

What's in a Domain Name?

Famous Names and the UDRP

BY LEIGH AUGUSTINE AND ZACH WARKENTIN



The Uniform Domain-Name Dispute Resolution Policy governs alternative dispute resolution of complaints about domain name registrations. This article describes the Policy and uses case summaries to illustrate key practice tips.

Imagine six weeks before the Olympic Games, a couple walks into your office with an urgent dilemma: their son, who was in the U.S. Ski Team's development program, unexpectedly earned a spot on the "A" Team and was headed to the Olympics. Along with the elation one would expect with such an honor, this newfound fame might also create some legal challenges. For example, the couple might ask why, when they typed in theirsonname.com, they were automatically forwarded to a pornographic website. You would have to explain that after their son's name had hit the headlines—but before they were able to register theirsonname.com—an opportunistic third party purchased the domain name in question. Then, to create a bit more urgency than merely "parking" the domain, the third party had set it to forward to the pornographic website. You would have to tell the couple that this third party

was likely just waiting for a phone call from the athlete or his representative in an attempt to make some quick cash, and advise them about their legal options to resolve the situation.

This article discusses domain name disputes under the Uniform Domain-Name Dispute Resolution Policy (UDRP). It provides an overview and brief history of the UDRP and summarizes several UDRP disputes regarding celebrities, politicians, and names used as trademarks. The article also highlights key takeaways from those cases.

A Brief History of UDRPs

In the 1990s, a new property issue arose from the advent of widespread Internet access and domain name registration: cybersquatting. One infamous cybersquatter, Dennis Toeppen, registered hundreds of domain names, including panavision.com, deltaairlines.com, eddiebauer.com, and yankeestadium.com.¹ He then used those registrations to try to coerce money from the rightful trademark owners.

In 1999, largely in response to cybersquatting, Congress passed the Anti-Cybersquatting Consumer Protection Act (ACPA),² which defined cybersquatting as the registration, trafficking, or use of a domain name in a bad faith attempt to profit from another's trade or service mark.³ The ACPA created a cause of action against those who use confusingly similar or dilutive domain names.

Around the same time, the Internet Corporation for Assigned Names and Numbers (ICANN),⁴ the nonprofit organization tasked with managing the Internet's global domain name system, approved the first version of a worldwide UDRP.⁵ The UDRP offers an aggrieved party (a complainant) a quick, simple, and international means of challenging a domain

name registration through alternative dispute resolution when it believes a third party (a registrant) is infringing or diluting its brand, or as in Toeppen's case, if the cybersquatter merely purchased a domain name quickly and did not have a legitimate commercial purpose for doing so.⁶

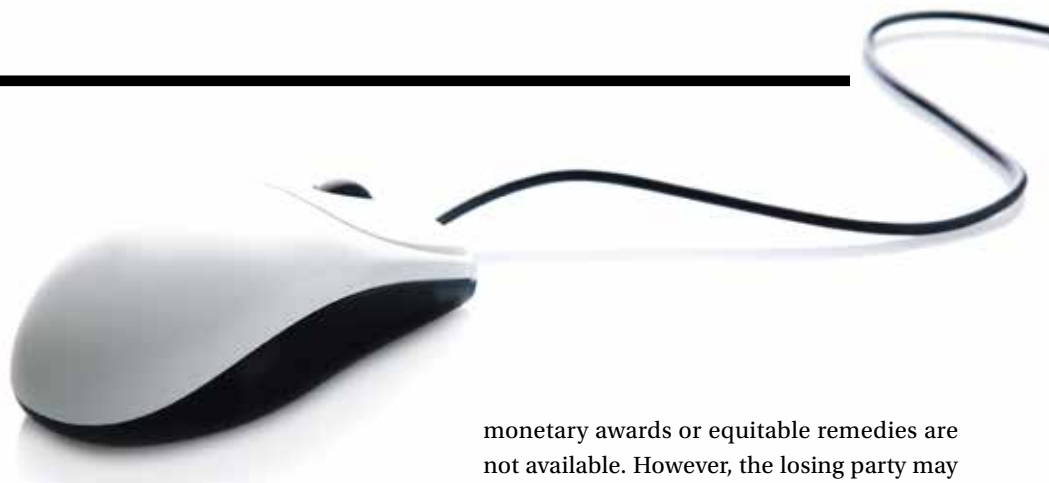
ICANN uses "registrars," which are companies it accredits to offer domain registration services, such as GoDaddy and Network Solutions.⁷ Whenever a registrant registers a domain name, the registrar requires the registrant to consent to the UDRP as part of the domain name registration agreement.

The UDRP allows complainants to adjudicate domain name disputes via five third-party mediators,⁸ such as the World Intellectual Property Organization's Arbitration and Mediation Center (WIPO)⁹ and the National Arbitration Foundation (NAF), which use one- or three-person panels (Panels) to decide the disputes.¹⁰ Panel decisions are enforceable internationally.¹¹

Registration agreement provisions vary, but generally, when a party believes a domain name violates its intellectual property rights, it may file a complaint with any of the five tribunals.¹² The tribunal immediately contacts the registrar, which (1) notifies the domain registrant of the complaint filing, and (2) places a "registrar lock" on the subject domain name¹³ to prevent "cyberflight."¹⁴ The registrar lock precludes modification, deletion, or alienation of the domain name, as well as modification of the domain name contact's details. This is typically the end of a domain name registration dispute, because a majority of domain name owners do not respond to complaints.¹⁵

WIPO in Geneva, Switzerland handles most UDRP proceedings.¹⁶ WIPO decided the first UDRP case on January 14, 2000,¹⁷ in a dispute over the domain name "worldwrestlingfederation.com." In that case, WIPO ruled the registrant registered the domain name in bad faith and solely for the purpose of attempting to sell it to the World Wrestling Federation (WWF), a then-existing, commercially successful sports and entertainment corporation. The WIPO panel ordered the registrar to transfer the domain name to the WWF.

