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WWW.YOURNAME.COM: How Useful is the Uniform Domain Name Dispute Resolution Policy ("UDRP") in Protecting Personal Names From CyberSquatters?, 22 J. Marshall J. Computer & Info. L. 535 (2004)

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ARTICLES

WWW.YOURNAME.COM: HOW USEFUL IS THE UNIFORM DOMAIN NAME DISPUTE RESOLUTION POLICY (“UDRP”) IN PROTECTING PERSONAL NAMES FROM CYBERSQUATTERS?

GEORGETTE H. TARNOW†

I. INTRODUCTION

Paul McCartney is a personal name that is also a registered trademark in the United States and the United Kingdom.¹ George Harrison, as is true of most personal names, is not a registered trademark.² One may attempt to protect one’s personal name through a number of legal theories, using the right of publicity laws, dilution statutes, and anti-cybersquatting legislation. The Uniform Domain Name Dispute Resolution Policy (“UDRP”)³ can be another effective tool to stop the use of one’s personal name as part of a domain name. When the personal name in question is not a registered trademark, however, the outcome of the dispute is not predictable.

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1. *MPL Communs. Ltd. v. Lovearth.net*, No. FA0104000097086 (Natl. Arb. Forum June 4, 2001) (available at <<http://www.arbitration-forum.com/domains/decisions/97086.htm>>) (disputing <paul-mccartney.com>, <paul-mccartney.net>, and <sirpaulmccartney.com>).

2. *Harrison v. Lovearth.net*, No. FA0104000097085 (Natl. Arb. Forum June 14, 2001) (available at <<http://www.arbitration-forum.com/domains/decisions/97085.htm>>) (disputing <georgeharrison.com>, <george-harrisoncom>, <george-harrison.org>, <george-harrison.net>, <georgharrison.org>, and <georgeharrison.net>).

3. See ICANN, *Uniform Domain Name Dispute Resolution Policy*, <http://www.icann.org/dndr/udrp/policy.htm> (Oct. 24, 1999).

II. BACKGROUND

In the early days of the Internet, domain names were viewed by some as being similar to addresses or telephone numbers. From that perspective, trademark rights would be irrelevant, as a trademark owner has no particular right in an address or telephone number merely because it has the trademark within it. As an example, a hotel chain with a telephone number consisting of 1-800 and its mark⁴ was found not to have rights in similar telephone numbers.⁵

However, although domain names are used to identify Web sites, they are quite different from addresses and telephone numbers in one substantial way: they are not organized. An Internet user can perform a search and locate hundreds if not thousands of Web sites. Often the user then guesses at the domain name of the desired Web site. Typically, if the Web site is related to an individual, one types that person's name with ".com" appended. Therefore, a trademark owner, whether of a registered or common law mark, needs to assert rights in any domain name that corresponds with his or her trademark because "[a] battle over a domain name is essentially a battle for the same 'intuitive' domain name: a domain name that makes sense without looking it up, because there is as yet no official directory of websites or domain names."⁶ A domain name owned by someone else but incorporating one's mark can easily divert Internet users from the trademark owner's site.

Early attempts to provide relief against cybersquatters, those who hoard domain names, were based on dilution laws and were largely ineffective. According to *McCarthy on Trademarks and Unfair Competition*, "cybersquatting has been held to be a form of dilution" and that "[i]n the author's opinion, there is a very poor fit between the action of a cybersquatter and the federal Anti-Dilution Act."⁷

The issue of domain names incorporating personal names was also addressed in the United States by the *Anti-Cybersquatting Consumer Protection Act* ("Act").⁸ The Act has a provision specifically for relief against the unauthorized use of personal names that are not registered trademarks. It too, is of limited assistance, as a defendant is not liable unless he had registered the domain name "with the specific intent to profit . . . by selling the domain name for financial gain."⁹ If the defen-

4. *Holiday Inns, Inc. v. 800 Reservation, Inc.*, 86 F.3d 619 (1996).

5. Holiday Inns had the telephone number 1-800 HOLIDAY and the defendant was allowed to keep the 800 number with the word "HOLIDAY" where the "O" was replaced by "zero" or the "I" was replaced by "one." *Id.*

6. J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition*, § 25:73 (4th ed., Clark, Boardman & Callaghan 2002).

7. *Id.* at § 25:77.

8. 15 U.S.C. § 1125.

9. 15 U.S.C. § 1129 1(A).

dant had no such intention, this Act provides no relief for the person whose name is being used.

III. THE UNIFORM DOMAIN NAME DISPUTE RESOLUTION POLICY

Although domain name lawsuits can be brought in U.S. courts and the courts of various countries, most disputes are handled through the Internet Corporation for Assigned Names and Numbers ("ICANN"),¹⁰ which adopted the UDRP in August 1999. ICANN relies on the voluntary participation of domain name registrars and has authorized the World Intellectual Property Organization ("WIPO"),¹¹ the National Arbitration Forum ("NAF"),¹² the Disputes.org/eResolutions Consortium,¹³ and the CPR Institute¹⁴ to resolve domain name disputes.¹⁵ WIPO receives most of the domain name controversies; by May 2003, five thousand cases had been filed with that organization.¹⁶ A survey of the first 1,200 disputes handled under the UDRP revealed that WIPO decided sixty-one percent, and the NAF, thirty-one percent, of the domain name decisions.¹⁷ I limited my analyses to decisions from these two fora.

Under the UDRP, complaints may be heard by a single panelist or, if requested, a three-person panel.¹⁸ WIPO, for example, has 354 panelists available from forty-eight countries.¹⁹ The only two remedies available in these domain name controversies are the transfer of the domain name registration from the Respondent to the Complainant or its cancellation. The latter is of no practical use; the domain name then could be registered by a third party necessitating another challenge by the Complainant. Three elements must be alleged by the Complainant. First, that the

10. ICANN, *Home*, <http://www.icann.org> (accessed April 26, 2004).

11. WIPO, *Home*, <http://www.wipo.int> (accessed April 26, 2004).

12. National Arbitration Forum, *Home*, <http://www.arbitration-forum.com> (accessed April 26, 2004).

13. *Domain Name Administrative Decisions*, <http://www.disputes.org> (accessed April 26, 2004).

