraging expedition to snap up 24 domain names with various versions of the child's name.

It is, I suppose, the inevitable cyber age equivalent of enrolling your child some years in advance in an exclusive school or club. However, even registering so many domain names did not protect the parents or the child in the Pitt case and <shilohnouveljolipitt.com>, although not now an active website, was set up with a slight spelling discrepancy in the domain name, which the astute reader will detect, as an unauthorised website devoted to baby wear and photographs.

But despite this commendable example set by the Jolie-Pitts, some celebrities are still too slow off the mark as was seen when Britney Spears and Kevin Federline had their baby. A gossip columnist let it be known that the baby had been named Sutton Pierce Federline and the next day, only a week after the child was born, someone registered the domain name <suttonpiercefederline.com> and several other variants. The unfortunate thing is that the owners of the domain name have been earning income from

their asset by linking it to a site that carries advertisements, depending on what the computer reads as being associated with or generic to the domain name. Consequently, <suttonpiercefederline.com> has sensed the ‘pierce’ part of the name and the website carries advertisements and links for body piercing. The irony was that the name used by the cybersquatter for the domain name turned out not to be the name given by the fond parents to their child.

Tom Cruise and Katie Holmes are in a similar position, as they allowed through delay a domain name to be registered in the name of their daughter, Suri: <suricruise.com>.

The problem with this approach, registering the domain name ahead of the cybersquatter, is that the really determined and mischievous cybersquatter, instead of registering, for instance, <madonna.com>, will register <madonnatours.com>, <madonnafashions.com> or Madonna with one ‘n’ or two ‘d’s or in the case of Nicole Kidman, <nicolekidmannude.com> or some similar variation.

There is literally no end to the possible combinations and permutations, as companies like Yahoo have found to their annoyance and cost, for they are now forced to have great stables of domain names on which they pay the annual registration fees, but never use, but are obliged to hold, just in case some inventive cybersquatter in Brazil concocts a new way of spelling ‘Yahoo’ in Portugese and succeeds in diverting Yahoo’s potential customers to the cybersquatter’s own unauthorised website.

For others celebrities, however, who have not been so quick off the mark, the only solution, if they find their name has been registered as a domain name, is to try to remedy the situation by taking some sort of action to try to have the domain name transferred to the celebrity.

Get a consent order

Sometimes domain name holders will consent to the transfer of the domain name to the celebrity, either to avoid a fight, or in the realisation that they would lose the fight, or because on reflection they realise they have no claim to the domain name. An example of this is ***Carnival Plc v. Dave Jackson***, NAF Case No: FA0997916 where the domain name at issue was <queen-elizabeth-2.com>. The Complainant was a cruise ship company that had registered trademarks over the name Queen Elizabeth 2 in relation to various goods

and services. The domain name was transferred to it by consent, because the registrant had lost interest in keeping the name and probably just did not want to put up a fight. Two other examples where consent orders were made were the 2006 decisions in ***Norgren, Inc. v. Norgren, Inc. c/o Domain Administrator,*** NAF Case No.: FA0603000670051 and ***DinersClub International Ltd. v. Nokta Internet Technologies,*** NAF Case: FA0605000720824. A further and more recent example where a consent order was made is ***Tom Stoppard, Tom Stoppard Limited v. Texas International Property Associates,*** WIPO Case No. D2007-1404. So, it is sometimes worthwhile trying to have the domain name transferred by consent.

Buy the domain name

Obviously, the first method that some celebrities think of, like some companies who find that their trademark or business name has been abused by some unauthorised person registering it as a domain name, is to try to buy the name from the registrant. This sometimes works, but the problem with this approach is that once they show interest in buying the domain name, the price goes up and they might end up having to buy the domain name for an exorbitant price[9].

They might also find that they are, in effect, being held to ransom by a group or person who wants more than money to hand over the registration of the domain name.

This was the experience faced by Paul McCartney of The Beatles, who tried to retrieve a domain name in his own name, only to be told by the Respondent who had registered it, that all he had to do to have it transferred to him was to read and adopt a letter that promoted a particularly extreme environmental political line of the Respondent. McCartney refused to do this, called the cybersquatter's bluff and took action to get the domain name back, proceedings in which he succeeded. The case is ***MPL Communications, Limited and MPL Communications, Inc. v LOVEARTH.net***, NAF Case: FA01097086. In that case, a good general

[9] At the time of writing, the domain name <dannielynnebirkhead.com>, reflecting the name of Anna Nicole Smith's child, is for sale on eBay for $1m, an asking price of course, but bids for it are up to $600,000.

statement was made by an experienced panellist, Mr Peter Michaelson on what celebrities should do when faced with this situation. He said:

> "No obligation is imposed on a trademark owner to do any act, support any activity or endorse or affirm any cause for any respondent in order to retrieve a domain name from that respondent that should rightfully belong to that owner. To require otherwise would permit a respondent to effectively extort action of some nature from the celebrity -- a result clearly in conflict with the Policy[10]. While the celebrity, in his (her) sole discretion, may decide, for whatever reason (s) he has, to acquiesce to or reach a negotiated settlement with a respondent in exchange for transfer of a corresponding domain name, the decision to do so lies solely with the celebrity. That respondent has absolutely no power, nor does the Policy permit any, to compel the celebrity to do any act -- regardless of how trivial that act might appear to be -- to obtain that domain name.

As well as this having been Paul McCartney's experience, it has also been the experience of other celebrities, who find that it is not the money that the cybersquatter wants, or not only the money, but an endorsement of a product or even a telephone call or meeting under the guise of being a fan.

Be extorted

Sometimes, however, the celebrity is forced to deal with someone who is not really a fan, but rather an opportunistic cybersquatter and the celebrity ends up paying a large sum of money to obtain the name. This, of course, is particularly galling, as the celebrity maintains that all he or she is doing is retrieving his own name.

However, with skilled negotiation and perhaps a bit of flattery, celebrities can sometimes obtain the domain name for a reasonable price.

Court action

If this cannot be done, the alternative is to sue, either for breach of trademark or passing off. This will depend on the facts, which may not always be strong enough to show that the celebrity has a trademark that has been tarnished by registration of the domain name. The facts may also not be strong enough to support an action for passing off, as it may turn out that the Defendant has not tried to pass himself off as Madonna or Brad Pitt and has

[10] The Uniform Domain Name Dispute Resolution Policy (UDRP), which effectively governs disputes over domain names. (Author's note).

done nothing but register a domain name and hope that one day it will become valuable. In a nutshell, the problem with court action is that sometimes it fails.

Moreover, court actions are notoriously slow and expensive and they may simply not be an appropriate means of attempting to recover a domain name.

Bring a Complaint under the Uniform Domain Name Dispute Resolution Process

The other solution-which is the subject of this article-is to bring an application under the Uniform Domain Name Dispute Resolution Process (the UDRP) and try to prise the domain name from the registrant by an order of an arbitrator directed to the registrar with whom the domain name is registered to transfer the domain name from the current registered party to the celebrity. The celebrity can then use the domain name for an official website or link it up with the official website that has already been established under a different domain name or he may just hold onto it and do nothing with it, but pay the subscription every time it comes up for renewal.

If the celebrity does not want the domain name transferred to him, he may ask for and obtain an order that it be cancelled. Of course, transfer is a more popular order than cancellation, for if the domain name is cancelled, the registrant may obtain it as soon as it becomes free and then register it again.

On balance, having regard to speed, costs and simplicity of process, proceedings under the UDRP are probably the best course of action to take for celebrities who are incensed that their name has been used in an unauthorised way for a domain name and who want the domain name transferred or cancelled.

The great attraction of the UDRP is that it is compulsory, quick and cheap.

It is compulsory, as against the person who has registered the domain name, meaning in effect that he has already agreed to be the Respondent in such proceedings, because when you register a domain name, you do so by entering into a contract with a registrar accredited by ICANN[11], the company that runs the internet. You do not register a domain name directly. You may

[11] The Internet Corporation for Assigned Names and Numbers.

do this only through a registrar and by means of a contract with an accredited registrar.

You cannot buy a domain name; the contract in effect enables you to lease it. That contract always has a clause in it to the effect that, if there is a challenge to your ownership[12] of the domain name, you agree to submit to a compulsory arbitration process[13], using an arbitrator provided by one of the bodies, also accredited by ICANN, that provides these arbitration services. The two major bodies that provide those services are the World Intellectual Property Organisation (WIPO) in Geneva and the National Arbitration Forum (NAF) in the United States.

If the registrar does not put in its contracts the clause that makes this jurisdiction compulsory, it may lose its accreditation with ICANN and its business will be destroyed. The same thing will happen if the registrar fails or refuses to implement an order to transfer or cancel a domain name; it might lose its accreditation. So, the reality is that anyone who registers a domain name always remains subject to a possible claim against the validity of the domain name brought by another person who claims to have a greater interest in the domain name than the person who registered it; if successful, there is a good chance for the reasons just given that the order obtained will be carried out.

Thus a celebrity is able to activate that process and bring a claim against the party who has registered the domain name and, if successful, will obtain an order to have the domain name transferred or cancelled.

Parties who have a complaint against your entitlement to the domain name thus have the right to compel you to take part in this arbitration process.

The process is quick because it is almost a form of strict liability and there are only a limited number of defences to such claims and in any event the agencies that provide the arbitration services and the arbitrators they appoint are under strict time limits to complete the process promptly.

The providers of the arbitration service go to great lengths to ensure that the panellist they choose for particular cases are unbiased and that there is neither the appearance nor the reality of a conflict of interest. Moreover, the

[12] Actually, you do not own a domain name, but rather, you lease it.
[13] Called an administrative proceeding.

number of sustained and reasoned rejections of complaints and the number of dissenting decisions in three-person tribunal judgments, show that the panelists take their work very seriously and conscientiously.

The process is also comparatively cheap because it is provided for a set fee and costs cannot be ordered for or against either party. Apart from the filing and administrative fee, the only costs for the celebrities bringing such an action are their own attorney's fees, if they wish to engage one. There are no oral hearings, interrogatories or discovery and cases are decided on the submissions in writing made by each side, together with additional submissions or material that the panel may request.

The system has one drawback, which is that the tribunal hearing the case, or the panel as it is referred to, may make only an order for transfer of the domain name to the successful Complainant or an order for its cancellation. There is no power to grant an injunction or to make an order of any sort, apart from the two just mentioned and no power to award damages, costs or interest. If the aggrieved party wants any of those remedies, he or she must sue in the courts, which of course gives rise to endless problems about jurisdiction, service and enforcement of the judgment.

But the good points about the procedure are that it is quick, cheap and there is no appeal from the decision. [14]

So, in summary, one course that is open to celebrities who are annoyed that someone has been using their name in a domain name is to bring one of these quick arbitration applications under the UDRP and, if they can, obtain an order, from which there is no appeal, that the domain name be cancelled or that it be transferred to them, so that they can use it themselves or lock it away and at least prevent anyone else from using it.

Of course, to bring a Complaint under the UDRP process, it must be really a case about domain names and not one where the process is being used as a guise or a device for bringing in reality a case that is really for breach of contract or trust or some other cause of action. Among several cases where this point has been made is ***The Estate of Marlon Brando v. WhoisGuard c/o WhoisGuard Protected,*** NAF Case: FA0506000503817 where the estate

[14] An unsuccessful respondent may, however, institute court proceedings to set aside the order for transfer or cancellation, but very few unsuccessful respondents in UDRP proceedings take such court proceedings.

was relying on a common law trademark to mount its claim for the return of a domain name. But the panellist held there was no jurisdiction. What the parties were fighting about was whether Marlon Brando had actually made a gift of the domain name to his former business manager or not. The former business manager said that he had made such a gift. Brando's estate said he had not. The panellist decided that Brando had registered the domain name himself, then put the business manager's name on it with him and that after she was dismissed and he, Brando, died, she had transferred it from Brando and herself to herself alone. The question was: had this taken place consistently with Californian law? That was the real dispute and the panellist held that there was no jurisdiction to deal with the domain name case as if that were what the dispute was. In other words, it was held that this was not a domain name dispute at all, but a dispute about what was required by Californian Law to effect the transfer of property. The latter issue could only be determined by hearing from witnesses, an element that is alien to the UDRP process.

This article is about the UDRP process. It asks the questions: can a celebrity bring a claim under the UDRP process and claim back his own name, which have been taken by someone else, put into a domain name and used either to make money by linking it to a website that pays money for every hit on the site, or used to exploit a fantasy or to blackmail the celebrity into buying the domain name or even just to run a fan site?

If such a claim can be brought, will the celebrity win?

What do celebrities have to prove?

Can celebrities establish a trademark in their own name?

The first thing that celebrities have to prove if they want to bring a claim under the UDRP process is that they have a trademark in their own name. That is so, because under the UDRP, the complainant has to prove 3 things, namely that:

(i) the domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights; and

(ii) the 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.

It will be seen therefore that the basis of the UDRP process is that the Complainant- the party bringing the claim-has a trademark or service mark in the same name or a similar name as the domain name that is being complained about. So if the Coca Cola Co is complaining that someone has registered the domain name <cocacola07.com>, <bestcocacola.com> or <cocacolafizz.net>, it will have to prove that it has a trademark in the exact name that has been registered as the domain name or a trademark that is confusingly similar to it, so that it can argue that, for example, <cocacolafizz.net> is confusingly similar to the trademark Coca Cola.

So the Complainant who brings the complaint is the trademark owner, in our case the celebrity and the Respondent is the party who has registered the domain name and who is sometimes called the registrant.

There has been a lot of debate about why it should be that only trademark owners may have access to the fast track UDRP process that we are now discussing. What about others who have legitimate and reasonable complaints about the registration of domain names and yet do not have trademarks on which they can base their claims?

This is not the place to debate this issue, for the fact is that people in that position will have to sue in the courts instead of using the fast track UDRP process; but it is worthwhile noting that there is such a debate.

The Australian .com.au scheme

Moreover, under some dispute resolution schemes for domain names, it is not necessary to prove a trademark. For example, under the Australian scheme for complaints on ‘.com.au’ domain names or the Australian country code as it is called, a complainant must establish that he or she has rights in ‘…a name [Note 1], trademark or service mark;’ The Note referred to tells us that ‘ For the purposes of this policy, auDA has determined that a "name … in which the complainant has rights" refers to:

a) the complainant's company, business or other legal or trading name, as registered with the relevant Australian government authority; or

b) the complainant's personal name.’

So if the domain name being complained about is someone's personal name, the Complainant will be able to get to first base by simply proving that fact and it is not necessary for him to prove that he has a trademark in his own name.

The new European .eu scheme

Likewise, in the new European .eu scheme, it is necessary only to show that the Complainant has a right described as 'a name in respect of which a right is recognised or established by national and/or Community law, such as the rights mentioned in Article 10(1)…'.

The examples given in Article 10 (1) are:

"…registered national and community trademarks, geographical indications or designations of origin, and, in as far as they are protected under national law in the Member-State where they are held: unregistered trademarks, trade names, business identifiers, company names, family names, and distinctive titles of protected literary and artistic works."

So, that again is much wider than the requirements of the UDRP scheme. It will be sufficient in the .eu scheme if the Complainant has a family name, to take an extreme case, but only if family names are protected under the national law of the country in question. Whether the Complainant has an unregistered trademark in the name or not, he or she could therefore bring a Complaint through the European provider of domain name arbitration services, the Czech Arbitration Court, on the basis that someone has improperly taken the Complainant's family name and used it for a domain name.

Claims for .com and similar domain names

But for the big league of .com, .net, .org, which are the domain names that celebrities and cybersquatters seem to go for, it is necessary to prove a trademark or service mark in the celebrity's name.

When that has been established, but only then, the tribunal can go on and decide if the domain name is identical to the trademark or confusingly similar to it, whether the person who registered the domain name had any right to register it and whether it was registered and used in bad faith. If all

three of these elements can be made out, the celebrity or other Complainant will win and the domain name will be transferred or cancelled.

But getting to first base is important and sometimes it is the most difficult thing for the Complainant to prove. In fact, quite a few complainants actually lose their cases by not being able to prove a registered or unregistered trademark: ***David Pecker v. Mr. Ferris***, WIPO Case No. D2006-1514 is one such case.

It is particularly difficult to prove in celebrity cases. Why? Because in most cases, the party complaining about the domain name is a company complaining about someone improperly taking a business name or the name of a product or service and there will sometimes be unregistered trademarks covering those products, even if there are not registered trademarks. But that is not always the case and there are many cases where even companies in business have failed to establish that they have an unregistered trademark as they have alleged. Here are some examples: ***Telecom Italia S.p.A. v. NetGears LLC c/o Domain Admin***, NAF Case No: FA0944807, where the Italian telephone company claimed that it had an unregistered trademark over the numbers “187” because it was the number for customer assistance on the Italian telephone system; ***Deutsche Post AG v. NJDomains,*** WIPO Case No. D2006-0001, where the German postal company claimed that it had an unregistered trademark over the word ‘post’; and ***WOW Audio Visual Superstores Pty Ltd v. Comonoz Pty Ltd,*** WIPO Case No. DAU2007-0003 where a company claimed to have an unregistered trademark over the exclamation ”wow”.

In this regard, it is surprising that many companies simply do not have registered trademarks over their signs and names and the symbols of their trade, even when they have been using them for many years.

If they do not have a registered trademark, they have to establish, if they are in a common law country which recognises unregistered or common law trademarks, that the name or the sign or the symbol or whatever other device or logo they use, has become so associated with their products or services and them alone, that it can truly be said that this is the, albeit unregistered, mark of their trade.

Companies can and regularly do, succeed in this task.

But it is harder for celebrities and other individuals to establish unregistered trademarks in their names because they are individuals, not companies with goods or products and they will have to show that they have a trademark in their own name or a trademark, if you like, in themselves, because it will be their own name that has been purloined and used in the domain name. So they will have to show that they have a trademark in their own name.

Merely to state the rule in that way makes it clear from the outset that it is not an easy thing to do.

Very few people would think that they had a trademark in their own name, partly because many people would not regard themselves as being in trade. Yet this is what they must prove if they want to use the UDRP scheme to prise back a domain name that someone else has registered.

So how does the celebrity get to first base? How does the celebrity show that he or she has a trademark in his or her own name?

Some have registered trademarks

The complainant may be fortunate enough to have a registered trademark, which solves the whole problem of proving the existence of the necessary trademark. Some of the most prominent celebrities who are household names – and clearly those who obtain the best legal advice - have registered trademarks.

For instance, it is apparent from the decision in ***Madonna Ciccone, p/k/a Madonna v. Dan Parisi and "Madonna.com"***, WIPO Case No. D2000-0847, that the singer Madonna had a registered trademark as well as an unregistered trademark that were both relied on and the decision of the panel that decided the case[15] clearly thought that either was sufficient.

[15] The decision-maker in an arbitration on a domain name is often referred to, not as an arbitrator but as the Panel or panelist, meaning they are members of approved panels of arbitrators maintained by one of the official providers of domain name arbitration services. The two largest of those bodies are the World Intellectual Property Organisation which is a specialized agency of the United Nations and the National Arbitration Forum in the United States. The Czech Arbitration Court has recently become another provider.

Likewise, the Rolling Stones had themselves covered by a long string of registered trademarks, as we see from the decision in ***Musidor B.V. v. Jung Hochul****;* NAF Case: FA0112000103053.

Jimi Hendrix, or rather his estate, was held to have both registered and unregistered trademarks and he also succeeded in his claim on that basis: ***Experience Hendrix, L.L.C. v. Denny Hammerton and The Jimi Hendrix Fan Club*** WIPO Case No. D2000-0364.

J K Rowling and Harry Potter

So also did J K Rowling, the author of the Harry Potter novels, have a registered trademark in her own name; that fact put her well on the way to succeeding in her several cases and retrieving various domain names, as she has done: ***Joanne Rowling v. Alvaro Collazo,*** WIPO Case No. D2004-0787.

To give you a taste of how the inventive cybersquatter plies his trade, the domain names in that case were <kjkrowling.com> and <www-jkrowling.com>, the former being a case of typosquatting because of the extra 'k' which is the next key on the keyboard to 'j' and the latter also being a case of typosquatting because of adding the letters 'www' before the domain name. The domain names were directed to the registrar's site and the user was then bombarded with pop up advertisements. After the decision and retrieving the domain name, Ms Rowling was able to turn an unofficial website into an apparently official one, judging by its contents today.[16] She also succeeded in other cases including the Irish case ***Joanne Rowling v. Hostine.net***, WIPO Case No. DIR2006-0004.

While we are dealing with Ms Rowling, I should say something else about Harry Potter. One of the issues in this area is whether a federal United States trademark registration is required or whether a registration in one of the States of the United States is sufficient. It has generally been accepted that State registrations are insufficient for the purposes of the UDRP and if the trademark owner is going to rely on registered trademarks they must be Federal ones.

[16]I.e., both domain names, <kjkrowling.com> and <www-jkrowling.com> now resolve to the official website at www.jkrowling.com.

However, as you will see later, the registrations of the HARRY POTTER trademarks themselves were State registrations and not Federal registrations. But they were apparently regarded as good enough in ***Time Warner Entertainment Company, L.P. v. HarperStephens*** WIPO Case No.D2000-1254 to support an application to have a long series of Harry Potter domain names transferred to Time Warner. The Respondent does not seem to have been doing anything with the domain names and hence the decision was based on the finding that the domain names had been registered to prevent the owner of the Trademark from obtaining a domain name in the same name, or, as it is put in the UDRP, preventing the trademark owner from reflecting the trademark in a corresponding domain name.

The works of the other literary icon, Tolkien, are subject to registered trademarks as well: ***JRR Tolkien Estate Limited v. tolkien.net***, WIPO Case No.D2003-0833 and ***JRR Tolkien Estate Limited v. Network Operations Center, Alberta Hot Rods***, WIPO Case No. D2003-0837.

Another celebrity, or at least a company representing a group of celebrities that had the foresight to have registered trademarks, was the company which held the commercial rights to the New York Yankees: ***New York Yankees Partnership d/b/a The New York Yankees Baseball Club v. Covanta Corporation*** **NAF Case FA060900080327**.

Likewise, the celebrity outfitters Abercrombie & Fitch Stores, Inc had registered trademarks, which stood them in good stead in two cases. In 2000 they took on the doyen of cybersquatting domain name registrants, John Zuccarini, in ***Abercrombie & Fitch Stores, Inc. and A & F Trademark, Inc. v. John Zuccarini d/b/a Cupcake Patrol*** WIPO Case No. D2000-1004, which they won and in the course of it they were able to rely on their registered trademarks[17].

Three years later they had another fight in ***A & F Trademark, Inc., Abercrombie & Fitch Stores, Inc., Abercrombie & Fitch Trading Co., Inc.***

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[17] We will later look at a case where another celebrity clothing designer was able to rely on an unregistered or common law trademark: ***Sound Unseen, Ltd.; Apple Bottoms, LLC; and Cornell Haynes p/k/a "Nelly" v. Patrick Vanderhorst***, WIPO Case No. D2005-0636.

v. Party Night, Inc., WIPO Case No. D2003-0172 where the panel was able to refer to the company's registered trademarks and find as follows:

> "Accordingly, the Panel finds that the Respondent's domain names <abercronbieandfitch.com>, <abrecombieandfitch.com> and <abocrombie.com> are confusingly similar to the Complainants' ABERCROMBIE & FITCH and ABERCROMBIE trademarks."

Footballers

Footballers also seem to well protected by registered trademarks. Thus, the company representing the interests of Pele, the Brazilian footballer, ***Glory Establishment v. FutbolMasters Ltd., FW, FM, Steve Leighton,*** WIPO Case D2007-0439 had a registered trademark and was successful in its claim. The English soccer player Wayne Rooney was in the same position and relied on his registered trademark in ***Stoneygate 48 Limited and Wayne Mark Rooney v. Huw Marshall,*** WIPO Case No. D2006-0916. So also did the Dutch soccer player Pierre van Hooijdonk have a registered trademark and, judging from the comments of the panel, he may have had trouble establishing a common law trademark on the evidence submitted, so it is just as well that he had a registered trademark: ***Pierre van Hooijdonk v. S.B. Tait***, WIPO Case No.D2000–1068. The panel said:

> "The Complainant has established that he is the owner of the Benelux registered trademark and service mark, details of which are set out above. It is noted that this would appear to be a very recent registration. Furthermore the Complainant has submitted that he is a world-renowned footballer with common law rights in the name <Pierre Van Hooijdonk>, ***although he has not submitted any evidence in support of this submission***. The said domain name is clearly identical to the said registered trademark and service mark save for the ".com" element in the domain name. This Administrative Panel is therefore satisfied that the said domain name is identical or confusingly similar to the said registered trademark and service mark in which the Complainant has rights."(emphasis added).

Other footballers with registered trademarks and who have been successful in domain name proceedings include Jaap Stam. a professional football player who played in Holland and also for Manchester United: ***Jaap Stam v. Oliver Cohen***, WIPO Case No. D2000–1061

Other sportspeople and entertainers

The Formula I driver Mika Hakkinen was also successful in relying on his registered trademark in ***Mr. Mika Häkkinen v. "For SALE"***, WIPO Case No. D2001-1306.

Returning to the entertainers, we find that the band ***Mettalica*** also had a registered trademark and used it to advantage**:** ***Metallica v. Josh Schneider,*** NAF Case: FA0095636. So also did a Chinese-American entrepreneur and television personality in ***Yue-Sai Kan et al. v. Gong Gen Yuan et al***, WIPO Case No. D2001-0548.

Without its being necessary to say much more about them other than to list them, here are some more cases based on registered trademarks: ***Warner Bros. Entertainment Inc. v Chris Sadler*** NAF Case No.250236, concerning more Harry Potter domain names, <shop4harrypotter.com> and <shopforharrypotter.com>; ***Warner Bros. Entertainment Inc. v Vivek Rana*** NAF304696, concerning <harrypottercollection.com>; ***Time Warner, Inc. v Alvaro Collazo*** NAF Case No.338464, concerning domain names like <compsuerve.com>, <copmpuserve.com>, <harrupotter.com>, <harrypotterandtheorderofphoenix.com>, <lordiftherings.net>, <thesopranos.net> and that ever popular way of spelling domain names to catch the unwary, by making the "www" part of the domain name, as in <wwwtimewarnercable.com>; ***DC Comics, Turner Entertainment Co. and Warner Bros. Entertainment Inc. v IQ Management Corporation*** NAF Case No.514423 concerning <batman-costume.com>; <gilligansisland.com> and ***Warner Bros. Entertainment Inc. v SCS Collectibles*** NAF Case No. 661419, concerning <harrypotterville.com>; and ***Sheryl Crow v. LOVEARTH*** , NAF Case No.FA203208.

For a recent illustration concerning ***Marlene Dietrich***, see ***Die Marlene Dietrich Collection GmbH V. Johan Duplesis Du Plesis*** WIPO Case No.D2007-1306.

Musicians

Here are other cases of musicians who have succeeded in UDRP proceedings relying on registered trademarks: ***Experience Hendrix, L.L.C. v. Denny Hammerton and The Jimi Hendrix Fan Club***,WIPO Case No.

D2000-0364; ***Laurence Fontaine v. Visiotex SA***, WIPO Case No. D2001-0071 (concerning the 'adult' singer and entertainer Laures Sainclair); Alain Delon in ***Alain Delon Diffusion S.A. .v. Unimetal Sanayi ve Tic A.S.,***WIPO Case No. D2000-0989; ***Gene Klein a/k/a Gene Simmons, Gene Simmons Company, and Kiss Catalog, Ltd. v. Darryl Boyd*** (KISS) WIPO Case D2001-0183; ***Herederos de Manuel De Falla C.B. v. Music Sales Group, WIPO*** Case No. D2001-1234 (concerning <manueldefalla.com>); ***Laure Pester (Lorie) and Sony Music Entertainment France SA v. Movie Name***, WIPO Case No. D2003-0312 (French singer); ***Peter Frampton vs. Frampton Enterprises, Inc.***WIPO Case No. D2002-0141; ***Isabel Preysler Arrastia v. Ediciones Delfín, S.L.*** WIPO Case No. D2001-0298; Tour ***de Charme, S.A.R.L., Sony Music, Entertainment (Holland) B.V. v. Mademoiselle Patricia Kaas contre Stars en Direct,*** WIPO Case No D2002-0733 and ***Robbie Williams v. Howard Taylor*** WIPO Case No. D2002-0588.

Branching out into more exotic forms of entertainment, in ***Nora Baumberger v. SAND WebNames – For Sale,*** WIPO Case No. D2001-0502 the Complainant was described by the panellist somewhat tautologically as "a pornographic pornography star known under the pseudonym "Dolly Buster" ". She was successful in relying on her registered German and European Community trademarks and in winning the proceeding.

As we have seen, literary works sometimes have registered trademarks, as in ***Anne of Green Gables Licensing Authority, Inc., v. Internetworks***, eResolution Case No AF-00109 (2000) concerning the domain name <anneofgreengables.com>.

There was also a registered trademark over the Little Prince, or more accurately Le Petit Prince: ***Société pour l'Oeuvre et la Mémoire d'Antoine de Saint Exupéry – Succession Saint Exupéry – D'Agay v. Perlegos Properties***, WIPO Case No. D2005-1085. The domain name was <thelittleprince.com>, but the trademark was LE PETIT PRINCE, giving rise to the interesting question whether a domain name could be identical or confusingly similar to a trademark that was in a different language. The panel resolved this question in the affirmative by saying:

> "However a semantic similarity between a trademark and a domain name can also exist if the trademark and the domain name contain

> word elements of different languages if a considerable part of the public understands the meaning of the translation. See e.g. *Compagnie Generale Des Etablissements Michelin - Michelin & Cie. v. Graeme Foster*, WIPO Case No. D2004-0279. The Panel observes that Complainant's registered trademark is identical with the English translation of Complainant's trademark and title "Le Petit Prince" and that the English title "The Little Prince" of Saint Exupéry's novel is well known in the English speaking world."

Business people

A business person successful with a registered trademark over her name was the female Chinese-American entrepreneur and television personality Yue-Sai Kan : ***Yue-Sai Kan et al. v. Gong Gen Yuan et al.***, WIPO Case No. D2001-0548. Another interesting case of a business person succeeding by relying on a registered trademark was Dodi Al Fayed in ***Harrods Limited v Robert Boyd***, WIPO Case No. D2000-0060, where the domain name at issue was not Harrods but <dodialfayed.com>. The trademark DODI FAYED was registered by Harrods as a European Community Trademark. After registering the domain name, the respondent placed it for sale at an auction website with an asking price of US$400,000. But Harrods succeeded in the claim and the domain name was transferred.

The case is interesting for two reasons, first that the complainant was seeking the transfer of a domain name that was not its own name, but the name of an associate, in this case the deceased son of the owner of the company. Secondly, Harrods relied on a registered trademark that was in the name of Harrods and not in the name of the executors of the deceased Dodi Al Fayed. As it was put in the decision:

> "The Complainant owns the trademark, DODI FAYED, and the late Dodi was a director of the Complainant, which is owned by Dodi's father, Mr Mohamed al-Fayed. "

The complainant was allowed to rely on the registered trademark, which helped it succeed in the proceedings. As we will see later, this same issue arises in the case of unregistered or common law trademarks, where the issue in some cases is whether an employer such as a media company may have an unregistered trademark in the name of an employee like a journalist

or an anchorman and what sort of evidence is needed to make out such a case.

Another interesting aspect of the ***Dodi Al Fayed Case*** is that there was a finding of bad faith made against the respondent who had registered the domain name on the basis that he was intending to try to sell it to the Complainant, that finding being the only rational conclusion that could be drawn from the few known facts, although it was only advertised for sale to the world at large and not offered directly to Harrods. The panel said that in view of the fact that:

> "The Complainant owns the trademark, DODI FAYED, and the late Dodi was a director of the Complainant, which is owned by Dodi's father, Mr Mohamed al-Fayed, (that) Mr Mohamed al-Fayed has personally been involved in public tributes to Dodi and Princess Diana, as well as in making well-publicised efforts to investigate how they were killed (and that as) (i)t strains belief that the Respondent was unaware of these matters…"

there should be a finding, to paraphrase the Policy, that the respondent had

> " registered… the domain name primarily for the purpose of selling, renting, or otherwise transferring …(it) to the complainant who is the owner of the trademark or service mark for valuable consideration in excess of the documented out-of-pocket costs directly relating to the domain name."

Nor is there any sign of any letting up in the practice of registering celebrity domain names. A recent one concerns Betty Ford: ***The Betty Ford Center at Eisenhower v. Domain Source, Inc***., WIPO Case No. D2007-0901. The domain name in dispute was <bettyford.com> and the Complainant operated a drug and alcohol rehabilitation centre co-founded in 1982 by the former U.S. First Lady Betty Ford. The panel noted, which is important for our present purposes, that

> "The Complainant's treatment center has been used by a number of celebrities, and is sometimes referred to as being the "rehab of the stars". The Complainant is the owner of a federal trademark registration for BETTY FORD CENTER, issued by the United States Patent and Trademark Office on September 28, 2004, and which the

> Complainant has used in commerce in relation to its counseling and rehabilitative services since as early as October 1982.
>
> The Respondent registered the disputed domain name <bettyford.com> on September 14, 2003. The Complainant has submitted evidence reflecting the Respondent's use of the domain name in relation to what appears to be a parked, pay-per-click website featuring direct links to websites of drug and alcohol rehabilitation centers that compete with the Complainant. The Respondent's website also features so-called "sponsored links", including "betty ford center", "betty ford treatment center", "betty ford clinic", and "betty ford institute", but these "sponsored links" merely direct Internet visitors to websites of competing rehabilitation centers.'

The registered trademark was clearly enough to get the case off the ground and, not surprisingly, the Complainant went on to win and obtain the domain name.

In the Australian context, although under the UDRP, not the Australian policy, for the domain name at issue was a '.com' domain name and not a '.com.au' one, the Wiggles company had registered trademarks in The Wiggles and Henry The Octopus that it could rely on in the proceedings: ***The Wiggles Touring Pty Ltd v. Thompson Media Pty Ltd,*** WIPO Case No. D2000-0124. The panel then had no difficulty in deciding that the domain names <thewiggles.com> and <henrytheoctopus.com> were identical to those trademarks.

Accordingly, the examples that have been given show that sometimes in these proceedings under the UDRP, registered trademarks have fortuitously been obtained and that it is legitimate for the trademark owner complainant to rely on them.

Sometimes registered trademarks are relied on, but it is not entirely clear from the decision whether the panellist deciding the case was acting on there being a registered or a common law trademark.

For example, in ***Sean Michaels Inc., v. Mark Allan Online Entertainment,*** E Resolution Case Number: AF-0214, the domain name was <seanmichaels.com>. The Complaint was in the name of a management company, but the panel said the celebrity being managed could have brought

the case in his own name, (he was a successful adult movie star) based on the principles laid down in other cases on unregistered trademarks. But he had not brought the case in his own name, so the question was whether the company that was in fact the complainant, because it was the registered owner of the trademark, could succeed, which it did. That could only have been on the basis of the service mark referred to in the decision that had been applied for, but apparently not registered.

The decision noted that:

> “The company filed an application to register the service mark "Sean Michaels" ... The … application states that the service mark in question was used for the first time in September 1989 and has been used in commerce since October 1989.”

But of course it was an application and not a registered service mark and as we have already seen it is generally not regarded as being sufficient merely to have an application for a trademark rather than a registered trademark or service mark.

The panel said:

> “Complainant states that Mr Sean Michaels is an actor who has performed in more than a thousand adult movies. Mr Michaels' products (in particular videos and DVDs) are distributed, as Complainant states, in many countries including Brazil, England and Canada.”

The complainant had said in the Complaint:

> "Sean Michaels International, Inc. has an official trademark for the use of the name "Sean Michaels" in any context. He has been using this name for 11 years and is known around the world for his name and likeness. He has performed in over 1,200 movies with his name. He has also made, shot, produced, and distributed his own live of movies with his name. He has an enormous fan base. He has done work for Playboy, Vivid, Anabolic, Elegant Angel (all leaders in the adult industry) using the name Sean Michaels. Sean Michaels has toys that have been made in his likeness. The current registrant is using Sean Michaels' celebrity status and his popular name for driving

> traffic to a interracial adult website which wilfully creates income at the expense of Sean Michaels International, Inc."