Pursuant to the UDRP, a tribunal can order



“
Registration agreement provisions vary, but generally, when a party believes a domain name violates its intellectual property rights, it may file a complaint with any of the five tribunals.
”

the transfer or cancellation of, or changes to, a domain name pursuant to the terms of the registrar's registration agreement.¹⁸ Upon such an order, the registrar has the authority to directly transfer the domain name without the registrant's authorization. The scope of any UDRP decision is limited to deciding who has superseding rights in the domain name;

monetary awards or equitable remedies are not available. However, the losing party may subsequently challenge a Panel's decision via a civil claim in an appropriate jurisdiction, which is generally where the respondent is located.¹⁹

WIPO handles approximately 2,000 to 3,000 cases per year, covering between 3,000 and 5,000 domain names.²⁰ WIPO fees typically cost between \$1,500 and \$5,000, depending on the number of domain names at issue and the number of arbitrators (one or three) a party requests to decide the issue. Most UDRP cases result in transferring the domain name to the complainant. Of the 2,538 WIPO cases filed in 2017, only 171 (7%) had the complaint denied, leaving 2332 (92%) to be transferred to the complainant, with 35 cases (1%) canceled before an arbitrator's ruling.²¹ The overwhelming reason for these results is respondents' failure to file a response.

UDRP disputes are adjudicated quickly. After commencement of a WIPO proceeding, which is filed and paid for online, the registrar typically locks down the domain name in question within four hours. Within 24 hours, WIPO generally replies to the complainant with a case number and notifies the respondent of the 20-day deadline to file a response.²² After expiration of the 20 days, WIPO assigns the case to a Panel,²³ which has 14 days after appointment to adjudicate the case based on the pleadings.²⁴ To win, a complainant must show three things:

- the subject domain name is identical or confusingly similar to a mark in which the complainant has rights;
- the respondent does not have any rights or legitimate interests in the domain name; and
- the respondent registered and used the domain name in bad faith.²⁵

The bad faith element is often the most difficult to prove. Bad faith may be established by showing:²⁶

1. circumstances indicate the domain name was registered or acquired primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the owner of the trademark or service mark (normally the complainant), or to a competitor of that complainant, for valuable consideration in excess of the respondent's out-of-pocket costs directly related to the domain name;
2. the domain name was registered to prevent the trademark or service mark owner from reflecting the mark in a corresponding domain name, provided the respondent has engaged in a pattern of such conduct;
3. the domain name was registered primarily for the purpose of disrupting the business of a competitor; or
4. by using the domain name, the respondent intentionally attempted to attract Internet users to the respondent's website or other online location for commercial gain 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 respondent's website or location.

Snapshots of Domain Name Cases

The following case summaries illustrate a variety of UDRP disputes involving (1) the actual name of a famous individual, (2) the stage name of a famous individual, (3) an individual's name that is also a registered trademark, or (4) politicians' names. The general rule is while the UDRP does not specifically protect personal names, where a complainant can demonstrate use of the name as a mark in trade or commerce, he or she may be able to establish intellectual property rights in the name.²⁷

Use of Actual Names

► **juliaroberts.com.**²⁸ After registering the domain name, the respondent placed it for auction on eBay. The respondent had also registered 50 other domain names and received offers as high as \$2,550 for the subject domain name.

Holding. WIPO ordered the domain to be transferred to Roberts. It ultimately found the

“

The general rule is while the UDRP does not specifically protect personal names, where a complainant can demonstrate use of the name as a mark in trade or commerce, he or she may be able to establish intellectual property rights in the name.

”

domain name was identical to Roberts's common law trademark in her name; the respondent had no rights or legitimate interests in the domain name; and the respondent registered and used the domain name in bad faith by attempting to auction the name to the highest bidder.

Takeaway. As one of the first celebrity cases (it was heard by WIPO four months after the world-wrestlingfederation.com case), the juliaroberts.com dispute is a seminal case for establishing the elements of a celebrity UDRP claim. More important, it was the first UDRP adjudication recognizing common law rights in a person's name.²⁹

► **mickjagger.com.**³⁰ The respondent purchased the domain name, and then linked it to a pornographic website.

Holding. The Panel ordered the domain name transferred. The Panel stated, “Complainant has presented clear and convincing evidence that the Complainant holds a *common law trademark in his famous name . . . even without registration at the United States Patent and Trademark Office.*”³¹ (Emphasis added.)

Takeaway. This case was heard at the NAF, which came to the same conclusion as WIPO in the *Roberts* case. NAF went a step further, however, by including the emphasized language, thereby memorializing the rule that there are common law rights in famous names used in commerce.

► **venusandserenawilliams.com.**³² The respondent registered venusandserenawilliams.com, and shortly thereafter registered similar domain names with .net and .org extensions. The respondent then placed the .com website “under construction” with a statement that the domain name “may go to auction.”³³ The respondent was, however, “open to offers over \$1 million dollars.”³⁴ After contact with the respondent, the Williamses' representatives filed a complaint.

Holding. The Panel ordered the domain name transferred. The Panel held the respondent registered the domain names with the sole intent to extort money from the Williams sisters, and bad faith was easily proven.³⁵

Takeaway. This matter further reinforces the existence of common law rights in famous names used in commerce. Additionally, the mere threat to auction the domain name was sufficient to constitute bad faith.³⁶

► **annanicolesmith.com.**³⁷ The respondent purchased annanicolesmith.com and set up an unofficial “fan club site” there.

