



1-1-2001

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Recommended Citation

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 (2001).

Available at: <https://digitalcommons.lmu.edu/elr/vol21/iss2/3>

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NOTES & COMMENTS

PLAYING THE HOLLYWOOD NAME GAME IN CYBERCOURT: THE BATTLE OVER DOMAIN NAMES IN THE AGE OF CELEBRITY-SQUATTING

I. INTRODUCTION

Twentieth-century developments in communications, advertising, and entertainment have created a new commodity—the public personality.¹ As a result, celebrity names now possess enormous value.² Therefore, it is not surprising that as the Internet has exploded, cybersquatting³ celebrity domain names has become a growing business. For example, the original registrant of www.jimihendrix.com reportedly offered to sell the celebrity domain name for forty-one million dollars.⁴ As a result, many celebrities find people or businesses beat them to the punch in registering their personal name as a domain name.⁵ Cybersquatters have even gone so far as

1. *Hirsch v. S.C. Johnson & Son, Inc.*, 280 N.W.2d 129, 134 (Wis. 1979) (citing Melville B. Nimmer, *The Right of Publicity*, 19 LAW & CONTEMP. PROBS. 203, 203–04 (1954)); Rosemary J. Coombe, *Publicity Rights and Political Aspiration: Mass Culture, Gender Identity and Democracy*, 26 NEW ENG. L. REV. 1221, 1228 (2000) (stating public personality is such a “potent force” that it “can be harnessed to ensure consumer demand”).

2. *Hirsch*, 280 N.W.2d at 134 (citing Melville B. Nimmer, *The Right of Publicity*, 19 LAW & CONTEMP. PROBS. 203, 203–04 (1954)). The public personality now has “a pecuniary value undreamed of at the turn of the century.” *Id.* (quoting Melville B. Nimmer, *The Right of Publicity*, 19 LAW & CONTEMP. PROBS. 203, 203–04 (1954)).

3. Cybersquatting has been defined as the speculative purchase of a domain name with the intent to sell the name for a profit. Ira S. Nathenson, Comment, *Showdown at the Domain Name Corral: Property Rights and Personal Jurisdiction over Squatters, Poachers, and Other Parasites*, 58 U. PITT. L. REV. 911, 925–26 (1997) (citing Robert Gurrola, *Federal Court Rules that Domain Name ‘Squatting’ Violates California and Federal Dilution Laws*, WEST’S LEGAL NEWS, Nov. 21, 1996, available at 1996 WL 669219). Generally, the cybersquatter will register the famous name and then attempt to sell it to the corresponding trademark holder. *Id.* Domain name disputes also feature “parasites,” who, like cybersquatters, register a name for profit. *Id.* at 927. A parasite uses a domain name that is a similar, commonly mistyped, or misspelled version of a famous name to confuse visitors or gain incidental traffic to a site. *Id.*

4. Joseph Gallivan, *Cybersquatter Gets Evicted in Victory for Hendrix Kin*, N.Y. POST, Aug. 9, 2000, at 37.

to register the names of celebrities' family members.⁶ For instance, actress Catherine Zeta-Jones and actor Michael Douglas discovered that cybersquatters registered six variations of their son's name just two weeks after his birth.⁷

The intentions of a domain name registrant may be genuine, yet, more often than not, the registrant desires profit.⁸ A registrant profits by selling the web site to the highest bidder, or by linking commercially-related sites to the celebrity domain name to attract visitors.⁹

Regardless of the registrant's intent, celebrities have several reasons to protect their domain names. They may hope to use the domain name for their own business and personal purposes. To illustrate, Barbara Streisand uses her site to dispel rumors about her life;¹⁰ Britney Spears uses hers to promote concerts;¹¹ Shirley Maclaine uses hers to discuss new-age issues;¹² and Stephen King uses his to sell his latest novel and answer questions.¹³

Moreover, celebrities wish to maintain their public images.¹⁴ For example, comedian/actress Rita Rudner expressed concern that an inactive web site registered under her name would adversely affect her reputation.¹⁵ She believed fans would be unable to obtain information about her or