14. CPR Institute for Dispute Resolution, *Home*, <http://www.cpradr.org> (accessed April 26, 2004).

15. UDRP ¶ 4(d).

16. WIPO, Press Release, *Update 193/2003* (May 20, 2003) (available at <www.wipo.int/pressroom/en/updates/2003/upd193.htm>). As of January 7, 2004, 5,582 cases have been filed, with parties from 115 countries. See WIPO Arbitration and Mediation Center, *Geographical Distribution of Parties Cumulative*, <http://www.arbiter.wipo.int/domains/statistics/cumulative/countries.html> (last updated April 26, 2004).

17. Dr. Milton Mueller, *Rough Justice: An Analysis of ICANN's Uniform Dispute Resolution Policy* § Executive Summary, <http://www.acm.org/usacm/IG/roughjustice.pdf> (Nov. 2000).

18. Rules of the UDRP ¶ 6.

19. WIPO Arbitration and Mediation Center, *WIPO Domain Name Panelists*, <http://arbiter.wipo.int/domains/panel/panelists.html> (last updated April 26, 2004).

“domain name is identical or confusingly similar to a trademark or service mark” in which he or she has rights.²⁰ Second, that the Respondent has no right or legitimate interest in the domain name.²¹ Third, one must allege that the domain name was registered and used in bad faith.²² The decisions are not binding; the losing party can file a lawsuit.²³

The UDRP Rules provide that a “Panel shall decide a complaint on the basis of . . . any rules and principles of law that it deems applicable.”²⁴ This is especially important because the parties may not be domiciled in the same country. Most of the decisions I discuss relied on U.S. trademark law, but as will be shown, a few applied English law.

In the “Report of the Second WIPO Internet Domain Name Process” (“Report”) published September 3, 2001,²⁵ it was recognized that “the legal principles and policies that can be deployed to protect personal names are . . . diverse and vary, as might be expected, from country to country.”²⁶ Thus, the Panels have a range of approaches to consider when deciding the issue of personal names if the parties are from different countries. The Report further stated that “many decisions under the UDRP have . . . determined that common law or unregistered trademark rights may be asserted by a complainant.”²⁷ This policy was not criticized and so has tacit approval. The Report indicates that “a significant number of commentators favored broadening the scope of the UDRP for purposes of protecting personal names.”²⁸ Further,

[c]ommentators who are opposed to broadening the scope of the UDRP to cover personality rights set out various reasons for their reluctance in this regard. Most importantly, they point out that there currently exist no internationally harmonized norms covering personality rights as such.²⁹

After acknowledging these differences of opinion, the Report “recommended that no modification be made to the UDRP to accommodate broader protection for personal names.”³⁰ Thus, although concerns about the UDRP as applied to personal names were given consideration, no changes were instituted. In addition, I detected no change in the

20. UDRP ¶ 4(a)(i).

21. *Id.* at ¶ 4(a)(ii).

22. *Id.* at ¶ 4(b)(iii).

23. *Id.* at ¶ 4(k).

24. Rules of the UDRP ¶ 15(a).

25. WIPO, *The Recognition of Rights and the Use of Names in the Internet Domain Name System*, <http://wipo2.wipo.int./process2/report/pdf/annex4.pdf> (Sept. 3, 2001).

26. *Id.* at ¶ 173.

27. *Id.* at ¶ 182.

28. *Id.* at ¶ 191.

29. *Id.* at ¶ 195.

30. *Id.* at ¶ 202.

Panels' handling of the issue in the decisions I reviewed that were issued after the publication of the WIPO Report.

IV. THE DECISIONS

In *Winterson v. Hogarth*, a widely cited decision, the Complainant, a British author, successfully sought to have three domain names, <jeanettewinterson.com>, <jeanettewinterson.net>, and <jeanettewinterson.org>, transferred to her.³¹ Both parties were domiciled in the U.K. and relevant cases from English Courts were considered, as well as UDRP decisions under both U.S. and English law. The sole Panelist questioned "whether under English common law unauthorized use of a mark can be restrained other than by an action for infringement of a trade mark," noting that "[t]he mere fact that the right to sue for infringement of an unregistered trade mark is not available under English law does not affect a person's rights of action against another for passing-off."³² Ultimately, the Panelist interpreted the UDRP as not requiring "registrability under English law" and determined that the UDRP's use of the term trademarks was meant broadly, "akin to the common law right to prevent [unauthorized] use of a name."³³

In *Roberts v. Boyd*,³⁴ the domain name in controversy was <juliaroberts.com>. The Panel decided in favor of Roberts, noting that "registration of her name as a registered trademark or service mark was not necessary" for a finding of common law trademark rights under United States trademark law.³⁵ The Panel accepted Roberts' allegation of common law trademark rights. Interestingly, the Panel did not refer to "secondary meaning," a phrase used in trademark law. Instead, the term used was "secondary association," which apparently is identical to secondary meaning.³⁶ Similarly, it was determined that singer Bill Withers' list of credits was evidence that common law trademark rights in his personal name were created because of "sufficient secondary association."³⁷ However, the sole Panelist in the *Withers* decision was the presiding Panelist in the *Roberts* decision so it may be simply a matter of

31. No. D2000-0235 (WIPO Arb. & Mediation Ctr. May 22, 2000) (available at <<http://arbitrator.wipo.int/domains/decisions/html/2000/d2000-0235.html>>).

32. *Id.* at § 6.9.

33. *Id.* at § 6.12.