Holding. The Panel denied the transfer request. The complainant could not establish bad faith because the respondent had a legitimate interest in the fan site.

Takeaway. The arbitrator attempted to establish a precedent on just how famous one needs to be to establish common law rights in his or her name, stating “[t]he 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 high commercial value and significant recognition of the name as solely that of the performer.”³⁸

► **alleewillis.com.**³⁹ The complainant was a well-known songwriter who wrote hits for such artists as Earth, Wind & Fire, Bonnie Raitt, Ray Charles, Diana Ross, Aretha Franklin, and Tina Turner. She also wrote the theme song to the television show *Friends*, “I’ll Be There For You.” The respondent claimed that “[e]xcept for her inside crowd and some trivia fanatics, no one knows who Allee Willis is, whereby no common law trademark could exist” and offered to sell the domain name to Willis for \$25,000.⁴⁰

Holding. The Panel ordered the domain name transferred.

Takeaway. The fact Willis was a well-known song author who worked closely in commerce with many professional musicians was sufficient to establish common law rights in Willis’s name.

► **patbenatar.com.**⁴¹ Complainant, the merchandising corporation for the famous musician, registered PAT BENATAR with the U.S. Patent and Trademark Office (USPTO) in 2000 (Class 9 for CDs and DVDs) with a listed first use in 1979. The respondent registered the disputed domain name in December 1998 and established a fan website that displayed a history of Benatar and her band, and listed a discography and past and future tour dates. The respondent also placed a clear disclaimer on the site that it did not have any formal association with Benatar. In October 2000, the complainant sent a message to the respondent inquiring as to the purpose of the site and requesting a link to Benatar’s official website at www.benatar.com “so there is no confusion.”⁴² In response, the respondent consistently disclaimed any interest in selling or transferring the disputed domain name, and stated his intention to continue operating the fan site.

Holding. The Panel denied the complaint. The “[c]omplaint failed to disclose material facts,” including that its trademark registration happened *after* the respondent’s registration of

PRACTICE POINTS FOR UDRP CASES

These UDRP cases signal several key practice points:

- 1** Whenever possible, register a domain name with a federal (country) trademark before a cybersquatter has the chance to purchase a domain name.¹ A trademark application may be considered in a UDRP dispute proceeding if its application date precedes the respondent’s filing date for the domain name. Regardless, if your celebrity, business, or politician client uses his or her name in commerce, register a trademark related to those goods or services.
- 2** Proving the respondent registered *and* used the domain name “in bad faith”² is extremely difficult. Prepare your case accordingly.
- 3** Be careful when corresponding with cybersquatters because what you say can be used against you. Additionally, if the cybersquatter senses that a UDRP proceeding is about to be filed, the cybersquatter might transfer the domain name to a third party or an alias, thus frustrating the process. Once you can clearly show bad faith, file the UDRP proceeding immediately and without conferring with the opposing side.
- 4** Be cognizant of predecessors-in-interest, which could have an agreement that the UDRP Panel finds to be detrimental to the complainant.
- 5** As with any legal proceeding, get bad facts out in the open right away. Knowing that the majority of respondents in UDRP cases do not file a response, complainants may be tempted to leave out potentially damaging facts. Do not get lured into that trap.
- 6** The UDRP guidelines are silent on whether the complainant may file a supplemental response after the respondent files a response. Therefore, if the respondent files a response that brings up additional facts or elements not addressed in the original complaint, address those issues in a supplemental response. The worst that could happen is the Panel will refuse to read it. In most cases, however, the Panel will accept a supplemental response.

1. See, e.g., *Pulko v. Frazier*, WIPO case no. D2006-0099 (Mar. 15, 2006).
2. UDRP ¶ 4.a. (emphasis added).

the domain name and its history of dealing with the respondent, including the acknowledgment of and implied consent to the domain name.⁴³ The Panel also admonished the complainant and its counsel for disclosing only those facts it considered to support its case and for withholding material, inconvenient facts.

Takeaway. The Panel will consider all relevant facts, not just those that favor the complainant. Although respondents often

fail to file a response, it is not advisable to leave out relevant bad facts in the complaint. Additionally, the date of the USPTO trademark (filing or registration) is potentially a key date in a UDRP proceeding.

► **jelanijenkins.com.**⁴⁴ In fall 2007, the complainant, Jelani Jenkins, was a star sophomore football linebacker at Good Counsel High School in Olney, Maryland. In January 2008,

the respondent registered jelanijenkins.com and jelanijenkins.net. In March of that year, the respondent married Kenneth Jenkins, a former NFL player with no relation to the complainant. From 2009 through 2013, the complainant played football at the University of Florida. The Miami Dolphins drafted him in April 2013. In March 2014, the respondent called the complainant and offered to sell him the domain names for \$10,000. The complainant filed a UDRP complaint. In response, the respondent argued she registered the name for use with a potential future child. She further argued she could not have foreseen Jenkins's success in 2008 when she purchased the domain name, because according to the NFL only 215 of every 100,000 football-playing high school seniors reach the professional ranks.

Holding. The Panel ordered the domain name transferred. The Panel held the respondent did not have any rights or legitimate interests

in the domain name. The Respondent and her husband did not have a child together. Further, the respondent also happened to reside near Olney High School and registered the disputed domain name after the complainant had been featured in significant media coverage. The Panel concluded the registration was nothing more than "an investment" in Jenkins's anticipated athletic and professional success.⁴⁵

► **sirpaulmccartney.com.**⁴⁶ In 2001, Sir Paul McCartney, through his companies, filed a complaint to have transferred sirpaulmccartney.com, paul-mccartney.com, and paul-mccartney.net. McCartney argued the respondent had infringed his common law and registered intellectual property rights in his name. The respondent had registered over 365 celebrity domain names, including a number in the names of the Beatles' former members. In exchange for the domain transfer, the respondent demanded

McCartney sign an agreement validating certain extreme environmental beliefs related to the respondent's organization (to which McCartney did not subscribe).