5. See Jon Swartz, *Profiteers Get Squat for Web Names*, USA TODAY, Aug. 25, 2000, at 18 (discussing the disputed domain names of Julia Roberts, Dan Marino, Ally McBeal, and Jimi Hendrix). Disputes concerning the following domain names have been filed in the last year: allymcbeal.com, angeddes.com, bradpitt.com, davematthewsband.com, gaultier.com, harpomarx.com, jamesdean.net, johnnycarson.com, julioiglesias.com, mickjagger.com, paulmccartney.com, pearljam.com, petergabriel.com, princessdiana.com, rossperot.com, and tinaturner.net. *List of Proceedings Under Uniform Domain Name Dispute Resolution Policy*, at <http://www.icann.org/udrp/proceedings-list-name.htm> (last visited Feb. 6, 2001).

6. Dominic Herbert, *Net Surfers to Cash in on Zeta's Dylan*, THE NEWS OF THE WORLD, Aug. 20, 2000.

7. *Id.*

8. See Swartz, *supra* note 5. For example, Dan Parisi purchased Madonna.com and used it as a pornography site. *Id.* Parisi then wanted to donate the web site to a rehabilitation hospital. *Id.* However, he spent \$100,000 to register the domain names of more than 500 companies with the suffix "sucks.com." *Id.*

9. See *id.*

10. Mike Pearson, *Celebrity Web Sites Push Personalities*, DENVER ROCKY MTN. NEWS, Aug. 20, 2000, at 3D.

11. *Id.*

12. Ian Ansdell, *The Game of the Name*, THE HERALD (Glasgow), Aug. 25, 2000, at 27.

13. Pearson, *supra* note 10.

14. Gallivan, *supra* note 4 (United Nations arbitrator awarded the rights to jimihendrix.com to Hendrix's family.).

15. Rudner v. Internetco Corp., No. D2000-0581, §§ 4, 5 (WIPO Aug. 3, 2000), at <http://arbiter.wipo.int/domains/decisions/html/d2000-0581.html> (last visited Aug. 31, 2000) [hereinafter *Rudner Case*].

worse, that the site would be linked to pornography.¹⁶ Also, a celebrity may seek to prevent cybersquatters from profiting from a name that the celebrity has struggled to establish.¹⁷ For instance, when Brad Pitt fought to gain control of www.bradpitt.com and www.bradpitt.net, his claim focused on the commercial value of his name.¹⁸ Pitt argued his name enjoyed enormous value both in the entertainment industry and in the public, based on "his talent, popularity and hard work."¹⁹ As such, Pitt refused to pay the registrant to obtain his domain name.²⁰

The problems faced by Pitt, Rudner, and others, prompted the development of the "Friend to Friend Foundation," which purchases domain names of celebrities, and subsequently gives the registration to the celebrity free of charge.²¹ However, as a practical matter, celebrities cannot rely on others to win the battle against cybersquatting. Therefore, they are turning to the legal system for assistance.²² Celebrity domain name protection, however, is a new issue for the courts, and it is questionable whether existing legal theories are adequate.²³

This Comment examines how both the courts and the Internet community have responded to the problem of celebrity-cybersquatting. It suggests these cases are best handled by the alternative dispute procedures of the International Corporation for Assigned Names and Numbers ("ICANN"). Although courts may be able to address celebrity-cybersquatting, ICANN has lead the way thus far, and is likely to continue to do so in the future. Part II of this Comment explains the evolution of the domain name system, and outlines the legal theories applicable to celebrity domain name disputes. Part III explores recent arbitration cases and their impact on the trend of famous-name disputes. Part IV analyzes the outcome of the high-profile battle over Madonna.com, as this decision clarifies past panel decisions. Part V highlights the benefits of the ICANN dispute policy. Finally, Part VI discusses what lies ahead in the area of domain name disputes.

16. *Id.*

17. See Ann Donahue, *Stars Battle Cybersquatters for Rights to Names*, L.A. BUS. J., Jan. 31, 2000, at 3.

18. *Id.*

19. *Id.*

20. See *id.*

21. Brenda Sandburg, *The Name Game*, THE RECORDER, Sept. 8, 1999, at 1. The Friend to Friend Foundation reserves the names on the original owners' behalf to prevent cybersquatting. *Id.*

22. *Id.*

23. See generally *id.* See also *infra* Part II.B (explaining the available claims and their application to domain name disputes).