That sounds like a build up to making a decision on a common law trademark, for it is the usual recital of the sort of facts that are relied on when the case is that the complainant had an unregistered or common law trademark. But it was not to be, for the decision continued:

> "Although the domain name at issue is identical to the name of Mr Sean Michaels, who appears to be a well-known adult movie actor, this case does not deal with the right of an individual who has reached a high level of notoriety to prevent third parties to make use of his name as a domain name. In this case the Complainant is a company that registered the service mark "Sean Michaels" and requested transfer of the domain name registered by Respondent.
>
> In lead panelist's opinion Mr Michaels himself could have started a procedure according to the Rules and the ICANN Uniform Domain Name Dispute Resolution Policy (the "Policy"), relying on the principle stated by the learned panelist in *Jeanette Winterson v. Mark Hogarth* (WIPO Case No. D2000-0235) and confirmed in *Cho Yong Pil v. ImageLand Inc*. (WIPO Case No. D2000-0229, relating to the name of a famous Korean pop singer), *Julia Fiona Roberts v. Russell Boyd* (WIPO Case No. D2000-0210, relating to the name of the world famous actress Julia Roberts) and *Harrods Limited v. Robert Boyd* (WIPO Case No. D2000-0060, relating to the name of the late Mr Emad Mohamed al-Fayed, widely known as Dodi, son of Mr Mohamed al-Fayed, owner of Harrods Limited)."

As it turned out, the case proceeded on the issue of whether the Michaels' company had made its case and it had succeeded in doing so, for the domain name was transferred to the Complainant, the company. It is thus not a very satisfactory decision, as it is not clear from the decision why the company should have been able to succeed when relying on a mere application and not a registered service mark. But on its terms, it is a case where a mere application for a trademark has been held to be sufficient.

Does it matter where the trademark was registered?

So long as the trademark is registered, it does not seem to matter in which country it was registered: ***Bernardka Pulko v. Greg Frazie****r*, WIPO Case No. D2006-0099. Ms Pulko is truly unique. She is the first human being to travel all seven continents on a motorcycle and the first woman to ride through Saudi Arabia; she also holds the Guinness World Record for the longest motorcycle journey by a female.

But for our purposes, her case was significant in that she had a trademark in her own name that was registered in Slovenia, which was enough to get her to first base in her claim, although the Respondent who had registered the contentious domain name was resident in the United States. Ms Pulko then went on to succeed in the whole claim.

Some celebrities have both registered trademarks and unregistered trademark rights as well.

It will be seen as we proceed, that it is not as if complainants in the cases we will be looking at have only registered trademarks or common law, unregistered trademarks, for sometimes they have both. In ***Stevland Morris a/k/a Stevie Wonder v. Unofficial Fan Club c/o Web Maste,*** NAF FA0453986, June 22, 2005, for example, it was held that Stevie Wonder had both registered and unregistered trademarks in his own name and that either could support his claim. As we will see later, having both registered and unregistered trademarks can be very useful and in some cases vital. Briefly, the reason is that if the domain name was registered before the registered trademark, it will be very difficult to show that it was registered in bad faith, because at that time it was not known that there was a trademark, as there was not one. But if an unregistered trademark can be said to have pre-dated the domain name, although the registered trademark post-dated it, the complainant may still be able to prove bad faith based on that sequence of events.

But at this stage of our discussion, the point is that if the Complainant has a registered trademark, that is enough to get the claim off to a good start.

A mere application for a trademark is not good enough

Note, however, that it has frequently been said that if the Complainant relies on a registered trademark, it must be a trademark that has been registered and not just an application for registration, for the latter carries no trademark

rights, as it has not been examined by the trademark authorities and might be rejected when it is.

That was the case in ***George Foreman Ventures LLC v. zinnia c/o Zinnia Gonzalez***, NAF, FA0599036. George Foreman had filed several trademark registrations with the United States Patent and Trademark Office for the GEORGE FOREMAN mark and had assigned them to the Complainant, a company of which he was the co-Chairman. But they were only applications for trademarks and not trademarks themselves. The decision noted that it had been held many times that mere applications for trademarks did not confer trademark rights and therefore that it was not enough for George Foreman to rely on these trademark applications.

The Complainant had therefore to go further and argue that it had a common law trademark in George Foreman's name. This it was able to do and go on and win the whole case.

Some strong statements on the insufficiency of applications for trademarks were also made in ***The Hebrew University of Jerusalem v. Alberta Hot Rods***, WIPO Case No. D2002-0616 that concerned the domain name domain name <alberteinstein.com>. It was said that:

> " Trademark registration applications do not give rise to trade mark rights: see *Aspen Grove, Inc. v. Aspen Grove*, WIPO Case No. D2001-0798 and *Spencer Douglass MGA v. Absolute Bonding Corporation*, WIPO Case No. D2001-0904."

See also, to the same effect, ***First Tuesday Limited v. The Startup Generator,*** WIPO Case No.D2000-1732 and ***Mk-Net-Work v. IVE Technologies,***WIPO Case No.D2004-0302.

We have already seen, however, that on occasions, panels seem to have accepted that mere application for trademarks are sufficient; this was so in the ***Sean Michael Case***. The Complainant could not have relied on an unregistered trademark, for those rights could only be established by Michaels himself and he was not the Complainant. He would have had to establish that he had granted a licence of his common law rights to his management company, which would be feasible, but the issue seems to have been ignored in the decision. Accordingly, the case can be explained only by relying on the application for the service mark as being sufficient to show

the trademark rights required by the Policy. See, also the discussion in ***Fashiotv.com GmbH V. Mr. Chris Olic***, WIPO Case No.2005-0994 and Lindsay, ***International Domain Name Law ICANN and the UDRP,*** Oxford and Portland, Oregon, 2007.

However, despite the general principle set out above, an application for a Federal registered trademark was held to be sufficient, at least in part, in the case concerning Kendra Todd and a case cited in it. The domain name at issue was <kendratodd.com>. See: ***Kendra Todd v. Real Estate Radio c/o Leo Miller,*** NAF Case: FA0783428.

Kendra Todd was and is a real celebrity, created by the celebrity industry itself. The facts of the case were described as follows:

> " Complainant, Kendra Todd, is a real estate broker and agent who is also a television and radio show personality as a result of winning season three of the popular television show, The Apprentice. Complainant has filed an application with the United States Patent and Trademark Office ("USPTO") for use of her name, the KENDRA TODD mark (Filing No. 78/655210). Complainant also holds a service mark registration with the State of Florida for the KENDRA TODD mark (Reg. No. T06000001023)."

So Ms. Todd had a mere application for a trademark under the Federal system and an actual registration from the State of Florida. The respondent registered the domain name <kendratodd.com> which originally resolved to a website giving false information concerning Ms. Todd with whom the respondent had a dispute. That information had since been removed by the respondent's internet service provider and the disputed domain name was not being actively used at the time of the decision. More of the facts of this case and some important background are set out in an article by Ms. Todd's lawyers in the claim.[18]

The decision seems a reasonably clear decision that an application rather than a registered Federal trademark is sufficient, at least in part, for UDRP

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[18] See article at http://www.lawyers.com/davidrellis/articles.jsp, by By David Roy Ellis, Attorney at Law, Largo, USA.

proceedings, for the best that Ms. Todd could show federally was an application for the registration of her name, not a registered trademark and yet she succeeded. The panel said the following in its decision:

> " The Panel finds that Complainant has established trademark rights in the KENDRA TODD mark through a State Service Mark registration, an application with the USPTO, and because the mark is Complainant's given and used personal name ".

Accordingly, although it is often said that mere applications for a trademark do not provide a sufficient basis for bringing a UDRP complaint, there are certainly decisions to the contrary effect. See also, the decision in the ***Princess Dianna Case***, ***CMG Worldwide, Inc. v. Naughtya Page***, NAF: FA0095641and the other cases referred to in that decision.

Faced with these conflicting decisions, it would therefore be prudent to establish a registered trademark in whatever jurisdiction is relevant or, failing that, to adduce evidence in the complaint to show that the complainant has an unregistered trademark and that it had that trademark for as long as possible.

Personal names that have not taken on the additional quality of unregistered trademarks are certainly not sufficient under the UDRP, without more[19].

US State registrations

It has also generally been held that, in the case of United States trademarks, only a Federal registration will be sufficient and that State registrations are not sufficient.

However, we have just seen one decision, ***Kendra Todd v. Real Estate Radio c/o Leo Miller,*** NAF Case: FA0783428, to the effect that a State registration is adequate, at least in part, for the panel in that case said:

> " The Panel finds that Complainant has established trademark rights in the KENDRA TODD mark through a State Service Mark registration, an application with the USPTO, and because the mark is

[19] On personal names as such, see the discussion on the Second WIPO Internet Domain Name Process at http://www.wipo.int/amc/en/processes/process2/index.html.

> Complainant's given and used personal name. See *Lee Enters., Inc. v. Polanski*, FA 135619 (Nat. Arb. Forum Jan. 22, 2003) (finding evidence that the complainant had established rights in the BILLINGS GAZETTE mark through registration with the Montana and Wyoming state trademark officials); …"

One wonders, therefore, just how universally true it is to say that only Federal registrations are sufficient.

Note also that the trademark rights must exist at the time the Complaint under the UDRP is being brought: ***R. E. 'Ted' Turner and Ted Turner Film Properties, LLC v. Mazen Fahmi,*** WIPO Case No. D2002-0251.

Conclusion on registered trademarks

Accordingly, if the celebrity has a trademark registered in his or her own name, that will be enough to form the basis for a successful domain name claim under the UDRP.

But what about unregistered trademarks?

It is not very surprising, however, to find that most celebrities do not have registered trademarks in their own names. The explanation is that they probably do not get around to it or their advisers do not recognise its importance.

The question then arises whether, if the celebrity does not have a registered trademark, will an unregistered or common law trademark be sufficient?

The answer is yes: unregistered trademarks are sufficient to commence UDRP proceedings. See, initially, *McCarthy on Trademarks and Unfair Competition*, § 25:74.2, Vol. 4 (2000); *MatchNet PLC. V. MAC Trading*, WIPO Case D2000-0205 and *British Broadcasting Corp. v. Renteria*, WIPO Case D2000-0050.[20] See also, the discussion on this[21] and other issues in Lindsay, ***International Domain Name Law ICANN and the UDRP,*** Oxford and Portland, Oregon, 2007.

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[20] The author noted these references when reading the decision in *Richard Juzwin v. Glen Stephens Stamps* Claim Number: FA0106000097690

[21] At pp.190-210

They can also be of very great importance, as I hinted at before, for if the Complainant has a registered trademark, but cannot show that it pre- dates the registration of the domain name, he may have difficulty in establishing bad faith. In other words, it is hard to say that the person who registered the domain name did so malevolently and to trample on the rights of a trademark owner if, at the time he registered the domain name, the trademark was not in existence; it is hard to trample on something that does not exist.

But if the Complainant also has common law rights, they may pre-date the registration of the domain name. That was the case in *2001* ***White Castle Way, Inc. v. Glyn O. Jacob****s,* WIPO Case No. D2004-0001 where it was said:

> "The Panel determines that Complainant has rights in the trademark "PAT BENATAR" based on long use in commerce and as evidenced by registration in 2000, at the USPTO. Complainant's common law rights in the mark arose prior to Respondent's registration of the disputed domain name on December 8, 1998. The disputed domain name is identical to the trademark within the meaning of the Policy".

So, that got the Complainant to first base.

It was also the case in the ***Joe Cole, Fatactress*** and ***Applebottoms Cases*** which we will look at later and where the complainants were able to rely on common law trademarks which pre-dated the registration of the disputed domain names and hence win the proceedings that they would otherwise have lost.

So it may be said that, if the Complainant can establish an unregistered or common law trademark, it will be able to bring a UDRP Complaint. It will be seen immediately that this could be very valuable for celebrity applicants.

But can individuals have unregistered trademarks in their own names?

Yes, they can, but it has not always been plain sailing to get that principle accepted or to have it applied in individual cases. [22]

The current practice and the prevailing view on this issue is set out in the valuable ***WIPO Overview of WIPO Panel Views on Selected UDRP Questions[23],*** where the following statementS appear:

> **"1.6 Can a complainant show rights in a personal name?**
>
> **Consensus view**: While the UDRP does not specifically protect personal names, in situations where an unregistered personal name is being used for trade or commerce, the complainant can establish common law trademark rights in the name. Reference can be made to the test required for the common law action of passing off. Personal names that have been trademarked are protected under the UDRP.

Relevant decisions:
Julia Fiona Roberts v. Russell Boyd D2000-0210, Transfer
Jeanette Winterson v. Mark Hogarth D2000-0235 among others, Transfer
Dr. Michael Crichton v. In Stealth Mode D2002-0874, Transfer

> However: The name in question should be actually used in trade or commerce to establish unregistered trademark rights. Merely having a famous name (such as a businessman, or religious leader) is not necessarily sufficient to show unregistered trademark rights.

Relevant decisions:
Israel Harold Asper v. Communication X Inc. D2001-0540 among others, Denied

Chinmoy Kumar Ghose v. ICDSoft.com and Maria Sliwa D2003-0248, Transfer."

In ***Ahmanson Land Company v. Save Open Space and Electronic Imaging*** Systems, WIPO Case No. D2000-0858, the panel had all of the material and

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[22] See the discussion on this issue in Lindsay, ***International Domain Name Law ICANN and the UDRP,*** Oxford and Portland, Oregon, 2007 at pp.210-223, including many examples.

[23] See http://www.wipo.int/amc/en/domains/search/overview/index.html

legal authority before it that one would have thought was necessary to give a considered decision on whether a common law trademark had been made out. The complainant had shown a long association between the Complainant and the commercial use of the name. Yet the panel dismissed the claim, saying merely that it was "not satisfied" with the complainant's case . In the related case, ***Ahmanson Land Company v. Vince Curtis,*** WIPO Case No. D2000-0859 and on similar evidence and submissions, the panel did not even get that far, ruling that it was not necessary to decide the issue, as it was of the view that the Respondent's web site, set up to oppose the land development ventures of the Complainant was a "legitimate non-commercial and fair use under the Policy".

Nevertheless, as we will see from many decisions, it is possible with adequate evidence for individuals to establish unregistered trademarks in their own names.

Apart from the requirement for good evidence, another difficulty may be that the name of the individual, or in our case the celebrity, may be a name over which a trademark may not be capable of being obtained or at least very difficult to obtain. This is shown by one of the early cases, which concerned the singer Sting**: *Gordon Sumner, p/k/a Sting v Michael Urvan***, WIPO Case No. D2000-0596. The panel said as follows:

> "This Administrative Panel is inclined to the view, therefore, that the Complainant's name STING is not a trademark or service mark within the scope of paragraph 4(a)(i) of the Uniform Policy."

The Panel accepted that there had been previous cases where it had been held that the individual names of entertainers had been accepted as unregistered trademarks. However, that did not mean that all such individual names would qualify as trademarks. As the Panel said:

> "Unlike the personal names in issue in the cases *Julia Fiona Roberts v Russell Boyd, Jeannette Winterson v Mark Hogarth, and Steven Rattner v BuyThisDomainName (John Pepin),* ***the personal name in this case (i.e. 'sting') is also a common word in the English language, with a number of different meanings"*** (emphasis added).

The other names were not common or generic words, but the word 'sting' was a common or generic word and, in support of that, the panel quoted

several dictionary definitions of the word, like ‘bee sting’ and a ‘trap for criminals’, as in the eponymous film.

But it is also clear that the Panel was influenced in coming to this conclusion by the wider notion of whether the ICANN Policy had ever been intended to protect personal rights. Thus it said:

> “6.4 …, the Report of the WIPO Internet Domain Name Process of April 30, 1999, on which ICANN based the Uniform Policy… states as follows (footnote citations deleted, emphasis added):
>
> The preponderance of views, however, was in favor of restricting the scope of the procedure, at least initially, in order to deal first with the most offensive forms of predatory practices and to establish the procedure on a sound footing. Two limitations on the scope of the procedure were, as indicated above, favored by these commentators. The first limitation would confine the availability of the procedure to cases of deliberate, bad faith abusive registrations. The definition of such abusive registrations is discussed in the next section. The second limitation would define abusive registration by reference only to trademarks and service marks. Thus, registrations that violate trade names, geographical indications or ***personality rights would not be considered to fall within the definition of abusive registration*** for the purposes of the administrative procedure. …***the law with respect to trade names, geographical indications and personality rights is less evenly harmonized throughout the world***.... [W]e consider that it is premature to extend the notion of abusive registration beyond the violation of trademarks and service marks at this stage. …”(emphasis added).
>
> …It must be concluded… that ICANN did not intend the procedure to apply to personality rights”.

These days, that statement, although still literally correct, would not seem to take account of the wide scope that exists to make out a case for an unregistered trademark. The modern rule or at least the modern practice is that, if it can be proved by proper evidence, an individual may be found to have established common law trademark rights in his or her own name and hence the personal name is protected.

But before leaving the ***Sting Case***, it will be interesting to note a few more things about it. The decision was given on July 19, 2000. It is interesting to look at the website on that date, i.e. on the date on which Sting himself lost the case. It can be seen by going to the Wayback machine at www.archive.org. It is in fact the website as it was set up by the registrant of the domain name. If the website is looked at as it is today, it will be seen to be quite different and in fact to be an official Sting website.

It seems, therefore, that after he lost the case, Sting was obliged to buy the domain name from Mr. Urvan. There is, however, at least one other domain name which is an attempt to trade on the Sting name: <sting.us> : see www.sting.us.

To return to the issue, it will be recalled that we said that, subject to proper evidence, an individual may be found to have common law trademark rights in his or her own name.

The test

Clearly, it would be useful to have a good working test to enable parties and their advisers to reach an informed judgment on whether the facts of an individual case go to establish a common law trademark. In that regard, the ***WIPO Overview*** (supra) contains the valuable statement that "The name in question should be actually used in trade or commerce to establish unregistered trademark rights. Merely having a famous name (such as a businessman, or religious leader) is not necessarily sufficient to show unregistered trademark rights." On the evidence required, the ***WIPO Overview*** *(supra*) also says:

> ***"1.7 What needs to be shown for the complainant to successfully assert common-law or unregistered trademark rights?***
>
> **Consensus view**: The complainant must show that the name has become ***a distinctive identifier associated with the complainant or its goods and services***. Relevant evidence of such " secondary meaning" includes length and amount of sales under the mark, the nature and extent of advertising, consumer surveys and media recognition. The fact that the secondary meaning may only exist in a small geographic area does not limit complainant's rights in a common law trademark.

> Unregistered rights can arise even when the complainant is based in a civil law jurisdiction.
>
> **Relevant decisions:**
> ***Uitgeverij Crux v. W. Frederic Isler*** D2000-0575, Transfer
> ***Skattedirektoratet v. Eivind Nag*** D2000-1314,Transfer
> ***Amsec Enterprises, L.C. v. Sharon McCall*** D2001-0083, Denied
> ***Australian Trade Commission v. Matthew Reader*** D2002-0786, Transfer
> ***Imperial College v. Christophe Dessimoz*** D2004-0322 among others, Transfer."(emphasis added).

Lindsay, (supra)[24] has stated the requirement that:

> "The upshot of the analysis undertaken in these decisions is that the preferred view is that, to be protected as a common law mark, a famous personal name ***must have acquired a secondary meaning so as to function as an identifier of goods or services***…Merely having a famous name, however, is not sufficient for there to be common law rights, ***even if the fame results from commercial activities."*** (emphasis added).

Beyond that, the jurisprudence and the practice of panelists in making decisions on this issue, must be found from the decisions themselves and the reasoning applied in them. We must therefore turn to some of the decisions.

Anna Nicole Smith

As a starting point it might be useful to cite a recent decision, ***Anna Nicole Smith c/o CMG Worldwide v. DNS Research, Inc.*** NAF Case FA0 0220007, to show the high standard of evidence that will be required, even where, as it that case, the personality concerned was a household name. The panel said:

> "…the mere fact of having a successful career as an actress, singer or TV program star does not provide exclusive rights to the use of a name under the trademark laws. The cases require a clear showing of

[24] Page 219

> ***high commercial value and significant recognition of the name as solely that of the performer***." (emphasis added).

For some wider reading, note also the contrast that was drawn with the ***Humphrey Bogart Case***: ***Bogart, Inc. v. Humphrey Bogart Club,*** FA 162770 NAF Case 2003).

Celebrities who have been able to establish trademarks in their own names

It will be seen in the following cases that various celebrities have been successful in having that principle applied and consequently in retrieving domain names that have been registered in their names without permission. It is worthwhile looking at these cases and seeing why it was held that the celebrities concerned had made out a case that they had an unregistered trademark in their own name.

The actress Julia Roberts, the writer Jeanette Winterson, the musician Nick Cannon and the actress Nicole Kidman are celebrities whose names are often cited as parties who have been successful in using this principle. As we will see, however, there are many others. There are also some others who have failed.

Julia Roberts

In the Julia Roberts Case, Julia Fiona Roberts v. Russell Boyd,WIPO Case No., the panel decided that Ms. Roberts had shown sufficient secondary meaning in the name to establish a common law trademark, but it is not a very helpful decision in that it does not say how she had established such a clear secondary, meaning. The closest the Panel came to saying how this had happened was that she had 'been featured in a number of motion pictures…'.

But it may well be that the Panel did not want the weakness of that case to help the domain name remain in the name of an eccentric registrant of celebrity names. Some clue to the nature of the Respondent is to be found in his Response where he submitted:

> "If Julia Roberts had picked up a phone and said, 'Hi Russ, can we talk about the domain name juliaroberts.com?' she would own it by now."

The Respondent concluded by saying "But as I mentioned at the beginning of this response, I still think Julia is nifty crazy wacko cool."

It is scarcely surprising that the domain name was ordered to be transferred to Julia Roberts.

Janet Winterson

The next decision and, as just noted, one that has often been followed is ***Jeanette Winterson v. Mark Hogarth***, WIPO Case No. D2000-0235. It has been followed and applied in a large number of subsequent cases such as: ***Rosa Montero Gallo v. Galileo Asesores S.L***., WIPO Case No. D2000-1649, ***Lorenzo Silva Amador v.Galileo Asesesores*** S.L WIPO Case No. D2000-1697, ***Louis De Bernieres v Old Barn Studios Limited***, WIPO Case No. D 2001-0122 (in which there is a valuable and persuasive discussion of the reasons why the Policy applies to common law or unregistered trademarks), ***Margaret Drabble v. Old Barn Studios Limited***,WIPO Case No. D 2001-0209, ***Dr. Michael Crichton v. Alberta Hot Rods***,WIPO Case No: D2002-0872, ***Jorge Antonio Labanda Blanco v. Xavier Mañé*** ,WIPO Case No. D2002-1111, ***Jose Luis Sampedro Saez v. Galileo Asesores***, WIPO Case No. D2000-1650, ***Julian Barnes –V- Old Barn Studios Limited***,WIPOCase No. D2001-0121, ***Antony Beevor –V- Old Barn Studios Limited***, WIPO Case No. D 2001-0123, ***Marian Keyes v. Old Barn Studios Ltd.***, WIPO Case No.D2002-0687, ***Dr. Michael Crichton v. In Stealth Mode***, WIPO Case No: D2002-0874 , ***Sibyl Avery Jackson v. Jan Teluch***, WIPO Case No. D2002-1180 (with qualifications), ***Joe David Graedon v. Modern Limited - Cayman Web Development***, WIPO Case No. D2003-0640; ***Jeffrey Archer v. Alberta Hotrods tda CELEBRITY 1000***, WIPO Case No. D2006-0431, ***Fondation Le Corbusier v. Mercado M.***,WIPO Case No. D2004-0723, ***Arthur Golden v. Galileo Asesores S.L.*** , WIPO Case No. D2006-1215 and ***Francis Newton Souza v. ZWYX.org Ltd.***, WIPO Case No. D2007-0221.

A Canadian decision on the issue and concerning an author is ***Barbara Kingsolver v. Old Barn Studios, Ltd***. AF-0762 (eResolution Aril 25, 2001).

The domain name was <barbarakingsolver.com>. The evidence was that the Complainant was ‘author of a number of bestselling books of fiction and nonfiction’ and also that ‘… the complainant's claim is the same as the claim sustained on January 8, 2000 against this same respondent, Old Barn Studios, Limited, in a proceeding brought by the The Authors Guild on behalf of nine authors, The Authors Guild, Inc. Paul Aiken, Ex. Dir. v. Old Barns Studios, Ltd., Case No. AF-0582 (a, b, c, d, e, f, g, h and i). “

The Panel in its decision on the issue merely said:

> “The complainant has presented evidence that her name enjoys common law trademark protection in at least the USA and the UK.”

Interestingly, the trademark may also be established in a product such as Mr Trump’s Trump Ice water: ***Donald J. Trump v. Fountainhead Entertainment LLC***, WIPO Case No. D2004-0429, where the domain name was <trumpice.com>. But see the apparently conflicting decision in A salutary reminder that this may not always succeed is ***Donald J. Trump and Trump Hotel & Casino Resorts, Inc. v. olegevtushenko a/k/a Oleg Evtushenko***, NAF, Claim Number: FA0110000101509. In that case it was held that the domain name <porntrumps.com> was not confusingly similar to the TRUMP trademark because readers would not associate it with Donald Trump, but with the notion that pornography succeeds or is paramount, i.e. trumps in the card playing sense.

Let us now look at the other two of the most frequently referred to cases on this issue, those of ***Nick Cannon*** and the actress ***Nicole Kidman***, both of whom were successful in using the principle and establishing an unregistered trademark in their own names which supported their claims under the UDRP.

The first is ***Nick Cannon v. Modern Limited - Cayman Web Development*** WIPO Case No.D2005-0757. The domain name was <nickcannon.com>. The Complainant was a television and film actor, a writer and producer of television programs and films and also a music composer and performer. Over the previous 10 years, the Complainant had appeared in numerous television programs and motion pictures, including “The Nick Cannon Show”, “Men in Black II” (2002), “Drumline” (2002), “Love Don’t Cost a Thing” (2003), “Shall We Dance” (2004), and “Jump Shot” (2005).

The panel dealt with the claim that Cannon had common law trademark rights in his own name and eventually held, following *Roberts* and *Kidman*, that he did.

The way the Panel expressed it was:

> "It is well established in numerous UDRP decisions cited by the Complainant that a complainant does not need to show that one enjoys rights from registered trademarks. See *Julia Fiona Roberts v. Russell Boyd*, WIPO Case No. D2000-0210. In numerous jurisdictions, including that of the United States, a complainant may assert common law trademark rights in his or her name. The Complainant has done so in the present case in referring to his movie experience (six films, from 2002 to 2005) and his extensive career as an actor, writer, producer, and musical composer and performer under his name since the 1980s."

What is interesting about the expression of this principle is that it is one of the earliest statements to the effect that the principle we are presently discussing can only be used in those jurisdiction where common law trademark rights are recognised, which are of course only common law countries and not civil law countries.

This distinction is now regularly used to deny some of the more optimistic claims for the recognition of unregistered trademarks in UDRP cases; eg the domain name <187.com> in ***Telecom Italia S.p.A. v. NetGears LLC c/o Domain Admin***, NAF Case No: FA0944807. However it is not provided for expressly in the Policy.

In any event Nick Cannon was held to have established common law rights. The panel had no trouble finding that the Respondent had no right or legitimate interest in the domain name and also that it had registered and used it in bad faith because:

> "The evidence shows in this present case that the domain name in dispute does not direct Internet users to a fan site for the Complainant but to a website of totally unrelated links to other web pages, including links to pornographic websites, as this Panel observed in its verification. The Panel finds that these activities, in addition to the pattern of "cybersquatting" on hundreds of domain names confusingly

> similar to the names of other famous persons and companies, demonstrate use of the domain name in dispute in bad faith."

That decision was recently followed in another case concerning Nick Cannon, ***Nick Cannon v. Nikolay Zuyev***, WIPO Case No. D2007-0870 where the domain name was<nickcannonmusic.com>, but it was linked to www.sunnygals.com and you can imagine what that website is all about.

Nicole Kidman

The ***Nicole Kidman Case***, the other leading case, is ***Nicole Kidman v. John Zuccarini, d/b/a Cupcake Party*** WIPO Case No. D2000-1415. In that case, the domain names at issue were <nicholekidman.com> and <nicolekidmannude.com> and the Respondent was the well-known cybersquatter John Zuccarini. Clicking on the domain name <nicholekidman.com> sites 'caused "pop-up" advertisements for a variety of commercial enterprises to appear', leading to users being "mousetrapped."

Because of her fame and obvious commercial success, it is not very surprising that the Panel found that Nicole Kidman had established common law trademark rights in her own name.

In addition to those, the leading cases, other prominent actors have also been successful, relying on unregistered trademarks, including Hugh Jackman in ***Hugh Jackman v. Peter Sun,*** NAF Case: FA0248716 and Tom Cruise in ***Tom Cruise v. Network Operations Center / Alberta Hot Rods***, WIPO Case No. D2006-0560.

Going back to the chronological development of the principle, another early success for unregistered trademark rights was the stand up comedienne Nita Rudner in ***Rita Rudner v. Internetco Corp.***, WIPO Case No. D2000-0581. Also successful in the same year were Bridget Moynahan (Sex and the City) ***Kathryn Bridget Moynahan v. Fantastic Sites, Inc,*** WIPO Case No. D2000-1083; ***Cem Yilmaz –v. Roman Club International***, WIPO Case No. D2000-1541, a well-known Turkish comedian, caricaturist and motion picture actor; the comedian and actor Billy Connolly in ***Billy Connolly v. Anthony Stewart***, WIPO Case No. D2000-1549; and the actress Julie Brown in ***Julie Brown v. Julie Brown Club,*** WIPO Case No, where the panel put the legal argument so well by saying:

> " Authors and performers can establish trade mark rights either by showing that they have registered their names as marks for certain goods or services, or because, through deployment of the names as source indicators in commerce, they have unregistered or "common law" rights to protection against misleading use."

Another case decided early in UDRP history, 2000 was valuable because the decision contained a concise but helpful statement of the application of the principle. It was given in the case of the film actress Isabelle Adjani in ***Isabelle Adjani .v. Second Orbit Communications, Inc.***WIPO Case No. D2000-0867, where the panel said:

> "The Rules paragraph 15(a) provide that a Panel shall decide a Complaint on the basis, inter alia, of
>
> "… any rules and principles of law that it deems applicable."
>
> The Complainant is resident in Switzerland and the Respondents give an address in the United States of America. To the extent that it assists in determining whether the Complainant has met her burden under paragraph 4a(i) of the Policy to establish that she has trademark rights in her name Isabelle Adjani, the Panel can look at applicable decision and laws of both countries. From the Julia Roberts case it seems clear that under the law of the United States of America it is possible for a well-known actress to have protectable common law trademark rights in her name. Under Swiss law it appears that the Complainant has protectable rights, akin to trademark rights, in her name.[25] Applying case law developed under the Policy the Panel refers to its own Decision in the Jeanette

[25] The Complainant's submission on this issue was as follows :
"4.3 As a resident in Switzerland, the Complainant claims a right to her name under Arts. 28 and 29 of the Swiss Civil Code. Art. 29.2 provides:

"Where a person assumes the name of another to the latter's prejudice, the latter can apply for an injunction to restrain the continuation of this assumption, and can in addition claim damages if the act is proved to be wrongful, and moral compensation if this is justified by the nature of the wrong suffered." "

> Winterson case, the Cedar Trade Associates case [paragraph 4.6 above] and, again, to the Julia Roberts case."

Another useful decision is ***Estate of Shakur v. Shakur Info Page***, AF-0346 (eResolution Case, Sept. 28, 2000). Mr.Tupac Shakur, often known as 2Pac or Tupac, was an internationally known "Hip-Hop" musician, actor and poet who was murdered in 1996 at the age of 25. His recordings sold millions of copies worldwide. He also appeared in several movies. The Panel was able to find that he had established common law trademark rights as:

> "A person may acquire such a reputation in his or her own name as to give rise to trademark rights in that name at common law …".

Mr Shakur had clearly done so.

Another case where common law rights were accepted concerned Pink Floyd and David Gilmour [26], the decision being ***David Gilmour Music Limited and David Gilmour Music Overseas Limited v. Ermanno Cenicolla,*** WIPO Case No. D2000-1459 where the common law rights were said by the Panel to be based on the following:

> "Although the artist has not registered his name as a trademark, he has incorporated two companies which bear his name, the second and third Complainants, which own the right to exploit his artistic services. The name David Gilmour represents the goodwill in the musical works and other projects with which the artist has been involved since the 1970's. That goodwill is fundamental to the businesses of the Complainants."

Then there was ***Elmore "RIP" Torn, Jr., p/k/a Rip Torn v Riptorn.com***,WIPO Case No. D2001-0850 and the actress and model Pamela Anderson in ***Pamela Anderson v. Alberta Hot Rods***, WIPO Case No. D2002-1104. Another model who was able to establish common law rights and go on to succeed was the Playboy model Patricia Ford in ***Patricia Ford and Online Creations Inc. v. Damir Kruzicevic,*** WIPO Case No. D2001-0059.

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[26] '… guitarist, vocalist and writer with Pink Floyd, he is also renowned for his solo work and collaborations with other artists including Kate Bush, Paul McCartney, and Pete Townshend.' Source: http://www.davidgilmour.com/biography.htm.

Likewise, the sex therapist Dr Roger Libby in ***Dr Roger Libby v. Tunga Tuzlaci and/or Tumay Asena***,WIPO Case No. D2001-1342, whose name was used in a domain name linked to a hardcore pornography site, was successful.

Another early success that is often cited is ***Helen Folsade Adu known as Sade v. Quantum Compouter Services Inc.,*** WIPO Case No. D2000-0794. This was a finding that although the complainant, the celebrity, did not register the word "SADE" either as a trademark or as a service mark, she had adapted the word "SADE" as her stage-name and as a trademark and service mark and therefore she had established common law rights in the mark[27].

A prominent success in the active year 2000 was Madonna in ***Madonna Ciccone, p/k/a Madonna v. Dan Parisi and "Madonna.com"*** WIPO Case No.D2000-0847.

In this case, the Panel very usefully decided that, although panels were not courts of law, they should nevertheless make decisions on questions of fact, even if they were in dispute and that the test was the balance of probabilities. This was one of the earliest cases where that test was laid down.

The Panel rejected the Respondent's claim that it had a right or legitimate interest in the domain name because, before the dispute, it had used the domain name for an adult entertainment site. The Panel accepted that that use had been made of the domain name, as a matter of fact, but found that it was not a *bona fide* use because there was no alternative explanation why the name Madonna was chosen when it must have been chosen because of Madonna's fame.

The website also had a curious disclaimer which was that 'Madonna.com is not affiliated with the Catholic Church, Madonna Hospital, Madonna College or Madonna the singer'. The disclaimed was held to be ineffective.

The Respondent also advanced a desperate argument that he had offered to transfer the domain name to the Madonna Hospital in Lincoln, Nebraska. This was rejected as a defence as the evidence was incomplete and it looked

[27] Sade is a Nigerian English singer and composer who won a Grammy award.

as if the offer was not unconditional. So the Respondent had no right or interest in the domain name.

The domain name had also been registered and used in bad faith because it had been registered to trade off the name and reputation of Madonna. The word may have other meanings, it was said, but the Respondent had not tried to tie the website to any dictionary definition of Madonna.

The case was also different from ***Sting*** because in ***Sting*** there was no indication that the registrant was trying to trade off the fame of the singer. In ***Madonna***, there was.

Another of the class of 2000 that is often cited concerns a Korean singer, Cho Yong PiL, in ***Cho Yong Pil v. ImageLand, Inc.*** WIPO Case No. D2000-0229. The Complainant submitted materials showing that Cho Yong Pil was the name of a famous Korean pop music artist who performed, recorded, and sold records, CDs, cassettes, and related music products under the name "Cho Yong Pil" (sometimes as "Cho Yong-Pil"), and that the name Cho Yong Pil had been used in association with his music products and performances over thirty years in Korea and internationally.

The decision on this issue was:

> "Here, the passing off is likely given Cho Yong Pil's fame, especially in Korea and Asia. Accordingly, the Panel determines that the Complainant has shown that the fame in his name Cho Yong Pil is sufficient to give the Complainant trademark or service mark rights for the purpose of the Rules. The Panel thus concludes that the domain name <CHOYONGPIL.COM> is identical or confusingly similar to the Complainant's mark, Cho Yong Pil."

Another case of an actor who succeeded in establishing common law rights in two cases, in 2001 and 2002 was Kevin Spacey in ***Kevin Spacey v John Zuccarini***, Claim Number: FA0096937 and ***Kevin Spacey v. Alberta Hot Rods***, NAF Case FA0114437 respectively.