Holding. The Panel ordered the domain name transferred. The Panel found the respondent had registered and used the domain names in bad faith, due to the above demand and because the respondent had already used the domain names to create the appearance McCartney endorsed his beliefs.

Takeaway. Bad faith does not have to be monetary in nature. The Panel stated,

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



CALL FOR NOMINATIONS:

CBA AWARD OF MERIT

The Award of Merit is awarded annually to a current member of the Colorado Bar Association for outstanding service or contributions to the association, the legal profession, the administration of justice or the community.

The deadline for nominations is Jan. 31, 2019

Send nominations and supporting statements to Melissa Nicoletti at melissan@cobar.org, or visit <https://bit.ly/2pmKUHT>



the celebrity—a result clearly in conflict with the [UDRP].⁴⁷

► **genekelly.com.**⁴⁸ In 2008, the Gene Kelly Image Trust filed a complaint against the respondent for registration of genekelly.com. Before his death in 1996, Kelly had granted the Trust the rights to use his name, likeness, signature, image, voice, and personality. A mark for “Gene Kelly” did not exist at the USPTO.

Holding. The Panel ordered the domain name transferred. The Panel determined Kelly held, and had assigned, common law rights in his name. The respondent was a repeat bad faith offender with multiple prior domain name cases.

Takeaway. Common law rights in a famous name may survive a celebrity’s death.

► **edwardvanhalen.com.**⁴⁹ The famous guitarist filed a complaint alleging the respondent coopted use of edwardvanhalen.com. The respondent claimed she was intending to establish a legitimate fan site. Van Halen alleged bad faith because of the respondent’s “failure to add content to the website for over a year.”⁵⁰

Holding. The Panel denied the complaint. The Panel held the establishment of a fan website theoretically could be a legitimate use, despite the fact the respondent could not provide any additional evidence of fandom or fan activities. Van Halen failed to demonstrate the respondent’s registration and use was in bad faith, such as by showing extortion or financial gain.

Takeaway. This case reinforces the importance of proving each element of the UDRP claim, especially where the Panel will decide the merits of the dispute on the pleadings alone.

Update. Currently, both eddievanhalen.com and edwardvanhalen.com forward to the guitarist’s official site at www.eddievanhalen.com.

► **bruce springsteen.com.**⁵¹ In 2000, New Jersey’s favorite son filed a complaint asserting the respondent, who owned approximately 1,500 celebrity domain names, had registered and used bruce springsteen.com in bad faith, including by linking it to Celebrity1000.com, an online site that respondent owned and operated and was the end point for many of those 1,500 domain names.

“
Common law
rights in a famous
name may survive
a celebrity’s death.
”

Holding. The Panel denied the complaint. Although the Panel found Springsteen had common law rights in his name, Springsteen could not establish the respondent’s intent for commercial gain through misleadingly diverting Springsteen’s fans. In addition, the Celebrity1000 site itself did not appear to tarnish Springsteen’s rights. The Panel stated:

For all the reasons set out above, 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.⁵²

Takeaway. Fan sites must be used or registered in bad faith to warrant transfer of a domain name to the complainant.

► **jenna.com.**⁵³ In 2004, Jenna Massoli, a/k/a Jenna Jameson, filed a complaint against the registrant of jenna.com. Jameson and her company, Jennasis Entertainment, had registered trademarks for “Jenna” and “Jenna Jameson.” Before that registration, however, the respondent had registered jenna.com and used it in connection with adult entertainment for a number of models, all with the first name “Jenna.”

Holding. The Panel denied the complaint. The Panel ultimately found the respondent’s use of the domain name constituted a bona fide use related to goods or services predating the complainant’s trademark registrations. Moreover, in 1999 the respondent’s predecessor-in-interest received a letter from Jameson’s representatives disclaiming any ownership rights in the disputed domain name, stating “[y]ou are free to create any content at all for www.jenna.com, so long as it does not include any mention to Jenna Jameson or . . . her intellectual property.”⁵⁴ The Panel stated, “Respondent has made out a good case that before any notice of the dispute, it used the disputed domain name in connection with *abona fide* offering of goods or services.”⁵⁵

Takeaway. Look out for any rights a predecessor-in-interest may have, as these may supersede a complainant’s rights.

► **pamanderson.com.**⁵⁶ In 2010, the starlet and Playboy model filed a complaint against the respondent for alleged improper use and registration of pamanderson.com. The parties had previously disputed the respondent’s registration of pamelaanderson.com, pamelaanderson.net, and pamelalee.com, resulting in a transfer of each to Anderson. The domain name was not in use when Anderson filed the complaint. The respondent was also involved in numerous other domain name disputes, including with Sandra Bullock, Ashley Judd, Cameron Diaz, Lynda Carter, Tom Cruise, Larry King, and J.R.R. Tolkien. Notably, the respondent had registered the domain name at issue in 1997, two years before the effective date of the UDRP in 1999 and 13 years before the WIPO complaint.

Holding. The Panel ordered the domain name transferred. WIPO held the UDRP retroactively applied via respondent’s registration

agreement with the registrar. The Panel further held the doctrine of laches did not apply to a domain name dispute. Notably, one panel member dissented, calling into question why Anderson did not file her complaint sooner.

Takeaway. File complaints expeditiously because laches may be found to apply.