II. BACKGROUND

Cybersquatting confronts both the legal and the Internet communities because control of a name is largely a property issue and domain name registration is an Internet issue.²⁴ As a result, both communities have developed methods of resolving domain name disputes. Celebrities, therefore, can either pursue traditional legal remedies or alternative dispute resolution services.

A. *The Domain Name System*

Before examining the available causes of action, it is necessary to understand the basic concepts surrounding domain names. Generally, a domain name allows an Internet user to easily navigate from web site to web site.²⁵ When a user enters a domain name into a browser, the user sees the "human-friendly address" of the web site, such as www.law.com.²⁶ What does not appear, however, is the Internet Protocol Number ("IP") that corresponds with the domain name.²⁷ The IP is the domain name's unique numeric address, such as 123.45.678.90.²⁸ Instead of entering a string of numbers, like a telephone number, the user simply types the domain name.²⁹ Thus, the domain name provides an address for a web site that is easy to remember.³⁰

Accordingly, domain names have come to serve as business or personal identifiers.³¹ The World Intellectual Property Organization ("WIPO") suggests although telephone and fax numbers consist of a random list of numbers, domain names are directly associated with the name of the person, company, product or service that is the subject of the web site.³² As a result, businesses opt to use their company names as their domain names so consumers can easily locate them on the Internet.³³ For

24. Neil L. Martin, Note, *The Anticybersquatting Consumer Protection Act: Empowering Trademark Owners, but Not the Last Word on Domain Name Disputes*, 25 IOWA J. CORP. L. 591, 592 (2000).

25. Final Report of the WIPO Internet Domain Name Process, *The Management of Internet Names and Addresses: Intellectual Property Issues*, at 2 (Apr. 30, 1999), at <http://wipo2.wipo.int> (last visited Oct. 18, 2000) [hereinafter Final Report of the WIPO Domain Name Process].

26. *See id.*

27. *See id.*

28. *Id.*

29. *See id.* at 3.

30. *Id.*

31. Final Report of the WIPO Internet Domain Name Process, *supra* note 25, at 3.

32. *Id.*

33. *See id.*

this reason, a domain name becomes valuable as a marketing tool, and worthy of protection.

Increased use of the Internet,³⁴ coupled with the increased value of domain names, has created a fast-growing domain name registration business. As of Spring 1999, 7.2 million domain names were registered at the rate of 21,000 per week.³⁵ VeriSign, one of the largest registration agencies, maintained registration data for 19 million domain names as of Fall 2000.³⁶

Registration of a domain name occurs on a first-come, first-serve basis.³⁷ Equally important, domain name registration is recognized internationally.³⁸ This differs from trademark registration because trademarks are registered according to certain domestic government rules and are subject to geographic parameters.³⁹

The registration process is not only far-reaching, but fairly simple. For instance, VeriSign provides an online four-step process to become a registrant.⁴⁰ Registering a domain name requires payment of a one-time license fee, credit approval, providing a deposit, and signing various agreements.⁴¹ It is also possible to discover the registrant of a domain name online.⁴² Interested parties can visit a registration web site and search by domain name, registrant or server.⁴³

34. The number of Internet users increased from one million to seventy million from 1990 to 1997. *Id.* at 1.

35. *Id.* at 3.

36. *Network Solutions Registry Division Renamed VeriSign Global Registry Services*, BUS. WIRE, Sept. 14, 2000.

37. Press Release, WIPO To Probe New Issues Relating to Domain Name Abuse (July 10, 2000), at <http://www.wipo.org/eng/pressrel/2000/p235.htm> (last visited Jan. 16, 2001) [hereinafter WIPO Press Release] (further explaining that a non-governmental organization administers domain names without any functional limitations); Helen A. Jimenez, *Cybersquatting Still Considered To Be a Serious Problem in the Internet World*, BUSINESSWORLD, July 18, 2000, at 9.

38. WIPO Press Release, *supra* note 37.

39. *Id.*; Jimenez, *supra* note 37.

40. *How To Become a Registrar*, VeriSign Global Registry Service, at <http://www.nsiregistry.org/registrar/index.html> (last visited Jan. 16, 2001).