34. No. D2000-0210 (WIPO Arb. & Mediation Ctr. May 29, 2000) (available at <<http://arbitrator.wipo.int/domains/decisions/html/2000/d2000-0210.html>>).

35. *Id.* at § 6.

36. *Id.*

37. *Withers v. Dominico*, No. D2000-1621 at § 6, ¶ 8 (WIPO Arb. & Mediation Ctr. Jan. 28, 2001) (available at <<http://arbitrator.wipo.int/domains/decisions/html/2000/d2000-1621.html>>) (finding for Complainant; no response was filed).

one's personal choice in phrasing.³⁸ In finding this secondary association between Complainant and the name Julia Roberts, the Panel in essence took judicial notice of her celebrity. Most Panels take this approach when the Complainant is well known, rather than requiring a formal submission of proof of renown. The Panel also mentioned the previously discussed *Winterson* case³⁹ to support their conclusion that registration was unnecessary; a finding of common law rights was sufficient under the UDRP.

Bruce Springsteen did not fare as well in a controversial opinion regarding <bruce.springsteen.com>.⁴⁰ In a split decision, the Panel accepted that "very well known celebrities" could have rights when their names acquired secondary meaning.⁴¹ Here, though, the Panel determined that the name Bruce Springsteen was not "associated with activities beyond the primary activities of Mr. Springsteen as a composer, performer and recorder of popular music."⁴² I believe, as did the dissenting Panelist, Richard W. Page, that the name Bruce Springsteen "has acquired secondary meaning," and "has come to be recognized by the general public as indicating an association with the Complainant."⁴³ The majority apparently felt that in cyberspace, secondary meaning, or as it was redundantly phrased, "distinctive secondary meaning," was more than the distinctiveness required in traditional trademark cases.⁴⁴ For this secondary meaning, they required something that was not part of a Complainant's "primary activities."⁴⁵ The majority also cited the aforementioned *Winterson* case, deeming it "notable for an erroneous interpretation of . . . bad faith."⁴⁶ The *Springsteen* dispute was decided on other grounds, however, so as to the remarkable discussion of secondary meaning and trademark rights, I concur with another Panelist who, in discussing this decision, observed, "their dictum is in no way necessary to their decision."⁴⁷

38. *Id.* at § 3. The Panelist was Richard W. Page.

39. *Id.* at § 6, ¶ 5.

40. *Springsteen v. Burgar*, No. D2000-1532 (WIPO Arb. & Mediation Ctr. Jan. 25, 2001) (available at <<http://arbitrator.wipo.int/domains/decisions/html/2000/d2000-1532.html>>).

41. *Id.* The majority in *Springsteen* specifically criticized the *Roberts* decision that was decided by a three-person panel including the dissenting panelist of *Springsteen*. *Id.* at § 6, ¶ 35.

42. *Id.* at § 6.

43. *Id.*

44. *Id.*

45. *Id.*

46. *Id.*; *Winterson*, No. D2000-0235.

47. *Brown v. Julie Brown Club*, No. D2000-1628 at § 6(1) (WIPO Arb. & Mediation Ctr. Feb. 13, 2001) (available at <<http://arbitrator.wipo.int/domains/decisions/html/2000/d2000-1628.html>>).

In addition, the *Springsteen* decision addressed the issue of the availability of alternative domain names for the Complainants' use. Other Panels generally do not consider the possibility of using another domain name as relevant in their findings based on trademark law. Although panelists do not articulate this reasoning, I believe they approach the issue of a domain name that is similar to a personal name by considering the UDRP threshold questions, including whether the similarity is confusing and whether trademark rights exist in the personal name. Then, if a violation is found, the Respondent's activity is considered to be, not only cybersquatting, but analogous to that of a trademark infringer, violating the Complainant's exclusive right to use that personal name. Thus, the availability of another domain name becomes irrelevant.

The UDRP delineates circumstances in which a Respondent's registration and use of a domain name can be in bad faith, including registering a "domain name in order to prevent the owners of the trademark or service mark from reflecting the mark in a corresponding domain name."⁴⁸ The *Springsteen* majority read this phrase to mean that if any domain name reflecting a trademark was available to the Complainant, there could be no bad faith.⁴⁹ In *Brown v. Julie Brown Club*, the Sole Panelist discussed the *Springsteen* controversy and differed with the *Springsteen* majority opinion.⁵⁰ When considering the phrase "a corresponding domain name," the Panel asked, "[d]oes 'a' mean 'any,' or does it mean 'a particular'?" If the meaning is the former . . . then this form of bad faith can scarcely ever be established."⁵¹ Thus, whenever an alternative domain name is available, and the permeations of a personal name to create a domain name are almost limitless, this form of bad faith could not exist.

Since the bad faith required under the UDRP can take many forms, perhaps one can make this argument: for any famous person whose work requires an audience, the ability to attract public attention to oneself is an integral part of his or her celebrity and therefore his or her business. The owner of a confusingly similar domain name arguably competes with the celebrity in attempting to attract public attention away from the other person and in some sense can be considered a competitor. Thus, one may attempt to show bad faith under UDRP ¶ 4(b)(iii), which states that bad faith can be proven if the Respondent "registered the domain name primarily for the purpose of disrupting the business of a competitor."⁵² If this argument were accepted, a celebrity might have a greater

48. UDRP ¶ 4(b)(ii).

49. No. D2000-1532 at § 6.

50. No. D2000-1628 at § 6(1).

51. *Id.* at § 6(2).

52. UDRP ¶ 4(b)(iii) (emphasis added).

chance of success.

In summary, the *Springsteen* majority first required an unusual and undefined standard for secondary meaning before a finding of common law rights in a trademark could be possible. Second, the majority had a unique concept of Internet use and domain name searches. Third, unlike other Panels, the majority appeared to require actual profit as proof that a Respondent was using a disputed domain name for "commercial gain." Finally, the majority did not find the Respondent to be a cybersquatter, despite his having more than 200 "mini sites."