Other celebrity Cases

It will useful, even if only as a matter of record, to note some of the other celebrity cases that have relied on there being an unregistered or common law trademark and to note any interesting feature of the cases.

In particular, we should also mention other entertainers who have reached celebrity status and have been able to avail themselves of common law trademarks in these proceedings.

Dame Elizabeth Taylor, The Elizabeth Taylor Cosmetics Company & Interplanet Productions Limited v. Day After c/o Robert Chafino
NAF Case No: FA0653586 is one where the domain names at issue were <houseoftaylorjewelry.com> and <houseoftaylorjewelry.net>. The celebrity complainant was able to rely on her common law trademark to succeed.

Then there is the ever-popular Celine Dion. The case is ***Celine Dion and Sony Music Entertainment (Canada) Inc. v. Jeff Burgar operating or carrying on business as Celine Dion Club***, WIPO Case No. D2000-1838.

Entertainers

Other cases where entertainers succeeded in establishing common law trademark rights were:

(a) ***Estate of Stanley Getz aka Stan Getz v. Peter Vogel,*** WIPO Case No. D2000-0773;

(b) ***Tracy Marrow p/k/a "ICE-T" v. iceT.com a/k/a Sverrir Geirmundsson***,WIPO Case No. D2000-1234;

(c) ***Bill Withers v. Robert Dominico et al.***, WIPO Case No. D2000-1621;

(d) ***Roy Harper v The Reprahduce Company***,WIPO Case No. D2001-0647; and

(e) ***Lara Crokaert and Les Productions Clandestines v. Buy This Domain Web Master***, WIPO Case No D2002-0062 .

Among the more exotic cases of entertainers who were successful in their claims are ***DM Entertainment Pvt. Ltd. v. Mr. Hemant Kumar***, WIPO Case No. D2001-1267 concerning, as the panel described him,"… probably the

most famous contemporary Punjabi performing artist, composer and lyricist" and the case concerning the adult video entertainer Sylvia Saint in ***Silvie Tomčalová a.k.a. Sylvia Saint v. Juan Campos***,WIPO Case No. D2006-0379.

Another case of an entertainer having been able to establish an unregistered trademark is Michael Feinstein in ***Michael J. Feinstein v. PAWS Video Production***, WIPO Case No. D2000-0880 where the domain names were "michaelfeinstein.com", "michaelfeinstein.net" and "purefeinstein.com". Michael Feinstein is a famous singer and entertainer. The common law trademarks were established, with the panel saying:

> "Complainant alleges that his career has spanned twenty years and that one if his more popular albums is entitled "Pure Feinstein." While these allegations do not describe the number of his recordings and concerts or the extent of their distribution, the allegations are uncontested. See, Julia Roberts v. Russell Boyd (WIPO Case No. D2000-0210). Therefore, the Sole Panelist finds that Complainant has common law trademarks in MICHAEL FEINSTEIN and PURE FEINSTEIN."

Likewise was the result in ***Carlos Santana v. Domain Sales a/k/a ########## This Domain Name is For Sale ##########***NAF Case No.: FA0222189. This case concerned the rock artist Santana who inducted into the Rock and Roll Hall of Fame in 1998 and who was prominently known worldwide for his musical talents and abilities. Since 1969, the Complainant had utilized the birth name and the trademark, CARLOS SANTANA to promote and sell 37 commercial music albums. It was held that he had established a common law or unregistered trademark. The domain name was used to market pornography, so the panel was also able to find that there was no right or legitimate interest in the registrant of the domain name and also that there had been bad faith registration and use of the domain name. The domain name was thus transferred to Santana.

Another 2007 case is ***Utada Hikaru v. Leonard Meng Lee***, WIPO Case No. D2007-0366. The Complainant was at the time of the decision the number one "pop" singer in Japan. Her first album "First Love" had been launched in 1999 and sold more than 9.5 million copies, making it one of the most successful best-selling albums in Japan. The domain name had been linked to a website with links to the complainant's goods, goods of other suppliers,

credit cards and such like. There was a finding of common law trademark rights, no right or legitimate interest and bad faith in the registration and use of the domain name.

Edward van Halen was successful in ***Edward Van Halen v. Deborah Morgan,*** WIPO Case No. D2000-1313. He alleged a common law trademark in EDWARD VAN HALEN, the Dutch guitarist, keyboardist, songwriter and producer most famous for being leader and co-founder of the hard rock band, Van Halen. He would have been able to make out the common law mark, but the Respondent conceded that Van Halen had rights in the mark EDWARD VAN HALEN.

The next case worth looking at is the case on Vin Diesel, aka Mark Vincent (Saving Private Ryan). The case is ***Vin Diesel v. LMN a/k/a L.M. Nordell*** NAF Case No: FA0804924, where Vin Diesel was held to have common law trademark rights because of his wide fame and sales of his products.

The Respondent's <vindiesel.com> domain name, which was held to be identical to Complainant's VIN DIESEL trademark, resolved to a commercial website featuring links to various content unrelated to the Complainant. This, although it is jumping ahead in the analysis, showed that the Respondent had no legitimate interest and also that he had registered and used the domain name in bad faith.

In 2005, there was ***Sound Unseen, Ltd.; Apple Bottoms, LLC; and Cornell Haynes p/k/a "Nelly" v. Patrick Vanderhorst***, WIPO Case No. D2005-0636 that concerned the clothing range Applebottoms, devised by the entertainer Nelly, described in the industry as a three time "Grammy award winning rap/hip-hop recording artist and actor who ha (d) achieved world-wide recognition."

A cybersquatter had registered several domain names such as <missapplebottom.com>, which were linked to a pornography site. It was held that Nelly had made out a case for a common law trademark, so there was no difficulty in his being able to bring the complaint, with the panel then finding that the respondent had no right or legitimate interest in the domain names and that he had registered and used them in bad faith.

It should also be noted that a production company may have a common law trademark in the name of its production, the show itself, by announcing it

and, apparently, even if it amounts to a trademark acquired one day prior to the day on which the domain name (in this case <fatactress.com>) was registered: see ***True Blue Productions, Inc. v. Chris Hoffman***, WIPO Case No. D2004-0930.

The issue of the common law trademark seems to have spanned the entire life of the UDRP; thus, a recent case found common law trademark rights established in the name of the famous dancer and actor Gene Kelly, so that his trust could bring a complaint under the USDRP: ***Gene Kelly Image Trust v. BWI Domain Manager***, WIPO Case No. D2008-0342. Gene Kelly had been dead for over 10 years and the panel was able to say:

> "… Gene Kelly had, through extensive and prolonged use, acquired common law trademark rights in his name. The rights in this mark were transferred to the Complainant upon Gene Kelly's death in 1996 pursuant to the Declaration of Trust. The Panel therefore finds that the "Gene Kelly" name and trademark is still used substantially in trade to promote his performance services."

Painters

Moving away from film star celebrities, another case in 2000 that raised some interesting issues concerned the abstract, impressionist painter Sam Francis: ***Frederick M. Nicholas, Administrator, The Sam Francis Estate v. Magidson Fine Art, Inc*** WIPO Case D2000-0673. This is an interesting decision for several reasons. First, it is one of the few decisions, although not a unique one, where there were three panellists deciding the case and a dissenting decision. Secondly, the dissent was perhaps more significant in the sense that it was the presiding panellist who dissented.

The Respondent registered <samfrancis.com> and used it for a website which sold only Sam Francis paintings, but from an art gallery that made it plain that it was a commercial gallery that was selling paintings by Francis and which did not claim falsely that it was Sam Francis' own website.

The Panel found that over the years the name Sam Francis had come to be associated exclusively with paintings by Sam Francis and that consequently the name '…***has acquired distinctiveness and secondary meaning as a common law trademark and service mark when associated with works of art***.'

The Panel then made an observation that was pivotal to deciding the case. It said:

> "The existence of a common law trademark or service mark does not prohibit art collectors or the general public from referring to a piece as a "Sam Francis" work. The existence of a common law trademark or service mark does prohibit the use of the phrase "Sam Francis" in a manner denoting that a gallery or exhibition, whether physical or virtual, is sponsored or authorized by Sam Francis or his Estate."

We will see that this was a significant observation, but for the moment we will just note that this was another case where common law trademark rights were established and held to have been adequate in UDRP proceedings.

Another case of a painter who similarly was held to have established common law trademark rights in her own name was ***George-Marie Glover and George-Marie Glover, LLC v. Cherie Pogue***, WIPO Case D2001-0600, she having worked under that name for 15 years. The respondent website designer had simply registered the domain name of her client in her own, the respondent's, name. The complainant artist won, but curiously, if you look at the website today she is not using it. Perhaps it was one of those cases where the main interest of the celebrity was to stop some unauthorised person from holding and using the domain name, even if the celebrity does not really want it.

Another artist covered by the principle was Thomas Blackshear in ***Thomas Blackshear v. Christ-Centered Mall, Inc.***, WIPO Case No. D2002-0736.

Also successful was the Spanish painter Antonio de Felipe. In his case, ***Antonio de Felipe v. Registerfly.com***, WIPO Case No. D2005-0969 there is a useful discussion of the issue, particularly the issue that there is no universal principle of common law trademark law, but that there was a common law trademark recognised in this case because the artist had held exhibitions in London, where of course common law trademark rights are recognised and his works were priced in pounds sterling. The panel said:

> "Furthermore, it is clear that these trading activities take place in the UK. There is evidence of an exhibition under the Complainant's name in London in 2004 and of a website for the Andipa Gallery which lists

> art by “Antonio de Felipe”. The website is not only accessible to internet users in the UK but appears to be aimed at least in part to the UK consumer by virtue of the fact that it offers the Complainant’s artworks for sale priced in Pounds Sterling.”

There was also held to bad faith registration and use of the domain name in that case because it resolved to a Spanish website where downloads and ringtones could be purchased.

Dianna, Princess of Wales

Another decision in the year 2000 was ***CMG Worldwide, Inc. v. Naughtya Page***, NAF: FA0095641, where the domain names were <princessdi.com> and <princessdiana.com>. The facts were said to be:

> “Complainant is in the business of representing living and deceased celebrities and the heirs, families and estates of the deceased celebrities for the purpose of licensing to third parties permission to commercially utilize among other things the names of said celebrities together with trademarks and related rights associated with the same. Complainant is the authorized representative for The Diana, Princess of Wales Memorial Fund, the only officially recognized body dedicated exclusively to continuing the work of the late Diana Spencer with the full approval of her estate. ‘

It is worthwhile quoting from the decision, which was that common law trademark rights had been made out:

> “Diana, Princess of Wales before her death had rights to her common law trademarks and the terms specifically at issue, Princess Diana and Princess Di. Those rights now belong to the Complainant. See Monty and Pat Roberts, Inc. v. Bill Keith, D2000-0299 (WIPO June 9, 2000) (finding that Respondent’s domain name "montyroberts.net" is confusingly similar to Complainant’s pending service mark "Monty Roberts"); Bibbero Systems, Inc. v. Tseu & Assoc., FA 94416 (finding common law rights in the mark BIBBERO as the Complainant, Bibbero Systems, Inc (Complainant owns a U.S. trademark for its full company name) had developed brand name recognition with this term by which the Complainant is commonly known); Roberts v. Boyd, D2000-0210 (WIPO May 29, 2000)

> (finding that trademark registration was not necessary and that the name "Julia Roberts" has sufficient secondary association with the Complainant that common law trademark rights exist).
>
> The ICANN dispute resolution policy is "broad in scope" in that "the reference to a trademark or service mark 'in which the complainant has rights' means that ownership of a registered mark is not required– unregistered or common law trademark or service mark rights will suffice" to support a domain name complaint under the policy. See McCarthy on Trademarks and Unfair Competition, § 25:74.2, Vol. 4 (2000) (emphasis in original).
>
> The Complainant currently has pending trademark applications for the mark DIANA PRINCESS OF WALES MEMORIAL FUND. Pending trademark applications provide rights in a mark. See ***SeekAmerica Networks Inc. v. Tariq Masood and Solo Signs***, D2000 - 0131 (WIPO April 13, 2000) (finding that the Rules do not require that the Complainant's trade mark or service mark be registered by a government authority or agency for such rights to exist); ***Phone-N-Phone Services (Bermuda) Ltd. v. Shlomi (Salomon) Levi***, D2000-00400 (WIPO Mar. 23, 2000) (finding that the domain name was identical or confusingly similar to the complainant's pending service mark application)."

The decision was correct on the issue of common law trademark rights, because the Trust that assigned the rights it inherited from the Princess was certainly engaged in trade. The issue of the trademark applications, however, is more doubtful, as we have also seen from other decisions.
There have been other decisions on Princess Diana, namely ***CMG Worldwide, Inc v Steve Gregory***, NAF Case No.FA95645 and ***CMG Worldwide, Inc v. Bonnie Masterson***, NAF Case, No.FA97061 and at least one other on royalty, ***Albert Furst von Thurn und Taxis v. Doris Eckert,*** WIPO Case No.D2004-0817.

Robert Downey Jnr.

Then we have Robert Downey Jnr. (Natural Born Killers; Golden Globe Award) in ***Robert Downey Jr. v. Mercedita Kyamko*** WIPO Case No. D2004-0895. The domain name was <robertdowneyjr.com>.The Panel found that the Complainant had established common law trademark rights.

The reason given for the finding was as follows:

> "The Panel accepts the Complainant's contention that the Complainant's longstanding involvement in the motion picture and television industries has resulted in the "Robert Downey Jr." name becoming unquestionably associated, in the public's mind, with the Complainant'.

The panellist may also have been influenced by attempting to obtain access to the website at the disputed domain name only to find that it resolved to the website at <clubpink.com>, which contains pornographic content.

Morgan Freeman

Morgan Freeman v. Mighty LLC **WIPO Case No. D2005-0263** is another useful decision because of its description of what has to be proved in such cases. The Panel said:

"To establish rights in a personal name for the purposes of Paragraph 4(a) of the Policy it is necessary to show that the name has been used as an indication of the source of goods or services supplied in trade or commerce and as a result of such use the name has become distinctive of that source".

So Mr Freeman had established common law trademark rights.

The Beatles

Of course, this discussion would not be complete without mention of the celebrities *par excellence*, the Beatles. There are several ***Beatles Cases.*** This one concerned Linda and Paul McCartney.

It is a case where one cannot help but say that the decision would have benefited from a better arguing out of the principles involved, at least with respect to Linda McCartney. The decision was ***MPL Communications Limited v. Denny Hammerton*** NAF Case: FAO95633. The domain names were "linda-mccartney.net" "lindamccartney.com" and "paulmccartney.com".

The Panel seemed to assume common law rights rather than make out a case to justify such a conclusion. It simply said:

> " The Complainant owns the rights to the common-law and registered trademarks and service marks of Sir Paul McCartney and his wife, the late Linda McCartney.
>
> Sir Paul McCartney is a well-known international recording artist. He began his career in 1960 as a member of The Beatles Sir Paul married Linda Eastman McCartney in 1969. Linda gained her own notoriety as a photographer. She was also known as an animal rights activist, which lead her to publishing several vegetarian cookbooks as well as a series of ready-made vegetarian meals. They performed together, both on recorded medium and live world tours, and also authored a collection of songs. "

It would have been better, with respect, had it been argued out, in the case of Mrs McCartney, why she had acquired common law trademark rights, although in Mr McCartney's case it was probably self-evident.

Not surprisingly, another Beatle, George Harrison was held to have established common law trademark rights in his own name in the 2001 decision, ***George Harrison v LOVEARTH.net***: NAF Case No: FA0097085. The panel said on this issue:

> "Complainant, George Harrison, enjoys an exceedingly valuable reputation and goodwill of enormous and inestimable value as a result of (a) the extensive sales and advertising of numerous musical compositions and recordings bearing his name; (b) the fame and acclaim surrounding the musical services of The Beatles and of Mr. Harrison individually and the popularity of the motion pictures in which he has appeared; (c) the widespread public recognition of the name GEORGE HARRISON and the association of that name with Complainant; and (d) the high quality and nature of George Harrison's musical compositions, musical recordings and musical services. This goodwill, which has come to be associated with the unique and distinctive features of Mr. Harrison and his work, has given great monetary value to his exclusive right to exploit the name and trademark, GEORGE HARRISON. This common law trademark has undoubtedly acquired a secondary meaning in the mind of the public

> and is a strong trademark worthy of protection. Complainant's name and trademark is distinctive and famous and is widely recognized throughout the United States and the world by millions of music fans. From the allegations of the Complainant and the admissions of the Respondent, it appears that the Respondent has registered the domain names at issue here in order to trade off the considerable good will associated with Complainant's trademark name…(and) Complainant's name has become a strong trademark worthy of protection…"

Another Beatles case in 2005 was ***MPL Communications, Limited and MPL Communications, Inc. v LOVEARTH.net***, NAF Claim Number: FA0097086 where the panellist held that although the Complainant had a registered trademark in the name Paul McCartney of The Beatles, it also had clear common law rights and the panellist made it clear that the case was being decided just as much on the common law trademark as on the registered trademark. It was said that McCartney himself had formed the Complainant company; so it was his alter ego, although nothing was said in the decision about who else may own common law trademark rights in a celebrity's name, except his estate.

Another Beatles Case was ***MPL Communications, Limited et al v 1WebAddress.com,*** NAF Case Claim: FA0097092 concerning the domain name <epaulmccartney.com>. It was held that there were common law trademark rights, which predated the registration of the domain names.

Although not directly relevant to our immediate area of inquiry, common law trademarks, it is interesting to note that the claim was defended and the respondent claimed that he had a right or legitimate interest in the domain name for the following reason:

> "While the Respondent claims its use of the contested domain name is solely for a fan site and particularly for McCartney whom the Respondent acknowledges is quite conscious of environmental and humanitarian causes, the Panel categorically rejects such a simplistic view."

The panel explained that conclusion in the following way:

> "The Panel views the purported fan site as a cleverly designed platform through which the Respondent furthers its own

> environmental interests by leveraging off and, in effect, misappropriating the widespread recognition and fame of the corresponding celebrity, here being Paul McCartney, to the Respondent's benefit by falsely suggesting, to Internet site visitors, an affiliation, sponsorship or connection between the celebrity and the specific causes advocated by the Respondent. If the Respondent established and were hosting a bona fide fan site (of which the present site is clearly not), then, in this Panel's mind, that site would solely be devoted to providing or exchanging information to and/or among Internet site visitors about the corresponding celebrity but, in all likelihood, would be devoid of information reflective of any cause advocated by the site operator which was not personally and specifically endorsed by that celebrity -- with such an endorsement clearly appearing on the site. The record before this Panel, and specifically the hard copies of the web pages on the Respondent's McCartney site, contains absolutely no endorsement by McCartney of any specific environmental cause advocated by the Respondent or Elsis, or of Elsis' "Rainforests" essay."

The decision is thus an important illustration of the important rule of practice in UDRP proceedings that evidence must be tendered in support of allegations and assertions made and if it is not tendered, the party concerned runs a distinct risk of losing.

This decision also observed that if a complainant is seeking to prove that the respondent's intention was to have the complainant buy the domain name, the proposed consideration for that sale does not have to be in monetary form to constitute the payment the respondent demanded; it may, for example, be a demand to support an environmental or other cause.

Mick Jagger

Another successful case in establishing common law rights was that in ***Jagger v. Hammerton,*** FA 95261 (Nat. Arb. Forum Sept. 11, 2000) where it was held that the Complainant held common law trademark rights in his famous name Mick Jagger. The way it was put by the Panel was as follows:

> "Complainant has presented clear and convincing evidence that the Complainant holds a common law trademark in his famous name…"

and again

> "Certainly, Complainant held a common law trademark in his famous name, "Mick Jagger," even without registration at the United States Patent and Trademark Office.'

The Horse Whisperer

The next case and one that is frequently cited in decisions, concerned **Monty Roberts ' The Horse Whisperer': *Monty and Pat Roberts, Inc. v. Bill Keith,*** WIPO Case No. D2000-0299 (June 9, 2000). We will have to look at this case again later on other contentious issues and the decision is a very significant one. For the moment, however, it is enough to note that it was another case where it was held that the Complainant, Monty Roberts, the famous horse trainer known as the Horse Whisperer had a common law trademark in his own name.

This conclusion was reached despite the fact that it was hotly argued against by the Respondent in vigorously defended proceedings.

The Panel put its decision this way:

> 'The Panel is persuaded that Complainant Monty Roberts holds a famous mark in connection with the service of horse training. The name appears to be very well known among service providers and consumers in this sector. As such, the Panel determines that Complainant is the holder of rights in a service mark within the meaning of paragraph 4(a)(1) of the Policy.'

In the preceding parts of the decision, there was a recital of a lot of evidence adduced by the complainant that showed he had used his name in the course of promoting goods and services. Among that evidence was the use of the name in connection with his authorship and sale of books on equestrian activities, thus making the case another of those, like the next case ***Bob Avila v. B&B Productions***, WIPO Case No. D2004-0013 and ***The Hillary Clinton Case*** where it was the sale of books that got the Complainant to first base on establishing a common law trademark.

In 2004 there was a case concerning another horse trainer Horse trainer, Bob Avila ***Bob Avila v. B&B Productions***, WIPO Case No. D2004-0013, where

the domain name was <bobavila.com>. The case resolved itself into some hotly disputed questions of fact, but on the initial question of the common law trademark, it was clear enough.

The panel said:

> "The Complainant is a horse trainer and showman of American Quarter Horses. He has successfully competed in Quarter Horse Association, National Reigning Horse Association and National Reined Cow Horse Association events. The Complainant has also marketed and sold books and video tapes demonstrating his techniques in training and showing American Quarter Horses. He has also commercially sponsored products used in the horse industry."

So, clearly he had established a common law trademark. The reliance on evidence of the sale of books has an echo in ***The Hillary Clinton Case*** as it was on that ground that Senator Clinton was held to have established a common law trademark in her own name and, without that evidence, she may have failed, as have other politicians seeking to establish such rights.

Establishing a common law trademark may not be the end of the story

One of the early cases where unregistered trademark rights were accepted without much argument was ***Dr. Werner Kupper [Executor of the Estate of The late Herbert von Karajan] and Eliette von Karajan v. Karajan Pty Ltd***, WIPO Case No. D2000-1578, as Herbert von Karajan was famous in his own right as a leading orchestral conductor. So the Complainant, his executor, got to first base.

But he faltered at second base; the case failed because the respondent was able, on good grounds, to show that it had a right or legitimate interest in the domain name <karajan.com> which it had used in business for many years prior to the complaint and the dispute.

Journalists and commentators

Several journalists have also been successful in establishing common law trademarks, for example in ***Bernardo Neustadt v. Link Commercial Corp.***, WIPO Case D2000 – 1256 and ***Lynne Russell v. Kenneth Young***, WIPO Case No. D2002-1133.

Another successful celebrity commentator in 2000 was Dan Marino. Dan Marino, who had spent 17 years as the quarterback for the Miami Dolphins, had been a sports commentator, acted in movies, had his own TV show and had been recognized for community service. It was held in the decision, ***Daniel C. Marino, Jr. v. Video Images Productions,*** WIPO Case, D2000-0598, that Marino had acquired sufficient secondary meaning within the American sports, entertainment and public service communities for his name to constitute a valid common law trademark. The panel said:

> "Complainant has evidence that he has spent 17 years as the quarterback for the Miami Dolphins, has been a sports commentator, has acted in movies and has been recognized for community service. Complainant's evidence is sufficient for the Sole Panelist to conclude that ***the name "Dan Marino" has acquired sufficient secondary meaning within the American sports, entertainment and public service communities to constitute a valid common law trademark***."(emphasis added).

In the same genre are news announcers and on-air personalities. A case concerning one of them was Nik Carter, the Boston on air announcer, in ***Nik Carter v. The Afternoon Fiasco,*** WIPO Case No. D2000-0658. He was described by the panel as being:

> "…a popular and well-known on-air personality (i.e., DJ) at WBCN-FM (104.1), a radio station in Boston, Massachusetts. WBCN is the top-ranked alternative or "modern" rock station in the Boston market. Complainant has been in the radio broadcasting business for many years.'

The panel gave a very short acceptance of his case by saying:

> "The Panel has reviewed the evidence submitted by the Complainant concerning ownership of the trademark NIK CARTER and is satisfied that the Complainant has proven trademark rights in his own name. Furthermore, the Panel finds that the domain names are confusingly similar to the trademark in which the Complainant has rights."

A more recent example of a journalist is ***Maria Bartiromo v. "Maria Bartiromo" and Dave Walton***, WIPO Case No. D2007-0242. Maria

Bartiromo was a leading finance journalist of long standing in the United States; she was the anchor of CNBC's "Closing Bell with Maria Bartiromo" and a widely syndicated commentator.

She was held to have common law rights in her name. The domain name had not been used, enabling the panel to show that this was opportunistic, showing no right or legitimate interest in the domain name and also bad faith registration and use of the domain name.

Who has the common law trademark ?

Journalists and those in similar occupations like anchormen, have also given rise to variations on the normal theme, probably because they are often employees, whereas the usual celebrity is self-employed. The issue that arises in this situation is whether it is the employee or the employer who has the common law trademark rights and which of them may bring the complaint under the UDRP. If the common law rights were originally with the individual, which they presumably would be, the issue then arises how those rights give the employer, the media company, the right to bring the application.

An illustration of this issue is to be found in ***Fox News Network, L.L.C. v. Pro-Life Domains Inc.***, WIPO Case No. D2003-0335. In that case it was accepted that Greta Van Susteren had assigned her common law trademark rights to FOX. Thus:

> "The Complainant further contends that, through appearing on the Complainant's television program, Ms. Van Susteren has acquired common law trademark rights in her name, and that she has assigned them to the Complainant. The Panel finds this argument convincing."

It is difficult to see from the decision where the evidence was to be found to justify this conclusion, although it is an interesting notion.

The better view was expressed in ***Fox News Network, L.L.C. v. Kenneth A. Young***, WIPO Case No. D2003-0407, which also concerned Greta Van Susteren. The panelist who decided that case said that, normally, one would expect the common law rights to be in Ms. Van Susteren herself rather than the television channel itself.

> "However, in the Panel's view in this case, it is probable that the Complainant does own a common law trademark right in the name of the program. The Respondent accepts that the program is ***broadcast by the Complainant*** throughout the United States and also in Europe. Because of the wide publication of the name of the program, and the relatively "instant" effect of television communications into some millions of homes, the panel is prepared to accept that the complainant has acquired common law service mark rights in the name of the program viz "On the Record with Greta Van Susteren," and that those rights existed by the time the domain name was registered on March 30, 2002, (in the Panel's view, it is probable that by that date the Complainant could have successfully sued in the tort of passing off anyone who used the name of the program (or a dominant part of it) without the Complainant's consent).
>
> The Panel also finds that the domain name is confusingly similar to that service mark."(emphasis added).

A television network was also successful as Complainant in ***Fox News Network, L.L.C. v. C&D International Ltd. and Whois Privacy Protection Service.***, WIPO Case No. D2004-0108, where the disputed domain name was <tonysnow.com>, clearly in the name of the presenter rather than the netwok. The panel held that the Complainant network had established common law trademark rights in the name Tony Snow. The panel was, however, critical of the paucity of evidence submitted by the Complainant and warned against too ready an assumption being made that such rights were easy to prove or that such claims would always be allowed. Indeed, the panel made it clear that had the Respondent defended the proceedings, the result may well have been different. The decision is a very useful one for its discussion of the history of this contentious issue and the importance of adducing sufficient evidence to make out the case.

Recent cases suggest that it is still open for news anchors thmselves to be held to have common law rights in their own name, as was the case in ***Larry King v. Alberta Hot Rods***, WIPO Case No. D2005-0570 (finding common law trademark rights in the mark Larry King) and the recent case concerning the news anchor and author, Tucker Carlson: ***Tucker Carlson v. Domain Privacy Ltd***, WIPO Case No. D2008-0474.

But there are always exceptions, such as ***Giampaolo Matteucci v. Webmaster, AWG***, WIPO Case No. D2001-1135. The domain name in issue in that case was: <giancarlofisichella.com>, he being the driver and Matteucci being his agent. It must at least be interesting to find that the common law trademark was owned by the manager.

How famous must the celebrity be?

It should also be said that complainants might succeed with a claim for an unregistered trademark in their name even although they are not a famous celebrity like Mick Jagger or Madonna. However, a celebrity who is not really a celebrity may have more difficulty in proving his or her case for a common law trademark than someone as famous as Mick Jagger or Madonna.

A useful yardstick of the evidence required is to be found in the case just discussed, ***Fox News Network, L.L.C. v. C&D International Ltd. and Whois Privacy Protection Service,*** *(supra)* where the panel suggested that the evidence required was in inverse proportion to the fame of the individual concerned[28], so less evidence might be demanded in a case concerning Mick Jagger than a newly emerging and only recently published poet.

Less prominent personalities may, however, succeed on appropriate evidence. For example, Mr. Richard Juzwin is a celebrity in his own field, being an international stamp collector in Hawthorn, Melbourne, although he may not be famous to the world at large. The facts in the case that he brought in 2001 are simple but disturbing and it is appropriate that he was successful.

The case is ***Richard Juzwin v. Glen Stephens Stamps,*** NAF Case, ***FA0106000097690.*** The Respondent, who was a rival stamp dealer in the United States, registered <richardjuzwin.com> without any authority and then linked it to his own, ie Stephens' website. It was a clear case of deception to attract internet users to the domain name and then siphon them off to a rival business. But the detailed facts as found by the Panel are worth just setting out as the Panel expressed them. They were:

[28] Sometimes referred to as *Taylor's Rule* after the panellist who decided the case.

> "Respondent and Complainant are both in the same specialized field. Respondent is using the <richardjuzwin.com> domain name to resolve to its own website, thus preventing users from contacting Complainant's business. …Furthermore, Complainant asserts that Respondent's use of the <richardjuzwin.com> domain name has already caused confusion and is likely to continue to do so as to whether Complainant sponsors, endorses or is otherwise affiliated with Respondent's website. Such an intentional attempt, for commercial gain, to cause confusion constitutes bad faith under Policy ¶ 4(b)(iv). …And finally, Respondent provided an incorrect address for the owner's contact information to Network Solutions, Inc. (the registrar) when (he) registered the <richardjuzwin.com> domain name. …"

The other relevant fact is that Juzwin did not have a registered trademark, so he had to argue that he had an unregistered or common law trademark. The Panel had no trouble finding that Juzwin had established that unregistered trademark in his own name, so had got to first base. We will see later what the Panel had to say on the other elements.

THE PRINCIPLE ALSO APPLIES TO SPORTSPEOPLE

The principle that an individual may make out a common law trademark in his or her own name and that this is enough to get a UDRP application off the ground, has also been applied to sportspeople. For example, it was so applied in ***Francesco Totti v. Jello Master***, WIPO Case No. D2002-0134, where the domain name was <francescototti.com>. The Complainant was a professional footballer player with the 'AS Roma' team since he was 12 years old and he became its captain. He was accepted as having common law trademark rights by the panellist who said:

> "The disputed domain name is identical to the Complainant's common law mark established by the Complainant's international reputation as a successful football player. The case is similar to many WIPO decisions in which the names of famous people with a reputation in a given area – (e.g. writing, singing, acting) has been found to have generated a common law mark arising out of that reputation. There is no reason why famous sportspeople should not have a similar ability to achieve a common law mark arising out of their fame in an area of life which attracts great interest – if not

> extreme enthusiasm – in those many countries of the world where "soccer" is part of the way of life. See in connection with a sportsperson, Daniel C. Marino, Jr v Video Image Productions, WIPO Case No. D2000-0598."

Also successful in similar circumstances were the golfer Seve Baallesteros in ***Mr. Severiano Ballesteros Sota, Fairway, S.A. and Amen Corner, S.A .v. Patrick Waldron***, WIPO Case No. D2001-0351 and other sportspeople in ***Xavier Hernández Creus v. Isidro Sentis Sales, WIPO Caso No. D2001-0710***, ***Juventus F.C. SpA v. Vincent Khouw***, WIPO Case No. D2001-0844 and ***Giampaolo Matteucci v. Webmaster, AWG***, WIPO Case No. D2001-1135. The domain name in issue in the last of those cases was: <giancarlofisichella.com>, he being the driver and Matteucci being his agent.

Another example is ***Michael James Owen v. MSM Commercial Services***, WIPO Case No. D2006-0155.

There were also the US footballer in ***Terrell Eldorado Owens v. Aran Smith d/b/a Sportsphenoms.com and/or Sportsphenoms***, WIPO Case No. D2003-0463 and the professional golfer Skip Kendall, (although the result was that he lost): ***Jules I. Kendall v. Donald Mayer Re skipkendall.com***,WIPO Case No. D2000-0868.

Celebrities in every sense came to the fore in ***Serena Williams and Venus Williams v. Eileen White Byrne and Allgolfconsultancy***, WIPO Case No. D 2000-1673 concerning <venusandserenawilliams.com>, <venusandserenawilliams.net> and <venusandserenawilliams.org>. It was very quickly established that they had common law rights in their own names.

In boxing, George Foreman was successful in ***George Foreman Ventures LLC v. zinnia c/o Zinnia Gonzalez*** NAF Case: FA0599036 where the panel said:

> "…GEORGE FOREMAN mark has acquired sufficient secondary meaning to establish common law rights based on George Foreman's reputation as a heavyweight boxing champion, celebrity and Olympic gold medallist. The Panel determines that Complainant's has proved that the GEORGE FOREMAN mark has become sufficiently

> connected to George Foreman's boxing career and various products endorsed under his name and likeness."

Notice again that it is not merely that he was famous, but that he was engaged in a commercial activity.

It should also be noted that the Respondent had registered the <georgeforemanenterprises.com> domain name rather than <georgeforeman.com>. Accordingly, the Complainant also had to establish that the domain name was confusingly similar to the trademark GEORGE FOREMAN, despite the addition of the word 'enterprises'. It was held that it was confusingly similar, despite the fact that the addition of that word. It was held that the domain name was confusingly similar to the trademark because 'simply adding a common term to Complainant's mark is not enough to create a domain name that is distinct from Complainant's mark'.

It was also said, quoting from ***Sony Kabushiki Kaisha v. Inja, Kil***, D2000-1409 (WIPO Dec. 9, 2000) that "[n] either the addition of an ordinary descriptive word . . . nor the suffix '. com' detract from the overall impression of the dominant part of the name … and thus Policy ¶ 4(a)(i) is satisfied).'

The footballer Joe Cole in ***Joe Cole v. Dave Skipper***, WIPO Case No. D2003-0843 was also successful in establishing common law rights. Another successful footballer was in ***Ronaldo de Assis Moreira v. Goldmark - Cd Webb,*** WIPO Case ***No. D2004-0827,*** where the panel said:

> **"**The Panel finds that the domain name <ronaldinhogaucho.com> is identical to the Complainant's professional name "Ronaldinho Gaúcho". The Panel notes that in similar cases, it was found that well-known sport persons may achieve common law trademark rights arising out of their fame. See: *Freddy Adu v. Frank Fushille* WIPO Case No. D2004-0682*; Terrell Eldorado Owens v. Aran Smith d/b/a Sportsphenoms.com and/or Sportphenoms* WIPO Case No. D2003-0463*; Joe Cole v. Dave Skipper* WIPO Case No. D2003-0843*; Francesco Totti v. Jello Master* WIPO Case No. D2002-0134; *Xavier Hernández Creus v. Isidro Sentis Sales* WIPO Case No. D2001-0710; *Daniel C. Marino, Jr. V Video Image Productions* WIPO Case No. D2000-0598.

> Moreover in this case, the Complainant has licensed the use of his name to identify and promote products, thus creating in the mind of the consumers a particular association between "Ronaldinho Gaúcho" and such products, from which the Complainant receives a commercial benefit.
>
> Therefore, the Panel finds that the Complainant has common law trademark rights in his professional name, which, pending the grant of his applications, is currently used as an unregistered trademark by third parties under license."

A particularly interesting sports case, because of its helpful commentary on the burden and standard of proof to be applied in establishing a common law trademark is a case we have already noted for another purpose, Fox ***News Network, L.L.C. v. C&D International Ltd. and Whois Privacy Protection Service***, WIPO Case No. D2004-0108 concerning Tony Snow. It is worth looking at this decision in some more detail.

The disputed domain name was <tonysnow.com>. Tony Snow joined Fox News Network, L.L.C. dba Fox News Channel (FNC) in 1996. Tony Snow is currently the host of "Weekend Live with Tony Snow" and former host of "Fox news Sunday with Tony Snow".