41. *Registrar Ramp-Up Process*, VeriSign Global Registry Service, at <http://www.nsiregistry.org/registrar/step2.html> (last visited Oct. 1, 2000).

42. See *WHOIS Search*, VeriSign Global Registry Service, at <http://www.nsiregistry.org/whois> (last visited Jan. 16, 2001).

43. See *id.*

B. Traditional Causes of Action

While the registration process is fairly simple, the law governing registration disputes is unclear.⁴⁴ For example, legal experts claim that even when a company owns a particular business name, the law does not guarantee the company will prevail in a domain name dispute.⁴⁵ The Internet community has coined this “the trademark problem”: who should receive the domain name registration in the case where two businesses each have a legitimate basis for seeking such registration?⁴⁶

The “trademark problem” is exacerbated by the newness of domain name disputes and the lack of case law offering definitive rules.⁴⁷ The few existing decisions involve ownership of a corporate domain name rather than a celebrity domain name.⁴⁸ Thus, it is not entirely clear how courts would handle a domain name dispute involving a celebrity as opposed to a corporate entity. Notwithstanding the level of uncertainty, there are several causes of action to consider, such as rights of publicity, trademark law, and the Anticybersquatting Consumer Protection Act (“ACPA”).⁴⁹

1. The Right of Publicity Claim

The common law right of publicity, also known as “the appropriation tort,” addresses the right of celebrities or other famous people to control the commercial value and exploitation of their names.⁵⁰ Although William L. Prosser has identified the right of publicity as one of four privacy torts,⁵¹

44. Fran Littlewood, *Dot-com Despair for Small Players*, THE TIMES (London), Aug. 19, 2000, at Features.

45. *Id.*

46. Jefferson F. Scher, *Swapping Claims in Cyberspace: Legal/Technical Context and Negotiation Strategies for Domain Name Deals*, 21 HASTINGS COMM. & ENT. L.J. 545, 557 (1999).

47. Littlewood, *supra* note 44.

48. Howard Siegel and Steven R. Doran, *Chasing Down Cybersquatters Who Register Celebrity Domain Names*, ENT. LAW & FIN., Mar. 2000, at 1, 4. Brad Pitt and John Tesh filed lawsuits, but later settled and relinquished their claims to the domain names. *Id.*

49. *See id.*

50. 63C AM. JUR. 2D *Property* § 6, at 73 & n.52 (1997) (citing *Estate of Presley v. Russen*, 513 F. Supp. 1339, 1358 (D.N.J. 1981)). The use of a person’s name and likeness is “ ‘a right of value upon which plaintiff can capitalize by selling licenses.’ ” *Lugosi v. Universal Pictures*, 603 P.2d 425, 428 (Cal. 1979) (quoting DEAN PROSSER, *LAW OF TORTS* § 117, at 807 (4th ed. 1971)). The law extends this protection to both names and nicknames. 63C AM. JUR. 2D *Property* § 6, at 73–74 & nn.58, 59 (1997) (citing *Haelon Labs., Inc. v. Topps Chewing Gum, Inc.*, 202 F.2d 866, 867 (2d Cir. 1953); *Hirsch v. S.C. Johnson & Son, Inc.*, 280 N.W.2d 129, 131 (Wis. 1979)).

51. *Hirsch*, 280 N.W.2d at 133 (citing Dean Prosser, *Privacy*, 48 CAL. L. REV. 383, 389 (1960)).

publicity rights differ from privacy rights.⁵² Privacy rights center on a person's right to be left alone, whereas publicity rights focus on a person's ability to control property, that is, their name or likeness.⁵³ Notably, unlike certain privacy rights, celebrities do not relinquish publicity rights despite their status as public figures.⁵⁴

a. The Elements of a Publicity Claim

Under the common law, a plaintiff must prove four elements to succeed on a publicity claim: 1) the defendant used the identity of the celebrity; 2) the defendant appropriated the identity to the defendant's advantage; 3) the plaintiff did not consent and 4) the defendant caused the plaintiff's injury.⁵⁵ Usually, the plaintiff possesses 'some degree of a celebrated status.'⁵⁶ Additionally, some states have codified a celebrity's right to publicity. California's statute,⁵⁷ for instance, resembles the common law, but also requires the plaintiff to demonstrate the defendant had knowledge of the use of the celebrity's name.⁵⁸ Consequently, the California requirement makes it more difficult to hold a defendant liable for accidentally using the name of a celebrity.

b. Application of Publicity Rights to Celebrity Domain Name Disputes

Generally, publicity actions arise when a defendant uses a celebrity's name in advertising, promotes a product without permission⁵⁹ or distributes an objectionable portrayal of the celebrity.⁶⁰ Federal courts encountered

52. 63C AM. JUR. 2D *Property* § 6, at 73 & n.56 (1997) (citing *Haelon Labs.*, 202 F.2d at 868; *Hirsch*, 280 N.W.2d at 132).