Some celebrities, of course, use professional or stage names that are different from their personal names. In some instances, this appears to strengthen the argument for common law trademark rights because the name was specifically chosen for business reasons. In *Starkey v. Lovearth.net*,⁵³ the Complainant was Ringo Starr and the domain name at issue was <ringo-starr.net>. Ringo Starr was held to be a common law trademark with secondary meaning.⁵⁴ The professional name was treated similarly to a personal name that had acquired common law trademark status.⁵⁵

Gordon Sumner, known professionally as Sting, challenged Respondent's ownership of <sting.com>.⁵⁶ The Sole Panelist acknowledged that the UDRP is not limited to registered trademarks, but further remarked that the name "Sting" was also a word in common usage that had several definitions.⁵⁷ The Panelist indicated that Complainant's name was not a trademark, but the decision in favor of Respondent was based on other grounds, so this observation was dicta.⁵⁸

In *Sade v. Quantum Computer Services Inc.*⁵⁹ the Panel dealt with the domain name <sade.com>. The Panel found common law rights, noting that Complainant had "since 1983 used the stage-name SADE as a mark to distinguish her goods and services as a singer."⁶⁰ Therefore, the Panel recognized "Sade" as having been intentionally chosen to be a mark and then applied common law, rather than treating "Sade" merely as a personal name that may or may not rise to the status of common law trademark.⁶¹ The *Sade* Panel distinguished the *Sting* case based on the

53. No. FA0104000097089 (Natl. Arb. Forum June 4, 2001) (available at <<http://www.arbitration-forum.com/domains/decisions/97089.htm>>).

54. *Id.* at § Findings.

55. *Id.*

56. *Sumner v. Urvan*, No. D2000-0596 (WIPO Arb. & Mediation Ctr. July 20, 2000) (available at <<http://arbiter.wipo.int/domains/decisions/html/2000/d2000-0596.html>>).

57. *Id.* at §§ 6.2, 6.5, 6.6.

58. *Id.* at § 7.

59. No. D2000-0794 (WIPO Arb. & Mediation Ctr. Sept. 26, 2000) (available at <<http://arbiter.wipo.int/domains/decisions/html/2000/d2000-0794.html>>).

60. *Id.* at § 4.

61. *Id.* at § 6, ¶ 3.

distinctiveness of the chosen name.⁶²

Another decision on the issue of a personal name that is also in common usage involved the performer Madonna and the domain name <madonna.com>.⁶³ That case is beyond the scope of this paper as Madonna is a registered U.S. trademark. However, Madonna is, like Sting, a common word, although unlike Sting, it is usually a name. They are interesting to review, but neither of these controversies was ultimately decided on the rights, or the lack of rights, in a personal name with a common dictionary meaning. This issue still needs to be addressed.

Professional golfer Jules Kendall, who is known as Skip Kendall, was unable to win transfer of <skipkendall.com> because it was determined the Respondent had not acted in bad faith as required by the UDRP.⁶⁴ Although it did not reach a decision on the issue, the Panel mentioned the conflicting opinions regarding whether personal names can be protected without a “showing of common law trademark or service mark rights.”⁶⁵ This case involved a personal name that also included a nickname. It will be interesting to observe how Panelists handle nicknames and professional names in the future, and whether they are treated differently than other personal names.

In the controversy over <stevierayvaughan.com>⁶⁶ the domain name included the name of a deceased celebrity. Here it was found that “[b]ecause of Vaughan’s fame and popularity, the mark is entitled to common law trademark rights.”⁶⁷ No response was filed and the late performer’s brother and Independent Administrator for his estate was able to have the domain name transferred. While this Panel used the term “fame,” it is doubtful that they intended to suggest that something more than secondary meaning was required. From this case we may infer that the common law right created in a person’s name survives the person’s death. The estate can assert the right for purposes of domain name disputes.

In the controversy over <tompapania.com>, the Complainant, Tom Papania, an evangelist, alleged that he marketed “himself by way of name recognition to conduct speaking engagements throughout the

62. *Id.* at § 6, ¶ 10.

63. *Ciccone v. Parisi*, No. D2000-0847 (WIPO Arb. & Mediation Ctr. Oct. 12, 2000) (available at <<http://arbiter.wipo.int/domains/decisions/html/2000/d2000-0847.html>>).

64. *Kendall v. Mayer*, No. D2000-00868 (WIPO Arb. & Mediation Ctr. Oct. 26, 2000) (available at <<http://arbiter.wipo.int/domains/decisions/html/2000/d2000-0868.html>>).

65. *Id.* at § 6A.

66. *Vaughan v. Domain Sales*, No. FA01120000102746 (Natl. Arb. Forum Jan. 4, 2002) (available at <<http://www.arbitration-forum.com/domains/decisions/102746.htm>>).

67. *Id.* at § Discussion.

country and in the sale of various media.”⁶⁸ However, “Complainant’s bald allegation” was deemed insufficient to meet the burden of proof required to show that he had trademark rights in his name. Interestingly, the record included a newsletter, provided by the *Respondent*, with Complainant’s name in a byline. The Sole Panelist considered the newsletter in determining if the Complainant had met its burden of proof, but held this one use was not sufficient to establish a protectable trademark right.