There was scarcely enough evidence adduced, although the panel eventually accepted it, encouraging the panelist to say:

> "The assertion that someone is well known or famous is subjective, but certainly easier to prove in the case of celebrities known worldwide such as Nicole Kidman and Julia Roberts and in the Complaints concerning these celebrities such assertions were also evidenced and thus clearly proven. However when someone has a lesser degree of renown, there is a greater need for this evidence, and thus in the view of the Panel, the lesser the degree of fame the greater the evidential burden becomes. One might say that the level and quality of the evidence necessary should be inversely proportional to the notoriety of the person concerned. In any event it needs to be clear, cogent and convincing."

And again:

> "As the degree of fame decreases from clearly identifiable celebrities with worldwide renown, to nationwide renown or to less well known authors, actors or businessmen with limited renown in a specific field, the burden of proof on the Complainant increases and the need for clear and convincing evidence becomes paramount. Without such compelling evidence proving the prior right, a Complainant may fall at the first hurdle. Such evidence may also prove crucial at the third hurdle of proving bad faith registration and use in seeking to prove that the personal name in question is known in the jurisdiction where the Respondent is situated, since the Complainant needs to demonstrate that the Respondent was aware of the Complainant at the time of registering the domain name."

Also, one could note here on the question of whether the evidence being submitted is sufficient or not, that the Panel in ***Nat'l Ass'n of Prof'l Baseball Leagues v. Zuccarini***, WIPO Case D2002-1011 held that the complainant had provided evidence that it had valuable goodwill in the <minorleaguebaseball.com> domain name, establishing common law rights in the MINOR LEAGUE BASEBALL mark.

Trying to Disprove the Common Law Trademark

In those cases which have been defended it is always interesting to see the sort of case advanced by the respondent in attempting to deny the common law trademark. Cases on this issue seem to bring out the best and the not so good in people. Some defences have succeeded but others have not.

Take for instance, ***Allee Willis v. NetHollywood***, WIPO Case No. D2004-1030. Allee Willis is a song writer and a high priestess of kitsch. Among her best-known compositions is "I'll Be There for You," the theme song of the very well-known and long running 'Friends' television series.

The Respondent, who had registered the domain name <alleewillis.com> and whom you would think would be above this sort of argument, denied that Ms. Willis was well-known or famous and argued that, accordingly, she could not have common law trademark rights in her own name.

In that case, one might wonder why he registered the domain name. Rather, according to him, as he put it in such charming language, "[e]xcept for her

inside crowd and some trivia fanatics, no one knows who Allee Willis is, whereby no common law trademark could exist." The response might be that he had obviously thought she was famous or he would not have registered the domain name in her name.

In any event, it was held that Ms Willis had common law trademark rights because she had used the name extensively for commercial purposes.

The Respondent's argument got weaker when he came to deal with the issue of bad faith that we will be looking at later; he tried to explain why he had registered the domain name in Ms Willis' name and other domain names in the names of Diana Ross, Aretha Franklin, Bette Midler, Tina Turner, The Pointer Sisters, and Sheena Easton which, on the surface, would suggest that he had been motivated by bad faith, as he was probably trading off these celebrity names for his own benefit.

But no, he said. The reason he had registered all of these names was to use them as fan sites and to assist law enforcement officials with high-profile unsolved crimes. He had also said he would sell the domain name in question for $25,000. He lost.

Preachers, politicians, personalities and the Pope

But good evidence is needed to satisfy the Panel that the celebrity is exactly that, a celebrity - and that his or her name is associated with goods and services in a commercial way so as to establish the common law trademark.

One celebrity who lost a case on failing to establish that factual matter was the American evangelist, the late **Gerry Fallwell.** The case is ***The Reverend Dr. Jerry Falwell and The Liberty Alliance v. Gary Cohn, Prolife.net, and God.info,*** WIPO Case No. D2002-0184.

The Rev Fallwell sought to show that he had used his name in trade by alleging that he had appeared on the cover of Time magazine, and in 1987 had finished second only to President Reagan in a poll conducted by Good Housekeeping magazine to determine America's Most Admired Men. This showed that he was famous, but that was already known to be so and, more importantly, it was not conclusive evidence of a common law trademark in his own name because it was not evidence of the commercialisation of his name, but merely evidence of his fame. There was no trade or commerce; in

fact, Rev Fallwell was ‘non-materialistic’ as it was described and a ‘non-materialistic’ by definition was not one who had used his name in trade or commerce.

There was a similar result in ***Gene Edwards v. David Miller,*** WIPO Case No.D2003-0339, which concerned another Evangelical church leader. The decision went against him as the previous decision went against Falwell, not because he was a religious leader, but because of the lack of evidence that he used his name in writing and television appearances for the purposes of making money, which the panellist said showed that the complainant’s case was inadequate.

The panel was quite critical of the complainant for not presenting a stronger case. It said:

> “For reasons the Panel cannot fathom, the Complainant has made little effort to convince the Panel that it has common law trademark rights in the disputed domain name, <geneedwards.org>.”

It then highlighted the difficulty faced by a complainant who was also a religious activist or practitioner, which was probably the reason why Mr Edwards had not argued that he was ‘commercial’, by adding:

> “Ordinarily, the Panel would be quite willing to assume that the Complainant writes and sells his books to make money from them. But the Panel does not believe this is necessarily a fair assumption to make in the context of an evangelical Christian minister.
>
> The lack of proof of the commercial intent is even more detrimental to the Complainant’s contentions regarding his public appearances in various media. Again, in the religious context of the Complainant’s activities, the Panel is not prepared to assume that these are commercial as well as religious undertakings.”

At the end of the decision, however, a ray of hope was held out for future religious complainants:

> “The Panel wishes to reiterate that it sees nothing wrong with the Complainant as a minister establishing common law trademark rights

> in his name by using it in commerce like the authors and entertainers cited above. However, the Panel finds the Complainant has not shown that he has used his name in commerce so as to acquire common law trademark rights."

Gurus and yogis, however, may have a better chance of success, if ***Chinmoy Kumar Ghose v. ICDSoft.com and Maria Sliwa,*** WIPO Case No. D2003-0248 is any guide. The case concerned the well-known yogi Sri Chinmoy and domain names at issue were <aboutsrichinmoy.com> and <gurusrichinmoy.com>. Sri Chinmoy succeeded; as the panel put it:

> "…the Panel notes (to borrow from the words of the Panel in the Asper case, paragraph 6.22 and quoted by the majority of the Panel in the Ted Turner case), that the Complainant does appear to have used his personal name as a marketable commodity, for direct commercial purposes in marketing his own goods or services. There is evidence of published works being sold online at "www.amazon.com" under or by reference to the name "Sri Chinmoy," and some of those works appear to have been on the market since the 1980s. There is also some (more limited) evidence of the name "Sri Chinmoy" being used as an identifier of a broadcasting service (a radio station), and also to identify a meditation center run by the Complainant (although there is nothing to tell the Panel whether or not the meditation center is operated as a commercial enterprise). It is not strong evidence but on balance the Panel finds that there has been sufficient use of the SRI CHINMOY mark in association with goods or services of the Complainant, for him to have acquired common law rights in the mark."

So, where others had lost, Sri Chinmoy succeeded.

Another religious leader who succeeded was Vernon Howard in ***New Life Church and Literary Foundation v. Private Business a/k/a Virgil Howard*** , NAF Case No: FA00096280. The domain names at issue were <vernonhoward.com>, < vernonhoward.net> and <vernonhoward.org>. Howard's son, Virgil, assigned the trademarks to the complainant Church after the death of the founder of the Church, his father Vernon Howard. But a few months later he registered the domain names and with a gesture that does not seem a model of filial devotion, pointed them at a website with a "homepage with what appears to be a book cover having the title Vernon

Howard Mystic or Maniac?...” and containing other material said to be defamatory of the Church and Vernon. The panel found in favour of the Complainant on the grounds that the Respondent had sold all of his rights at the settlement and this contaminated the registration and use of the domain names.

Politicians

An odd decision, but one again where a celebrity succeeded, was one of several cases concerning politicians, in this case ***Anne McLellan v. Smartcanuk.com***, AF 0303 (eResolution Sept 25, 2000). The domain names were <annemclellan.com> and <annemclellan.org>.The panel found that the Complainant, a Member of Parliament, who was also the Minister of Justice and Attorney General of Canada, had acquired sufficient common law rights in her name.

You will find that that decision is inconsistent with some others that we will be looking at because there was no commercial or trade element and Ms McLellan’s fame must surely have depended on paid community service rather than trade. The part of the Panel’s decision devoted to the issue of the unregistered trademark is somewhat unsatisfactory. It merely said:

> “This Panel finds that the Complainant has established common law trademark rights in her name sufficient to support a complaint under the ICANN Policy. Anne McLellan is well known in Canada as the Member of Parliament for the federal riding of Edmonton West, and also as the Minister of Justice and Attorney General of Canada. She is the most senior Government of Canada official in the Province of Alberta, which the province in which both the Complainant and Respondent reside.”

In contrast***, Kathleen Kennedy Townsend v. B. G. Birt,*** WIPO Case No. D2002-0030 was a case of a politician who failed to establish common law trademark rights, because it was held that Ms Kennedy Townsend, the daughter of the late Senator Robert Kennedy, was a public figure although not one who was engaged in trade.

The distinguished three person panel that decided the case therefore found that Ms Townsend, did not have an unregistered trademark in her own name.

It was put thus:

> "The Panel finds that the protection of an individual politician's name, no matter how famous, is outside the scope of the Policy since it is not connected with commercial exploitation as set out in the Second WIPO Report."

It drew a distinction, however, between Ms Townsend herself and the fund raising entity that was used to raise money for candidates and also between MsTownsend's situation and a situation where a trademark owner was exploiting intellectual property, as had been done in ***Princess Diana's Case***, (**CMG Worldwide, Inc. v. Naughtya Page)**, NAF Case No. FA95641 . These circumstances, the panel said, would both have provided the requisite element of commerciality, as both of those entities could be said to be engaged in commerce and thus able to establish a common law trademark.

As the panel put it:

"… we determined that the legal fund-raising entity would have been the appropriate party to bring a complaint based upon service mark rights grounded upon political fund-raising activities."

The panel in ***Townsend's Case*** also explained why it was not following the previous and inconsistent ***Anne McLellan v. smartcanuk.com Case,*** which of course had decided in favour of a politician and not a fund raising entity having common law trademark rights. It justified not following ***McLellan*** in the following way, that a year after the decision had been given:

> "…the World Intellectual Property Organization issued its Final Report on the Second WIPO Domain Name Process, dated September 3, 2001 ("Second WIPO Report"). In that report, WIPO carefully considered to what degree protection should be extended to personal names. In its recommendations, WIPO clearly indicated that the Policy should be limited to personal names that had been commercially exploited. "Persons who have gained eminence and respect, but who have not profited from their reputation in commerce, may not avail themselves of the UDRP to protect their personal names against parasitic registrations. The UDRP is thus perceived by some as implementing an excessively materialistic conception of contribution to society." Second WIPO Report, 1999.

So for that reason the panel concluded that it was right in not allowing a finding of common law trademark rights in the case of Ms Kennedy and that the previous decision in ***McLellan***, if not wrong, had been overtaken by events.

Then in 2002 was the unsuccessful case ***Planned Parenthood Federation of America, Inc. and Gloria Feldt v. Chris Hoffman***, WIPO Case No. D2002-1073

> "Complainant Gloria Feldt is the President of Complainant Planned Parenthood Federation of America, Inc. ("Planned Parenthood"). Complainant Planned Parenthood is a not-for-profit corporation organized and existing under the laws of the State of New York.
>
> For almost 30 years, Complainant Feldt has spoken publicly in support of women's reproductive rights. Complainant Feldt has established relationships and contacts based on her personal reputation and credibility. Complainant Feldt has been profiled in the press as a pioneer of the reproductive freedom movement and is the author of many articles on the subject, as well as the author of a book that was scheduled for publication in January 2003 on the subject of reproductive freedom. She has given testimony before legislative and administrative agencies on the subject. Complainant Feldt has given numerous public lectures and speeches at colleges, universities, and other institutions and has appeared on many television and radio news shows.
>
> Complainant Planned Parenthood is a non-profit organization incorporated in 1922, dedicated to reproductive health care services and information for men and women. It has more than 850 health care centers in 49 states and the District of Columbia."

But did that give her common law trademark rights in her name? The answer was 'No'. The rationale was given by the majority of the panel as follows:

> "Complainants have failed to show that the personal name at issue, "Gloria Feldt," has been used in connection with the commercial offering of goods or services or that the personal name in question has

> acquired secondary meaning as the source of such goods or services. It is certainly true that Ms. Feldt has acquired a reputation as an articulate spokesperson for freedom of reproductive choice. However admirable that might be, it is not enough to acquire a common law trademark or service mark. Accordingly, the panel finds that Complainant Feldt does not have rights in a trademark or service mark."

A concurring but separate opinion said that:

> "…use of the term "commercial" should not be understood to suggest that only for-profit enterprises, or individuals, may acquire rights in common law service marks[7]. …If Ms. Feldt is providing reproductive rights "services", we should not hold her to the requirement of doing so for a profit." But she was not providing those services personally.

After ***McLellan***, ***Kennedy*** and ***Feldt,*** the situation for public figures did not look very bright with respect to establishing common law trademark rights, But they were followed in 2005 by the interesting and instructive decision of ***Hillary Rodham Clinton v. Michelle Dinoia a/k/a SZK.com***, NAF Case No.: FA0414641.

Like some other celebrities, Senator Clinton was able to establish a trademark in her own name, not simply because she was famous and not simply because she was a Senator and the wife of a former President, but because in addition to that, she earned income from trade or commerce under her name as the author of several books that had had big sales and produced income. In other words, she was in trade.

Although she won this case, it should never be forgotten in the world of domain names, that there is always another similar name to register. Thus it has been noted that:

> "Although, for example, Senator Hillary Clinton now owns "hillaryclinton.com", the more generic 'hillary.com' is registered to a software firm, Hillary Software, Inc. What about "hillary2008.com"? It is registered to someone outside the Clinton campaign and is not

currently in active use."[29]

In a contrast to the ***Clinton*** decision, although decided before it, in 2000, a panelist in ***Mark Warner 2001 v Mike Larson,*** NAF Case No.95746 found that the Complainant had common law rights in his own name because he was:

> "…A former candidate for the U.S. Senate and is the presumptive candidate for Governor of the Commonwealth of Virginia in2001." [30]The domain names were <markwarner2001.com>, and <warner2001.com>.

The facts were that the

> "…. Respondent registered the domain name "markwarner2001.com" on February 20, 2000 and registered the domain name "warner2001.com" on February 25, 2000. When accessed, both web sites purport to be "warner2001.com" and feature a banner announcement stating "Coming In The Fall of 2000", an outline of the Commonwealth of Virginia, and an e-mail address. Additionally, these web sites state, "This site is not affiliated with any registered political party or candidate for public office." Neither web site provides any other information, commentary, or links."

The Respondent argued that there was no trademark and later that there was no bad faith. He also argued that:

> "…his registration of the domain names in question are not actionable given the political and non-commercial context of their use and that Complainant seeks to squelch the Respondent's right to engage in constitutionally protected free speech."

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[29] Lipton, Jacqueline D., "Who Owns 'Hillary.Com'? Political Speech and the First Amendment in Cyberspace" . Boston College Law Review, Spring 2008 Available at SSRN: http://ssrn.com/abstract=982430

[30] He subsequently became and served as Governor of Virginia, was nominated as a candidate for the Senate, was mooted as a possible Democrat Party candidate for President of the USA and delivered the keynote speech at the Democrat Convention in August 2008.

One would have thought that that was a persuasive argument. However, the panel found in favour of Mr. Warner and justified its decision in finding in the following way that there was a common law trademark:

> "Mr. Warner, who is not a movie star, an NFL quarterback, or a member of the Canadian Parliament, has, in the opinion of the undersigned, established sufficient common law rights in his name. Mr. Warner is a former candidate for the U.S. Senate and is the presumptive candidate for Governor of the Commonwealth of Virginia in 2001."

But there was no mention of a commercial or financial aspect which had been thought to be essential and really none of the sort of evidence generally expected to be adduced before a finding of common law trademark is made. The decision is therefore at odds with the generally accepted line of argument.

On the later and separate issue of rights and legitimate interests, the panel found that the Respondent had no right or legitimate interest in the domain names because he could not bring himself within any of the provisions of the Policy that would establish his legitimacy in that regard. Moreover, the domain names were only bookmark sites with no comment or anything else and were therefore clearly not making a *bona fide* offering of goods and services and were not a fair use.

So the Complainant won on that issue as he had on the first issue, identicality or confusing similarity. But he came unstuck at that stage and lost the whole case, because he was not able to show bad faith in the Respondent both in registering and using the domain name.

The panel's decision on bad faith was:

> "There is also no evidence that Respondent is or ever will attempt to attract internet users to its web site for commercial gain. See Maureen A. Healy v. Andreas Kuhlen, D2000-0698 (WIPO Aug. 24, 2000) (finding no bad faith where Respondent registered the domain name "dvdnews.com" in order to create a "web of DVD sites" or a DVD community despite the fact that Complainant had registered mark for DVD NEWS). While the use of a candidate's name or campaign as a

> domain name will attract internet users, the attraction is arguably for political, not commercial gain."

So the Complainant failed on bad faith.

But, curiously, the last reference to the website on www.archive.org is on April 1, 2001, when the decision was issued on November 15, 2000. One cannot help thinking that this is another case where the Complainant had to buy the Respondent out after losing the case.

But another politician lost, namely Mark Partridge. A note on this case [31] says:

> "A similar result was reached in ***Robin K.A. Ficker v. John W. Thouhy, 305 F.Supp.2d 569 (D.Md. 2004)***. The defendant registered the domain name and used it to provide summaries of critical news stories during Robin Ficker's run for Congress in 2004. Ficker sought a TRO. The court denied relief on several grounds. First, the Court concluded that the web site was clearly a political web site and was protected by the First Amendment. Second, because the site included a disclaimer stating that it was an unofficial site and not "Robin Ficker for U.S. Congress," visitors would not be mislead. Finally, the court questioned whether the ACPA protected "personal names that are not trademarked" where the web site was not a commercial use."

Another loss, occurring in 2006, was ***Fields for Senate v. Toddles Inc.,*** WIPO Case No. D2006-1510 concerning the domain name <virginiafields.com> and the New York politician Virginia Fields. Here again it was held that there was no evidence her name had been used in commerce or as a source of goods or services, so she was unable to establish common law trademark rights.

The importance of Evidence

It is clear, therefore, that care must be taken in preparing these cases before they are submitted for decision and in particular in drawing on every piece of evidence available to show that on the traditional test the Complainant

[31] http://www.circleid.com/posts/personal_names_politics_and_cybersquatting

seeking to retrieve his domain name really has a trademark in his or her own name.

Accordingly, we should remind ourselves as in all cases of the importance of collecting the evidence. One case of a prominent person, where the issue of the alleged common law trademark was lost, illustrates this yet again.

The Hebrew University of Jerusalem v. Alberta Hot Rods, WIPO Case No. D2002-0616 concerned Albert Einstein and his literary works. The panel found as follows:

> "There is no evidence before the Panel that Dr. Einstein used his name for commercial purposes during his lifetime nor that his name, famous though it was, became identified as a source of goods or services. Accordingly, Complainant fails to establish that Dr. Einstein had a common law trademark or service mark in his name."

Nor could the Complainant itself, who had been left the literary works by Einstein, make out such a case on any other basis.

However, the day was saved because the Complainant was able to establish a registered French trademark and that was sufficient to get it past the first element.

All of this raises the interesting question of the Pope. Before the election of the current Pope, an enterprising journalist registered the domain name <bendictxvi.com> and donated it to the Vatican after the election. But other people have not been so generous. Someone registered <benedict16.com> and < popebenedict16.com> and offered them for sale on eBay. Could the Vatican claim it has a trademark on the name of the Pope if it decides to take action to obtain these domain names? To succeed in this claim it would have to show that the Pope is in trade or commerce. Dare the Vatican claim this?

To whet your appetite, there has been one case so far concerning the domain name <vaticanlibrary.com>: ***1451 International Ltd. and Second Renaissance, LLC v. Steven Levine, c/o DomainSystems, Inc.,*** NAF Case No.: FA0583774.

Some parties clearly feel that they can take a risk and not adduce a

substantial quantity of evidence in support of their claim. Thus, in ***Patti LuPone v. XC2/ Moniker Online Services LLC,*** WIPO Case No. D2008-0450, concerning the singer and actress Patti LuPone there was clearly an absence of hard evidence and yet the complainant succeeded. The panelist commented on the absence of the evidence and its consequences in the following way:

> "Although the Complainant has not produced evidence in support of the assertions made in the Complaint that she has, indeed, appeared in the many shows and television programmes mentioned, in the absence of any Response the Panel accepts that she has, through extensive use, acquired common law rights in her name. See *Julia Fiona Roberts v. Russell Boyd*, WIPO Case No. D2000-0210."

Other panelists impose harder targets in terms of the evidence they will expect to see. Thus, in ***Alan Bond v. Information360 Limited***, WIPO Case No. D2007-1081 it was claimed that the formerly successful Australian businessman Alan Bond had established common law trademark rights in his own name and the complaint recited his most notable achievements. The panel did not accept that it was sufficient to make these assertions and said:

> "None of that information is supported by documentation. The Complaint features two annexes, one containing the Whois records relating to the Domain Names and the other containing the Policy. The Panel has nothing before him to show how the Complainant's name is used. Nor are any figures provided to show the extent of the Complainant's use of his name. The Panel accepts that the Complainant is a very well-known Australian businessman, but having a famous name does not of itself equate to unregistered rights in respect of that name.
>
> The Complainant may or may not have unregistered rights in respect of his name, but the Panel has not been provided with relevant hard evidence to enable the Panel to make the assessment.
>
> The Complainant has failed to satisfy the Panel in these proceedings that the Domain Names are identical or confusingly similar to a trademark or service mark in which he has rights."

But if the risk is taken and the case fails for lack of evidence, or more

precisely that the panelist appointed to hear the case expects to find persuasive evidence that is simply not present and rejects the claim, the consequences financially and otherwise can be disastrous. The classic case of course is that of ***David Pecker*** who could have adduced better evidence but did not and lost his case.

More recently, there is the case of ***Jacques Chardeau, Dominique Chardeau, Olivier Chardeau, Gilles Chardeau, Jean-Jacques Chardeau, Patrick Chardeau, Sybille Guinard née Chardeau, and Florence Bret v. MindViews LLC***, WIPO Case No. D2008-0778. This was another bad result for complainants.

The complainants claimed to be the descendants of the 19 th century French impressionist painter Gustave Caillebotte (*Paris Street; Rainy Day*).The family had registered the disputed domain name <caillebotte.com> but allowed it to lapse, when it was taken up by the Respondent.

Initially, the complainants had to establish common law trademark rights in his name but simply failed to do so for lack of evidence. The panel summed up the situation as follows:

> "In any event, the Complainants - though they may be descendants of Gustave Caillebotte's only heir -have not shown that they are in any way involved with commerce associated with the "Caillebotte" name in the 21st Century or have any legally protected interest in the commercial use of the "Caillebotte" name. There is no evidence in the record, for example, indicating that the Complainants buy, sell, or promote the works of Gustave Caillebotte, license reproductions of his works, or receive royalties from third parties exhibiting or reproducing his works. The Complainants emphasize that a family representative has registered several domain names using the name "Caillebotte", but the Complainants have not used these domain names for a website, commercial or otherwise, relating to Gustave Caillebotte."

Reading the decision suggests that the complainants were at no time aware of the need to adduce persuasive evidence.

The strong view of this author is that potential complainants should not take the risk, but adduce all available evidence and do so in the proper manner with certified copies of relevant documents and statutory declarations or

affidavits to support any claims made. The same advice applies, of course to respondents seeking to defeat a claim.

I faced the dilemma myself of deciding if enough evidence had been adduced in ***Cedric Kyles v. Domains by Proxy, Inc. /Asia Ventures, Inc.*** WIPO Case No. D2006-0046**.** In my view, this was a case that on the facts it was a borderline one. Nevertheless, I decided on balance that the actor Cedric Kyles had made out a case for a common law trademark. You can see Mr Kyles' profile at www.ceddybear.com and I am pleased to say that his career seems to have been busy since I decided he was a celebrity.

Business identities

It can be hard for a businessperson to make out such a claim, because the businessperson's trade or commercial activity is more likely to be carried out in the name of a company or a product.

As it was put in the recent decision ***Kotak Mahindra Bank Limited v. Richard Brown***, WIPO Case No. D2008-0243:

> "It is less common for businessmen to have unregistered rights in their personal names as marks protected by the Policy, since businesses are normally carried on by companies which are separate legal persons. "

It is therefore hard to establish that it is the personal name rather than the company name that should attract the trademark rights and be protected, especially where the personal name is not the *alter ego* of the company.

Then there are the cases where the case is made out only that a businessman is well known but is not the alter ego of the company. It is harder for the businessman to establish a trademark in his own name because the name is not often the alter ego of the company or the product.

It has succeeded in some cases, of which two will serve as examples, the first being ***Steven Rattner v. BuyThisDomainName (John Pepin***) WIPO Case No. D2000-0402, where the domain name was "stevenrattner.com". The Complainant had announced his resignation as deputy Chairman of Lazard Frères, a story that was carried in a number of major newspapers and other media throughout the world on March 1st and 2nd, 2000. Shortly thereafter the complainant became aware that the Respondent had registered

the Domain Name. The Panel allowed the claim that the Complainant had a common law trademark. Its basis for saying so was:

> "Common law rights have been found sufficient for the purposes of the Complaint in a number of cases …
>
> It is perhaps important to point out, however, that protection at common law is determined on a case by case basis and depends greatly on the factual basis of each individual case. At common law, as the primary task is to determine if there is confusion in the mind of the consumer, the notoriety of a particular mark is gauged relative to a number of factors, including the territory within which the mark is used, the products for which it is being used, etc.
>
> The above tradition has been continued by panelists in the context of domain name disputes. For example, in ***Monty and Pat Roberts, Inc. v. Bill Keith,*** Case D2000-0299, it was held that, for a claim to be brought under the ICANN Policy based on a personal name, the Complainant must establish the distinctive character of the name. The panelist in that decision goes on to equate the distinctive character with the whether or not the person in question is sufficiently famous in connection with the services offered by that complainant. The Panel agrees with this manner of proceeding and based on the materials provided by the Complainant finds that the Complainant holds a common law mark in connection with investment banking and corporate advisory services which is well known."

This result would suggest that it is not particularly hard to establish common law rights in a businessman's name.

The second example where it has succeeded was ***Chung, Mong Koo v. Individual,*** WIPO Case No. D2005-1068, followed in ***Soin International LLC v. Michael W. Solley, PrivateRegContact Admin/TECH***, WIPO Case No. D2007-0094 and endorsed in ***Kotak Mahindra Bank Limited v. Richard Brown***, WIPO Case No. D2008-0243.[32]

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[32] See the discussion of this decision in Lindsay, ***International Domain Name Law ICANN and the UDRP,*** Oxford and Portland, Oregon, 2007, pp220-221.

But these successes should not lead to the conclusion that a businessperson will always succeed in establishing a common law trademark. For example, it was not so in a case the year after ***Rattner's Case*** that concerned the Canadian media mogul and philanthropist Israel Asper. The case was ***Israel Harold Asper v. Communication X Inc.***,WIPO Case No. D2001-0540 where it was held that although Mr Asper was well known and had done good charitable works, his name itself had not been associated with trade and commerce and consequently had not established any trademark rights.

Nor was it so the case of his son, Leonard Asper in ***Leonard Asper in Leonard Asper v. Communication X Inc.***, WIPO Case No. D2001-0539 who also failed in a claim. In that case, there was no evidence that the Complainant had ever used his personal name for the purpose of merchandising or other commercial promotion of goods or services, or that he intended to do so.

Thus, the panel said:

> "This Panel is not able to find that the Complainant, Leonard Asper, is entitled to a finding that he has rights in a trademark or service mark of such nature as to successfully challenge a Domain Name which is identical or confusingly similar. There is an additional basis for this beyond the interpretation of the Policy and Rules as set out above. It is the view of this Panel that the appropriate date of making any such finding, were this Panel to feel entitled to do so, would be the date of the registration of the Domain Names in question. Were it otherwise, any Complainant who anytime subsequent to the registration of the Domain Names, having achieved the necessary recognition in question, could seek a transfer or cancellation of a Domain Name. In any event, it is difficult for this Panel to find that at this stage of his career, Leonard Asper has the same level of notoriety as that of his father. In saying this, the Panel wishes to make it abundantly clear that this is not meant in any way to deprecate the achievements of the Complainant in this case as an officer or member of the Board of CanWest Global Communications. These are not the issue here."

The other side of the coin in the case of business enterprises, as in the case of some individuals, is that sometimes decisions are made in favour of there being a common law trademark when some might say the evidence was not

strong enough. One such example is ***Film Council v. Boolean Consulting Limited***, eResolution Case Number: AF-0503. The Panel said:

> "The Panel is of the opinion that, notwithstanding the relatively short span in time which passed between the incorporation of the Complainant and the registration of the Domain name by the Respondent, the prior incorporation of the Complainant under the name FILM COUNCIL combined with the broad press coverage in the United Kingdom, both prior to the incorporation and following incorporation during advertising for the position of chief executive and subsequently following his appointment, are sufficient to vest a right in the mark FILM COUNCIL in the Complainant. Furthermore, the fact that the sectors in which the Parties' businesses are engaged is the same, only supports the appropriateness of this finding."

These problems of the evidentiary standard that must be reached have come into particularly sharp focus in the case of businessmen, as the examples just mentioned have already shown. Can they also establish common law trademarks in their own personal name? Can they do so in particular when their fame may be due not so much to themselves but to the fact that they are associated with a company name?

Sometimes, of course, the businessperson can make out the case of common law trademark rights in his own name, as we have seen. A further example of success is ***Barry Diller v. INTERNETCO CORP***, WIPO Case No. D2000-1734. Mr. Diller, the media mogul had no trouble establishing common law rights in his own name, although his claim to fame was his ownership of the media companies and his role as an office bearer of those companies. The panel was able to conclude that:

> "The Complainant is claiming common law servicemark rights in his own name which he contends is widely known to the American public as an unusually successful and knowledgeable business executive and investor."

They were linked to a pornographic sites and thinly veiled offers to sell had been made, so he succeeded in the whole case.

In ***UBS AG v. has book publishers, Inc.***, WIPO Cases No. D2001-0637 and D2001-0639 there were two domain names <ubs-privatebanking.com>

(D2001-0637) and <marcelospel.com> (D2001-0639). Mr Ospel was the Chairman and the former CEO of the Bank. The websites were used to air allegations of money laundering and corruption by the Bank for which it was said Mr Ospel was responsible. The Bank had registered trademarks on UBS and similar and the panel found that the first domain name was confusingly similar to those marks.

But could the only Complainant, the Bank, complain about the domain name in Mr Ospel's name? The answer was given in these terms:

> "Complaints about misuse of a famous name in a domain name should be made by the person whose name is being so used. However, Mr. Ospel is not the Complainant in D2001-0639. There have been complaints in other cases from famous persons who have alleged that a domain name is identical or confusingly similar to their own name. The Policy requires the domain name to be identical or confusingly similar to a mark in which the Complainant has rights. Normally this requirement refers to a registered trade or service mark where the Complainant is registrant or licensee. The situation is more difficult where there is reliance by a Complainant upon an unregistered or 'common law' mark.
>
> The Complainant in D2001-0639 makes no reference to any assignment by Mr. Ospel of any rights over his personal 'mark' that relate to his personal reputation and fame as distinct from the Complainant's. Because he was the CEO and now President of the Complainant, it might be argued in terms of paragraph 4(a)(i) of the Policy that the Complainant has rights in the common law mark created by Mr. Ospel's international reputation. However, in the Panel's view, so to argue would be stretching the words of the Policy.
>
> The fact that someone else has registered a similar domain name (i.e. <marcel-ospel>) without challenge from the Complainant or Mr. Ospel is immaterial in this present context. The Panel is confined to the facts of the present case.
>
> There is nothing to stop Mr. Ospel in his own name making a Complaint against the present Respondent that would have to be dealt with on the evidence. Consequently the Panel cannot find that in

> respect of the domain name <marcelospel.com>, the first criterion has been proved."

Similarly, where there is a common law trademark claimed by an individual and he is deceased, his widow cannot make a complaint based on a claim that she has inherited the common law trademark, just as in ***Einstein's case*** there was no evidence that this had been done by Einstein's will. So in the absence of evidence of the proper law and/or of the businessman's will, the panel will not assume that the widow may bring the complaint. But a company he founded may bring the complaint, if the panel finds that it has a common law trademark in the individual's name, as it did in ***Wal-Mart Stores, Inc. and Mrs. Helen Walton v. Bestinfo/David Webb***, WIPO Case No. D2005-0086, because it had used the name SAM WALTON in its trade.

Another case where business people failed on this issue was in ***Estee Lauder, Inc. v. Jeremy Stamper d/b/a Pon***,WIPO Case No. D2003-0036.In that case the company had registered trademarks in both Estee Lauder and Lauder. The disputed domain names at issue were <ronaldlauder.com> and <ronaldlauder.org>.

The panel held that the domain names were not confusingly similar to the Estee Lauder trademark because, as it was said:

> " Even though they share the "Lauder" family name, the different first names clearly refer to two different persons, and Internet users viewing the domain names are therefore unlikely to believe that the Complainant is associated with them."

Nor were the domain names confusingly similar to the Lauder mark. As the panel said:

> "The Complainant also contends the disputed domain names are confusingly similar to the Complainant's "Lauder" mark, which is based on the family name of Estee Lauder. The Complainant makes a number of arguments to support this contention. First, the Complainant argues confusing similarity because of the family affiliation between Ronald Lauder and the company Estee Lauder. The Complainant offers no legal authority for this contention and the Panel does not find it convincing. To be sure, there is affiliation between a son, Ronald Lauder, working for a company, Estee Lauder,

> Inc., that was founded by his mother, Estee Lauder. But, in the Panel's view, this affiliation is not likely to confuse anyone into believing that there is a relationship between Complainant and the disputed domain names.
>
> Next, the Complainant argues that Ronald is a generic word added to the famous Lauder mark. The Complainant cites a number of UDRP cases but they are not apposite because the first name "Ronald" certainly is not a generic term (cf. "Microsoft Home" being found confusingly similar to the mark "Microsoft" in Microsoft Corporation v. StepWeb, WIPO Case No. D2000-1500 (January 19, 2001))".

Thus the panel concluded:

> "The Panel finds the disputed domain names, <ronaldlauder.com> and <ronaldlauder.org>, are not confusingly similar to the Complainant's marks "Estee Lauder" and "Lauder". Thus, the Complainant has not carried its burden of proof under the Policy at paragraph 4(a)(i)."

But business people can succeed, on appropriate evidence, as did Philip Berber in ***Philip Berber v. Karl Flanagan and KP Enterprises***, WIPO Case No. D2000-0661. He had received worldwide publicity when the online trading brokerage firm that he founded was sold to Charles Schwab & Co. for $488 million.

He established common law rights in his name because, as the panel put it:

> "The Complainant is a well known businessman. The press reports surrounding the success of his business show that he has a significant reputation in the field of electronic trading of stocks over the Internet. Were anyone to try to set up an electronic stock trading business or to offer software related to this field no doubt Mr Berber would have an arguable case in passing off.
>
> To this extent he can be said to have common law rights in his name."

A recent decision, moreover in a defended case, shows again that on proper evidence, it is possible to establish common law trademark rights: ***Gaetano, Inc. d/b/a Lisa Curran Swim v. Texas International Property Associates***, WIPO Case No. D2007-1428.

Cases concerning business people that have been lost

It should not be surprising, however, that business people have also lost such claims.

Thus, in ***Joacim Bruus-Jensen v. John Adamsen,*** WIPO Case No. D2004-0458, the complainant owned some Danish investment companies and it was sought to be shown that he had common law trademark rights in his own name. The panel rejected this argument on the ground that the evidence to support such a claim had not been adduced. Thus, it said:

> "In Ahmanson Land Company v. Save Open Space and Electronic Imaging Systems, WIPO Case No. D2000-0858 and Ahmanson Land Company v. Vince Curtis, WIPO Case No. D2000-0859, the Panels found that trade names or marks that have, through usage, become distinctive of the users' goods or services in commerce may be protectable as they have acquired a "secondary meaning." In the former case, it said: "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."
>
> This is not the case here. There is no information available to the Panel that the Complainant has acquired such a secondary meaning in his personal name as a reference to a particular source or organization. This is not the case here. There is no information available to the Panel that the Complainant has acquired such a secondary meaning in his personal name as a reference to a particular source or organization."