► **tedturner.com.**⁵⁷ In 2002, Ted Turner filed a complaint related to the respondent's use of tedturner.com. The respondent, a college student, claimed to have registered the site to post his student work, including a report on Ted Turner and his business successes.

Holding. The Panel denied the complaint. The Panel made specific note of the fact Ted Turner was famous for his business dealings, rather than artistic achievements, but nonetheless held he had acquired rights in his name due to his fame. Yet while "Turner" was used in association with many of his business entities, "Ted Turner" was not, and Turner's legitimate use in commerce was via his surname alone. Turner also had not filed to register a federal trademark in his name until well after the respondent registered the domain name, and after the complaint was filed. Turner therefore could not establish legitimate commercial rights (either statutory or common law) in his full name.

Use of Stage Names

► **sting.com.**⁵⁸ In July 2000, Gordon Sumner, a/k/a "Sting," filed a complaint for the respondent's registration of sting.com. Sumner had used the name Sting in connection with worldwide touring and merchandise since 1978, but did not have any registered trademarks for it. The respondent registered sting.com in 1995, but did not use it in any way until 2000, after Sumner contacted him about it. The respondent then linked the website to gunbroker.com and offered to sell it to Sumner for \$25,000.

Holding. The Panel denied the complaint. The Panel ruled a nickname was not the same as a birth name. Sumner could not prove any legitimate interests in the specific word "sting," despite his continuous use of it for more than 20 years in the music business, because "sting" is a common word in the English language. This diminished any likelihood of confusion,

and Sumner could not otherwise demonstrate any statutory ownership of the name. Though the Panel ultimately declined to rule on the issue, it questioned whether the UDRP was even applicable to disputes over nicknames sounding in common words. Further, Sumner had failed to establish any bad faith.

Takeaway. Nicknames may not be protectable in UDRP proceedings.

Update. Sumner subsequently purchased the domain name directly from the respondent for an undisclosed amount.

► **madonna.com.**⁵⁹ In October 2000, Madonna Ciccone, a/k/a "Madonna," filed a complaint regarding the registration of madonna.com. The respondent had purchased the already-registered domain name for \$20,000 and linked it to a pornographic website. He had also registered a trademark for "Madonna" in Tunisia and included a disclaimer on the website that it was "not affiliated or endorsed by the Catholic Church, Madonna College, Madonna Hospital or Madonna the singer."⁶⁰ The respondent eventually took down the pornographic material but left the disclaimer in place.

Holding. The Panel ordered the domain name transferred. The Panel easily found a likelihood of confusion, because Madonna had registered marks in her name (in contrast to the *Sting* case) and had used her first name as a professional name since 1979. The legitimate interest factor was less clear due to the respondent's Tunisian mark registration. The Panel held, however, that the Tunisian mark alone was insufficient to establish a legitimate interest in the mark, primarily because the respondent admitted he had obtained the mark solely to establish rights in the domain name. Finally, the Panel held respondent had obtained the domain name solely to trade off Madonna's fame, and he could not provide any other plausible purpose.

Takeaway. Respondent's bad faith acquisition was sufficient to satisfy the requirement of bad faith registration. As an aside, the Panel found—although it did not rely upon the fact—the respondent had tarnished Madonna's reputation through the link to a pornographic site. This finding was made despite the fact

Madonna had previously posed in *Penthouse* and published the book *Sex* because, unlike those events, Madonna had no ability to control the "creative intent" or "standards of quality" of the linked porn site.⁶¹

► **dylanlarkin71.com.**⁶² Dylan Larkin, a center for the Detroit Red Wings hockey club, filed a complaint regarding dylanlarkin71.com. Shortly thereafter, the respondent emailed Larkin's agent, stating in part, "I have received multiple offers from people wanting to buy [the Domain Name] and being a Detroit Red Wings fan and a huge fan of Dylan Larkin, I wanted to first give you the opportunity to do so before I put it up for sale."⁶³ After several email exchanges, the respondent ultimately replied he had received "much better" offers from others and was going to pursue other options.⁶⁴ A complaint was immediately filed thereafter.

Holding. The Panel ordered the domain name transferred. Larkin had not registered a mark associated with his name, but his celebrity was sufficient to establish common law rights in it. Relying on the *Jenkins* case, the Panel held Larkin had rights in his name by way of his use of it as a professional hockey player. There was no evidence the respondent intended to do anything with the domain name other than extort money from Larkin.

Takeaway. The respondent demonstrated bad faith by stating he was considering better offers from other suitors. In addition, there was some question about whether the respondent's inclusion of Larkin's jersey number interfered with common law rights in the domain name. Ultimately, the Panel found the use of the number in addition to the name strengthened the complainant's argument, stating "the additional number does not meaningfully distinguish the Domain Name from the mark. Indeed, the fact that Complainant wears number 71 on his sweater indicates that confusing similarity may be exacerbated by the '71.'"⁶⁵

Names that are also Trademarks

► **mikerowesoft.com.** In August 2003, Mike Rowe, then a 17-year-old Canadian student, registered mikerowesoft.com as a play on his own name and set it up as a part-time web



LAWPAY IS FIVE STAR!



In our firm, it's actually fun to do our billings and get paid. I send our bills out first thing in the morning and more than half are paid by lunchtime.

LawPay makes my day!