Similarly, in the case involving <jerryfalwell.com>, the Panel noted that, “Complainant failed to provide any marketing brochures, trade advertisements, or other evidence of use as a trademark.”⁶⁹ Falwell’s evidence that he appeared on the cover of *Time* magazine and on a weekly television program was not sufficient to create protectable rights in his name. Thus, the Panel held that “Complainant’s rights in his personal name are not protectable under the [UDRP] Policy.”⁷⁰

In *Diller v. Internetco Corp.*, the Complainant was able to prove “common law servicemark rights in his own name” despite being neither a performer nor other celebrity but a businessman.⁷¹ Diller alleged the media often mentioned him and cited articles in various magazines, including *Time*, as proof.⁷²

In the controversy over <stevenrattner.com>, the Complainant, a businessman who offered “investment banking and corporate advisory services under his own name” also prevailed.⁷³ Complainant was a U.S. resident and the Respondent was in the U.K. The Panel, in its discussion, cited two cases that had been decided under U.S. law and one that had been decided under English law.⁷⁴ The Panel then observed that, “[t]raditionally at common law personal names used in the context of a

68. *Papania v. Fraud Expose*, No. D2001-0978 (WIPO Arb. & Mediation Ctr. Oct. 4, 2001) (available at <<http://arbiter.wipo.int/domains/decisions/html/2001/d2001-0978.html>>).

69. *Falwell v. Cohn*, No. D2002-0184 (WIPO Arb. & Mediation Ctr. June 3, 2002) (available at <<http://arbiter.wipo.int/domains/decisions/html/2002/d2002-0184.html>>).

70. *Id.* at § 7.

71. No. D2000-1734 (WIPO Arb. & Mediation Ctr. March 9, 2001) (available at <<http://arbiter.wipo.int/domains/decisions/html/2000/d2000-1734.html>>) (finding for Complainant, no response was filed).

72. *Id.* at § 6.

73. *Rattner v. BuyThisDomainName*, No. D2000-0402 (WIPO Arb. & Mediation Ctr. July 3, 2000) (available at <<http://arbiter.wipo.int/domains/decisions/html/2000/d2000-0402.html>>).

74. *Monty and Pat Roberts, Inc. v. Keith*, No. D2000-0299 (WIPO Arb. & Mediation Ctr. June 13, 2000) (available at <<http://www.arbiter.wipo.int/domains/decisions/html/2000/d2000-0300.html>>) (relying on U.S. law); *Roberts v. Boyd*, No. D2000-0210 (WIPO Arb. & Mediation Ctr. May 29, 2000) (available at <<http://arbiter.wipo.int/domains/decisions/html/2000/d2000-0210.html>>) (relying on U.S. law); *Winterson*, No. D2000-0235 (involving English law).

business have often been protected by the Courts, and English jurisprudence provides examples of some even quite common names being afforded protection.⁷⁵ The Panel further noted “[t]he above tradition has been continued by Panelists in the context of domain name disputes.”⁷⁶ Thus, the Panel indicated that the outcome of domain name disputes involving common law trademark rights in personal names would be the same whether decided under English law or U.S. law.

Ted Turner did not fare as well in his quest to obtain <tedturner.com>.⁷⁷ The Panel, with one dissent, held “there is insufficient evidence that his personal name has been used commercially as a trademark to promote goods and services.”⁷⁸ In this case, the Complainant was a U.S. resident and the Respondent was a resident of Canada. The majority said “there is insufficient evidence of Mr. Turner’s name having acquired a secondary meaning as a trademark. . . . The distinction between names and trademarks is also recognized by the authorities both in Anglo-Australasian law and in United States law.”⁷⁹ The dissenting Panelist, Richard W. Page, was a member of the Panel that found in favor of Barry Diller. Page also dissented in the previously discussed *Springsteen* case.

The *Turner* majority relied on the analysis in *Asper v. Communication X Inc.*⁸⁰ In that case, Complainant, nicknamed Izzy Asper, was challenging the registration of <izzyasper.com>, <izzyasper.net>, and <izzyasper.org>. The Sole Panelist categorized cases into those involving entertainers, authors, athletes, business people, royalty, and politicians.⁸¹ The Panel suggested Complainants should explain what the commercial use of the domain name in controversy would be.⁸² Although the Panel found Respondent registered and used the domain names in bad faith, he found for the Respondent.⁸³ Noting that the Complainant had a “deservedly famous name,” the Panel nonetheless held that “the present Policy and Rules which bind this Panel do not permit a finding that he has rights in a trademark or service mark.”⁸⁴

In contrast, former CNN news anchor Lynne Russell won her com-

75. *Rattner*, No. D2000-0402 at § 7.

76. *Id.*

77. *Turner v. Fahmi*, No. D2002-0251 (WIPO Arb. & Mediation Ctr. July 4, 2002) (available at <<http://arbiter.wipo.int/domains/decisions/html/2002/d2002-0251.html>>).

78. *Id.* at § 6.

79. *Id.*

80. *Id.*; *Asper v. Communication X Inc.*, No. D2001-0540 (WIPO Arb. & Mediation Ctr. June 11, 2001) (available at <<http://arbiter.wipo.int/domains/decisions/html/2001/d2001-0540.html>>).

81. *Id.* at § 6.

82. *Id.*

83. *Id.*

84. *Id.* at § 7.

plaint about <lynnerrussell.com>.⁸⁵ The Panel noted she was “well-known and internationally recognizable.”⁸⁶ Further, the Panel said, “she has common law trademark rights in her name . . . and is trading off her name and reputation to sell products such as cosmetics and books.”⁸⁷ This commercial use can be a critical factor in Complainants’ suits.

Maryland’s Lieutenant Governor, Kathleen Kennedy Townsend, lost both as an individual and through her political committee, Friends of Kathleen Kennedy Townsend because of the issue of commercial use. Two cases dealt with <kathleenkennedytownsend.com> and four other domain names that incorporated her name. In the first case, *Townsend v. B.G. Birt*, the Panel implied that the political action committee and not the individual was the proper entity to file suit.⁸⁸ The Panel held “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.”⁸⁹ The Panel in the second case, *Friends of Kathleen Kennedy Townsend v. B.G. Birt*,⁹⁰ contains confusing references to Respondent’s position regarding the issue of whether an alleged license from Kathleen Kennedy Townsend to the Friends of Kathleen Kennedy Townsend would assign rights in that name. No discussion regarding the distinctions between licenses and assignments was made. The majority went perhaps too far afield when it noted that the Complaint did not contain the kind of “verified showing” required for United States intent-to-use trademark applications.⁹¹ Richard W. Page again dissented from the majority opinion.⁹²

Similarly, political activist Gloria Feldt, president of Planned Parenthood Federation of America, was unable to show a common law trademark right in <gloriafeldt.com>.⁹³ The majority noted a lack of proof that the name was “used in connection with the commercial offering of goods or services or that the personal name in question has ac-

85. *Russell v. Young*, No. D2002-1133 (WIPO Arb. & Mediation Ctr. Jan. 21, 2003) (available at <<http://arbiter.wipo.int/domains/decisions/html/2002/d2002-1133.html>>).