David Pecker v. Mr. Ferris, WIPO Case No. D2006-1514 is a recent and instructive case on the dangers and pitfalls in these proceedings. Mr David Pecker was and is Chairman and CEO of American Media, Inc (AMI). a magazine publisher. One can readily understand Mr Pecker's concern about not only having his name used as domain name but the website that the malefactors decided to establish because of the association between his name and certain blandishments But he failed to establish common law rights because of the lack of evidence. This was a clear case where the

complainant's advisers failed to understand the difference between making an assertion and adducing evidence to prove the assertion. The complainant's advisers had asserted that he had a common law mark, but adduced no evidence to that effect and in particular none of the exhibit material that must have been available.

The Complaint had asserted that the Complainant was Chairman and CEO of American Media, Inc (AMI). a magazine publisher and had submitted that his "name is used to promote AMI and the public understands his name as referring to AMI". But as the panel said:

> "In any event, other than the broad assertions and affidavit cited above, "the Complainant has made little effort to convince the Panel that it has common law trademark rights in the disputed domain name". Gene Edwards v. David Miller, WIPO Case No. D2003-0339. For example, the Complaint does not provide any exhibits showing Complainant's use of the name as a trademark. Nor has Complainant provided any evidence other than the cited statements that the name is being used for trade or commerce."

Mr Pecker was therefore unsuccessful, a very bad result for someone of his prominence.

Another case where common law trademark rights could not be established was ***Marvin Lundy and Law Offices of Marvin Lundy, LLP v. Scott E. Idmaond (Scott E. Diamond),*** WIPO Case No. D2001-1327. He was a lawyer who claimed to be famous in his city, but the Respondent denied this and, as there was no sufficient evidence put forward to verify it, the complainant lost.

In at least one extreme case, the panel found that the complainant had common law rights after expressly finding there was no evidence from the complainant to that effect, but that the panel could so conclude on the evidence of the respondent: ***Geert Hofstede v. Sigma Two***,WIPO Case No. D2003-0646.The basis for this approach was that the Complainant claimed to be and the Respondent affirmed that he was, a distinguished, international, academic scholar.

A more recent loss was that suffered by Birgit Rausing, one of the Rausing (Tetra Pak) family who was also an author. The case is ***Birgit Rausing, AB***

Tetra Pak v. Darren Morgan, WIPO Case No. D2008-0212. The panel held that it was not enough for the individual to have written three books and apparently felt that the complainant would have to have written more than three books and to have acquired real fame as a result, not simply being a famous person who had written three books. The panel imposed what some might regard a stringent test in saying:

> "Even accepting this (*having written three books*) as evidence of the first Complainant's authorship of such books, and use of the name "Birgit Rausing" in trade or commerce, it does not show for example that the first Complainant has sold a significant number of books, or that a substantial investment of time and resources has been made in the marketing of such books, or that the Complainant's books themselves are famous. In sum, it does not, on balance, establish that the name "Birgit Rausing" has acquired a significant measure of distinctiveness or secondary meaning in connection with her work as an author. All of these things may be so, but the burden of proof in a proceeding under the Policy falls squarely on the Complainant, particularly so in cases of claimed unregistered trademark rights in a name."

It will be recalled that the ***Hillary Clinton Case*** was won on the ground that she had written books for which she had been paid, but it would not seem that the panellist in the ***Hillary Clinton Case*** would have adopted the notion that there was a sliding scale and that only in the upper echelons of authors, based on the number of books they had written, were there to be found those who had established common law trademark rights in their own names.

When trademark rights must exist

Trademark rights must exist at the time of making the complaint taken to mean at the time of filing of the complaint: ***R. E. 'Ted' Turner and Ted Turner Film Properties, LLC v. Mazen Fahmi,*** WIPO Case No. D2002-0251.

The general analysis based on this and similar decisions has been criticised in ***Bruce Springsteen -v- Jeff Burgar and Bruce Springsteen Club*** WIPO Case No. D2000-1532.

It was said that there was nothing misleading about connecting the domain name to the 'celebrities. .1000 site', which the Respondent had done. Celebrities like Springsteen, it was said, would expect to be mentioned on such a site. The panel said:

> '…the users of the internet do not expect all sites bearing the name of celebrities or famous historical figures or politicians, to be authorised or in some way connected with the figure themselves. The internet is an instrument for purveying information, comment, and opinion on a wide range of issues and topics. It is a valuable source of information in many fields, and any attempt to curtail its use should be strongly discouraged. Users fully expect domain names incorporating the names of well-known figures in any walk of life to exist independently of any connection with the figure themselves, but having been placed there by admirers or critics as the case may be'.

But this is not, however, the majority view being expounded by UDRP panellists today and several of them have said so.

Conclusion on common law trademarks

The current position on common law trademarks, then, is that a complainant may establish unregistered trademark rights based on an individual name and succeed in the claim on that basis. But the facts are very important, as is the evidence adduced in support of them and will determine the outcome of any given case.

The further requirement: Confusingly similar

It should also not be forgotten that even if a common law trademark has been established, the celebrity must still show that the domain name he is complaining about is identical or confusing similar to the trademark he has established.

A salutary reminder that this may not always succeed is ***Donald J. Trump and Trump Hotel & Casino Resorts, Inc. v. olegevtushenko a/k/a Oleg Evtushenko***, NAF, Claim Number: FA0110000101509. In that case it was held that the domain name <porntrumps.com> was not confusingly similar to the TRUMP trademark because readers would not associate it with

Donald Trump, but with the notion that pornography succeeds or is paramount, i.e. trumps in the card playing sense.

Mr. Trump was the source of a similar failure in ***Donald J. Trump v. eStore of New York***,WIPO Case No. D2007-0119, where the domain name was <trumpfurniture.com>. It was held that the domain name was not confusingly similar to the trademark TRUMP as furniture would not necessarily be assumed to be one of his business activities and the word 'trump' itself would not necessarily be taken to refer to Mr. Trump; it had other meanings such as its use in card games and exclamations, in the same way that 'Sting' does not necessarily refer to the entertainer, but could be taken to refer to a bee sting or the ambush of a criminal enterprise.

A more recent case shows the difficulty that may arise in convincing a panelist that a domain name is confusingly similar to a trademark, a case we have already noted: ***Birgit Rausing, AB Tetra Pak v. Darren Morgan***, WIPO Case No. D2008-0212.

The panel held that there was no confusing similarity between the domain name <birgitrausing.com> and the registered trademark RAUSING (Ms Rausing had not established common law trademark rights in her name, but the company had a registered trademark in RAUSING) as the viewer may not think the domain name was referring to the trademark, but rather that it was referring to the individual, Ms Rausing, who was famous in her own right.

In many cases, however, celebrities will be able to prove to the satisfaction of the panelist that the domain name is confusingly similar to the trademark; this will be so because it was the intention of the person who registered the domain name that it would confuse people into thinking that the domain name was 'official' or was referring to the celebrity or his trademark. For example, it was probably no co-incidence in ***Gaetano, Inc. d/b/a Lisa Curran Swim v. Texas International Property Associates***, WIPOCase No. D2007-1428 that the Respondent made a slight difference in spelling the name of Lisa Curran when registering the domain name <lisacurren.com> and <lisacurrenswim.com>.

The panel had no difficulty in finding confusing similarity and in saying:

> "The disputed domain names <lisacurren.com> and <lisacurrenswim.com> differ from Complainant's Marks by only one letter. The disputed domain names are virtually identical and confusingly similar to Complainant's Marks. But for the typographical error of one letter in each of the domain names, the domain names are identical to Complainant's Marks."

There are also in the case of celebrities, cases where there is confusing similarity between the domain name and the trademark, even where the domain name contains an additional word. Thus, in ***Startrek Paramount Pictures Corporation v. Buy This Domain aka Domains Best Domains***, WIPO Case No. D2003-0058, it was held that adding to the STARTREK trademark the word 'armada', did not prevent <startrekamada.com> from being confusing similar to STARTREK. That is so because people associate the notion of the armada with the Startrek series and would assume that the 'startrek' in <startrekamada.com> was the same as the 'startrek' of the trademark. As the panel said:

> " Appending the phrase "armada" or "armada2" to the mark does not signify a different field of use, unlike appending the phrase "travel" to the mark "CITI," which is best known in conjunction with financial services.

Another example of the same principle is to be found in a ***Rolling Stones Case, Musidor B.V. v. Phil K.,*** NAF Case: FA0602000648140 where the addition of the word 'concerts' to the trademark THE STONES and dropping the 'THE", to make<stonesconcerts.com>, which the panelist referred to as having 'an obvious relationship to Complainant's business activities', did not prevent a finding of confusing similarity.

A similar situation with a similar result arose in ***George Foreman Ventures LLC v. zinnia c/o Zinnia Gonzalez*** NAF Case: FA0599036 where the word 'enterprises' had been added to the trademark 'George Foreman'. The panel decided that there was still confusing similarity.

See, as another example of the same problem that the issue of confusing similarity can pose for complainants, in the context of the Australian country code '. com.au', ***WOW Audio Visual Superstores Pty Ltd v. Comonoz Pty Ltd***, WIPO Case No. DAU2007-0003.

Designating the Right Complainant

It probably goes without saying that care must be taken to ensure that the right party is designated as the complainant and that that party is the one who is entitled to the common law trademark rights and entitled to take action to protect them.

One case where this could have been an issue was ***Gene Kelly Image Trust v. BWI Domain Manage***, WIPO Case No. D2008-0342 where it seems the panel found that a trust was the correct complainant, observing that:

> " The rights in this mark were transferred to the Complainant upon Gene Kelly's death in 1996 pursuant to the Declaration of Trust. The Panel therefore finds that the "Gene Kelly" name and trademark is still used substantially in trade to promote his performance services."

The Next step

Let us assume that our celebrity Complainant has established a registered or common law trademark, that the Complainant has rights in that trademark and that the domain name at issue is identical or confusingly similar to the trademark. We may then confidently expect that the panellist considering the claim will find that our celebrity has reached safe harbour on the first of the three elements that must be established under the UDRP to make out the claim.

But is now time to consider the second of those three elements.

Rights or legitimate interests.

A celebrity complainant in UDRP proceedings has to prove, like any other complainant, the remaining two elements under paragraph 4 of the Policy to succeed. The three elements that must be proven before a complainant can succeed are:

(i) The domain name is identical or confusingly similar to a trademark or service mark in which the Complainants have rights; and

(ii) The 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.

Thus, the celebrity must now prove the second element, that the party who registered the domain name has no rights or legitimate interests in it.

But by virtue of paragraph 4(c) of the Policy and by way of defence to the claim, it is open to a respondent to 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, who registered the domain name] 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 use of the expression, “among other circumstances” in the introductory words is important because it shows that the respondent, the party that registered the domain name and is now under challenge, is not confined to the three situations described in paragraph 4 (c) if he wants to defend the domain name. Respondents who want to bring themselves within one of those criteria, may do so, of course, but if they want to rely on other circumstances not mentioned in any of the three criteria, they may do that instead. Thus, if a respondent proves any of these elements or indeed anything else that shows it has a right or legitimate interest in the domain name, the complainant will have failed to discharge its onus to prove its case

and the complaint will fail.

But it is often difficult for the complainant to discharge that onus because it has to prove a negative, which may be well nigh impossible. If you think about it for a moment, all that the Complainant may know is that his or her name has been taken and used in a domain name. Apart from seeing who it is who registered the domain name, which may give rise to a few clues as to the basis on which the respondent registered the name and what claim he might have to it and perhaps looking at the website to which the domain name is linked[33], the complainant is in the dark and may know nothing of the claim that the registrant has to the domain name.

Accordingly the practice has been developed whereby it is said that the complainant must initially prove only a *prima facie* case that the respondent has no right or legitimate interest in the domain name, whereupon the onus moves to the respondent to rebut that *prima facie* case. If the respondent says nothing, the *prima facie* case will not have been rebutted and will have carried the day; the complainant will be taken to have proved the second element that the respondent has no right or legitimate interest in the domain name.

This is set out in paragraph 2.1 of the valuable **Overview of WIPO Panel Views on Selected UDRP Questions[34].**

Some examples

Sub-paragraph (i)

-bona fide offering of goods or services

Examples of the sort of case where a respondent has been successful under sub-paragraph (i) have been where the respondent, before the dispute, was using the domain name as an email address service for customers or where he connected it to a site which simply carried advertisements for a wide range of products. Those uses may, subject to all of the circumstances, be regarded as legitimate.

[33] Or 'to which it resolves', as it is put by those working in this field.
[34] See www.wipo.int and follow the links to the Overview.

If the respondent was doing the latter, but a suspicion arose that it was cashing in on the complainant's good name and trying to trade off that name by offering, for example, generic branded products, or by diverting hits to his own site, the panel would probably say that was not legitimate.

An example where the respondent succeeded on paragraph (c)(i) and thus was able to show that it had a right or legitimate interest in the domain name, was a case we have already looked at under the first element, ***The Hebrew University of Jerusalem v. Alberta Hot Rods,*** WIPO Case No. D2002-0616.

The domain name at issue was <alberteinstein.com>. Einstein had left literary works to the University. The domain name was linked to <celebrity1000.com> which was a legitimate commercial site with information about many celebrities.

The panel said:

> "Because Dr. Einstein died long before the advent of the Internet and was not in his lifetime engaged in the supply of goods or services under his name, this Panel finds that what Internauts are seeking when they enter the disputed domain name is information about Dr.Einstein. That is precisely what Respondent's site <celebrity1000.com> contains. Accordingly, it was not misleading for Respondent to select and use the disputed domain name to lead to that site nor, for the above reasons, does the use of the disputed domain name for this purpose tarnish Complainant's trademark.
>
> The Panel finds that, before notice to Respondent of this dispute, Respondent used the disputed domain name in connection with a bona fide offering of goods or services, within paragraph 4(c)(i) of the Policy…"

Sub-paragraph (ii)

-commonly known by the domain name

There are a few, but not many, examples of success by respondents who had

the foresight to register domain names in their own names and who were able to rely on under sub paragraph (ii) when their right to the domain name was challenged.

It must be borne in mind that what must be shown is that the holder of the domain name was *'commonly known'* by the domain name. Sometimes, respondents argue in their response that as they were the registered holder of the domain name, they were 'commonly known' by that name. That does not follow and is not a correct application of the Policy. If it were, it would have been completely pointless to include sub paragraph (ii) in the Policy. The respondent must go further than showing that he uses the domain name and must virtually show that it was his name or that it had come to be understood to be his name for all practical purposes.

The illustrations will make this clearer.

First, there is the lucky Mr. A. R. Mani in G***. A. Modefine S.A. v. A.R. Mani,*** WIPO Case No. D2001-0537 who was able to show that his name was in fact A. R. Mani and that, as he had included all of the letters of that name in the domain name, <armani.com> and no others, he came within sub paragraph (ii). The panelist accepted this argument and the decision was probably correct.

Then there was the equally lucky Maggi family, in ***Societe des Produits Nestle S.A. v. Pro Fiducia Treuhand AG***, WIPO Case No. D2001-0916.whose name was naturally coveted by the Nestle Company. The family was able to show that their name was Maggi and that they had included that name and only the letters making up that name in their domain name <maggi.com>. Like Mr. Amani, they were successful.

Looking at the current websites, it seems that, after losing, both the Armani company and Nestle were obliged to buy the respective domain name.

Such cases are really a matter of fact to be decided one way or the other. The argument that the respondent was commonly known by the domain name was unsuccessful in ***Peter Frampton v. Frampton Enterprises, Inc.,*** WIPO Case No. D2002-0141, but successful in ***Weider Publications Inc. v. Don Ho Cha***, WIPO Case No.D2001-0105, the latter decision being significant as the domain name was <musclenfitness.com> and not a more regular given or family name.

Sub-paragraph (iii)

-making a legitimate noncommercial or fair use of the domain name

Cases arising under sub-paragraph (iii), where it must be proved that the domain name holder was making a legitimate non-commercial or fair use of the domain name, generate a lot of debate, particularly around the issue of free speech. Thus, if the domain name is a genuine "sucks" case where the domain name is being used for a strictly non-commercial criticism site, it may be concluded that this was a legitimate exercise of free speech. Again, if a registrant registers a domain name in the name of a celebrity, as we will see shortly and uses it to conduct a strictly non-commercial fan site, the panel may well say that such a use of the domain name gives rise to a legitimate interest in the domain name and the alleged transgressor may end up keeping the domain name.

One case where the respondent succeeded is the case just mentioned: ***The Hebrew University of Jerusalem v. Alberta Hot Rods,*** WIPO Case No. D2002-0616 where the panel also found that "…within paragraph 4(c)(iii) of the Policy, Respondent is making legitimate fair use of the disputed domain name, without intent for commercial gain misleadingly to divert consumers or to tarnish Complainant's French registered trademark ALBERT EINSTEIN." The basis on which the panel made that decision was that the <clebrity1000.com> site, to which hits on <alberteinstein.com> were directed, provided information on Albert Einstein, as people would expect to find. They would not expect references to particular commercial offerings, because Einstein was not known for them during his lifetime and, consequently, no one was mislead.

The panel also found that a right or legitimate interest was established within paragraph 4(c)(i) of the Policy, because the <celebrity1000.com> site had links to offerings of goods and services like < amazon.com>.

Accordingly, the decision seems to be saying that a case may be made out under paragraph 4(c)(iii), even although there is commercial activity on the website.

So, in celebrity cases, the celebrity will have to prove the same as in all other cases and the challenged holder of a celebrity domain name will have the

same defences and the same opportunity to show he has a right or legitimate interest in the domain name as the respondent in any other case. But it will get the same short shrift if its conduct negates any normally accepted notion of legitimacy; thus In ***A & F Trademark, Inc., Abercrombie & Fitch Stores, Inc., Abercrombie & Fitch Trading Co., Inc. v. Party Night, Inc.***,WIPO Case No. D2003-0172, it was held that linking the domain names of the celebrity outfitters Abercrombie & Fitch to pornography sites denied there being any right or legitimate interest in the domain names on the part of the registrant.

Nevertheless, some interesting and unique issues have arisen in the case of the celebrity domain names where these issues have come up for decision.

In so far as there is such a thing as an 'ordinary case' in this unique field of disputation, in the ordinary case where the respondent has taken the celebrity's name and used it in a domain name for blatantly improper purposes, like linking it to a pornography site or using it to sell all sorts of blandishments, the celebrity complainant should not have too much trouble in proving that his opponent has no right or legitimate interest in the domain name that has been registered.

Applying all of the above principles, the general test of what is required to show that the Respondent did not have a right or legitimate interest in the domain name was given in ***Richard Juzwin v. Glen Stephens Stamps,*** **NAF Case: FA0097690. (2001)**, a particularly clear case, where the Panel said:

> "Respondent uses the <richardjuzwin.com> domain name to resolve to its own competing website. It is firmly established that such a use does not constitute a bona fide offering of goods or services pursuant to Policy ¶ 4(c)(i). See, e.g., *Ticketmaster Corp. v. DiscoverNet, Inc.*, D2001-0252 (WIPO Apr. 9, 2001) (finding no bona fide use where Respondent generated commercial gain by intentionally and misleadingly diverting users away from the Complainant's site to a competing website); see also *North Coast Med., Inc. v. Allegro Med.*, FA 95541 (Nat. Arb. Forum Oct. 2, 2000) (finding no bona fide use where Respondent used the domain name to divert Internet users to its competing website).
>
> Respondent is not licensed or in any way authorized to use Complainant's RICHARD JUZWIN mark and is not commonly

> known by the <richardjuzwin.com> domain name. Moreover, Respondent is using Complainant's mark to offer competing goods and services, which does not constitute a legitimate non-commercial or fair use of the disputed domain name. Thus, Respondent does not have rights or legitimate interests under Policy ¶ 4(c)(ii) or (iii). …Therefore, the Panel finds that Policy ¶ 4(a)(ii) has been satisfied."

It is then up to the respondent to get together whatever evidence is available to measure up to these requirements of proof and to show a legitimate interest and it is for the complainant to show that what the respondent has been doing with the domain name is inappropriate and does not amount to a right or legitimate interest.

So, in some cases that have gone to decision, the complainant has made out the case on this second element, i.e. that the respondent who registered the domain name has not shown that he has a right or legitimate interest in it. But in other cases the respondent has been able to show a right or legitimate interest in the domain name and has succeeded.

We will look at some cases on each side of that divide. Some of them are clear illustrations of cases coming under one or the other of the sub-paragraphs referred to above. Some are cases where the panel has been influenced by a more general notion of right or legitimate interest, where the panel has been not so concerned to put the case under one or other of the sub-paragraphs, but to say whether the facts measure up to this general concept of right or legitimate interest.

Cases where the respondent has failed to prove a right or legitimate interest in the domain name against a celebrity

This has frequently happened in the case of celebrities where the respondent has clearly been anxious to make money from purloining a famous person's name. For example, In ***Nicole Kidman v. John Zuccarini, d/b/a Cupcake Party*** WIPO Case No. D2000-1415, the panel decided that the Respondent had no right or legitimate interest in <nicholekidman.com> or <nicolekidmannude.com>, partly because Nicole Kidman had made out a *prima facie* case, an application of the reversal of the onus of proof already mentioned and partly because of Mr Zuccerini's reputation as a cybersquatter. This is the more obvious type of case where the mere fact that a regular cybersquatter has registered a domain name in a celebrity's name

or adds " nude" or some other derogatory word after the name, calls out for some legitimate explanation, which would seem to be virtually impossible to provide.

Another example is ***Barry Diller v. INTERNETCO CORP***,WIPO Case No. D2000-1734. Barry Diller, the media mogul, had no trouble establishing common law rights in his own name, although his claim to fame was his ownership of the media companies and his role as an office bearer in them. The domain names were linked to a pornography sites and there had been thinly veiled offers by the respondent to sell them. So it was held that there was no right or legitimate interest that the respondent had in the domain names. The panel said on this issue:

> "The Respondent appears to be using the disputed domain name only to link to many other domain names that offer pay-per-view pornography while, at the same time, making overtures to sell or rent the name. As will be clear in the bad faith section, this cannot qualify as a legitimate right or interest under the Policy as it infringes the Complainant's common law mark rights in his own name."

Another and more recent case measured up, so far as the complainant was concerned, because of the obviously unprincipled conduct in which the respondent had engaged. That was the ***Kendra Todd Case*** *(supra)***.** The Respondent has used the website to display false information regarding Ms.Todd, a former business partner. In addition, he attempted to use the disputed domain name as leverage in attempting to collect money from her, after she had been successful on the Donald Trump apprenticeship program. He also attempted to sell the <kendratodd.com> domain name to Complainant. The Panel found that "these actions demonstrate that Respondent is not using the disputed domain name for either a bona fide offering of goods or services under Policy ¶ 4(c)(i) or a legitimate non-commercial or fair use under Policy ¶ 4(c)(iii)." One could not but agree.

Another celebrity case, which was undefended, shows how circumstances often arise where the lack of any plausible explanation for choosing as a domain name the name of a famous entertainer, almost guarantees a successful result for the celebrity complainant. That is ***Estate of Tupac Shakur v. Shakur Info Page*** NAF Case No: AF-0346, where the domain name was<tupacshakur.org>. The panel described the facts as follows:

> “Mr. Tupac Shakur, often known as 2Pac or Tupac, was an internationally known "Hip-Hop" musician, actor and poet, murdered in 1996 at the age of 25. His recordings have sold millions worldwide. Two of his albums, "Me Against the World" and "All Eyez on Me" opened at number one on the record charts. "All Eyez on Me" received quintuple platinum status. Since his death, his estate has released three albums, all of which opened in the top ten.
>
> As an actor, Mr. Shakur appeared in numerous large budget Hollywood features, including "Gang Related", "Gridlock'd" and "Poetic Justice". Mr. Shakur also released a book of poetry. He toured numerous times throughout the world prior to his death. There are approximately 1000 web sites on the Internet dedicated to Mr. Shakur.
>
> On January 9, 2000 the contested domain name was registered in the name of the respondent. The name does not resolve to an active web site. However, the respondent's registered email address, hiphopspot@hiphopspot.com provides an association between the respondent and the web site www.hiphopspot.com, which exploits Mr. Shakur's recordings by offering for sale "bootleg" and "unreleased" 2Pac CDs.”

Especially because of the suggestion of commercial exploitation, it would have required a monumental effort to show a right or legitimate interest in the domain name and the panellist negated any such result by saying:

> “Having regard to the unusual name Tupac Shakur, the undisputed reputation of that name in relation to Hip-Hop music and the respondent's active involvement in the supply of Hip-Hop music, notably the recordings of Mr Tupac Shakur, through the respondent's web site www.hiphopspot.com, the panel finds that the respondent had knowledge of the complainant's mark when choosing to register the contested domain name.
>
> The respondent has not been licensed or otherwise authorised by the complainant to use the complainant's trademark nor to register the contested domain name.

> The name Tupac Shakur is not one traders in the field of Hip-Hop music would legitimately choose unless seeking to create the impression of an association with the complainant.
>
> The respondent, despite actual notice of the complaint, has not proffered any response which could clothe with legitimacy its registration of the contested domain name.
>
> For these reasons the panel finds the complainant has discharged its burden of proving that the respondent has no rights or legitimate interests in the contested domain name."

In ***The Wiggles Touring Pty Ltd v. Thompson Media Pty Ltd,*** WIPO Case No. D2000-0124, the Australian Wiggles company had registered trademarks over The Wiggles and Henry The Octopus and the Respondent had registered<thewiggles.com> and <henrytheoctopus.com>. The panel quickly decided that the domain names were identical to the trademarks and then went on to find that the Respondent had no rights or legitimate interests in the domain names. That was so because the evidence was that it had registered the domain names with the intention of selling them. Indeed, the head of the Respondent company had said he made his living from selling domain names, so it was an easy case to decide.

But whether this element of right or legitimate interest is proved or not also raises some interesting questions and fact situations in the celebrity context.

Thus, in the ***Madonna* case**, the Respondent who registered the domain name Madonna and who for a time used it for an explicit sex site, argued that he had a right or legitimate interest in the domain name for several reasons. One of the reasons he advanced was that, before he was notified of the dispute, he was using the name in connection with a *bona fide* offering of goods and services, namely running his adult entertainment site.

The panel that decided the case found that he had been using it for this purpose, but it was concerned by the fact that he had used the name Madonna to do it.

As the Panel said:

> '…, Respondent has failed to provide a reasonable explanation for the selection of Madonna as a domain name. Although the word "Madonna" has an ordinary dictionary meaning not associated with Complainant, nothing in the record supports a conclusion that Respondent adopted and used the term "Madonna" in good faith based on its ordinary dictionary meaning. We find instead that name was selected and used by Respondent with the intent to attract for commercial gain Internet users to Respondent's web site by trading on the fame of Complainant's mark. ***We see no other plausible explanation for Respondent's conduct*** and conclude that use which intentionally trades on the fame of another can not constitute a "bona fide" offering of goods or services. To conclude otherwise would mean that a Respondent could rely on intentional infringement to demonstrate a legitimate interest, an interpretation that is obviously contrary to the intent of the Policy.'(emphasis added).

The Panel was thus using a test that is often used in UDRP proceedings, which of course are not trials and where the panel does not have a chance to look the parties or witnesses in the eye and hear what they say under cross-examination. Because of that limitation, panels in UDRP proceedings often ask questions like: 'why did the Respondent choose this particular name over all other names that it could have chosen' and 'is there a legitimate reason why a party would have chosen this particular name?'

In this case, not only had the Respondent given a reason for registering the name, but it was reasonably clear that he had chosen the name Madonna to trade off the name of the famous entertainer and such conduct could scarcely be described as *bona fide.*

The Monty Roberts Case

Another case where it was held that the Respondent who had registered the domain name did not have a right or legitimate interest in the domain name was***' The Horse Whisperer' case*: *Monty and Pat Roberts, Inc. v. Bill Keith,*** WIPO Case No. D2000-0299.

Monty Roberts had been able to register < montyroberts.com> himself and use it for his website; so he already had one domain name. He was now challenging Bill Keith who had registered the domain name <montyroberts.net>.

This decision is important because it raises the significant issue of free speech on the internet, which of course has always been advocated as being one of the great virtues of the internet. In a nutshell, the respondent Mr. Keith claimed as one of his grounds for having a right or legitimate interest in the domain name that he had been using it not for commercial purposes, but to stimulate debate and discussion or what is referred to in the ICANN Policy as 'legitimate non-commercial or fair use purposes'.

Thus he said:

> "The website montyroberts.net is engaged ***solely in the dissemination of legitimate news-worthy information about Monty Roberts and his horse training techniques from various sources***, including the press and people who know him personally or have come to know his techniques and ***dispute their validity***." (Response, para. 8(a)) [emphasis added]
>
> "The fact that Complainant and his lawyers are trying to sway the proceedings with information about Monty Roberts' wealth and presumed stature by stating that he has won horse related championships 50 and 60 years ago and is an author of a book is entirely superfluous to the ***legitimate use of the montyroberts.net website to disseminate information about his perpetrating a fraud on the public***." (Id., para. 8(b)). [emphasis added]

He was thus relying on a free speech defence, which often comes up in domain name cases, especially where there is a United States context or there are US arbitrators deciding the case.

The New York Times principle

The Panel accepted the importance of free speech on the internet, but ruled against it as being a defence in this case. Note therefore, before we go on, that this is a finding that, in an appropriate case, the exercise of free speech may give rise to a legitimate interest in the domain name and defeat the celebrity's claim to the domain name. But the present case was not such a case, the panel found, because:

> "...Respondent has impermissibly taken advantage of the Complainant's commercial interests in the mark."

The Panel then delivered itself of what has become one of the most prominent of observations by a panellist since the ICANN arbitration process began. It said:

> "However, the right to express one's views is not the same as the right to use another's name to identify one's self as the source of those views. One may be perfectly free to express his or her views about the quality or characteristics of the reporting of the New York Times or Time Magazine. That does not, however, translate into a right to identify one's self as the New York Times or Time Magazine."

Applying that principle to the present case the panel said:

> "In the instant case, Respondent is using as its identifier the domain name "montyroberts.net". When an Internet user searches for Complainant's mark, it will find Respondent's website address. 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. By using Complainant's mark, Respondent diverts Internet traffic to its own site, thereby potentially depriving Complainant of visits by Internet users.
>
> The fact that Respondent's primary motive for establishing its site may be to criticize Complainant does not insulate Respondent from the fact that it is directly and indirectly offering products for sale on its website, or at websites hyperlinked to its site.
>
> In the instant case, the Panel does not dispute Respondent's right to establish and maintain a website critical of Complainant (without prejudice to any claims Complainant may have regarding the truthfulness and intent of such criticism). ***However, the panel does not consider that this gives Respondent the right to identify itself as Complainant***. Respondent is using Complainant's famous mark to attract Internet users to its own website. Upon reaching Complainant's audience, Respondent then directs users to a site where a book may be purchased, a site where t-shirts and other items may be purchased, and

> to sites of persons who compete in the same channels of trade as Complainant (that is, other noted horse trainers).
>
> The Panel concludes that Respondent has not established a legitimate non-commercial or fair use of Complainant's mark. Consequently, Complainant has established the second element necessary to succeed on a claim of abusive domain name registration." (emphasis added).

The New York Times argument has become a major issue of disputation in UDRP arbitration. A form of the same argument was used in the ***Leonard Asper Case***, ***Leonard Asper v. Communication X Inc.,*** WIPO Case No. D2001-0539, although the result was not that the celebrity, Mr.Asper, won, as you would expect, as he was able to disprove the right or legitimate interest defence; rather, the result was that the celebrity lost as he had been unable to prove the first element, namely that he had a common law trademark in his own name. But on the issue of the right or legitimate interest that the domain name registrant might have had in the domain name, the panel described the facts and its conclusion on this issue as follows:

> "…
>
> The Respondent says that his possession of the three Domain Names involving the Complainant is integral for it to maintain both the artistic merit and the purely satirical nature of a web site created by him entitled Who Wants To Be A Canadian Media Baron. The site, he says, "was designed in response to the both the popularity of the program WHO WANT TO BE A MILLIONAIRE [sic], and the public outcry over Canadian media mergers and acquisitions, particularly those of the complainants." The site was operated as a game with people answering a question "Who Wants to Be A Canadian Media Baron" with the options including the Complainant in this case. This site is not now available, says the Respondent, due to the fact that the Domain registrar required that it be disabled, although a screen shot of one of the frames from the multimedia project is annexed to the Response. A copy of the communications from the registrar to this effect is not provided.
>
> Previous Panel decisions have held that it is not appropriate to use the name of the entity whom one wishes to criticize on the basis of "fair use" to divert Internet traffic to the site. See the Monty Roberts case,

> above, along with *Compagnie de Saint Gobain v. Com-Union Corp,* WIPO Case No. D2000-0020 and *Ahmanson Land Company v. Save Open Space and Electronic Imaging Systems*, WIPO Case No. D2000-0858."

Accordingly, the panel found that the respondent had no right or legitimate interest in the domain name.

Another failure to make out rights or legitimate interests, i.e. where the celebrity complainant succeeded, was ***Fondation Le Corbusier v. Mercado M.***, WIPO Case No. D2004-0723. The respondent argued that there was a right or legitimate interest in the domain name because the website was a fan site and using a domain name for a fan site was legitimate. The trouble with the argument and what militated against a finding that it was legitimate, was that the site was made to look as if it were the official Le Corbusier site and there were also some commercial links attached to it. It was therefore not a pure fan site.

Likewise, in the case of the Slovenian female motorcyclist ***Bernardka Pulko v. Greg Frazier***, WIPO Case No.D2006-0099, the respondent failed to show a right or legitimate interest in the four domain names at issue, all of which incorporated Ms.Pulko's name. Here again, as in the ***Monty Roberts Case*** it was really because the domain name incorporated the trademark owner's name that was determinative.

The website of the domain name <benkapulko.com> led to a commercial website which was a portal and included links to web pages where motorcycle products could be ordered, whereas the other domain names went to the home page of Google.

The question was whether the commercial activity on the web site was legitimate ? The case in interesting for that purpose. The answer was, as the panel put it:

> "The Panel finds that these activities do not make the use of the domain names legitimate. "Legitimacy" presupposes that there must be some justification in the choice or adoption of the domain names, in the present case, such a justification seems lacking. …

> All four domain names at issue represent the personal name which Complainant uses, and by which she is known to the global public. The domain names at issue were previously registered by Complainant. The <benkapulko.com> domain name was also used on the cover of Complainant's published and awarded book "Around the World Following the Sun".
>
> ***All four domain names also represent Complainant's registered mark. In this situation it cannot be legitimate for Respondent to use the domain names without permission from Complainant.***
>
> ***All four domain names give, because of the strong similarity to Complainant's name and mark, the false impression of being associated with Complainant. Due to this there is potential for customers and for the public to be misleadingly diverted."*** (emphasis added).

Where the Respondent does not defend the proceedings

It often turns out that the respondent does not reply to the Complaint, which enables the panel to say that the respondent had an opportunity to say what his right or legitimate interest was and yet he failed to respond.

Indeed, Rule 14(b) provides in effect that in the case of such a default, the panel may draw "appropriate" inferences[35]. Panellists who decide these case often rely on the default of the Respondent to conclude that there was no right or legitimate interest, for if there were one it would have been easy enough for the Respondent to say what it was.

This was the case in ***Dr Roger Libby v. Tunga Tuzlaci and/or Tumay Asena Case No. D2001-1342*** where the sex therapist Dr Roger Libby had let his domain name expire and the fleet of foot respondent who quickly registered it asked for an offer to sell it back to him.

The panel was able to say:

> "The Panel can think of no reason why the Respondent might reasonably claim to have rights or legitimate interests in respect of the

[35] Rules for Uniform Domain Name Dispute Resolution Policy

> Domain Name and finds that the Respondent has no rights or legitimate interests in respect of the Domain Name."