– Cheryl Ischy, Legal Administrator
Austin, Texas



Trusted by more than **35,000** firms and verified **'5-Star'** rating on Trustpilot

PAYMENT INBOX		
	INVOICE PAID receipts@lawpay.com	\$775.00
	INVOICE PAID receipts@lawpay.com	\$1,500.00
	INVOICE PAID receipts@lawpay.com	

VISA **mastercard.**
AMERICAN EXPRESS **DISCOVER**

PAYMENT RECEIVED

LAWPAY[®]

AN AFFINIPAY SOLUTION

THE #1 PAYMENT SOLUTION FOR LAW FIRMS

Getting paid should be the easiest part of your job, and with LawPay, it is! However you run your firm, LawPay's flexible, easy-to-use system can work for you. Designed specifically for the legal industry, your earned/unearned fees are properly separated and your IOLTA is always protected against third-party debiting. Give your firm, and your clients, the benefit of easy online payments with LawPay.

866-227-6006 or visit lawpay.com/cobar

LawPay is proud to be a vetted and approved Member Benefit of the Colorado Bar Association.



Special offer for bar members.
Call for details

design business. Microsoft Corporation, viewing the name as phonetically similar to its famous brand and thus infringing on its mark, wrote Rowe and demanded transfer of the domain name. After Rowe offered to sell the name, the computer megacorporation offered Rowe \$10 for out-of-pocket expenses in registering it. Rowe countered, requesting \$10,000. Microsoft replied with a 25-page cease and desist letter, accusing Rowe of cybersquatting. Rowe went to the press and garnered substantial media attention. The attention was so great that Rowe's webpage crashed and he was forced to move the domain to a new Internet provider with higher capacity. He also received thousands of dollars in donations and free legal advice. The case became a public relations mess for Microsoft, which was pitted as the big bully corporation attacking the poor teenager.

Holding. None. Microsoft filed a UDRP complaint,⁶⁶ but it and Rowe ultimately reached

an out-of-court settlement whereby Rowe transferred the domain to Microsoft. As part of the settlement, Microsoft also set up a new website for Rowe, mikeroweforums.com, and gave Rowe an X-Box and an all-expenses-paid trip to the Microsoft Research Tech Fest in Redmond, Washington. Rowe donated the majority of the monies he received to a children's hospital, with the remainder funding his college education. Rowe went on to found Magic Pixel Labs, which creates iOS and Android apps.

Takeaway. Don't be too heavy-handed in domain-name dispute communications, particularly when a dispute may be reasonably and amicably resolved.

► **armani.com.**⁶⁷ In 2001, the fashion company sued Anand Ramnath Mani (A.R. Mani), a graphic designer and illustrator, for the latter's registration of armani.com in 1995. The design company owned a trademark related to "Armani"

and was upset that the respondent had registered the domain name, in accordance with his initials, for use with several of his businesses. The respondent demonstrated he had used his name in commerce since at least 1981. Armani offered the respondent money for the domain name on several occasions over a period of several years. When those efforts proved fruitless, Armani filed the complaint.

Holding. The Panel denied the complaint. The Panel held the designer had legitimate business use for the domain name and the fashion company could not demonstrate bad faith.

► **samfrancis.com.**⁶⁸ In a dispute over samfrancis.com, the estate of the abstract expressionist Sam Francis sued an Aspen, Colorado art gallery for its use of the domain name in connection with selling lithographs, etchings, and screen prints of the artist's paintings. The respondent argued its disclaimer made it clear the site was a commercial

COLORADO LAWYER ASSISTANCE PROGRAM



The Colorado Lawyer Assistance Program (COLAP) is an **independent and confidential** program exclusively for judges, lawyers, and law students.

Established by Colorado Supreme Court Rule 254, COLAP provides assistance with practice management, work/life integration, stress/anger management, anxiety, depression, substance abuse, and any career challenge that interferes with the ability to be a productive member of the legal community. COLAP provides referrals for a wide variety of personal and professional issues, assistance with interventions, voluntary monitoring programs, supportive relationships with peer volunteers, and educational programs (including ethics CLEs).

We would love to share our success stories,
but they are completely confidential.

For more information or for confidential assistance, please contact COLAP at **303-986-3345**.
Visit our website at **www.coloradolap.org**.

Appellate Practice Update 2018

Co-sponsored by the
CBA Litigation Section,
Appellate Practice Subcommittee

Friday, December 14, 2018

YOU WILL LEARN:

- Current Colorado Appellate Court Statistics
- Court Clerks and Staff Attorneys' Perspectives on Appeals and Motions
- Appellate Practice in the District Court
- Hot Topics in Criminal Appeals
- Appellate Ethics Tips and Traps
- Perspectives of the Bench on Oral Argument and Remote Arguments
- Tips for Effective Brief Writing in the Court's Eyes

PLUS, NEW THIS YEAR—During the noon hour, grab your lunch and attend one of the panel discussions. Your options are:

- Expanding into Appellate Practice
- Burning Questions? Ask the Judges!
- Talkin' Bout My Generation: Generational Differences and Technology in Appellate Practice

**AT THE
RALPH L. CARR
COLORADO JUDICIAL
CENTER**

2 E. 14th Avenue, Denver, CO

Video Replays: **January 9, 2019**
In Denver, Colorado Springs, and
Grand Junction

**Submitted for 7 General CLE Credits,
Including 1 Ethics Credit**

**REGISTER ONLINE TODAY
@ www.cba-cle.org**

gallery that merely sold works by the artist Sam Francis and was not run by Sam Francis himself.

Holding. The Panel denied the complaint. The complainant could not prove bad faith. The Panel declined to decide whether the studio demonstrated a legitimate business use in the domain name or whether its use of the domain name could constitute a fair use under U.S. trademark law. Both potentials, however, rebutted any bad faith in connection with the registration and use of the domain name.

Special Considerations for Politicians

► **annemcclellan.com.**⁶⁹ McLellan is a Canadian academic and politician. While serving as a member of the Canadian Parliament and the Minister of Justice, she filed two complaints regarding the respondent’s registration of annemcclellan.com and annemcclellan.org.