86. *Id.* at § 6A.

87. *Id.*

88. No. D2002-0030 (WIPO Arb. & Mediation Ctr. April 11, 2002) (available at <<http://arbiter.wipo.int/domains/decisions/html/2002/d2002-0030.html>>). The other domain names at issue were <kennedytownsend.com>, <kennedytownsend.org>, <kennedytownsend.net>, and <kathleenkennedytownsend.org>. *Id.*

89. *Id.* at § 6.

90. No. D2002-0451 (WIPO Arb. & Mediation Ctr. July 31, 2002) (available at <<http://arbiter.wipo.int/domains/decisions/html/2002/d2002-0451.html>>).

91. *Id.*

92. *Id.*

93. *Planned Parenthood Fedn. of Am., Inc. v. Hoffman*, No. D2002-1073 (WIPO Arb. & Mediation Ctr. Feb. 21, 2003) (available at <http://arbiter.wipo.int/domains/decisions/html/2002/d2002-1073.html>) (finding for Respondent, no response was filed).

quired secondary meaning as to the source of such goods or services.”⁹⁴ The concurring Panelist clarified that “the term ‘commercial’ should not be understood to suggest that only for-profit enterprises, or individuals, may acquire rights in common law service marks.”⁹⁵

The domain names <princessdi.com> and <princessdiana.com> were transferred to the representative of The Diana, Princess of Wales Memorial Foundation, in *CMG Worldwide, Inc. v. Page*.⁹⁶ The Panel stated that “Diana, Princess of Wales before her death had rights to her common law trademarks.”⁹⁷ The Complainant’s U.S. trademark application for “Diana Princess of Wales Memorial Fund,” the Panel noted, created a right in that mark. The Panel then found the disputed domain names were confusingly similar to that mark.⁹⁸

Supermodel Stephanie Seymour won her complaint regarding <stephanieseymour.com> against Jeff Burgar,⁹⁹ Respondent in several of the cases discussed in this paper and operator of the <celebrity1000.com> Web site.¹⁰⁰ The Panel found that “years of international fame as a top supermodel . . . established a common law right to her name.”¹⁰¹ Further, the Panel found that use of <stephanieseymour.com> to divert Internet users to his <celebrity1000.com> Web site was evidence of Respondent’s bad faith registration for UDRP ¶ 4a(iii).¹⁰²

Interestingly, another Panel found that diverting users to the <celebrity1000.com> Web site was evidence of Respondent’s requisite legitimate interest in the domain name in controversy under UDRP ¶ 4(c)(i) or ¶ 4(c)(iii). In that case,¹⁰³ Hebrew University of Jerusalem, in Israel, which inherited some of Dr. Albert Einstein’s intellectual property,¹⁰⁴ sued Alberta Hot Rods, of Canada, over the domain name <albert

94. *Id.* at § 6A.

95. *Id.* at § Concurrence.

96. No. FA0009000095641 (Natl. Arb. Forum Nov. 8, 2000) (available at <<http://www.arbitration-forum.com/domains/decisions/95641.htm>>).

97. *Id.* at § Discussion.

98. *Id.*

99. *Seymour v. Burgar*, No. FA0104000097112 (Natl. Arb. Forum May 29, 2001) (available at <<http://www.arbitration-forum.com/domains/decisions/97112.htm>>).

100. Celebrities’ problems with Jeff Burgar and the <celebrity1000.com> Web site continue: Carmen Electra recently won her complaint regarding <carmenelectra.com> which diverted Internet users to <celebrity1000.com>. See *Electra v. Network Operations Center*, No. D2003-0852 (WIPO Arb. & Mediation Ctr. Dec. 23, 2003) (available at <<http://arbitr.wipo.int/domains/decisions/html/2003/d2003-0852.html>>).

101. *Seymour*, No. FA0104000097112 at § Discussion.

102. *Id.*

103. *Hebrew University of Jerusalem v. Alberta Hot Rods*, No. D2002-0616 (WIPO Arb. & Mediation Ctr. Oct. 7, 2002) (available at <<http://arbitr.wipo.int/domains/decisions/html/2002/d2002-0616.html>>).

104. *Id.* at § 4. The decision includes the relevant language from Dr. Einstein’s last will and testament:

einstein.com>.¹⁰⁵ The Panel did not find bad faith registration or use but rather noted that Internet users could not be “misleadingly diverted” because no one could have an expectation of finding goods or services related to Dr. Einstein at a Web site.¹⁰⁶ The Panel found no evidence that Dr. Einstein ever used his name commercially.¹⁰⁷ Complainant’s French trademark registration for “Albert Einstein,” Australian and U.S. trademark registrations for “Einstein” and German registration for “Einstein Verlag” were not sufficient to give the name secondary meaning because of the lack of commercial use.¹⁰⁸