53. *Id.* & n.57 (citing *Hirsch*, 280 N.W.2d at 134).

54. *See* *Ali v. Playgirl, Inc.*, 447 F. Supp. 723, 727 (S.D.N.Y. 1978) (citing *Booth v. Curtis Publ'g Co.*, 223 N.Y.S.2d 737, 745 (N.Y. App. Div. 1962)).

55. *Eastwood v. Superior Court*, 198 Cal. Rptr. 342, 347 (Ct. App. 1983) (citing DEAN PROSSER, *LAW OF TORTS* § 117, at 804-07 (4th ed. 1971)).

56. *Ali*, 447 F. Supp. at 729 (quoting *Price v. Hal Roach Studios, Inc.*, 400 F. Supp. 836, 847 & n.18 (S.D.N.Y. 1975) (quoting Harold Gordon, *Right of Property in Name, Likeness, Personality and History*, 55 NW. U. L. REV. 553, 607 (1960))).

57. *See* CAL. CIV. CODE § 3344 (West 1997).

58. *Eastwood*, 198 Cal. Rptr. at 347.

59. *Abdul-Jabbar v. GMC*, 85 F.3d 407, 409 (9th Cir. 1996) (finding advertiser used athlete's name in television commercials without consent); *Cher v. Forum Int'l, Ltd.*, 213 U.S.P.Q. (BNA) 96, 98-99 (C.D. Cal. 1982) (finding magazine used celebrity's interview without consent); *Carson v. Nat'l Bank of Commerce Trust & Savs.*, 501 F.2d 1082, 1082-83 (8th Cir. 1974) (finding bank used celebrity's name in connection with tour package).

60. *Ali*, 447 F. Supp. at 726 (portrait published in *Playgirl Magazine* depicted a nude, black man seated in a boxing ring corner).

the question of whether these rights apply to the Internet in *McGraw v. Salmon*,⁶¹ the first, and currently only, lawsuit brought before the courts to enter a judgment in a celebrity domain name dispute.⁶² In *McGraw*, twenty-seven country musicians, including Trisha Yearwood, Vince Gill, Reba McEntire, and Randy Travis, sued the registrant of their domain names.⁶³ In a brief opinion, the California district court granted summary judgment for the plaintiffs' claims of violation of publicity rights and trademark infringement.⁶⁴ While the reasoning was not extensive, the court in *McGraw* established that a right of publicity claim is a viable choice for celebrity plaintiffs when a celebrity can demonstrate the registrant appropriated the celebrity's identity for commercial gain.⁶⁵

Although publicity rights have not been the predominant claim in domain dispute litigation,⁶⁶ two specific aspects of the cause of action make it a useful tool for plaintiffs. First, a right of publicity claim does not require likelihood of confusion.⁶⁷ Second, the plaintiff is not required to prove the registrant intended to infringe on the mark or to cause harm.⁶⁸ Thus, a right of publicity claim may be an easier method of proving a registrant infringed on a celebrity's right to the domain name.

2. Trademark Law and Anticybersquatting Legislation

Like a publicity claim, trademark law is based on property rights.⁶⁹ Therefore, it is possible trademark law is an appropriate companion theory to a publicity claim in a domain name dispute. For example, the plaintiffs in *McGraw* pursued a publicity claim and a trademark claim in their

61. *McGraw v. Salmon*, No. 98-2495, 1998 U.S. Dist. LEXIS 10987 (C.D. Cal. June 30, 1998) (order granting summary judgment).

62. Chet Flippo, *Country Artists Win Suit Against 'Cybersquatter'*, BILLBOARD, July 11, 1998, at 2.

63. *See McGraw*, 1998 U.S. Dist. LEXIS 10987, at *1-2.