The need for evidence

It must be remembered, however, that the Complainant's case must be proved. It is not sufficient to make assertions, unverified by evidence, as was done in the case concerning the pornography star Sylvie Saint: ***Silvie Tomčalová a.k.a. Sylvia Saint v. Juan Campos,*** WIPO Case No. D2006-0379. In that case the panel found that the complainant had failed to show lack of right or legitimate interest by simply making an assertion to that effect. The panel responded to this assertion by saying:

> " …, this is not a case where the Disputed Domain is not being used. Indeed, the Complainant positively maintains in the context of her submissions as to bad faith that the Disputed Domain links to a "third party web site" that "competes" with the Complainant. It would not have been difficult for the Complainant to go on and at the very least explain the nature of that "competing" use from which conclusions as to legitimate rights and interests could sensibly be drawn. However, …no further information is given. It may well be that the Complainant is right when she asserts that this site does not involve a bona fide offering of goods or services. However, without further explanation as to why this is the case, this is essentially little more than an assertion that we are left to take on trust. The Panel does not think that this is sufficient."

Another case where assertions were held to be not enough, in this case assertions by the respondent that he had a right or legitimate interest, was ***Glory Establishment v. FutbolMasters Ltd., FW, FM, Steve Leighton***, WIPO Case No. D2007-0439 concerning the footballer Pele. The panel gave the respondent a second chance to produce documentary evidence which would have existed if what the respondent had said was true, namely a letter from Pele supporting him. But the respondent did not produce any evidence to that effect. The panel therefore concluded:

> "In the face of Pele's letter and in the absence of any explanation from the Respondent, the Panel has little alternative but to infer for present purposes that the Respondent's claims as to rights and legitimate interests in respect of the Domain Names are groundless."

So, a panel can and will make findings of fact in the way that a court will make them, if necessary by drawing inferences from the failure of a party to produce evidence, especially when the tribunal says that it wants that evidence. That was the process followed by the panel in ***Pele's Case*** to conclude that the respondent did not have a right or legitimate interest in the domain names.

The panel went through a similar process when it came to bad faith.

Cases where the respondent has succeeded in proving a right or legitimate interest in the domain name

The cases we have been considering were cases where the respondent who has registered the domain name has not been able to establish that he has a right or legitimate interest in the domain name. Sometimes, however, a complainant will fail to establish the second element, i.e. the respondent who registered the domain name will prove that it did have a right or legitimate interest in the domain name and the Complainant trademark owner will fail. In other words, some celebrity claimants lose when trying to establish that the Respondent has no right or legitimate interest in the domain name.

One such case is ***Louis Vuitton Malletier S.A. v. Manifest Information Services c/o Manifest Hostmaster*** NAF Case No. FA0609000796276. The high-end fashion luggage retailer Louis Vuitton Malletier filed a complaint against Manifest Information Services, the registered owner of the domain name <lv.com>.

In its defence, the respondent drew attention to the website to which the domain name resolved, namely www.lv.com. It was by then a blank page, but in the past it had been used as a directory of Las Vegas services and businesses. The respondent argued that it was this prior use to which it had put the domain name that gave it a right or legitimate interest.

The Panel agreed and found that the respondent owner of the <lv.com> domain name had a legitimate interest that was constituted by its having been used in this way for a legitimate offering of goods and that that use had occurred before the dispute arose.

It is interesting to note the specific aspects of the evidence which influenced the panel and which lead to the conclusion that the case came within paragraph 4(c)(i);

> "Respondent contends that it used the disputed domain name in connection with a bona fide offering of goods or services because it previously used the disputed domain name to host a web portal for Las Vegas businesses. Respondent asserts that between 1995 and 2001, it hosted several Las Vegas businesses through various uses of the disputed domain name, and has included archive Internet screen shots as evidence of this assertion. This use, although not current, was prior to notice of the dispute. ...Respondent used the <lv.com> domain name for a significant period of time for business purposes. Respondent alleges that at all times his business was entirely unrelated to that carried on by Complainant. …Furthermore, the disputed domain name is comprised only of two letters, which in theory may stand for several different things…Consequently, on the basis of the evidence submitted, the Panel finds that the disputed domain name was initially used by Respondent in connection with a bona fide offering of goods or services in accord with Policy ¶ 4(c)(i)."

The panel also found that the respondent had not used the domain name in bad faith. No bad faith was shown for, although the domain name had been for sale, the panel said that this did not necessarily show an intention to acquire the domain name to sell it to the Complainant or a competitor. So the Respondent would also have won on that ground even if it had not won on the ground of its having a right or legitimate interest.

Although Louis Vuitton Malletier used the 'LV' initials as a trademark, it had thus failed to meet all three elements required under the ICANN policy to transfer the domain name.

This case ended a run of good luck by Louis Vuitton as it had won several other domain name cases: ***Louis Vuitton Malletier S.A. v. Salvia Corporation*** NAF Case No.: FA0600968; ***Louis Vuitton Malletier S.A. and Marc Jacobs Trademarks, L.L.C. v. Unasi Inc.***NAF Case No: FA0603008 and ***Louis Vuitton Malletier, S.A. v. L Lui***, NAF Case No.: FA0630912, concerning long strings of domain names based on misspellings and the charmingly, but appropriately named, domain name

<louisvuittonknockoff.com>. So by definition, in all of those cases it had shown that the respondent did not have a right or legitimate interest in the domain name in question.

Other cases where the respondent has been successful

But to return to those cases where the respondent has been able to make out a case for a right or legitimate interest in the domain name and thus defeat a complainant's case, another case where the respondent could show it had been using the domain name in business was ***Dr. Werner Kupper [Executor of the Estate of The late Herbert von Karajan and Eliette von Karajan v. Karajan Pty Ltd***, WIPO Case No. D2000-1578, concerning the estate of the later conductor Herbert Von Karajan. The claim failed because the domain name and business name had been taken up by the respondent and used in its business for several years before the complaint by von Karajan's estate was made. The panel put the argument so concisely that it is worthwhile setting it out in detail:

> "The first issue to be addressed is whether before July 2000 - when the Complainants first put the Respondent on notice - the Respondent was making bona fide use of the domain name in issue. On the evidence before it [as set out above] the Panel must conclude that the Respondent was trading legitimately under the domain name. Second, it would appear that the Respondent was commonly known by the domain name in issue. Third, there is no evidence to suggest that the Respondent's use of the domain name in issue is intended misleadingly to divert consumers or to tarnish the 2 marks in issue."

In ***Falwell's Case*** that we have seen in the context of unregistered trademarks, the celebrity complainant also failed because the respondent was able to show that he had a right or legitimate interest in the domain name. The ground that he was able to make out was that he had used the domain name to run a website that was a parody of Falwell. That argument was accepted.

Another successful case for a respondent concerning rights and legitimate interests and which has already been considered in the context of the common law trademark was the ***Sam Francis Case.*** The case was ***Frederick M. Nicholas, Administrator, The Sam Francis Estate v. Magidson Fine Art, Inc*** WIPO Case D2000-0673. The reader will recall that this was the

case where, unusually, there was a dissenting decision by the presiding panellist.

The Respondent had registered the domain name <samfrancis.com> and used it for the website of an art gallery that sold only Sam Francis paintings and a gallery that was commercial. However, equally importantly, it did not claim that it was Sam Francis' own website.

The Panel found that the name 'has acquired distinctiveness and secondary meaning as a common law trademark and service mark when associated with works of art.'

The Panel made the observation:

> "The existence of a common law trademark or service mark does not prohibit art collectors or the general public from referring to a piece as a "Sam Francis" work. The existence of a common law trademark or service mark does prohibit the use of the phrase "Sam Francis" in a manner denoting that a gallery or exhibition, whether physical or virtual, is sponsored or authorized by Sam Francis or his Estate."

The issue that the Panel then had to resolve was whether the Respondent art gallery had a right or legitimate interest in the domain name.

The Respondent claimed that it did and relied on paragraph 4(c) of the Policy which meant that it had to show that it was
"… making a legitimate non-commercial 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."

Thus it was claiming that it was making a fair use of the domain name under trademark law.The Panel accepted this argument in the following words:

> "Respondent admits that it had actual knowledge of the works and notoriety of Sam Francis as an artist before it registered or used the Domain Name. However, Respondent is using the name to describe the artist who painted the works it sells at the web site. As noted below, Respondent may have rights or a legitimate interest in the Domain Name, if it can be justified under the "fair use" principles of trademark law, ….

> …
> Respondent suggests that it has made fair use of the Domain Name and although admittedly attracting consumers in this manner, claims it has not done so in a misleading manner. The majority of the Panel finds that, because the Domain Name is identical to the SAM FRANCIS marks, there is some basis for concluding that Respondent has intentionally sought to attract consumers by using the SAM FRANCIS name in the website www.samfrancis.com; however, upon reaching it, Respondent has made clear that it is a commercial art gallery selling Sam Francis works. ***There is, therefore, no misleading assertion that it is sponsored or authorized by the artist.*** Similarly, the use does not tarnish the reputation of the artist, since it is presumably his paintings that are offered for sale here.
>
> The majority of the Panel believes that Respondent may have, under the principles of fair use or what is sometimes called a "nominative use" in the trademark law, a legitimate interest in the Domain Name pursuant to the Policy paragraph 4(a)(iii). Some of the panel members are concerned, however, that this conclusion not be construed to mean that every use of the artist's name to sell his or her works would be a fair use, ***so that this decision should be limited to the facts of this particular case where the Respondent gallery makes clear on the website that it is not the artist's site and that it is a commercial art gallery selling the works of this particular artist."***(emphasis added)

The dissenting panellist was certainly 'concerned' in the way indicated, but that is something of an understatement. On the issue of rights and legitimate interest he said:

> "Respondent suggests that it has made fair use of the Domain Name and although admittedly attracting consumers has not done so in a misleading manner. I would find that, because the Domain Name is identical to the SAM FRANCIS marks, ***Respondent has intentionally attracted consumers by creating the impression that the website www.samfrancis.com is sponsored or authorized by the artist...***(and accordingly had not shown a right or legitimate interest)."(emphasis added).

It is a matter for debate which of them is right on the proper interpretation of the website. In any event, this difference of opinion shows the importance,

once again, of adducing all of the evidence available and of addressing arguments in submissions to try to sway the tribunal on disputed points.

Interestingly, the issue in the ***Sam Francis Case*** arose again in ***Thomas Blackshear v. Christ-Centered Mall, Inc.***, WIPO Case No. D2002-0736, another case of a painter and his works. The panel found that the complainant, a religious painter, had established common law trademark rights in his own name, as he had been painting and selling for many years under that name. The domain name resolved to a website where the paintings of Mr. Blackshear were sold, but the paintings of other artists were also sold there. This led the panel to comment on the similarity between this case and the ***Sam Francis Case***, except that in the current case the website asserted it sold paintings of other painters as well as those of Mr.Blackshear. Accordingly,

> "Respondent is effectively using Complainant's trademark to sell not only those works (theoretically to Complainant's benefit) but also competing products (apparently not to Complainant's benefit and possibly to his detriment). As such, Respondent's actions constitute neither a "fair use" of the disputed domain name nor a "bona fide offering" of goods under that name."

The result was thus that the respondent had not made out a right or legitimate interest.

How the panel goes about its task

In fact, whether the Respondent succeeds in making out his right or legitimate interest in the domain name involves a fair amount of judgment by the panellist as to what constitutes legitimate conduct. This is very apparent when a panellist comes to consider the situation where there has undoubtedly been a commercial use of the domain name and it has taken place prior to the dispute being brought to the notice of the respondent, but where the question nevertheless remains whether that use was legitimate or not. The panellist has to make his own judgement on what is legitimate behaviour and what is not. It is always difficult for a court or tribunal to make value judgments of this sort and particularly so where, as in the case of UDRP proceedings, the case must be resolved on the papers and there is no opportunity to see or test the witnesses and thus obtain a full and detailed

understanding of the facts of the case. Let us look at an example of how that judgment is exercised.

For example, consider the decision in 2006 in the ***New York Yankees Partnership d/b/a The New York Yankees Baseball Club v. Covanta Corporation,*** NAF Case: FA0803277. The respondent used the domain name <nyyankees.com> to operate a website providing links to third-party commercial websites offering tickets to the professional sporting events of Complainant and merchandise bearing Complainant's NEW YORK YANKEES mark. This was clearly commercial, but was it legitimate?

Relying on ***Bank of Am. Corp. v. Nw. Free Cmty. Access***, FA 180704 (Nat. Arb. Forum Sept. 30, 2003) and ***TM Acquisition Corp. v. Sign Guards,*** FA 132439 (Nat. Arb. Forum Dec. 31, 2002), the panel found that this use was not *bona fide* under paragraph 4(c)(i) and not a legitimate non-commercial or fair use under paragraph 4(c)(iii) because it was misleading Internet users who were seeking tickets, merchandise, or information through Complainant's registered website when they were being induced to do so through the Respondent's website. Accordingly, the respondent had no rights or legitimate interest in the domain name, which also went to make out the third element of bad faith.

All of these cases depend on their own facts and of course the claims of the parties will be tested. We saw this in action in the ***Pele Case***, where the Respondent, who had registered the Pele domain names and allegedly without Pele's consent, said that he was actually a friend of Pele's and that he had a letter from Pele supporting the claim that he had registered the domain names "…at Pele's request and for his personal use as part of the United Nations charitable programme with which … Pele …(was) associated." The panellist who decided the case called the respondent's bluff and made on order inviting the Respondent to produce this letter. No such letter was forthcoming and the Panel was then able to decide that the Respondent had no right or legitimate interest in the domain names.

Another case where the respondent was tested and found wanting is ***Lewis Black v. Burke Advertising, LLC***, WIPO Case No. D2006-1128. Here the domain name <lewisblack.com> was registered, relating to the "national known entertainer, actor and author". The Respondent claimed that:

> "The domain lewisblack.com was registered on 5 January of 2000 as a brand name for one of our client's food products. Although the client has not yet launched the product we continued to register the domain each year and note on the website that it was the future home for the client's cheese product. Investments have been made for over six years to utilize the name."

The panel put the respondent to its test and issued an order requiring the respondent to provide evidence of this under pain of perjury, but nothing was forthcoming. The panel was therefore able to decide that there was no right or legitimate interest and also that the domain name had been registered and used in bad faith.

But, as we are presently illustrating, there are cases where the respondent on the facts can show a right or legitimate interest because of a *bona fide* offering of goods and services prior to notice of the dispute, as in ***Jenna Massoli p/k/a Jenna Jameson, Jennasis Entertainment, Inc., Club Jenna, Inc. v. Linq Entertainment, Inc.***, WIPO Case No. D2004-1042, (" Jenna More Than Just a porn star") where the panel described what had happened in the following way:

> "…the Respondent has made out a good case that before any notice of the dispute, it used the disputed domain name in connection with a bona fide offering of goods or services. …The credible uncontradicted evidence establishes that in 1998 there was at least a verbal agreement where the Respondent's predecessor-in-interest was given the right to market the website to which the disputed domain name resolved as the official Jenna Jameson website. Although that agreement fell apart, Respondent's predecessor-in-interest entered into a Service Agreement … wherein it obtained rights … to display various photographs and likelinesses of Complainant Jameson." The complainant's representative had also apparently acknowledged that the predecessor-in-interest owned the domain name."

These prior dealings with the complainant showed that the respondent had acquired the right to use the domain name and this was held by the panel as showing a *bona fide* offering of services and hence a right or legitimate interest in the domain name.

A respondent who cannot prove right or legitimate interest may still win,

by showing no bad faith in registering and using the domain name

Now let us look at a case where the respondent failed to establish a right or legitimate interest in the domain name, but nevertheless won the entire case because although the complainant had proved the first two elements he could not prove the third, bad faith. As it is a case concerning computer games, you could say that the young respondent Mr. Jones lost the battle but won the war. The case is ***Nintendo of America Inc. v. Alex Jones*** WIPO Case No. D2000-0998 where the 15-year-old respondent had registered the domain name <legendofzelda.com> and set up a web site devoted to the popular Nintendo game Legend of Zelda. The website carried a host of information about the game that must have been very compelling for its devotees.

The Panel rejected the young man's claim that the fan site he was running gave him a right or legitimate interest to the domain name, presumably because it was also being used for links to commercial outlets, which cancelled out the notion of a pure non-commercial fan site.

But Mr. Jones still won and still today has his fan site. This was so because the Complainant failed to prove that the domain name had been registered and used in bad faith.

The Panel said on this issue:

> "The Respondent has made no effort to sell the subject domain name.
>
> Although the Complainant says that the registration of the subject domain name prevents it from "…reflecting [its] mark in a corresponding domain name", there is no evidence that the Respondent has engaged in a pattern of such conduct as required by the Policy.
>
> The evidence does not support a finding that the Respondent seeks to disrupt the business of the Complainant. In fact, the opposite appears to be true.
>
> The evidence is clear that the Respondent has not sought commercial gain. Although his website contains links to commercial outlets, he states that he derives no personal gain.

> The circumstances in the Policy from which evidence of bad faith can be inferred are not present. Taking the evidence as a whole, there is no other basis on which the Administrative Panel could find bad faith."

Conclusion on these aspects

It may seem an anodyne one, but the real conclusion on this area is that each case will depend on its facts and the duty on those presenting the case is to ensure that all possible evidence is put forward to show, on the part of the complainant trademark owner, that the registrant of the domain name has no right or legitimate interest in the domain name and, on the part of the registrant, that he does.

Fan sites

Often, respondents try to make out their case for rights or legitimate interests by arguing that they were operating a fan site. A proper, non-commercial fan site can certainly give rise to a right or legitimate interest.

The WIPO Overview makes this point:

"2.5 Can a fan site constitute a right or legitimate interest in the disputed domain name?

This section only deals with fan sites that are clearly active and non-commercial. There are many UDRP cases in which the respondent claims to have an active non-commercial fan site but the panel decides otherwise. See Helen Fielding v. Anthony Corbert aka Anthony Corbett D2000-1000, Transfer

View 1: An active and clearly non-commercial fan site may have rights and legitimate interests in the domain name that includes the complainant's trademark. The site should be non-commercial and clearly distinctive from any official site.

Relevant decisions:
Estate of Gary Jennings and Joyce O. Servis v. Submachine and Joe Ross D2001-1042, Denied
White Castle Way, Inc. v. Glyn O. Jacobs D2004-0001, Denied

View 2: Respondent does not have rights to express its view, even if positive, on an individual or entity by using a confusingly similar domain name, as the respondent is misrepresenting itself as being that individual or entity. In particular, where the domain name is identical to the trademark, the respondent, in its actions, prevents the trademark holder from exercising the rights to its mark and managing its presence on the Internet.

Relevant decisions:
David Gilmour, David Gilmour Music Limited and David Gilmour Music Overseas Limited v. Ermanno Cenicolla D2000-1459, Transfer
Galatasaray Spor Kulubu Dernegi, Galatasaray Pazarlama A.S. and Galatasaray Sportif Sinai Ve Ticari Yatirimlar A.S. v. Maksimum Iletisim A.S. D2002-0726, Transfer."

The argument that some commentators put is that people are entitled to register domain names in names of their heroes' because they are entitled to establish fan sites as an exercise if free speech even if the celebrities have trademarks in their own names.

The free speech issue is certainly important in those cases where the domain name registrant says he was running a fan club site. It is the same argument used in the 'sucks cases", like <wallmartsucks.com> and is thus a more popular one in the in the USA.

As we have now seen, it is an important area in celebrities' issues, as is illustrated by the ***Bruce Springsteen Case***. To defeat the argument that the respondent registrant was legitimately using the domain name to run a fan site, the Complainant, the trademark owner bringing the claim, will have to find evidence of commercial use, e.g. linking the site to commercial sites , selling products on it or making an unsolicited offer to sell the domain name for a profit. These facts tend to suggest that the registrant was not just running a genuine fan site or a criticism site, but was really commercial and was trading on the celebrity's name to make money.

Cases where the fan site argument was successful

The operation of the UDRP scheme, however, does give opportunity for the registrant of a domain name to succeed on the ground that the site is a

genuine fan site established pursuant to the rights of free speech on the internet.

One case where the fan site argument prevailed as a defence, concerned the band Pearl Jam: ***Pearl Jam, A General Partnership v. Streaming Digital Media Dot Com c/o Brian J. Spencer*** NAF Case: FA023583.

In that case the Panel found that the Complainant had not proved that the Respondent had no right or legitimate interest in the domain name. The Panel relied on facts described by the panel as follows:

> "In this case, Respondent is not purporting to sell any product or service or to generate any revenues at all. Accordingly, the Panel is of the view that Respondent's evidence and Complainant's admissions support the conclusion that Respondent is making a non-commercial use of the Domain Name …UDRP panels have ruled and may rule in the future that the operation of a non-commercial fan site can constitute a legitimate non-commercial or fair use of a domain name**.** See ***Halen v. Morgan***, D2000-1313 (WIPO Dec. 20, 2000); see also ***Springsteen v. Burgur***, D2000-1532 (WIPO Jan. 25, 2001); see also ***Smith v. DNS Research, Inc***., NAF Case No:FA 220007 (2004).
>
> There appears to be nothing illegitimate about the content of Respondent's site. Complainant initially claimed that Respondent was offering illegal and unauthorized downloads of concerts on its site. However, the evidence submitted by Respondent, and not denied by Complainant, shows that Complainant has publicly authorized members of the public to make copies of Complainant's live shows and to trade them online. Complainant has provided no other evidence regarding such allegedly illegal and unauthorized downloads."

In other words, the site was a genuine fan site and there were no ulterior motives.

The fan site argument was also successful in ***Estate of Francis Newton Souza v. ZWYX.org Ltd.***, WIPO Case No. D2007-0221 concerning the Indian artist F N Souza. It should be remembered that as the panel described it:

> "Lal is an artist who had a relationship with Souza for approximately 10 years; however, the nature and extent of this relationship is in dispute. The Respondent provides web services. The Respondent uses the disputed domain name to operate, on behalf of Lal, a website featuring Souza's works and information about his life and death."

It appears also that Souza knew of the website and had no objection to it. The site was also non-commercial. The panel said, summarising the whole issue:

> "The Panel thus concludes that the website at the disputed domain name does not contain any commerce or other commercial activity.
>
> The Panel best characterizes the website as a non-commercial fan or tribute website. It does not appear that the nature of this website has changed since it was first created.
>
> The question whether fan sites that are clearly non-commercial constitute a right or legitimate interest in the disputed domain name is one on which there is a split among Panels (see WIPO Decision Overview, § 2.5). Several Panels have ruled that operators of such websites can have rights and legitimate interests in a domain name that includes the complainant's trademark (see, e.g., Chivas USA Enterprises, LLC, et al. v. Cesar Carbajal, WIPO Case No. D2006-0551; 2001 White Castle Way, Inc. v. Glyn O. Jacobs, WIPO Case No. D2004-0001; Estate of Gary Jennings and Joyce O. Servis v. Submachine and Joe Ross, WIPO Case No. D2001-1042; Besiktas Jimnastik Kulubu Dernegi v. Mehmet Tolga Avcioglu, WIPO Case No. D2003-0035); other Panels have espoused the view that fan site operators do not have rights to express their views, even if positive, on an individual or entity using an identical or confusingly similar domain name because such sites are, in essence, misrepresenting themselves as being the official site of that individual or entity (see, e.g., David Gilmour, David Gilmour Music Limited and David Gilmour Music Overseas Limited v. Ermanno Cenicolla, WIPO Case No. D2000-1459; Galatasaray Spor Kulubu Dernegi, Galatasaray Pazarlama A.S. and Galatasaray Sportif Sinai Ve Ticari Yatirimlar A.S. v. Maksimum Iletisim A.S., WIPO Case No. D2002-0726; Monty and Pat Roberts, Inc. v. Bill Keith, WIPO Case No. D2000-

> 0299; Nintendo of America Inc. v. Alex Jones, WIPO Case No. D2000-0998).
>
> Based on a careful reading of the Policy, this Panel sides with the former and believes that ***genuine non-commercial fan sites may indeed give rise to a legitimate interest***. Paragraph 4(c)(iii) of the Policy provides as an example of how to demonstrate rights or legitimate interests in a domain name that the registrant is "making a legitimate non-commercial 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". This language makes it clear that the operator of a non-commercial fan site can take advantage of this provision unless the operator, with an intent for commercial gain, is misleadingly diverting consumers or tarnishing the mark. Here, even if consumers might be confused as to whether the site is an official site of F.N.Souza or his former curator or his estate, the fact is that there is no showing that any of this is being done with an "intent for commercial gain", and thus ***the Policy mandates a finding that the noncommercial fan site operator has a legitimate interest under Section 4(c)(iii).*** 3 Cf. Ryanair Ltd. v. Michael Coulston, WIPO Case No. D2006-1194 (in case involving criticism cite, concluding that, "if the diversion of traffic was not made misleadingly with an intention of realizing some commercial gain, it does not fall under the language of the Policy, which is intended to address commercial diversions"); Xtraplus Corp. v. Flawless Computers, WIPO Case No. D2007-0070.4"(emphasis added).

Another case of there having been a legitimate use of the domain name for a non-commercial fan site and one referred to in ***Estate of Francis Newton Souza v. ZWYX.org Ltd.***, (*supra*) leading to a favourable result for the registrant of the domain name, is ***Estate of Gary Jennings v. Submarine,*** WIPO Case D2001-1042, where it was said:

> '…, Respondent appears to be providing reviews of Gary Jennings' books; and not advertising. Based on the record, before any notice to Respondent of the dispute, it appears that Respondent was using the Domain name in connection with a bona fide offering of goods and services. Respondent has been using the Domain name in connection with a web site to share information on the author Gary Jennings. The

> Panel finds on this basis that respondent has a legitimate interest in the Domain name.'

That was a genuine fan site with no commercial content, although it did have a link to www.amazon.com. This link, however, did not apparently give any commercial gain to the Respondent.

Sometimes, as in this case, genuine fan sites carry links of this type as a service to devotees to enable them to find books and products on their heroes rather than for the operator of the fan site to make money and, if that appears to be the situation in any given case, panels can and do find in favour of the registrant of the domain name.

Likewise, in the ***Pat Benatar Case***, ***White Castle Way, Inc. v. Jacobs***, WIPO Case D2004-0001, the fan site argument was successful. The panel said:

> " Respondent's website provides a wide range of information concerning Pat Benatar, the recording artist. There are clear disclaimers on the website stating that it is not endorsed by or an official website of the recording artist. There is no evidence on the record of this proceeding that Respondent obtains any commercial benefit from the website. While he does make a recommendation regarding the Internet retailer which he believes to stock the widest selection of the recording artist's work, there is no evidence that Respondent receives compensation from the retailer. Respondent is not seeking to disparage the recording artist. Complainant was aware of Respondent's website and activities for a substantial period, and requested that his website be linked to its official website before changing its view and attempting to obtain a transfer of the disputed domain name. The combination of these factors leads the Panel to conclude that Respondent is engaging in legitimate non-commercial use of the disputed domain name."

An attempt was made to rely on the ***Pat Benatar Case*** to prove a legitimate fan site in ***Société pour l'œuvre et la mémoire d'Antoine de Saint Exupéry-Succession Saint Exupéry - D'Agay v. The Holding Company*** WIPO Case No. D2005-0165. However the analogy was rejected and the fan site argument failed as a whole. The ***Pat Benatar Case*** was not followed as in that case the respondent had "the implicit consent of the Complainant to

operate his fan website and in which there was no evidence of a commercial link to recommended CD vendors". In the ***Saint Exupery Case,*** however, there was no such consent and there was evidence of active commercial dealing through the website. Accordingly, no right or legitimate interest could be made out.

A further example where the case of the respondent, that he had established a genuine fan site, was accepted, concerned the famous author Jorge Luis Borges: ***Borges, S.A., Tanio, S.A.U. v. James English***, WIPO Case No. D2007-0477. It was a somewhat unusual case, where the complainant, instead of being the celebrity, was a company with the same name as the domain name and the defence of the registrant was that he had indeed chosen the celebrity's name deliberately for his domain name, but to use it as a genuine fan site to give tribute to the celebrity.

The panel said:

> "The Respondent claims and provides evidence (as outlined above, in the summary of the Respondent's case) that he has an amateur interest in the author Jorge Luis Borges. For this purpose, the Respondent includes evidence of having obtained the disputed domain name recently, having a collection of works by the author and having discussed the author's works with others (evidence by a third party declaration). The Respondent provided a declaration also attesting to these and other things, as well as indicating that his intention is to use the disputed domain name for a website relating to the author Jorge Luis Borges. There is no evidence that the Respondent acquired the disputed domain name for commercial gain to misleadingly divert consumers or to tarnish the Complainant's trademark."

The decision in ***David Gilmour, David Gilmour Music Limited and David Gilmour Music Overseas Limited v. Ermanno Cenicolla,*** WIPO Case No. D2000-1459 also raised the question of the fan site.

In that case, the first point that the panel relied on was that the domain name was for sale together with domain names in the names of other celebrities. The panel also made a finding that "...the Respondent intended using the site for commercial gain by selling any exclusive merchandise associated with …" David Gilmour if he could obtain a licence. The panel then quoted with approval the observation in ***Madonna's Case*** that "Use which intentionally

trades on the fame of another cannot constitute a ‘bona fide’ offering of goods or services": (***Madonna Ciccone, p/k/a Madonna v. Dan Parisi and "Madonna.com***"(D2000-0847).

The panel then dealt with the respondent’s argument that he had intended “… to provide a forum for David Gilmour fans, most of whom, one might think, would have favourable comment to make about the first Complainant and his artistic work…” and that the case could be dealt with as a criticism case, presumably for that reason giving rise to a right or legitimate interest.

However, the panel decided against that conclusion on the ground that as in the ***Monty Roberts Case*** there was nothing to show in the domain name itself that it would lead to anything other than the complainant’s own site, which of course it would not.

The panel thus concluded by saying in effect that although the respondent was free to use the internet for praise, this did not give it a right or legitimate interest in the domain name. But the earlier finding that the respondent had intended to use the domain name for commercial purposes must also have been influential.

Cases where the fan site argument was not successful

How a panel goes about deciding if the claim by the Respondent that he was using the domain name for a fan site is valid is seen from the decision in ***Experience Hendrix, L.L.C. v. Denny Hammerton and The Jimi Hendrix Fan Club***, WIPO Case No. D2000-0364. The Respondent claimed that he was planning to establish a Jimi Hendrix Internet Fan Club. He said that he had already created the club and that he had detailed plans to provide services on it through the website. He pointed particularly to the emails addresses he was issuing. The Panel, however, decided that these were mere plans and far short of actually using the domain name for a fan club site and that the email addresses he had issued were vanity email addresses, the offering of which was the real reason why he had registered the domain name. Thus it was held that he had no right or legitimate interest in the domain name.

Another early fan site case where the fan site argument was not successful was ***Edward Van Halen v. Deborah Morgan,*** WIPO Case No. D2000-1313.

The Complainant alleged that he owned a common law trademark in EDWARD VAN HALEN, the Dutch guitarist, keyboardist, songwriter and producer most famous for being leader and co-founder of the hard rock band, Van Halen. He would have been able to make out that argument, on the basis of other similar cases of prominent musicians who had succeeded in establishing a common law trademark, but the respondent conceded that he had common law rights in the mark EDWARD VAN HALEN, so that was not the issue.

The respondent then went on to defend the claim on the other available issues, namely rights or legitimate interests and bad faith.

On rights and legitimate issues, she argued that, by virtue of being a "fan" of the Complainant and intending to put up a fan website, she had rights or legitimate interests in the domain name.

The Respondent's status as a fan might have justified a finding of legitimate interests if she given evidence of offline fan activity of which the website was an extension or if the website had been operational for a sufficient period. However, it was held that, under the circumstances, the Respondent merely has an expectation of developing a legitimate interest in the domain name rather than having acquired one already. Accordingly, she had not established that she was running a fan site and the Complainant had thus proved that the Respondent had no right or legitimate interest in the domain name.In other words, these cases will always be decided on the facts and the facts in that case did not show a genuine fan site and hence a legitimate interest in the domain name.

Nor was the fan site argument successful in a claim brought by Julie Brown (the American comedienne, actress), ***Julie Brown v. Julie Brown Club***,WIPO Case No. D2000-1628, because the evidence went only as far as forming an intention to start a fan club, with no evidence of one "…having any substantial existence". In contrast, the panel said that what the respondent had to do was:

> "… demonstrate positively a legitimate interest in retaining them (the domain names) for instance by providing an established fan club, or for that matter a site for criticism or satire. It is for him to show that the new use of the site is substantial and genuine, rather than merely a

> colourable continuation of his former stockpiling activity (in which the domain name like a lot of other celebrities' domain names were pointed to celebrity www.1000.com)."

Again, there was just not the evidence that there was a fan site.

The fan site argument was again held not to be successful on similar grounds in ***Robbie Williams v. Howard Taylor,*** WIPO Case No. D2002-0588 because, as the panel said:

> " The Respondent says it intends to set up an unofficial fan club using the Domain Name. However, there is no evidence that the Respondent has run his own Robbie Williams fan club either on-line or off line and he has yet to use the Domain Name for this purpose. He has not produced any evidence whatsoever of his preparations to do so. Accordingly, the Respondent has not used or made demonstrable preparations to use the Domain Name in connection with a bona fide offering of goods and services. Nor has the Respondent been commonly known by the Domain Name. Nor is he making a legitimate non commercial or fair use of the Domain name. He has previously pointed it to the commercial site of the band Oasis, rivals of the Complainant. Currently he is pointing it at a "Google" search page on which the official commercial site of the Complainant appears as the first item. The Respondent says he has plans to substitute his own site in future and it is not at all clear that this use will be non commercial or fair. Respondent has not demonstrated any rights or legitimate interest in the Domain Name."

In other words, the evidence just did not come up to scratch.

Other examples of the fan site argument being defeated on the inadequacy the respondent's mere intention to establish one in the future, rather than his showing actual evidence of a fan site being conducted, are as follows.

First, there is ***Joe Cole v. Dave Skipper***, WIPO Case No. D2003-0843, where it was held again that the mere assertion that a fan site would be created in the future would not be sufficient and the fact that the respondent had taken several years, but had not established the fan site, showed that the explanation for registering the domain name was not genuine .

The result was the same in ***Hugh Jackman v. Peter Sun*** NAF Case, FA0403000248716, where again all that the respondent could show was that he intended to set up a fan site, but had not done so.

> Nor in 2006 was the fan site argument successful, for the same reason, in ***Wayne Rooney's Case***, ***Stoneygate 48 Limited and Wayne Mark Rooney v. Huw Marshall***, WIPO Case No. D2006-0916, concerning the Everton and then Manchester United footballer Wayne Rooney, because the respondent had done nothing to put into practice the passion he claimed for his hero and which he intended to manifest in a fan site.

A recent decision to the same effect and which produced a similar result for Ringo Starr is ***Richard Starkey v. Mr. Bradley***, NAF Case No FA0612000874575 , a '.mobi'[36] case, where the domain name was **<ringostarr.mobi>** and the panel said that there was no evidence that the respondent had made any demonstrable preparations for the fan site.

George Harrison v. Lovearth .net, NAF Case No.: FAO97085, (2001), another Beatles Case, was a case of a fan site, but one that did not give rise to a right or legitimate interest in the domain name because " the domain names at issue have essentially been held hostage by Respondent to coerce Complainant to take a position of sponsorship of (the Respondent's) particular environmental movement …" The respondent had registered various versions of George Harrison's name as domain names and then linked them to his, the respondent's, environmental websites. On the respondent's own<celebrity-websites.com> home page he explained that: " [W] e ask that the celebrities . . . read and understand the most important study there is on Earth. Rainforests Biodiversity."

The site also contained a letter addressed to "Dear Celebrity" which stated:

> "It is our belief when these Eco Celebrities understand the true ramifications they will help bring this critical study to the forefront of human consciousness as fast as possible. "

The panel summarised the respondent's activities by saying:

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[36] Intended for use on mobile telephones

> “Elsis and LOVEARTH.net are admittedly "trying to get to the top people throughout the world" in order to urge them to read Elsis' manifesto on the destruction of the rainforests in exchange for the transfer of their domain names. In this regard, Elsis has attempted to obtain meetings and other forms of assurance from Complainant regarding support for Respondent's environmental causes in exchange for the transfer of all of his George Harrison domain names.”

The respondent’s argument was that these were legitimate "fans sites" which have freedom of speech rights.

The panel found that the respondent was “… not making a legitimate noncommercial or fair use of the disputed domain names without misleadingly diverting consumers to its web site or tarnishing Complainant’s famous mark. …(and also that) Respondent’s various uses of Complainant’s mark as fan sites does not substantiate Respondent’s rights or legitimate interests. See ***Marino v. Video Images Prod***., D2000-0598 (WIPO Aug. 2, 2000) (and) ***Kasparov v. American Computer Co***., FA 94644 (Nat. Arb. Forum May 30, 2000) (finding no legitimate rights and interests when Respondent used Complainant's name as a portal to a web site which, without permission, associated the Complainant as an endorser of Respondent's causes).”