Another often cited dispute is *Roberts, Inc. v. Barrel*, which dealt with the domain name <montyrobarts.org>.¹⁰⁹ The Panel determined that the burden was on the Complainant to prove common law rights in his name, stating that if the Complainant did have a registered trademark it “would not create a presumption of secondary meaning in its favor.”¹¹⁰ Roberts claimed common law trademark rights under California law and asserted that he had won equestrian championships, used his name with his horse training technique, advertised in horse training publications, provided services world wide, wrote two books, and was the subject of a video, television show, and magazine articles.¹¹¹ The Sole Panelist discussed the criteria for proving a trademark to be famous and then decided for the Complainant, finding that Roberts held 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.”¹¹² This is particularly significant for two reasons: first, the fame required to find protectable trademark rights did not have to be among all consumers or the general public. The fame of the personal name in one niche was sufficient to create common law trademark rights. Secondly, for a finding of common law trademark rights, the Panelist required “fame” rather than secondary meaning or distinctiveness that is the standard usually applied in UDRP decisions.¹¹³ Fame or being fa-

‘all of my manuscripts, copyrights, publication rights, royalties and royalty agreements, and all other literary property and rights, of any and every kind or nature whatsoever.’ were to be held in trust for the lives of his secretary and his step-daughter and thereafter ‘all funds or property, if any, still held in this trust,’ including ‘all literary rights or property’ were to pass to Complainant.

Id.

105. *Hebrew University*, No. D2002-0616.

106. *Id.*

107. *Id.*

108. *Id.* at § 6(I).

109. No. D2000-0300 (WIPO Arb. & Mediation Ctr. June 13, 2000) (available at <<http://arbitrator.wipo.int/domains/decisions/html/2000/d2000-0300.html>>).

110. *Id.* at § 6.

111. *Id.* at § 4.

112. *Id.* at § 6.

113. *Id.*

mous is a high standard. In the U.S., fame generally is not required in trademark law. However, a finding of dilution of a trademark does require proof that the trademark is famous. Further, by indicating, albeit in dicta, that registration of a trademark not only would not prove secondary meaning but would not create a presumption of secondary meaning, the Panelist is setting a difficult standard for Complainants to prevail. Therefore, the Panelist expanded protection under the UDRP by allowing protection of a name with renown in a niche rather than requiring renown among all consumers. However, he also narrowed protection under the UDRP by requiring the much more burdensome proof of fame in the name rather than mere secondary meaning.

Can we make an analogy with, for example, the *Papania*¹¹⁴ case discussed previously? Would this Panel have found in favor of Complainant Tom Papania by looking to his fame, if any, in the niche of religion, public speakers, or evangelists? They probably would not, unless a similarly impressive list of uses of the name Tom Papania was offered. Nevertheless, in *Carter v. The Afternoon Fiasco*,¹¹⁵ the Complainant, a Boston radio personality, was held to have common law rights in this personal name, despite the fact that his renown was in a limited geographic area.¹¹⁶ The Panel accepted Complainant's allegation that his name was distinctive.¹¹⁷ In another controversy dealing with a niche, *Skaggs v. Vincente*,¹¹⁸ the Panel cited the *Roberts, Inc.* case¹¹⁹ with approval. The Complainant was held to have common law rights in his personal name in connection with country and bluegrass music based on the materials he provided to the Panel.¹²⁰

In *Kidman v. Zuccarini* the disputed domain name, <nicholekidman.com>, had a common misspelling of Complainant's name.¹²¹ It was held, that "purposeful" misspellings were actionable under the UDRP.¹²² Further, Kevin Spacey won his case against the same respondent, Zuccarini,

114. *Papania*, No. D2001-0978 (WIPO Arb. & Mediation Ctr. Oct. 4, 2001).

115. No. D2000-0658 (WIPO Arb. & Mediation Ctr. Oct. 17, 2000) (available at <<http://arbiter.wipo.int/domains/decisions/html/2000/d2000-0658.html>>) (finding for Complainant, no response was filed).

116. *Id.* at § 7.

117. *Id.* at § 6.

118. No. D2000-1134 (WIPO Arb. & Mediation Ctr. Dec. 18, 2000) (available at <<http://arbiter.wipo.int/domains/decisions/html/2000/d2000-1134.html>>) (finding for Complainant, no response was filed).

119. *Roberts, Inc.*, No. D2000-0300 (WIPO Arb. & Mediation Ctr. June 13, 2000) (available at <<http://arbiter.wipo.int/domains/decisions/html/2000/d2000-0300.html>>).

120. *Skaggs*, No. D2000-1134 at § 6.

121. No. D2000-1415 (WIPO Arb. & Mediation Ctr. Jan. 23, 2001) (available at <<http://arbiter.wipo.int/domains/decisions/html/2000/d2000-1415.html>>) (finding for Complainant, no response was filed).

122. *Id.* at § 5A.

where the domain name in question was a misspelling of his name, <kevinspacy.com>.¹²³ The Panel stated that “[t]he deletion of the letter ‘e’ from the mark does not diminish the confusing similarity between Respondent’s domain name and the Complainant’s mark.”¹²⁴ The Panel also observed that the Respondent made a profit when “unsuspecting Internet users misspell Complainant’s name.”¹²⁵

Regarding this issue of commercial gain, which is a factor under the UDRP, arguably the Respondents in both the *Spacey* and the previously analyzed *Springsteen*¹²⁶ cases actually were operating their Web sites with the intent to make a profit. Although the *Springsteen* Respondent did not actually make a profit, that is not the criterion for proof that an activity was undertaken for commercial gain. In addition, the majority in *Springsteen* had a much different view of Internet users than did the *Spacey* Panel, remarking that “they would very soon realise that the site they reached was not the official site, and consequently would move on.”¹²⁷ Most Panelists seem to share the *Spacey* Panel’s concern for Internet users. For example, in *Harrison v. Lovearth.net*, which involved six domain names, the Panel stated that a “reasonable Internet user would assume that they are somehow associated with Complainant’s well-established common law mark.”¹²⁸ Similarly, regarding <nicolekidmannude.com>, which also was disputed in the *Kidman* case discussed above, the Panel acknowledged the possibility that some Internet users would be confused and think it was associated with Kidman.¹²⁹ Therefore, it is reasonable to assume that the *Spacey* Panel would have decided in favor of the Complainant in the *Springsteen*¹³⁰ controversy both because of its concern for Internet users and because of the possibility of showing commercial gain.