Holding. The Panel ordered the domain names transferred. The Panel determined McLellan had acquired sufficient common law rights in her name via her fame as a politician.

► **kathleenkennedytownsend.com.**⁷⁰ Townsend is a former U.S. politician and a relative of the late Robert Kennedy. In 2002, she filed a complaint concerning the respondent’s registration of kathleenkennedytownsend.com. At that time, Townsend was the lieutenant governor of Maryland and a potential candidate for Maryland’s upcoming governor race. The respondent had registered the domain name at issue, in addition to 10 other related domains, and had not done anything with them.

Holding. The Panel denied the complaint. Notably, the Panel contradicted *McLellan*, holding Townsend could not establish common law rights in her name solely based on her work as a politician. It relied on a 1999 WIPO report that stated the UDRP’s application “should be limited to personal names that had been commercially exploited.”⁷¹ The Panel stated, “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.”⁷² It additionally noted that had her political organization brought the complaint instead of Townsend, the outcome may have

been different, because the organization would qualify as an entity using the politician’s name within the scope of the UDRP’s commercial protections.⁷³


Takeaway. Make sure the correct party is named as the complainant.

► **hillaryclinton.com.**⁷⁴ In February 2005, then Senator Clinton filed a complaint against the respondent, who had registered hillaryclinton.com. The respondent used the disputed domain name to redirect to a generic search engine. The Panel viewed the evidence in the light most favorable to Clinton because the respondent failed to file a response.

Holding. The Panel ordered the domain name transferred. The Panel held Clinton had established common law rights in her name through the use of it in the marketplace—Clinton was then a best-selling author of four books that sold millions of copies—as well as her position as an internationally famous politician. The Panel found the respondent did not have any legitimate rights in the domain and had registered and used it in bad faith.

Takeaway. Fame alone may not be enough to meet the UDRP’s requirement of demonstrating use of the disputed mark in commerce. To be safe, a politician needs to show actual use of the mark in commerce, either via registration or common law rights.

Conclusion

The UDRP offers an efficient process for domain-name registration disputes. Practitioners filing UDRP cases should pay careful attention to UDRP precedent to ensure they can prove the elements of their claims. 

“
Fame alone may not be enough to meet the UDRP’s requirement of demonstrating use of the disputed mark in commerce. To be safe, a politician needs to show actual use of the mark in commerce, either via registration or common law rights.
”



Leigh Augustine is the managing partner at EIP US, LLP—laugustine@eip.com. **Zach Warkentin** is the principal of Warkentin

LLC. He advises companies and creatives on a variety of intellectual property, risk, compliance, and corporate issues—zach@warkentinllc.com.

Coordinating Editors: William Vobach, bvobach@iplaw.com; K Kalan, kmkalan@yahoo.com