In other words, the fan site was not good enough if it was being used for an improper purpose.

Another George Harrison case, where the domain name was <egeorgeharrison.com>, produced the same result:
George Harrison v 1WebAddress.com, NAF Case: FA0097090 (2001).

A somewhat more difficult case was ***Stevland Morris a/k/a Stevie Wonder v. Unofficial Fan Club c/o Web Master,*** NAF Case No: FA0453986 . It is worth studying because it shows the processes a panellist will have to go through on some occasions in analysing particular issues. The disputed domain name was <steviewonder.com>. The context of the decision was that Stevie Wonder had registered trademarks, but the Panel found that he had established common law rights as well, because he had been a famous singer for so long.

It was then held that what the respondent claimed to be a fan site was not one. The panel said:

> "It is quite clear that the web site itself is not the Fan Club. It is, as we have seen, and as Respondent repeatedly assures us, ***only the gateway through which erstwhile fans of Stevie Wonder can apply for information about the Club.*** The inevitable conclusion therefore is that the web site at the disputed domain name is not active as a Fan Club. This activity occurs elsewhere. Respondent emphasizes again and again that theirs is an unofficial fan club, but that hardly matters once one has established that the web site itself is not the Club. In any case, as Complainant has pointed out, an Internet user is likely to have been confused before perceiving that the site carries an unofficial label."(emphasis added).

It had to be shown, first, that the fan site was clearly non – commercial and the Panel decided that this had been proved.

But it also had to be shown that the site was an active fan site and it was here that the Respondent fell down. That was so because for several years the site had had no content and only after the dispute started did it start to carry perfunctory information about Stevie Wonder.

Commercial use

The fan site argument will also be defeated if there is evidence that the respondent has been using the site for commercial purposes. An example of this result is ***JRR Tolkien Estate Limited v. tolkien.net***, WIPO Case No. D2003-0833, where the panel said:

> "In light of the inclusion of the links to commercial websites such as "www.amazon.com" and "www.sell.com" on the Respondent's website which the Respondent admits generate income for the Respondent, and as the Respondent has provided no substantive evidence of its demonstrable preparations to establish a bona fide non-commercial fan site, even though the Disputed Domain Name was registered almost 5 years ago, the Panel finds that (a) the use made by the Respondent of the Disputed Domain Name has not been in connection with a bona fide offering of goods or services; and (b) the Respondent is not making a legitimate non-commercial or fair use of

> the Disputed Domain Name, without intent for commercial gain to misleadingly divert consumers or to tarnish the Complainant's TOLKIEN trademark."

What can be particularly irritating is where the panel could have rejected an argument on interesting grounds but does not do so, because a later decision will make it irrelevant. This was the situation in ***Jules I. Kendall v. Donald Mayer Re skipkendall.com***, WIPO Case No. D2000-0868, another charming family dispute, where it was not necessary to decide the issue of right or legitimate interest, because it could be seen that the complainant would fail on bad faith and that the case would be lost on that ground.

The site was headed "Skip Kendall – PGA Golf Pro and Deadbeat (?) – You Be The Judge." To paraphrase the decision, the site contained no advertising and did not promote or offer the sale of any goods or services. The text of the site was limited to the Respondent's statements about the loan dispute that existed between Complainant and his sister and which was the reason why the sister had registered the domain name and set up the website. In this case, the panel could have said something significant on criticism sites but did not.

Another failed attempt to establish a fan site argument was in ***Kevin Spacey v. Alberta Hot Rods,*** NAF Case No: FA0114437 where it was said that:

> "Until December 2000, Respondent used the <kevinspacey.com> domain name to divert Internet traffic to Respondent's commercial website, <celebrity1000.com>. After receiving notice from Complainant that Respondent's actions were being challenged, Respondent changed the registration name and used the <kevinspacey.com> domain name as an unauthorized fan site. The creation of a fan site after notice of a dispute has been found not to be a bona fide offering of goods or services pursuant to Policy ¶ 4(c)(i). See Brown v. Julie Brown Club, D2000-1628 (WIPO Feb. 13, 2000).
>
> Moreover, Respondent's use of the <kevinspacey.com> domain name for an unauthorized fan site, as an apparent stratagem after previously using the site to direct Internet traffic to its own commercial site, demonstrates that Respondent is not making fair use of the domain name within the meaning of Policy ¶ 4(c)(iii). Cf. Big Dog Holdings, Inc. v. Day, FA 93554 (Nat. Arb. Forum Mar. 9, 2000) (finding no

> legitimate use when the Respondent was diverting consumers to its own website by using Complainant's trademarks); see also MSNBC Cable, LLC v. Tysys.com, D2000-1204 (WIPO Dec. 8, 2000) (finding no rights or legitimate interests in the famous MSNBC mark where Respondent attempted to profit using the Complainant's mark by redirecting Internet traffic to its own website)."

The use of the fan site must be legitimate

Sometimes, the case for a fan site may well be made out, but it does not succeed in establishing a right or legitimate interest in the domain name. This was the case in ***Anne of Green Gables Licensing Authority, Inc., v. Internetworks***, eResolution Case No AF-00109 (2000). On the issue of right or legitimate interest in the domain name, the panel said:

> "The Panel finds that Respondent does not have a legitimate interest in the domain name. ANNE OF GREEN GABLES is a well-known mark and likely, a famous mark in Canada. Respondent seeks to use the well-known mark as a domain name ***to attract visitors to a tourism web site*** devoted to Prince Edward Island, the location of the Anne of Green Gables Museum, the birthplace of L. M. Montgomery, the creator of the Anne of Green Gables fictional works, and the site of the annual festival celebrating L. M. Montgomery. Respondent's proposed use of the well-known mark owned by Complainant ***to lure fans and potential tourists to Respondent's web site is definitively not a legitimate use***. Accordingly, Complainant has met its burden to prove the second of the three factors."(emphases added).

Conclusion on this element

We have seen decisions where a right or legitimate interest has been made out by a successful argument that the respondent was using the domain name for a legitimate fan site: ***Pearl Jam, Souza, Gary Jennings, Pat Benatar and Borges.***

We have also seen cases where that argument has failed***: Saint Exupery, David Gilmour, Hendrix, Van Halen, Julie Brown, Robbie Williams, Joe Cole, Hugh Jackman, Wayne Rooney, Ringo Starr, George Harrison*** and ***Kevin Spacey.***

It might therefore be thought that celebrities will usually carry the day, meaning that registrants of domain names are more likely than not to fail in trying to establish that they were using the domain name for a genuine fan site.

Such a generalization would be erroneous. The only conclusion that can be drawn is that each case depends on its own facts and that the challenge again is to marshal the facts and the evidence that proves them, to advance the respective arguments. Cases can be won and still are won on the facts.

Bad faith

The three elements that must be proven before a complainant can succeed are:

(i) The domain name is identical or confusingly similar to a trademark or service mark in which the Complainants have rights; and

(ii) The 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.

As we have looked at the first two, it is now time to look at the third, because the celebrity must also prove this element.

As in the case of rights or legitimate interests, so in the case of bad faith, the Policy gives us a help in interpreting it. That is done by means of paragraph 4(b) of the Policy, which sets out four circumstances, any one of which shall be evidence of the registration and use of a domain name in bad faith, although other circumstances may also be relied on, as the four circumstances are not exclusive. The four specified circumstances are:

"(i) circumstances indicating that the respondent has registered or acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that

complainant, for valuable consideration in excess of the respondent's documented out-of-pocket costs directly related to the domain name; or

(ii) the respondent has registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that Respondent has engaged in a pattern of such conduct; or

(iii) the respondent has registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, respondent has intentionally attempted to attract, for commercial gain, internet users to respondent's website or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of the respondent's website or location or of a product or service on the site or location."

So a complainant may prove facts that bring the case within any of the sub-paragraphs of paragraph 4(b) of the Policy or may rely on any other facts that show general bad faith in the registration and use of the domain name.

The celebrity, like all other complainants in UDRP proceedings, also has to show both that the domain name in question was registered in bad faith and that it is being used in bad faith.

There have been cases where the celebrity has been able to prove bad faith and cases where the celebrity has failed. The cases where the celebrity has succeeded have usually been cases where it can be deduced that the respondent has registered the name because of its prominence and because it will ensnare the interest of internet users who can then be directed to websites for the benefit of the respondent by buying goods or services that will be on offer on that web site. The combination of facts like linking the domain name to a pornography site or a non-pornography site that nevertheless is obviously a commercial one, offering the domain name for sale, or not having a plausible explanation for registering the name has often lead to a finding of registration and use of the domain name in bad faith. It

also tends to make that result more likely when the respondent gives an explanation that does not have the air of verisimilitude about it. ***Madonna's Case*** had quite a few of these elements.

In the ***Madonna's* Case** the Panel said:

> "The pleadings in this case are consistent with Respondent's having adopted <madonna.com> for the specific purpose of trading off the name and reputation of the Complainant, and Respondent has offered no alternative explanation for his adoption of the name despite his otherwise detailed and complete submissions. Respondent has not explained why <madonna.com> was worth $20,000 to him or why that name was thought to be valuable as an attraction for a sexually explicit web site. Respondent notes that the complainant, identifying herself as Madonna, has appeared in Penthouse and has published a "Sex" book. The statement that "madonna" is a word in the English language, by itself, is no more of a defense than would be the similar statement made in reference to the word "coke". Respondent has not even attempted to tie in his web site to any dictionary definition of madonna. The only plausible explanation for Respondent's actions appears to be an intentional effort to trade upon the fame of Complainant's name and mark for commercial gain. That purpose is a violation of the Policy, as well as U.S. Trademark Law."

The Panel also said that putting a disclaimer on the website was not a defence. However, as will be seen in many of the cases, a disclaimer may be effective but its effectiveness will depend on where it is situated, the degree of notice it gives to the viewer and whether in substance it makes it clear that the website is not associated with the trademark owner or whether it simply creates more confusion as to whether it is or is not so associated.

Madonna's Case also made the interesting point that, for present purposes, acquisition of a domain name was the same as registering it and concluded that:

> 'We therefore conclude that bad faith acquisition satisfies the requirement of bad faith registration under the Policy.'

In the course of dealing with that argument, the panel drew an interesting distinction between ***Madonn'sa Case*** and the previous ***Sting Case***.

In the ***Sting Case***, as was noted earlier, the Panel clearly had doubts as to whether the ICANN Policy and hence the dispute resolution scheme applied to individuals at all. It did not expressly decide the case on that ground however, because it felt more strongly that the Complaint had not shown that the domain name had been registered and used in bad faith.

Here again the panel had resort to asking itself whether it was plausible that the Respondent had registered the domain name for some reason other than to trade off the fame of the celebrity in question. The word 'sting' was a generic and common word and it was therefore plausible to say that there were other reasons why the word 'sting' had been chosen as the domain name. That was so because there were other meanings of the word 'sting' than the meaning that invoked the name of the famous singer.

Thus, in the ***Sting Case*** it could be said that the registrant was not trading on the celebrity's name. But in ***Madonna's Case*** it was different, for it was hard to see a legitimate reason for choosing the name of the *uber* celebrity Madonna.

The Panel in Madonna concluded:

> "In the Sting decision there was evidence that the Respondent had made bona fide use of the name Sting prior to obtaining the domain name registration and there was no indication that he was seeking to trade on the good will of the well-known singer. Here, there is no similar evidence of prior use by Respondent and the evidence demonstrates a deliberate intent to trade on the good will of complainant. Where no plausible explanation has been provided for adopting a domain name that corresponds to the name of a famous entertainer, other Panels have found a violation of the Policy. See *Julia Fiona Roberts v. Russell Boyd*, Case No. D2000-0210 (WIPO May 29, 2000); *Helen Folsade Adu p/k/a Sade v.Quantum Computer Services Inc.*, Case No. D2000-0794 (WIPO September 26, 2000)."

The need for evidence

Whether bad faith can be shown will depend on the particular facts of the case and as in the other elements that must be proved, so in the case of bad faith the evidence must come up to scratch. Many cases fail because the

complainant has not appreciated the importance of adducing the necessary evidence, has wrongly assumed that the panelist will blithely go along with unsupported assertions of bad faith or, in other cases, because the evidence is simply not there, despite the best attempts of complainants to present what they have.

There is another underlying principle to remember in trying to prove UDRP cases. That is that bad faith has necessarily an air of impropriety or immorality about it and for that reason it is wise for a complainant to try to prove or suggest that notion rather than assume it is present or assert it.

In other words, it is not enough to show that the respondent was guilty of a breach of the complainant's trademark, for to do that does not require proof of bad faith; the UDRP requires proof of the additional element of bad faith and it must be proved.

The importance of this requirement was noted in ***Edward Van Halen v. Deborah Morgan,*** WIPO Case No. D2000-1313 where the claim failed for the complainant was unable to prove bad faith. In setting the context in which this issue is to be resolved, the panelist set out the reason why there is a specific requirement in the Policy for a finding of bad faith. The panelist put it this way:

> "The Policy is, thus, not designed to combat trademark infringement on the Internet or even questionable cases of cybersquatting, but rather, abusive, bad faith cybersquatting."

Having done that, the panellist then went through each of the specified criteria, but concluded there was no evidence of any of them and no evidence of general bad faith, for the respondent had not tried to sell the domain name or use it for a commercial purpose. The panellist therefore concluded:

> "…the Panel cannot infer bad faith without other evidence. If Respondent were to make use (of a website) in the future and seek commercial gain by creating confusion, then Complainant might at that time have a better case, but that is not the circumstance presented here. See *Nintendo Inc. v. Alex Jones,* WIPO Case No. D2000-0998.
> …

> Simply put, the evidence here is insufficient to justify a finding of bad faith. Instead, Respondent claims that she has a desire to use the domain name for a legitimate fan site and, if she follows through on that intention, it would not constitute the kind of abusive, bad faith cybersquatting that the Policy is designed to prevent."

As things stood at the time the decision was being made, there was no evidence of bad faith.

By way of contrast, in the **Horse Whisperer' case,** ***Monty and Pat Roberts, Inc. v. Bill Keith,*** WIPO Case No. D2000-0299, it was held that the Respondent had used the domain name in bad faith. The Panel said on this issue:

> "In the instant case, Respondent is using the domain name "montyroberts.net" to attract Internet users to its website by creating a likelihood of confusion with Complainant's mark. It is doing so for direct or indirect commercial gain. Whether or not such gains are ultimately used for charitable purposes does not alter this conclusion. Upon examination of Respondent's "montyroberts.net", Internet users would become aware that the website is not sponsored by Complainant. However, commercial benefit may well accrue to Respondent if the products it offers for sale (directly and indirectly) are purchased by those visiting its website, and commercial harm may well be suffered by Complainant if Internet users abandon their efforts to reach its website. Respondent will have achieved commercial gain by creating confusion regarding the website location of Complainant and its services – diverting Internet users to its own website as a source of products and services.
>
> The Panel determines that Respondent acted in bad faith in registering and using the disputed domain name. Complainant has thus established the third and final element necessary for a finding that the Respondent has engaged in abusive domain name registration."

An easy case on bad faith was ***The Wiggles Touring Pty Ltd v. Thompson Media Pty Ltd,*** WIPO Case No. D2000-0124: the Wiggles company had registered trademarks over The Wiggles and Henry The Octopus and the Respondent had registered<thewiggles.com> and <henrytheoctopus.com>:

So the panel decided that the domain names were identical to those trademarks and then went on to find that the Respondent had no rights or legitimate interests in the domain names as the evidence was that it had registered them with the intention of selling them. Indeed, the head of the Respondent had said he made his living from selling domain names, so it was an easy case. It was then held that the same facts showed bad faith and the Wiggles were successful.

Cases where bad faith has been established

Some cases of bad faith are easy to prove. Where a domain name reflecting the name of a celebrity has been linked to a pornography site, especially a commercial one, it would be hard to see how this could not be evidence of bad faith, either under the criteria set out in paragraph 4 (b) of the Policy or under general notions of bad faith. There are therefore many cases that have been decided to that effect.

For example, in ***A & F Trademark, Inc., Abercrombie & Fitch Stores, Inc., Abercrombie & Fitch Trading Co., Inc. v. Party Night, Inc***., WIPO Case No. D2003-0172, it was held that linking the domain names to pornography sites denied there being any right or legitimate interest in the domain names and that the same facts showed bad faith in registration and use.

Similarly, in ***Barry Diller v. INTERNETCO CORP***, WIPO Case No. D2000-1734 there was a finding of bad faith. The Complainant, Barry Diller, is a well-known businessperson in the film, television, and interactive technology industries. The panel found that:

> "…the Respondent is making a patent commercial use of the disputed domain name, ie, the Respondent is using a well-known name in the media industry to attract clients to its pay-per-view pornography websites. This violates the bad faith provision of the Policy at para 4 b(iv)…".

This was also the case in ***Dr Roger Libby v. Tunga Tuzlaci and/or Tumay Asena***, WIPO Case No. D2001-1342, concerning the sex therapist Dr Roger Libby whose domain name was linked to a hard core pornography site. It was held to be in bad faith because the inference could be drawn that the respondent was probably going to sell the domain name or just use it to

attract the complainant's sex therapy clients to his, the respondent's, pornography site.

Business people succeeding in showing bad faith

It will be recalled that when we were looking at common law trademarks, the point was made that business people had difficulty in showing a common law trademark in their own name. They also have difficulty in proving that the respondent who registered the domain name in the name of the prominent business person, registered and used it in bad faith.

Such cases can, however, succeed on proper evidence and on the inferences to be drawn from the evidence.

On such case that succeeded on inferences drawn from the evidence was the ***Barry Diller Case*** we have just looked at. Another was ***Philip Berber v. Karl Flanagan and KP Enterprises***, WIPO Case No. D2000 066. In that case, the Respondent registered the Domain Name PHILIPBERBER.com and linked it to a website which contained a photograph of the Complainant and a press article about his success.

The Respondent claimed that the site "…has been constructed in good faith, having been put up for information purposes only, with content that is already in the public domain;.."

That was doubted by the panel, as it said:

> "The Complainant points out that in the past the Respondent's sites had only a live link to a site selling web sites and contained language suggesting that the domain names in his possession were obtainable by interested parties. This would suggest that the Respondent was in the business of domain name dealing. The Respondent does not deny this in his email communication to WIPO. Further he appears to have registered the names of two other well known wealthy Irish businessmen. Accordingly, the Respondent appears to have registered and used the domain name in bad faith in accordance with paragraphs 4 (b) (i) and (ii) of the rules."

Another cases where the decision largely went on inferences about the respondent's intentions drawn from the evidence, was ***Joe Cole v. Dave***

Skipper, WIPO Case No. D2003-0843. It was said that because the respondent has registered a domain name, for example in the name of a famous footballer and was giving implausible explanations on his intention, this enabled the panellist to conclude that "…the Respondent has registered and used the Domain Name for the reasons identified within the scope of paragraph 4(b)(i) of the UDRP Policy and/or with the intention of selling the Domain Name to a person for use in a manner described in paragraph 4(b)(iv) of the UDRP Policy."

The importance of this decision is to be found in the willingness of the panelist to draw inferences from the known facts.

Another case where the decision went largely on inferences drawn from the facts was ***David Gilmour, David Gilmour Music Limited and David Gilmour Music Overseas Limited v. Ermanno Cenicolla*** WIPO Case No. D2000-1459 .The facts were that the respondent registered the name with the intention of establishing a fan site to pay tribute to David Gilmour, one the founders of Pink Floyd and getting an exclusive licence to sell merchandise, but had not yet done either of those things. That was not enough to save him and the Panel found that the domain name was registered and used in bad faith.

The panel said:

> "Here there is no dispute that the Respondent knew of the name and reputation of David Gilmour as a recording artist and musician long before he registered the disputed domain name. The panel finds that the Respondent registered the disputed domain name in order to trade off that reputation by creating a false association between that domain name and the Complainant's trademark, so as to attract to the Respondent's site Internet users (being David Gilmour fans) seeking the first Complainant or his authorized site. The Panel finds this to be bad faith registration.
>
> There has been no active use of the domain name prior to this dispute except to offer it for sale (but) …(i)naction has been determined as being within the concept of 'use' for the purpose of the Policy…In light of the Respondent's choice of domain name with knowledge (as the panel has found) of the Complainants' mark and reputation in the music industry and the Respondent's expressed intention to use the

> domain name to sell any exclusive David Gilmour and Pink Floyd merchandise if he can obtain a licence to do so, the panel finds the Respondent is using the domain name (albeit passively) in order to advance his aim of obtaining any such exclusive merchandise, knowing that the domain name represents the goodwill of the Complainants and that, while the Respondent remains the registrant of the disputed domain name, the Complainants may be coerced into dealing with the Respondent so as to maximize their opportunities to market any of their exclusive merchandise on the Internet. The panel finds such use to be use in bad faith."

Likewise, there was a finding of bad faith in the ***Kendra Todd Case. Kendra Todd v. Real Estate Radio c/o Leo Miller,*** NAF Case No: FA0783428. The panel said:

> "Additionally, the Panel finds that Respondent registered the disputed domain name in an attempt to use the disputed domain name against Complainant through a likelihood of confusion as to the source and affiliation of Complainant with the disputed domain name. Such use of the <kendratodd.com> domain name constitutes bad faith registration and use under Policy ¶ 4(a)(iii). See Experience Hendrix, L.L.C. v. Hammerton D2000-0364 (WIPO Aug. 4, 2000) (finding bad faith because "registration and use of the [<jimihendrix.com>] domain name by Respondent do not predate the Complainant's use and rights in the name and mark but rather appears [sic] to be an attempt to usurp Complainant's rights therein"); see also Gilmour v. Cenicolla, D2000-1459 (WIPO Dec. 15, 2000) (finding bad faith registration of the <davidgilmour.com> domain name where the respondent knew of the complainant's fame long before the registration of the domain name and registered the name in order to "trade off that reputation by creating a false association between that domain name and the Complainant's trademark").'
>
> The Panel finds that Policy ¶ 4(a)(iii) has been satisfied."

Other cases based on inferences

Often, an experienced arbitrator can very quickly assess by inference from the conduct of the respondent that there was bad faith, as there was held to be under sub-paragraph (i) in ***Serena Williams and Venus Williams v.***

Eileen White Byrne and Allgolfconsultancy, WIPO Case No. D 2000-1673 where the respondent gave a very spurious explanation for registering the names of Venus and Serena Williams, namely that she was going to set up a sports website, but that she would sell the name for over $1 million. That was clearly bad faith registration and use and it was so held.

The inability to find a rational and legitimate explanation for registering the domain name, leading to an inference of bad faith, came through again in the decision in ***True Blue Productions, Inc. v. Chris Hoffman***, WIPO Case No. D2004-0930 where the domain name was <fatactress.com> after the television show, starring Kirstie Alley. The respondent had directed it to his website where his views on pornography, abortion, Hollywood movies *inter alia* were promoted. The panel was able to say:

> "It simply defies reason to think that the Respondent, upon learning of Ms. Alley's new television series, and appreciating the resulting widespread recognition which the mark "FAT ACTRESS" would quickly attain, had absolutely no intention of misappropriating some of that recognition for his own ends -- specifically as a means of substantially increasing the number of visitors to his websites than he would otherwise attract. Unsuspectingly, those additional visitors, upon being re-directed to the Respondent's website, would be exposed to the Respondent's viewpoint on various issues, including, e.g., abortion, pornography, birth control, planned parenthood, and Hollywood movies -- none of which has any apparent connection to Ms. Alley or her television series. The inevitable viewer confusion resulting from the re-direction clearly injures the Complainant by damaging its reputation. If the Respondent had no such intention of opportunistically exploiting the Complainant's mark to increase his own audience, then why would he have registered the disputed domain name in the first place? This Panel sees no other plausible explanation."

Another case where bad faith was concluded by way of inference rather than direct evidence is ***Jaap Stam v. Oliver Cohen,***WIPO Case No. D 2000 – 1061.

This case concerned the Dutch and Manchester United footballer Jaap Stam and shows how bad faith may be proved by inference from the conduct of the Respondent. The panellist said:

> "The Respondent has stated that he innocently registered the said domain name, but besides that assertion the Respondent has not provided any explanation as to how or why he chose this domain name. This Administrative Panel does not accept the Respondent's submission that the Complainant is known only "by a miniscule number of esoteric people following sports in foreign countries". Alternatively if this is the case, the selection and combination of the unusual (and in the English language -meaningless) words <jaap> and <stam> by the Respondent as a domain name, without any explanation, leads this Administrative Panel to be of the view that the Respondent appears to fall into that category."

Sometimes the adverse inference can come from the mere fact that the celebrity is so well known that the respondent must, in the absence of circumstances to rebut the inference, have registered the domain name to benefit himself and trade on the name of the celebrity. That was the case in ***Richard Starkey v. Mr. Bradley***, NAF Case No FA0612000874575 , where the panel said :

> "In the view of the majority of the Panel, there is an inference that the Respondent registered and used the disputed domain name in bad faith. The inference comes from his admitted knowledge of the worldwide fame of Ringo Starr and the fact that he registered this name so soon after .mobi registrations were permitted."

It was also said:

> "The majority of the Panel agrees with the cases cited by the Complainant, particularly the *Elizabeth Taylor*, *supra*, and the *Stevie Wonder* case, i.e. *Stevland Morris a/k/a Stevie Wonder v. Unofficial Fan Club*, FA 453986 (Nat. Arb. Forum June 22, 2005). "***These cases show that the mere fact of registration of a famous name is in itself evidence of bad faith."*** (emphasis added).

Findings of bad faith under the specific criteria of paragraph 4 (b)

Some cases are decided specifically on the basis of one or more of the criteria set out in paragraph 4 (b) of the Policy and some aspect of them.

Sub-paragraph (i)
Intention to sell

The relevant provision in the Policy is:

> "(i) circumstances indicating that the respondent has registered or acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of the respondent's documented out-of-pocket costs directly related to the domain name;…"

It will be seen that to prove bad faith under this provision, there must be evidence of "valuable consideration". But it has been held that "valuable consideration" is not only money, but other benefits as well.

One such finding of bad faith on this basis was in the case we have already noted, ***Joe Cole v. Dave Skipper***, WIPO Case No. D2003-0843. The early decision in ***Cho Yong Pil v. ImageLand, Inc.,***WIPO Case No. D2000-0229, concerning the Korean pop singer Cho Yong Pil, was to a similar effect. The Panel said:

> **"**In the present case, there is evidence of an offer by the Respondent to sell the domain name to the Complainant in exchange for the endorsement from the Complainant for the Respondent's business. Such endorsement is likely to exceed the Respondent's out-of-pocket expenses. Thus, the Panel determines that the Respondent is using the domain name in bad faith."

To a similar effect was ***Mr. Severiano Ballesteros Sota, Fairway, S.A. and Amen Corner, S.A.v. Patrick Waldron***, WIPO Case No. D2001-0351, where the respondent's solicitors, somewhat unwisely, it might be thought, said they would sell the domain name:

> "4 complimentary tickets for the Seve Ballesteros for every year that the Seve Ballesteros Trophy takes place or some such other gesture whether monetary or otherwise" .

It was said that this demand showed that the respondent had always intended to sell the domain name and accordingly it was held to be evidence of bad faith under sub-paragraph 4(b) (i).

Thus, it is not only a finding of an intention to sell the domain name for money that will justify a finding of bad faith; an offer to accept some other substantial benefit in return for the domain name may be regarded as evidence of bad faith.

A prominent case in this field to the same effect was ***MPL Communications, Limited and MPL Communications, Inc. v LOVEARTH.net***, NAF Case: FA0097086, decided on June 1, 2001 and concerning Paul MacCartney. The panel held that it was bad faith under paragraph 4(b)(i) of the Policy if, instead of seeking money, the Respondent sought, as he did, an undertaking that MacCartney had read his environmental manifesto. It was recognised that these sorts of demands could be more valuable to a Respondent than real money. The Panel said:

> "While paragraph 4(b)(i) of the Policy requires that a respondent register or acquire a domain name for the purpose of selling, renting or otherwise transferring it for "valuable consideration" in excess of the document out-of-pocket costs of registration, ***the Policy does not limit this consideration strictly to monetary form***. ***This Panel believes that consideration can take on many different forms, only one of which is monetary, with the test being whether the consideration demanded by a respondent has value to that particular respondent beyond the direct out-of-pocket costs to that respondent of registering the domain name***. See ***Metallica v. Schneider*** FA 95636 (Nat. Arb. Forum Oct. 18, 2000) where the panel held, with respect to a respondent registering a celebrity domain name and then offering to transfer it in exchange for various actions taken by the respondent: "The Respondent also registered and used the domain name in order to extract valuable concessions from the Complainant. ...Policy ¶ 4(b)(i) was broadly construed as to provide relief when the infringing domain name holder seeks transfer of the domain name for something valuable other than money. The Respondent offered to

> transfer the domain name in exchange for a meeting with the Complainant, phone calls from the Complainant, and an interview with the Complainant. Given the Complainant's fame, these encounters with the Complainant would be of great value -- certainly a value in excess of the minimal costs associated with registering and maintaining the domain name 'metallica.org'."(emphasis added).

The Panel in that case also found that there was bad faith under paragraph 4(b)(i), (ii) and (iii) of the Policy.

Another example of a Respondent trying to extract some benefit other than money is the case relied on in ***MPL Communications, Limited and MPL Communications, Inc. v LOVEARTH.net,*** namely ***Metallica v. Josh Schneide,*** NAF Case No***:*** FA0095636 that had been decided in 2000. It was not a difficult case as there was a registered trademark and the Respondent had linked it to a commercial website. So there was a finding against it of bad faith under each of the three headings under paragraph 4(b), but most interestingly under paragraph 4(b)(i), because:

> "…The Respondent offered to transfer the domain name ***in exchange for a meeting with the Complainant, phone calls from the Complainant, and an interview with the Complainant***. Given the Complainant's fame, these encounters with the Complainant would be of great value—certainly a value in excess of the minimal costs associated with registering and maintaining the domain name "metallica.org". Thus, the Panel concludes that the Respondent has met the requirements of Policy ¶ 4.b(i)."

Where the allegation is that the respondent offered the domain name for sale or was prepared to sell it, complainants should be wary of including in their evidence only part of the correspondence between the parties and not the whole correspondence : ***Die Marlene Dietrich Collection GmbH V. Johan Duplesis Du Plesis*** WIPO Case No.D2007-1306.

Sub paragraph (ii)

Denial of corresponding trademark

The relevant provision of the Policy is:

(ii) "the respondent has registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that Respondent has engaged in a pattern of such conduct."

One such case where the decision turned on this element was ***Stevland Morris a/k/a Stevie Wonder v. Unofficial Fan Club c/o Web Master,*** NAF Case No: FA0453986 (2005) that we have already looked at under the issues of common law trademarks and "rights or legitimate interests". The disputed domain name was <steviewonder.com>. The context of the decision was that Steveie Wonder had registered trademarks, but the Panel found that he had established common law rights as well, because he had been a famous singer for so long. It was then held that what the respondent claimed to be a fan site was not one, as a matter of fact.

It was then held that there had been bad faith because of the registration of the domain name. As the panel put it:

> "In the present case, the Panel finds that this allegation (a breach of sub paragraph (ii)) is proved conclusively. It is true that Complainant has established a very full site to promote his activities at <www.steviewonder.net> but ***everyone knows that a '.com' site is to be preferred*** and it is where an Internet user looking for information about the singer would look first, so Respondent's registration of <steviewonder.com> has been a barrier to Complainant."

That proposition should give rise to some debate, although it is certainly supported by other panellists.

Sub-paragraph (iii)

Disrupting the business of a competitor

The relevant provision of the Policy is:

(iii) "the respondent has registered the domain name primarily for the purpose of disrupting the business of a competitor. "

This requirement is given a wide operation in decisions. A recalcitrant registrant may well have registered a domain name with the intention of misleading consumers and diverting internet traffic away from a competitor and to the registrant's own web site. In such cases it can be said that the registrant's intention is to disrupt the business of a competitor, namely the trademark owner.

Not surprisingly, there are as many variations on the facts as there are individual cases and it must be emphasised again that every effort should be made to adduce evidence to show that the only inference that can be drawn from the conduct of the respondent is that he intended to disrupt the business of the complainant.

Such cases can succeed but they can also fail. For a case that failed under this heading see ***Frederick M. Nicholas, Administrator, The Sam Francis Estate v. Magidson Fine Art, Inc*** WIPO Case D2000-0673 that we discussed above and which will arise for consideration again. It will be recalled that the respondent gallery was using the domain name <samfrancis.com> to sell paintings by Mr.Francis. The case failed on the issue of bad faith as, according to the majority, there was no evidence that the respondent registered and used the domain name for the purpose of profiting from the Complainant's service mark, that it engaged in a pattern of conduct, or was seeking to prevent the use of a mark by a competitor. Nor was there anything on the gallery's web site suggesting an affiliation between the respondent and Mr. Francis' estate and the respondent made no claim of trademark rights in either "samfrancis.com" or any other variation of the words "Sam Francis".

Sub-paragraph 4(b) (iv)

Creating confusion

The relevant provision of the Policy is:

> "(iv) by using the domain name, respondent has intentionally attempted to attract, for commercial gain, internet users to respondent's website or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of the respondent's website or location or of a product or service on the

site or location."

Many contests in defended UDRP cases revolve around whether the facts of the case bring it within this provision. The argument is often whether or not it can be concluded on the facts that the registrant was trying to mislead people into believing in effect that the goods and services being promoted on his website were endorsed by the trademark owner complainant. There are many examples of where the conclusion is that such was the intention and that, indeed, it was the result. But there are, of course, cases where the conclusion is to the contrary.

For example, in the ***Dan Marino Case*** *(supra*) there was a finding of bad faith under 4 (iv) because, as the panellist said:

> "The Domain Name resolves to a website at www.danmarino.com which is automatically linked to a site administered and operated by Respondents, www.multicenter.com, which provides a variety of sports, entertainment, trivia and other special programs and includes links to vendors of Dan Marino related products. Thus, Respondents intentionally attempt to attract visitors to www.danmarino.com for commerce. Dan Marino is not connected with these vendors, nor does he have a relationship of any kind with Respondents. Respondents are attracting users by creating a likelihood of confusion as to the source, sponsorship, affiliation or endorsement of their website, its products or its services."

Another example is ***Anne of Green Gable Licensing Auth., Inc. v. Internetworks***, AF-0109 (eResolution Case, June 12, 2000) where there was a finding bad faith where Respondent had used the domain name <anneofgreengables.com> to link users to a web site that contained information about the Anne of Green Gables literary works, motion pictures and the author, L. M. Montgomery. It was said by the panel that:

> "Respondent has admitted that it is aware of Complainant's registrations for the well-known mark ANNE OF GREEN GABLES. Respondent also admits that its purpose in registering the domain name was to attract Internet users to its web site who are seeking tourism information about Prince Edward Island, the Canadian locale that is intimately associated with the Anne of Green Gables literary works, motion pictures, television programs and merchandising.

> Indeed, the home page of Respondent's web site is entitled "Anne of Green Gables" and contains information about the Anne of Green Gables literary works, motion pictures and L. M. Montgomery, the author of the literary works. ***A visitor to the web site may very well believe that the owner of the mark ANNE OF GREEN GABLES is affiliated with or has sponsored or endorsed Respondent's web site***. In sum, Respondent's knowledge of Complainant's well-known mark ANNE OF GREEN GABLES, Respondent's use of that mark as a domain name to drive traffic to Respondent's tourism web site devoted to Prince Edward Island tourism, and the importance of the mark to the tourism information services contained on Respondent's web site are compelling evidence of Respondent's bad faith. Accordingly, the Panel finds that Complainant has met its burden to prove that Respondent registered and is using the domain name in bad faith."

A recent case to the same effect is ***Gene Kelly Image Trust v. BWI Domain Manager***, WIPO Case No. D2008-0342 where the domain name in the name of the famous dancer and actor led to a website with sponsored links "the majority of which relate to movies or Gene Kelly." This was held to constitute bad faith registration and use.

No study of celebrities would be complete without The Simpsons; the domain name <*thesimpsonsmovie.com*> was transferred as an application of sub-paragraph 4(b) (iv) in ***Twentieth Century Fox Film Corp. v. KeithMalley.com;*** WIPO Case No.D2007-0760.