Another controversy involving a misspelling was *Connolly v. Stewart*,¹³¹ in which both parties were residents of the U.K. Two domain names were in dispute, <billyconnolly.com> and <billyconnelly.com>, a common misspelling of the actor and comedian’s name. The Respondent

123. *Spacey v. Zuccarini*, No. FA0103000096937 (Natl. Arb. Forum May 8, 2001) (available at <<http://www.arbitration-forum.com/domains/decisions/96937.htm>>) (finding for Complainant, no response was filed).

124. *Id.* at § Discussion.

125. *Id.*

126. *Springsteen v. Burgar*, No. D2000-1532 (WIPO Arb. & Mediation Ctr. Jan. 25, 2001).

127. *Id.*

128. No. FA0104000097085 (Natl. Arb. Forum June 4, 2001) (available at <<http://www.arbitration-forum.com/domains/decisions/97085.htm>>).

129. *Kidman*, No. D2000-1415.

130. *Springsteen*, No. D2000-1532.

131. *Connolly*, No. D2000-1549 (WIPO Arb. & Mediation Ctr. Feb. 5, 2001) (available at <<http://arbiter.wipo.int/domains/decisions/html/2000/d2000-1549.html>>).

alleged that the name 'Connelly' was very common, with 330 listings in the Glasgow, Scotland directory.¹³² The Panel was not persuaded by this argument and found for the Complainant stating, that the "names and the mark are visually and phonetically identical for all practical purposes."¹³³

*Williams v. Byrne*¹³⁴ involved Complainants in the U.S. and a Respondent in the U.K. This situation was unusual because two personal names were incorporated in the domain names: <venusandserenawilliams.com>, <venusandserenawilliams.net>, and <venusandserenawilliams.org>. Serena Williams and Venus Williams are the names of sisters who are well-known tennis players and the Panel found in their favor because they "both individually and together have established a significant reputation and goodwill in their names for the purposes of trade."¹³⁵ The Sole Panelist did not discuss either U.S. or English law in determining that rights can exist in two personal names used together.

In the previously discussed dispute over <nicolekidmannude>,¹³⁶ one thought-provoking question raised was whether a domain name could be confusingly similar to a trademark when an additional term was appended to the personal name. The Panel determined that it could by reasoning that it must view the domain name from the perspective of the purpose of the UDRP, which is to prevent cybersquatting. Similarly, in *Feinstein v. PAWS Video Prods.*, the entertainer disputed three domain names, including <purefeinstein.com>, the title of his popular album.¹³⁷ The Sole Panelist decided that the domain name was identical to the album and that the Complainant had a common law mark in the album.¹³⁸ Of greater significance, the Panelist held that not only was <purefeinstein.com> confusingly similar to the album name, it was also confusingly similar to the common law mark Respondent had in his personal name.¹³⁹ These decisions make it clear that a respondent cannot save a domain name simply by adding a word to the personal name of another where that person has common law trademark rights in his or her name.

132. *Id.* at § 5.2.1.

133. *Id.* at § 6.3.2.

134. No. D2000-1673 (WIPO Arb. & Mediation Ctr. Jan. 30, 2001) (available at <<http://arbiter.wipo.int/domains/decisions/html/2000/d2000-1673.html>>).

135. *Id.* at § 6.

136. No. D2000-1415 (WIPO Arb. & Mediation Ctr. Jan. 23, 2001) (available at <<http://arbiter.wipo.int/domains/decisions/html/2000/d2000-1415.html>>).

137. No. D2000-0880 (WIPO Arb. & Mediation Ctr. Oct. 21, 2000) (available at <<http://arbiter.wipo.int/domains/decisions/html/2000/d2000-0880.html>>) (finding for Complainant, no response was filed).

138. *Id.* § 6.

139. *Id.*

Further, in the controversy over <celinedion.com>, the Sole Panelist found in favor of Complainant Celine Dion stating her fame gave her a “reputation which can warrant protection against passing off.”¹⁴⁰ All the parties were domiciled in Canada and the Panelist made reference to English law. Again, although the term “fame” was used, there is no suggestion that this Panel was requiring a higher standard than secondary meaning. Thus, some Panels reach the conclusion that common law trademark rights exist in a personal name based on the theory of common law passing-off.

V. CONCLUSION

Generally, under the UDRP, Complainants prevail if they can prove common law trademark rights in the name at issue. The greater the renown of the personal name, the greater the chances of success of the complaint. The more closely this celebrity is related to some commercial exploitation of the name, the more likely the Complainant is to succeed

Commentators are largely supportive of the UDRP. The process is fast, efficient, and inexpensive in comparison with litigation. One writer pointed out that “[a]lthough the drafters of the policy may not have intended the policy to protect celebrities per se, it has served this purpose . . . and the resulting case precedent overwhelmingly favors celebrities.”¹⁴¹ Another commentator remarked, “[i]f applied properly, the policy serves as an effective remedy against abusive registrations while preventing overreaching by trademark holders.”¹⁴²

Thus, although the UDRP is an effective tool for stopping the use of a personal name within a domain name, Complainants are not guaranteed success when asserting common law trademark rights.

140. *Dion v. Burgar*, No. D2000-1828 (WIPO Arb. & Mediation Ctr. Feb. 13, 2001) (available at <<http://arbiter.wipo.int/domains/decisions/html/2000/d2000-1828.html>>).

141. Leah Phillips Falzone, *Playing the Hollywood Name Game in Cybercourt: The Battle Over Domain Names in the Age of Celebrity-Squatting*, 21 *Loy. L.A. Ent. L. Rev.* 289, 324 (2001).

142. Mueller, *Rough Justice*, *supra* n. 17.