NOTES

1. *Panavision Int'l, L.P. v. Toepfen*, 945F. Supp.1296 (C.D. Cal.1996), *aff'd*, 141F.3d1316 (9th Cir.1998).
2. 15 USC § 1125(d). Because the U.S. Congress created the ACPA, its scope is limited to registrations and disputes occurring within the United States.
3. See *id.*
4. www.icann.org.
5. The current version is available at www.icann.org/resources/pages/policy-2012-02-25-en.
6. See, e.g., www.godaddy.com/agreements/showdoc.aspx?pageid=REG_SA at ¶ 6.
7. www.godaddy.com; www.networksolutions.com.
8. www.icann.org/resources/pages/providers-6d-2012-02-25-en.
9. www.wipo.int/amc/en.
10. www.adrforum.com/Home/HomePage.
11. www.wipo.int/amc/en/center/faq/index.html.
12. www.icann.org/resources/pages/providers-6d-2012-02-25-en.
13. www.wipo.int/amc/en/domains/complainant.
14. "Cyberflight has beendefinedas 'an attempt to avoid or delay judicial or UDRP proceedings by changing domain registration details or registrars after learning of a complaint.' Many domain name dispute panels have found that 'this conduct is itself an indication of bad-faith registration and use under Paragraph 4(b)' of the UDRP." <https://giga.law/blog/2015/05/19/new-udrp-rules-will-help-reduce-cyberflight>.
15. See, e.g., Berkens, 2014 Final UDRP Stats from WIPO & NAF: 0.003% of All Domains Subject to A UDRP/URS, TheDomains.com (Oct. 16, 2015), www.thedomains.com/2015/10/16/2014-final-udrp-stats-from-wipo-naf-0-003-of-all-domains-subject-to-a-udrpurs.
16. *Id.* See also www.wipo.int/amc/en/domains/guide/#e.
17. *World Wrestling Fed'n Entm't, Inc. v. Bosman*, WIPO case no. D1999-001, www.wipo.int/amc/en/domains/decisions/html/1999/d1999-0001.html.
18. *Id.* at ¶ 3.
19. *Id.* at ¶ 4(k); www.icann.org/resources/pages/policy-2012-02-25-en#4.
20. See Berkens, *supra* note 18.
21. www.wipo.int/amc/en/domains/statistics/decision_rate.jsp?year=2017.
22. UDRP Rule 5(b), www.icann.org/resources/pages/udrp-rules-2015-03-11-en.
23. UDRP Rule 6(b) and (c).
24. UDRP Rule 15(b).
25. UDRP Rule 4.a. (emphasis added).
26. UDRP Rule 4.b.
27. *Larkin v. Johnson*, WIPO case no. D2016-1115 (July 20, 2016), www.wipo.int/amc/en/domains/search/text.jsp?case=D2016-1115.
28. *Roberts v. Boyd*, WIPO case no. D2000-0210 (May 29, 2000), www.wipo.int/amc/en/domains/decisions/html/2000/d2000-0210.html.
29. For other cases laying out the key elements of proof, see *Spacey v. Rods* (kevinspacey.com), NAF case no. FA0205000114437 (Aug. 1, 2002), www.adrforum.com/domaindecisions/114437.htm; and *Experience Hendrix. L.L.C. v. Hammerton* (jimihendrix.com), WIPO case no. D2000-0364 (Aug. 15, 2000), www.wipo.int/amc/en/domains/decisions/html/2000/d2000-0364.html (finding bad faith in registration and use of domain name that did not predate the complainant's use and rights in the name and mark and appeared to be an attempt to usurp the complainant's rights in them).
30. For a similar analysis, see also *Mick Jagger v. Denny Hammerton*, NAF case no. FA0007000095261 (Sep. 11, 2000), regarding [MickJagger.com](http://www.adrforum.com/domaindecisions/95261.htm) (Sep. 11, 2000), www.adrforum.com/domaindecisions/95261.htm.
31. *Id.*
32. *Williams v. Byrne*, WIPO case no. D2000-1673 (Jan. 30, 2001), www.wipo.int/amc/en/domains/decisions/html/2000/d2000-1673.html.
33. *Id.*
34. *Id.*
35. *Id.*
36. *Id.*
37. *Smith v. DNS Research, Inc.*, NAF case no. FA0312000220007 (Feb. 21, 2004), www.adrforum.com/domaindecisions/220007.htm.
38. *Id.*
39. *Willis v. NetHollywood*, WIPO case no. D2004-1030 (Feb. 17, 2004), www.wipo.int/amc/en/domains/decisions/html/2004/d2004-1030.html.
40. *Id.*
41. *2001 White Castle Way, Inc. v. Jacobs*, WIPO Case D2004-0001 (Mar. 26, 2004), www.wipo.int/amc/en/domains/decisions/html/2004/d2004-0001.html.
42. *Id.*
43. *Id.*
44. *Jenkins v. Lewis*, WIPO case no. D2014-0695 (June 23, 2014), www.wipo.int/amc/en/domains/search/text.jsp?case=D2014-0695.
45. *Id.*
46. *MPL Commc'ns, Ltd. v. LOVEARTH.net*, NAF case no. FA0104000097086 (June 4, 2001), www.adrforum.com/domaindecisions/97086.htm.
47. *Id.*
48. *Gene Kelly Image Trust v. BWI Domain Manager*, WIPO case no. D2008-0342 (Apr. 22, 2008), www.wipo.int/amc/en/domains/decisions/html/2008/d2008-0342.html.
49. *Van Halen v. Morgan*, WIPO case no. D2000-1313 (Dec. 20, 2000), www.wipo.int/amc/en/domains/decisions/html/2000/d2000-1313.html.
50. *Id.*
51. *Springsteen v. Burgar*, WIPO case no. D2000-1532 (Jan. 25, 2001), www.wipo.int/amc/en/domains/decisions/html/2000/d2000-1532.html.
52. *Id.*
53. *Massdi p/k/a Jameson v. Linq Entertainment, Inc.*, WIPO case no. D2004-1042 (Feb. 15, 2005), www.wipo.int/amc/en/domains/decisions/html/2004/d2004-1042.html.
54. *Id.*
55. *Id.*
56. *Anderson v. Rods*, WIPO case no. D2010-1144 (Sept. 8, 2010), www.wipo.int/amc/en/domains/search/text.jsp?case=D2010-1144.
57. *Turner v. Fahmi*, WIPO case no. D2002-0251 (July 4, 2002), www.wipo.int/amc/en/domains/decisions/html/2002/d2002-0251.html.
58. *Sumner p/k/a Sting v. Urvan*, WIPO case no. D2000-0596 (July 24, 2000), www.wipo.int/amc/en/domains/decisions/html/2000/d2000-0596.html.
59. *Cicccone p/k/a Madonna v. Parisi*, WIPO case no. D2000-0847 (Oct. 12, 2000), www.wipo.int/amc/en/domains/decisions/html/2000/d2000-0847.html.
60. *Id.*
61. *Id.*
62. *Larkin v. Johnson*, WIPO case no. D2016-1115 (July 20, 2016), www.wipo.int/amc/en/domains/search/text.jsp?case=D2016-1115.
63. *Id.*
64. *Id.*
65. *Id.*
66. *Microsoft Corp.*, WIPO case no. 2004-0024 www.wipo.int/amc/en/domains/search/case.jsp?case_id=5799.
67. *Moddefine S.A. v. A.R. Mani*, WIPO case no. D2001-0537 (July 20, 2001), www.wipo.int/amc/en/domains/decisions/html/2001/d2001-0537.html.
68. *Nicholas ex rel. The Sam Francis Estate v. Magidson Fine Art, Inc.*, WIPO case no. D2000-0673 (Sept. 27, 2000), www.wipo.int/amc/en/domains/decisions/html/2000/d2000-0673.html.
69. *McClellan v. Smartcanuk.com*, eResolution case nos. AF-0303a and AF-0303b (Sept. 25, 2000), www.disputes.org/decisions/0303.htm.
70. *Townsend v. B.G. Birt*, WIPO case no. 2002-0030 (Apr. 11, 2002), www.wipo.int/amc/en/domains/decisions/html/2002/d2002-0030.html.
71. *Id.*
72. *Id.*
73. *Id.*
74. *Clinton v. Dinoia a/k/a/SZK.com*, NAF FA0502000414641 (Mar. 18, 2005), www.adrforum.com/domaindecisions/414641.htm.