The test to be applied

What is the test to be applied? One answer was given in ***Société pour l'œuvre et la mémoire d'Antoine de Saint Exupéry-Succession Saint Exupéry - D'Agay v.The Holding Company,*** WIPO Case No. D2005-0165. The panel put it this way:

> "The question that remains is whether ***an average Internet user is likely to get the impression of sponsorship or affiliation*** in the presence of a disclaimer (which may have been added only after the Complainant notified the Respondent). In the Panel's view, that likelihood exists. The "Respondent has intentionally attempted to attract, for commercial gain, Internet users to Respondent's website or other on-line location, by creating a likelihood of confusion with the

> complainant's mark as to the source, sponsorship, affiliation, or endorsement of Respondent's web site" (Paragraph 4(b)(iv)). That constitutes bad faith registration and use under the Policy.
>
> Put differently, the Respondent is using a valid, registered trademark (the Respondent's arguments that the name of famous deceased persons should not be protected as trademarks are not relevant in this context) in a commercial context, i.e., with the intent to generate commissions on sales of books and other memorabilia concerning Antoine de Saint-Exupéry. That does not constitute bona fide use." (emphasis added).

It is interesting to look at its application to the case of a sportsperson: ***Michael James Owen v. MSM Commercial Services***, WIPO Case No. D2006-0155. The panel said:

> "The Panel does not find it proven that the Respondent has engaged in a pattern of registering domain names in order to prevent the owner of the trade mark from reflecting the mark in corresponding domain names.
>
> However, as a result of the worldwide fame of Michael Owen, the Panel finds it inconceivable that Respondent should not have been aware of Michael Owen when registering the domain names at issue and therefore the Respondent could not have been unaware that the registration of the disputed domain names would infringe upon the Complainants' rights.
>
> The website resolving to the domain names at issue has redirected to a website entitled "The Michael Owen Football Page" which advertised a number of sports related websites offering products for sale. The registration and use of the disputed domain names thus appears to be an attempt to attract for commercial gain, Internet users to Respondent's website, by creating a likelihood of confusion with the Complainants' mark. This is evidence of bad faith registration and use pursuant to the Policy, paragraph 4(b)(iii).
>
> Accordingly, the Panel finds that the Respondent has registered and used the Domain Names in bad faith."

Other successes on bad faith

In ***Experience Hendrix, L.L.C. v. Denny Hammerton and The Jimi Hendrix Fan Club***, WIPO Case No. D2000-0364, Hendrix's estate won on bad faith as on the other issues, because of the Respondent's standing as a serial celebrity cybersquatter who, moreover, had offered to sell the domain name and others.

So we see again some of the various elements that have influenced panels to make findings of bad faith come together in the one case.To take one of the facts, evidence of the Respondent's being a serial offender, is helpful in establishing bad faith, but it is not essential and a Respondent may be found to have acted in bad faith even in those cases where it is obviously a one-off transgression. That was the situation in ***Richard Juzwin v. Glen Stephens Stamps,*** NAF Case No: FA00097690. (2001).

It will be recalled that in this case a stamp dealer had registered his rival stamp dealer's name as a domain name and linked it to his own site, so that customers of his rival did not even get to the rival's front cyberdoor. I had had a similar case where a real estate agent in Sydney had done a similar thing, but claiming that the rival's name was a generic name and that he was therefore entitled to do it. On the facts of that case, that was not a conclusion I could come to.

In the ***Richard Juzwin Case***, there was no such argument open to the party who registered the domain name, as <richardjuzwin.com> was clearly the man's own name, not a generic expression. In those circumstances the panel decided that such conduct, which is really pilfering your competitor's clients who are looking on the internet for him and not you, was bad faith.

The panel's decision gave a good summary of the whole bad faith issue and the sort of conduct that will establish it. It is worthwhile setting it out in full:

> "Respondent and Complainant are both in the same specialized field. Respondent is using the <richardjuzwin.com> domain name to resolve to its own website, thus preventing users from contacting Complainant's business. These circumstances provide strong evidence of bad faith registration and use pursuant to Policy ¶ 4(b)(iii). See *SR Motorsports v. Rotary Performance,* FA 95859 (Nat. Arb. Forum Jan. 4, 2001) (finding it "obvious" that the domain names were registered

for the primary purpose of disrupting the competitor's business when the parties are part of the same, highly specialized field); see also *Southern Exposure v. Southern Exposure, Inc.*, FA 94864 (Nat. Arb. Forum July 18, 2000) (finding that Respondent registered the domain name in question to disrupt the business of the Complainant, a competitor of the Respondent).

Furthermore, Complainant asserts that Respondent's use of the <richardjuzwin.com> domain name has already caused confusion and is likely to continue to do so as to whether Complainant sponsors, endorses or is otherwise affiliated with Respondent's website. Such an intentional attempt, for commercial gain, to cause confusion constitutes bad faith under Policy ¶ 4(b)(iv). See *Identigene, Inc. v. Genetest Lab*., D2000-1100 (WIPO Nov. 30, 2000) (finding bad faith where Respondent's use of the domain name at issue to resolve to a website where similar services are offered to Internet users is likely to confuse the user into believing that Complainant is the source of or is sponsoring the services offered at the site); see also *Net2phone Inc. v. Netcall SAGL*, D2000-0666 (WIPO Sept. 26, 2000) (finding constructive notice as a result of Complainant's widespread promotional efforts coupled with diversion from Complainant's site to Respondents for competing commercial gain is sufficient evidence of bad faith registration and use).

And finally, Respondent provided an incorrect address for the owner's contact information to (the registrar) Network Solutions, Inc. when Respondent registered the <richardjuzwin.com> domain name. Providing false or misleading information is further evidence of bad faith registration. See, e.g., *Home Director, Inc. v. HomeDirector*, D2000-0111, (WIPO Apr. 11, 2000) (finding that providing false or misleading information in connection with the registration of the domain name is evidence of bad faith).

Accordingly, the Panel finds that Policy ¶ 4(a)(iii) has been satisfied."

Note that in a proper case the panel will do some probing and arguing as it draws inferences from the conduct of the parties and in particular to see if the conduct of the respondent was consistent with the intention he declared in the proceedings.

An example of this was the case of Wayne Rooney, the Everton and then Manchester United footballer: ***Stoneygate 48 Limited and Wayne Mark Rooney v. Huw Marshall***, WIPO Case No. D2006-0916. The panel was faced with the situation where the trademark was registered after the domain name. After a long examination of the evidence, the panel concluded:

> "The Panel finds that when the Respondent registered the Domain Name he knew that the Second Complainant was likely to become a very hot property indeed and saw a benefit in registering the Domain Name with a view to creating a site and deriving a commercial benefit via that site. A high proportion of visitors to a site with the URL "www.waynerooney.com" would believe it to be the official website of the Complainants (in precisely the same way that people would expect "www.evertonfc.com" to be the official website of Everton Football Club) and would be visiting it for that reason. On reaching the site they might or might not appreciate that it is not an official site, but by then the deception will have occurred. If as is likely the site is offering (directly or indirectly) Wayne Rooney merchandise, there is a high chance that visitors will consider purchasing it. If they see other links that interest them, they will click on those links and thereby generate click revenue for the Respondent, the operator of the site.
>
> The Panel finds that registration of the Domain Name with that intent in the circumstances of this case constitutes bad faith registration and use. The fact that, as things have turned out, the Respondent has never actually got around to using the Domain Name is neither here nor there.
>
> This finding stems in part from the Panel's inability to accept as plausible the Respondent's claim that his fan site would be non-commercial and because the fan sites which the Respondent himself has cited as examples ("www.waynerooneyonline.com" and "www.davidbeckham.ws") are indeed commercial fan sites.
>
> Accordingly, the Panel finds for the Complainant under the third element of the Policy."

This is really a decision that says that if it can be shown that a respondent registered a domain name before the trademark was registered and if the panel can find that the respondent knew that in the future the domain name

was something he would be able to trade on commercially, that may well give rise to a finding of bad faith registration and use.

Bad faith also proved in **Tolkien's Case** *(supra)*, where the panel said:

> "On the evidence, the Panel accepts that the Respondent has used and is using the Disputed Domain Name to intentionally attempt to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the Complainant's distinctive TOLKIEN mark and has therefore registered and used the Disputed Domain Name in bad faith (paragraph 4(b)(iv) of the Policy). In the Panel's opinion, for the purposes of this paragraph 4(b)(iv) of the Policy, it does not matter that the Complainant may also benefit by visitors to the Respondent's site purchasing its licensed products by following the links provided on the site. The fact remains that the Respondent has also benefited financially (as it has admitted) and the Panel finds that the Respondent has created a likelihood of confusion as to the source, sponsorship, affiliation or endorsement of its site."

More recently, bad faith in the general sense, rather than within one of the defined criteria under paragraph 4(b) of the Policy was found in ***Die Marlene Dietrich Collection GmbH V. Johan Duplesis Du Plesis*** WIPO Case No.D2007-1306; it was said that when a domain name in the name of such a famous person as Marlene Dietrich was registered the panel could conclude that " the Respondent registered the Domain Name with the intention of exploiting, in one shape or form, the goodwill associated with the Complainant's widely known trademark…".

Cases where bad faith has not been proven

Not all cases have gone in favour of the celebrity on the issue of bad faith, however.

For example, in ***White Castle Way, Inc. v. Jacobs***, WIPO Case D2004-0001 (2004), ***the Pat Benator Case***, it was said:

> "Respondent's website provides a wide range of information concerning Pat Benatar, the recording artist. There are clear

> disclaimers on the website stating that it is not endorsed by or an official website of the recording artist. There is no evidence on the record of this proceeding that Respondent obtains any commercial benefit from the website. While he does make a recommendation regarding the Internet retailer which he believes to stock the widest selection of the recording artist's work, there is no evidence that Respondent receives compensation from the retailer. Respondent is not seeking to disparage the recording artist. Complainant was aware of Respondent's website and activities for a substantial period, and requested that his website be linked to its official website before changing its view and attempting to obtain a transfer of the disputed domain name. The combination of these factors leads the Panel to conclude that Respondent is engaging in legitimate non-commercial use of the disputed domain name."

That extract contains a host of indicia which, when taken together, justify a finding that the respondent was not acting with any of the immorality or malevolent intention that we have also seen has to be present in one form or another before there can be a finding of bad faith registration and use.

To a similar effect was the majority decision in ***Frederick M. Nicholas, Administrator, The Sam Francis Estate v. Madison Fine Art, Inc*** WIPO Case D2000-0673. You will recall that this was one of those cases where there was a split decision, which often gives rise to interesting reading, especially in this case, where the dissenting opinion was given by the presiding panellist.

It will be recalled that the Respondent registered the domain name <samfrancis.com> and used it for a website which sold only Sam Francis paintings, but from an art gallery that made it plain that it was a commercial gallery that was selling paintings by Francis, without claiming that it was Sam Francis' own website.

The Panel found that the name 'has acquired distinctiveness and secondary meaning as a common law trademark and service mark when associated with works of art.' Thus, the complainant was successful in Round One.

However, the respondent gallery that had registered the domain name won Round Two. This was so because the Panel found that the Respondent gallery had a right or legitimate interest in the domain name because.

although it had intentionally sought to attract consumers by using the SAM FRANCIS name in the website www.samfrancis.com, he also made it clear that it was “a commercial art gallery selling Sam Francis works. There (was), therefore, no misleading assertion that it is sponsored or authorized by the artist. Similarly, the use does not tarnish the reputation of the artist, since it is presumably his paintings that are offered for sale here”.

The majority therefore decided in favour of the respondent on that issue and of course if the respondent wins on any of the three issues, it must succeed overall.

The dissenting panellist however said that, on his interpretation of the evidence, the gallery owner had:

> ‘…intentionally attracted consumers by creating the impression that the website www.samfrancis.com is sponsored or authorized by the artist.’

Accordingly, in the view of the dissenting panellist, the respondent by that conduct had negated the claim that he had a right or legitimate interest in the domain name. He would therefore have also scored Round Two to the complainant.

On the votes of the entire three person panel, the complainant had lost at this stage, as he had not succeeded with a majority of the panel finding in his favour on the second ground and there was therefore no need to proceed to the third issue.

But the Panel did go on to consider the issue of bad faith. On that issue the majority said:

> “The majority of the Panel’s analysis, on the issue of any bad faith registration and use, must take into consideration that Respondent offers artwork by the late Sam Francis for sale at www.samfrancis.com. There is no allegation or suggestion that anything other than Mr. Francis’ art is available at the site. There is nothing on the site suggesting an affiliation between Respondent and Mr. Francis’ estate. Respondent makes no claim of trademark rights in either "samfrancis.com" or any other variation of the words "Sam Francis".

> On these facts, the majority of the Panel does not conclude that Respondent has registered and used the Domain Name in bad faith under Policy paragraph 4(a)(iii). To use an artist's name as an informational reference in the context of otherwise legitimately offering that artist's genuine work for sale to the public may well constitute a fair use under applicable trademark law. However, determination of the issue of whether Respondent's registration and use of the domain "samfrancis.com" is to be deemed a fair use is more properly, we believe, for the courts, to decide and is not contemplated as an issue to be determined under the ICANN Policy and Rules. As noted above, if this is a fair use, then Respondent would have a legitimate interest in the Domain Name and would not be deemed to have registered or be using the name in bad faith.
>
> The majority of the Panel does not believe, therefore, that this forum is the appropriate one for resolving the instant dispute, ***nor do we believe that the Complainant has met its burden of proof on these facts."*** (emphasis added).

It is clear that this was a decision that the claim of registration and use in bad faith had not been made out. Accordingly, the complainant had also lost on Round Three and was thoroughly out.

The dissenting presiding panellist decided that there was bad faith, although his vote could not carry the day. He said:

> 'My analysis of bad faith focuses on Policy paragraph 4(b)(iv)[37].In my analysis above of rights or legitimate interests, I would have concluded that, because the Domain Name is identical to the SAM FRANCIS marks, Respondent has intentionally attracted consumers by creating the impression that the website www.samfrancis.com is sponsored or authorized by the artist. Therefore, the elements of paragraph 4(b)(iv) have been met.
>
> I would find that Complainant has shown the existence of the elements in the Policy paragraph 4(b)(iv).'

[37] i.e.whether the gallery owner had acted in a misleading way.

In the counterfoil to the ***Sam Francis Case,*** the later case of ***Thomas Blackshear v. Christ-Centered Mall, Inc.***, WIPO Case No. D2002-0736, the panel found that the domain name in that case had been registered and used in bad faith because

> "In evaluating the facts in this case, where Respondent does offer the works of other artists at its site, the Panel concludes that Respondent, fully aware of the notoriety of Complainant's name, has intentionally attracted consumers to Respondent's web site for the purchase of those works (as distinct from Complainant's works, which Respondent also hopes to sell) by creating the false impression that they are sponsored or endorsed by Complainant.
>
> Thus, the Panel finds that the elements of Paragraph 4(b)(iv) of the Policy apply in this case and that Respondent has registered and is using the disputed domain name in bad faith."

Some observers would say that the dissenting view in the ***Sam Francis Case*** is the more generally accepted approach in UDRP cases. For example, when the panel in ***Estate of Shakur v. Shakur Info Page***, AF-0346 (eResolution Sept. 28, 2000) found bad faith in registering a domain name in the artist's name and not much else, other than the fact that the Respondent's email address was at a site that sold bootlegged Shakur CDs, it made an adverse finding on bad faith against the Respondent and relied among other grounds on the following:

> "(iii) the false representation inherent in the contested domain name that its owner is officially associated with the complainant;…"

In other words, the Panel's view was that the implication in putting up the domain name and the incipient website was that it was the website of Shakur or his estate, an implication that justified a finding of bad faith.

Indeed, one can say that when the evidence comes up to scratch and is persuasive on the balance of probabilities, the regular result is that the panel finds bad faith. For example, as you will recall, ***Nicole Kidman v. John Zuccarini, d/b/a Cupcake Party*** WIPO Case No. D2000-1415 concerned the domain names <nicholekidman.com> and <nicolekidmannude.com> and the Respondent was the well-known cybersquatter John Zuccarini. This was a bad case as the Respondent had linked <nicolekidmannude.com> to a

salacious website and apparently both domain names to a series of pop –up sites resulting in the internet user being ‘mousetrapped’. The Panel found that Ms Kidman had common law trademark rights to her name and that the Respondent had no right or legitimate interest in the domain names. On the issue of bad faith that the Panel then had to consider it said:

> “Zuccarini’s registration and use of the domain name is in bad faith. As noted above, the only explanation of Zuccarini’s actions is that he intended to divert the internet traffic of persons intending to find websites legitimately associated with Kidman, and that he appears to have done so to profit from fees paid by advertisers. This in and of itself can show bad faith. See Policy ¶ 4(b)(iv) (it is evidence of bad faith that, "by using the domain name, [the respondent] ha[s] intentionally attempted to attract, for commercial gain, Internet users to [his or her] web site or other on-line location, by creating a likelihood of confusion with the complainant’s mark as to the source, sponsorship, affiliation, or endorsement of [the respondent’s] web site or location or of a product or service on [the respondent’s] web site or location.").
>
> In addition, the many arbitral and judicial decisions rendered against Zuccarini show that his behavior is part of an overall pattern of misuse of famous marks for illegitimate purposes. His practice of profiting from the good name of others is evidence of his bad faith registration and use of the domain names <nicholekidman.com> and <nicolekidmannude.com>.
>
> We therefore find that Zuccarini has registered and used the domain names in bad faith.”

Moreover, in ***Nick Cannon v. Modern Limited - Cayman Web Development,*** WIPO Case No.D2005-0757, the panel had no trouble finding that the Respondent had no right or legitimate interest in the domain name and that it had registered and used it in bad faith because, as the Panel put it,

> “The evidence shows in this present case that the domain name in dispute does not direct Internet users to a fan site for the Complainant but to a website of totally unrelated links to other web pages, including links to pornographic websites, as this Panel observed in its

> verification. The Panel finds that these activities, in addition to the pattern of "cybersquatting" on hundreds of domain names confusingly similar to the names of other famous persons and companies, demonstrate use of the domain name in dispute in bad faith."

Another one of Mr. Zuccerini's cases with a similar result was ***Abercrombie & Fitch Stores, Inc. and A & F Trademark, Inc. v. John Zuccarini d/b/a/ Cupcake Patrol***, Case No. D2000-1004 (WIPO Nov.1, 2000) where the celebrity outfitter easily succeeded on all grounds.

Still another example of bad faith having been proven in a defended case was ***Bernardka Pulko v. Greg Frazier***, WIPO Case No. D2006-0099, the case of the Slovenian lady motorbike rider. The panel said:

> "The domain name <benkapulko.com> is used for commercial gain, namely to sell different products or advertisements connected with motorcycling. This reflects Respondent's attempt to attract users to its website by improperly associating itself with Complainant's mark and name and misleadingly suggesting an affiliation with, or sponsorship by, Complainant."

Finding of no bad faith

Sometimes the panel will decide the case by making a finding against there having been bad faith because it cannot decide it, as it were, as the conflict in evidence is so great and the UDRP process does not lend itself to hearings, cross examination of witnesses and other processes that would in a court enable more definite findings of fact.

That was the position in ***Bob Avila v. B&B Productions***, WIPO Case No. D2004-0013, the case of another celebrity horse trainer where the conflicts in evidence were so great that the panel concluded that the case had not been made out.

> "The Complainant is a horse trainer and showman of American Quarter Horses. He has successfully competed in Quarter Horse Association, National Reigning Horse Association and National Reined Cow Horse Association events. The Complainant has also marketed and sold books and video tapes demonstrating his

> techniques in training and showing American Quarter Horses. He has also commercially sponsored products used in the horse industry."

The allegation was that the respondent had gone into partnership with the complainant on the domain name and website, but this was denied by the complainant. There were too many conflicts in the evidence for the panel to decide the issue of bad faith.

The panel might also make a finding of no bad faith having been made out because the Complainant was merely making assertions and not proving the case and, in the course of that, putting too much of a burden on the panel itself to make out the Complainant's case for it.

This was so in the case of the Czech pornography star Sylvie Saint in ***Silvie Tomčalová a.k.a. Sylvia Saint v. Juan Campos***, WIPO Case No. D2006-0379 where the result was a finding of no bad faith and where the claim consequently failed.

Of course in some cases, the evidence is unsatisfactory, but it leads the panel to conclude that there probably *was* bad faith, rather than that the case for bad faith was not made out. That was so in Glory ***Establishment v. FutbolMasters Ltd., FW, FM, Steve Leighton***, WIPO Case No. D2007-0439 concerning the footballer Pele, where the panel said:

> "By the same reasoning (as the panel had used in rejecting the argument that the respondent had a right or legitimate interest in the domain name) the Panel is not prepared to accept the Respondent's denials as to bad faith with regard to registration and use of the Domain Names. Forensically, the Panel asks: why submit what would appear to be an inaccurate record as to the purpose of the registrations if it is not to conceal a mala fide intent in respect of the Domain Names?
>
> It seems strange that a body such as the Respondent, which is said to be involved in United Nations Development and Peace initiatives, should behave in this way, but the correspondence from Pele and the lack of persuasive evidence or further explanation from the Respondent leave the Panel with no scope for any other interpretation.

> The Panel finds that the Respondent registered the Domain Names ***for a purpose which the Respondent is not prepared to confirm*** and which in all probability was to attract/divert Internet users for commercial gain along the lines of paragraph 4(b)(iv) of the Policy."(emphasis added).

In other words, the panel will look at all of the conduct of the respondent , even during the proceedings and draw inferences from what the respondent has done and said and even from its silence and use these considerations to decide that there was bad faith registration and use.

Again, this shows the importance of presenting the best case possible by way of evidence and submissions.

A further good illustration of how a panel will work its way to a finding of no bad faith use and registration is ***Borges, S.A., Tanio, S.A.U. v. James English,*** WIPO Case No. D2007-0477, a case we have already looked at in the context of rights and legitimate interests.

The complainant was in trade, in fact as a manufacturer and had a trademark on the name BORGES, but the respondent registered the domain name in the name, he thought, of the famous writer of the same name and did not know of the complainant, an explanation which the panel accepted. This was the foundation of a finding that bad faith had not been shown.

The views of the panel on bad faith were expressed as follows:

> "Firstly, a finding of bad faith registration and use requires at least evidence that the Respondent knew of the Complainant or its mark. The Respondent has plausibly denied having such knowledge of the Complainant. The word element of the Complainant's mark is apparently subject to substantial third party use. It is not only identical to the surname of a worldwide known writer, but apparently also to other trademarks, all of which suggests that the word part of the Complainant's trademark is not as distinctive as the Complainant would claim.
>
> In other words, the more generic the word part of a trademark, in many cases the less distinctive it will be in the market, and the more difficult it will be to impute knowledge to the Respondent. In these

> circumstances, even if the Respondent had actively searched (before registering the disputed domain name) for prior rights in the term "Borges" - e.g. by typing that term into a search engine - it does not appear that he should have identified the Complainant as having distinct or exclusive rights in that term."

No other ground could be found against the respondent to negate right or legitimate interest and nothing to show bad faith. So the complainant lost.

An earlier case where the Complainant failed to prove bad faith was the **Albert Einstein Case,** ***The Hebrew University of Jerusalem v. Alberta Hot Rods***WIPO Case No. D2002-0616.

On this issue, the panel said:

> "Complainant relies on paragraph 4(b)(ii) of the Policy, claiming Respondent registered the disputed domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, and that Respondent has engaged in a pattern of such conduct.
>
> There is no doubt Respondent has previously been found by several Panels to have engaged in conduct of that kind, sufficient to constitute a pattern. However, there is no evidence Respondent had Complainant in mind when registering the disputed domain name and …it was unaware Complainant claimed trademark rights in the name ALBERT EINSTEIN.
>
> It is not sufficient, to establish bad faith under this paragraph, simply to show that the registration of a domain name necessarily prevents someone else from registering the exact same domain name. Although it is not necessary that a Respondent be shown to know the identity of the trademark owner, it must at least be shown that Respondent was aware that the domain name was identical or confusingly similar to a mark.
>
> Here there was no reason for Respondent to believe that the name ALBERT EINSTEIN was or was claimed to be a trademark. The Panel therefore finds Respondent has not been shown to have

> registered the disputed domain name in order to prevent the owner of the mark from registering the corresponding domain name. … Complainant also relies on paragraph 4(b)(iv) of the Policy, claiming Respondent intentionally attempted to attract, for commercial gain, Internet users to Respondent's web site or other on-line location, by creating a likelihood of confusion with Complainant's mark as to the source, sponsorship, affiliation, or endorsement of the web site and the activities therein. Such a claim was upheld in ***Stephanie Seymour, Celine Dion, Julie Brown*** and ***Michael Andretti,*** all cases of living celebrities whose names had become distinctive of their goods or services before Respondent registered the domain names in issue.
>
> Here the Panel has accepted that Respondent was unaware that Complainant claimed trademark rights in the name ALBERT EINSTEIN. Accordingly, although Respondent intentionally attempted to attract Internauts, for commercial gain, to his website, it did not attempt to do so by creating confusion with a trademark, since it had no reason to suppose that the name ALBERT EINSTEIN was a trademark. To the contrary, it had every reason to believe that Dr. Einstein did not engage during his lifetime in commerce and did not therefore have trademark rights in his name at the time of his death."

Sometimes the evidence is just not there, as in ***Pearl Jam, A General Partnership v. Streaming Digital Media Dot Com c/o Brian J. Spencer*** NAF Case: FA0235831. On bad faith the Panel said:

> "There is no evidence that any of the circumstances in paragraph 4(b) of the Policy apply to Respondent' and hence no evidence of bad faith."

Pearl Jam had more success in obtaining domain names in the following cases: ***Pearl Jam, A General Partnership v Phoebe's Fantasy Playhouse and n/a c/o John Hewell,*** NAF Case No: 226451; ***Pearl Jam, A General Partnership v Adot LP c/o Robert Dunlap,*** NAF Case No: 232955; ***Pearl Jam, A General Partnership v Francesco Catalano,*** NAF Case No: 236583 ; and ***Pearl Jam, A General Partnership v Vertical Axis, Inc. c/o Domain Administrator***, NAF Case No 593325 .

Bad faith by inaction: ***Telstra v. Nuclear Mushrooms***

It is not always necessary to prove positive acts of the respondent going to show bad faith. That is so because celebrity cases have also been able to establish the requirement of bad faith by inaction under the principle espoused in ***Telstra v. Nuclear Marshmallows.***

Thus it was said in ***Michael J. Feinstein v. PAWS Video Productions***, WIPO Case No. D2000-0880 that "…the Respondent posted no content on the corresponding website prior to receiving notice of this dispute and that such failure to post content constitutes "inaction" under *Telstra*. This inaction considered together with the refusal of Respondent to communicate with Complainant and with the creation of a firewall to block Complainant's monitoring of content constitute a separate basis for finding bad faith."

The same view was expressed in Société ***pour l'Oeuvre et la Mémoire d'Antoine de Saint Exupéry – Succession Saint Exupéry – D'Agay v. Perlegos Properties***, WIPO Case No. D2005-1085.

Falling at the last hurdle

Accordingly, although celebrity cases have been successful and as part of that success have involved findings of bad faith in the registration and use of the domain name, they sometimes, like other cases, fall down on an inability to prove bad faith even although the earlier two elements have been proven.

One such case is ***Edward Van Halen v. Deborah Morgan,*** WIPO Case No. D2000-1313, concerning the co-founder of the hard rock band, Van Halen. When it got to the issue of bad faith the panel said that it:

> "… cannot infer bad faith without other evidence. If Respondent were to make use in the future and seek commercial gain by creating confusion, then Complainant might at that time have a better case, but that is not the circumstance presented here. See *Nintendo Inc. v. Alex Jones,* Case No. D2000-0998 (WIPO, Nov. 17, 2000).
>
> There was no breach of any of the specific tests in the Policy and no suggestion of general bad faith. There was no attempted sale and no commercial elements.

> Simply put, the evidence here is insufficient to justify a finding of bad faith. Instead, Respondent claims that she has a desire to use the domain name for a legitimate fan site and, if she follows through on that intention, it would not constitute the kind of abusive, bad faith cybersquatting that the Policy is designed to prevent."

Another case was ***Estate of Gary Jennings v. Submachine***, WIPO Case No: D2001-1042, where it was said on the earlier issue of right or legitimate interest that:

> "Based upon a review of Respondent's web site, Respondent appears to be providing reviews of Gary Jennings' books; and not advertising. Based on the record, before any notice to Respondent of the dispute, it appears that Respondent was using the Domain name in connection with a bona fide offering of goods and services. Respondent has been using the Domain name in connection with a web site to share information on the author Gary Jennings. The Panel finds on this basis that respondent has a legitimate interest in the Domain name."

This was a genuine fan site with no commercial content, although it did have a link to www.amazon.com., although apparently not for commercial gain to the Respondent, but just so the reader could see other reviews and buy the books, with no advantage to the registrant. So as the complainant had not proved this, the second element, it failed.

But the panel went on to consider bad faith and found that there had not been bad faith. On the issue of bad faith the panel said that although the respondent also had other celebrity domain names, "…(t)he Panel is not persuaded that Respondent has engaged in a pattern of registering domain names in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name as required by the Policy pursuant to subparagraph (ii) above." Moreover, the respondent had made no effort to sell the domain name, it did not appear that Respondent sought to disrupt Complainants' business and although the domain name was linked to a commercial outlet, "…based on the evidence presented, Respondent has not sought commercial gain." So bad faith had not been made out.

Improper use of a fan site may amount to bad faith

We have already looked at ***Kevin Spacey v. Alberta Hot Rods*** NAF Case No: FA0114437 under other elements and this is one case where the case was made complete with an adverse finding on bad faith. The panel said:

> " Complainant argues that both of Respondent's uses of the kevinspacey.com> domain name--first diverting Internet traffic to celebrity1000.com> and then connecting the domain name to an unauthorized fan website--constitute an opportunistic attempt to trade off Complainant's fame. Complainant contends that Respondent's initial use of the domain name, before notification of Complainant's objections, is bad faith under Policy ¶ 4(b)(iv) because Internet users were misleadingly diverted to the <celebrity1000.com> domain name that had banner advertisements from which Respondent profited. We agree."

In the other ***Spacey Case, Kevin Spacey v John Zuccarini***, NAF Case No: FA0096937, the domain name at issue was <kevinspacy.com> so there was a spelling difference. On the issue of bad faith, that was again found to be established, for:

> "Respondent is a well known cybersquatter and has "admitted that he registered…thousands of other domain names because they are confusingly similar to others' famous marks and personal names…in an effort to divert Internet traffic to his sites…. For example, he has registered obvious misspellings of celebrities names, such as gwenythpaltrow.com, rikymartin.com, and britineyspears.com." See *Shields v. Zuccarini and Cupcake Patrol*, 89 F. Supp.2d 634, 640 (E.D. Pa. 2000)."

The Respondent also did not use the website for a legitimate purposes but for carrying pop up ads for which he was paid. So there was no legitimate interest in the domain name and the same considerations gave rise to the conclusion that there had been bad faith in the registration and use of the domain name.

To a similar effect was the decision in ***George Harrison v LOVEARTH.net***: NAF Case No.FA0097085, where the decision on bad faith was that the domain names had been registered and used in bad faith although there had been a desultory argument that the domain name was being used for a fan site. The panel said:

> "Respondent has shown bad faith by offering to transfer most of the domain names involving Complainant, and then withholding some of them. … because Respondent has intentionally attempted to attract, for commercial gain, Internet users to Respondent's web site or other on-line location, by creating a likelihood of confusion with Complainant's mark as to the source, sponsorship, affiliation, or endorsement of the website and the activities therein… because the registration of the multiple domain names similar to Complainant's trademark establishes a pattern of conduct preventing the owner of the trademark or service mark from reflecting the mark in a corresponding domain name…(and)…"fan sites," such as Respondent claims to maintain, do cause confusion as to their source, sponsorship, affiliation, or endorsement vis-à-vis the celebrity. Further, the nexus between Respondent's domain name sales business and its environmental pursuits is close enough to satisfy the commercial gain provision of Paragraph 4(b)(iv) of the Policy. See *Jews for Jesus v. Brodsky*, 993 F.Supp 282, 309 (D.N.J. 1998) (holding that to be considered commercial, it is not necessary for a website to make a profit)."

Another failure of the grounds of bad faith although the Complainant has succeeded on the previous two issues was ***Mark Warner 2001 v Mike Larson*** NAF: FA0095746. The case failed on bad faith although it had succeeded on all other grounds including the doubtful ruling on a politician having common law rights even without any evidence of monetary commitment to the name or earning money through commerce involving the name. It failed on the ground that there was no bad faith as "While the use of a candidate's name or campaign as a domain name will attract internet users, the attraction is arguably for political, not commercial gain."

It was a similar process in ***Nintendo of America Inc. v. Alex Jones*** WIPO Case No. D2000-0998; in other words, the complainant succeeded on the first two elements but lost on the third element, bad faith and hence lost the entire proceedings.

This decision is particularly interesting as there was a robust finding that the respondent who had registered the domain name had no right or legitimate interest in doing so and no valid claim that he was running a fan site, yet this

was followed by a finding that he had not registered or used the domain name in bad faith. It was , for the young respondent, a very narrow escape.

The Respondent had registered <legendofzelda.com> as a fan site for fans of the popular Nintendo game. He agreed that the domain name was identical to the trademark, but he claimed he had a right or legitimate interest in the domain name and he denied that he had registered or used it in bad faith. The panel rejected his claim that he had a right or legitimate interest in the domain name for reasons that we have already seen. However, when it came to the issue of bad faith, he was successful; the panel found that he had not been guilty of bad faith. On that it issue it said :

However the Panel went on and decided that the Complainant had not proved bad faith. The panel went through every relevant consideration and concluded that evidence showing bad faith was simply not there. The panel said:

> “The Respondent has made no effort to sell the subject domain name.
>
> Although the Complainant says that the registration of the subject domain name prevents it from "…reflecting [its] mark in a corresponding domain name", there is no evidence that the Respondent has engaged in a pattern of such conduct as required by the Policy.
>
> The evidence does not support a finding that the Respondent seeks to disrupt the business of the Complainant. In fact, the opposite appears to be true.
>
> The evidence is clear that the Respondent has not sought commercial gain. Although his website contains links to commercial outlets, he states that he derives no personal gain.
>
> The circumstances in the Policy from which evidence of bad faith can be inferred are not present. Taking the evidence as a whole, there is no other basis on which the Administrative Panel could find bad faith.”

So, the respondent still won after all and the web site is still operating today. It is worth looking at; see www.legendofzelda.com.

The other consideration emerging from the case and from looking at the website, although not strictly relevant to our considerations, is how the complainant could have thought that any harm was being done to it by the efforts of this band of young devotees who seemed to have nothing at heart but the welfare and advancement of the complainant and its computer game.

Conclusion on this issue

It is perhaps healthy to see decisions on the issue of bad faith going both ways, as it shows the impartiality of the system and above all the importance of evidence, which can result in the decision going one way or the other.

Celebrities as Respondents

Of course celebrities can sometimes be Respondents, not complainants. But the only one I know of was unsuccessful. It is ***Morgan Stanley v. Meow*** NAF: FA0604000671304. In that case the full name of the Respondent was Meow ("Respondent"), Baroness Penelope Cat of Nash DCB, Ashbed Barn, Boraston Track, Tenbury Wells, Worcestershire WR15 8LQ, GB. The domain name at issue was <mymorganstanleyplatinum.com>. It is an amusing decision and one which is authority for the proposition that a domain name may not be registered in the name of a cat

Another odd situation is where the domain name is the celebrity or it is said to be, but where the celebrity is not the complainant, the respondent had clearly never heard of the complainant and the complainant had probably never heard of the celebrity. That was the case in ***Borges, S.A., Tanio, S.A.U. v. James English*** WIPO Case No. D2007-0477, to which reference has already been made. The disputed domain name was <borges.com>, registered to invoke the name of the author, but the claim was brought by the Borges company. The respondent claimed to be a fan of the writer Borges. The domain name was directed to a site presumably maintained by the registrant with links, some of which were to sites dealing with the writer. It was held that that the registrant had a right or legitimate interest in the domain name, as the site was used only as a critical literary site and could not have been in competition with the complainant's products.

Conclusion

Perhaps a fitting conclusion about celebrities and their domain names might be said to be the remarks of a very experiences panellist Mr Peter Michaelson in ***MPL Communications, Limited and MPL Communications, Inc. v LOVEARTH.net*** NAF Case No: FA0097086:

> "A celebrity, having rights resulting through registration and/or common law, is entitled to the exclusive control and exploitation of his (her) mark in connection with the goods and services with which that celebrity is associated and provides (either directly or, e.g., via license) under that mark."

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