64. *See id.*

65. *See generally McGraw*, 1998 U.S. Dist. LEXIS 10987.

66. Since *McGraw*, there have not been any reported celebrity domain dispute cases that involve rights of publicity. *See supra* note 5 and accompanying text (listing cases previously brought before the ICANN dispute forum).

67. *Rogers v. Grimaldi*, 875 F.2d 994, 1004 (2d Cir. 1989); *see also* ADAM L. BROOKMAN, TRADEMARK LAW: PROTECTION, ENFORCEMENT AND LICENSING § 6.06[A] (Supp. 2000) (discussing the nine factors to determine likelihood of confusion from the RESTATEMENT OF TORTS § 731 (1938)); *see also infra* Part II.B.2.a (discussing the likelihood of confusion element of trademark law).

68. Martin, *supra* note 24, at 605.

69. Trade-Mark Cases, 100 U.S. 82, 92 (1879).

cybersquatting lawsuit.⁷⁰ Celebrities have employed both claims in non-cybersquatting contexts as well.⁷¹

a. Trademarks and Service Marks

A trademark allows the public to identify the source of a product,⁷² whereas a service mark applies to services.⁷³ In simple terms, trademark law⁷⁴ gives the mark's owner the exclusive right to use the mark.⁷⁵ In effect, a trademark infringement claim enables the trademark owner to prevent others from confusing consumers "into wrongly associating products with an enterprise from which they do not originate."⁷⁶ To succeed on a statutory or common law trademark claim, a plaintiff must establish: 1) the plaintiff owned a name or symbol that is legally protectable and 2) the defendant used the name or symbol in a manner likely to create confusion concerning the origin of the goods or services.⁷⁷

In terms of the preliminary requirement of legal protectability, the general rule under common law is that personal names are considered "non-inherently distinctive terms."⁷⁸ Therefore, a celebrity can only acquire protection if the personal name develops distinctiveness and secondary meaning through use.⁷⁹ Personal names acquire secondary

70. See *McGraw v. Salmon*, No. 98-2495, 1998 U.S. Dist. LEXIS 10987 (C.D. Cal. June 30, 1998) (order granting summary judgment).

71. *Estate of Presley v. Russen*, 513 F. Supp. 1339, 1344 (D.N.J. 1981) (Plaintiff filed trademark infringement and right of publicity claims to protect images and names associated with Elvis Presley.).

72. Final Report of the WIPO Internet Domain Name Process, *supra* note 25, at 4.

73. 15 U.S.C. § 1127 (1994). A service mark is a word, name or symbol used in the sale or advertising of services to identify the source of the service and distinguish it from the services of others. *Id.*

74. For the purposes of this discussion, any references to trademark law or claims will include the protection of service marks because trademarks and service marks are governed by the same standards. *Boston Prof'l Hockey Assoc'n., Inc. v. Dallas Cap & Emblem Mfg., Inc.*, 510 F.2d 1004, 1009 (5th Cir. 1975).

75. Final Report of the WIPO Internet Domain Name Process, *supra* note 25, at 4.

76. *Id.*

77. See 15 U.S.C. § 1125(a) (1994); *Estate of Presley*, 513 F. Supp. at 1362.

78. *E. & J. Gallo Winery v. Gallo Cattle Co.*, 967 F.2d 1280, 1291 (9th Cir. 1992) (citing J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 13:2 (4th ed. 1984)). A personal name includes a first name and/or surnames. J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 13:2, at n.1 (4th ed. 2000).

79. *E. & J. Gallo Winery*, 967 F.2d at 1291 (Gallo mark acquired secondary meaning through the winery's long use of the mark, public recognition, and advertising promotions).

meaning when the name and personality become synonymous in the mind of the public.⁸⁰

Moreover, under federal trademark law, a performer can register a fictitious or real name as a service mark for the entertainment services the performer provides.⁸¹ For example, when the estate of Elvis Presley claimed legal protection for the names Elvis, Elvis Presley, and The King,⁸² the court found only the first two names were service marks.⁸³ “The King” did not warrant protection because the name was not used in advertising, in concerts, or on records.⁸⁴ “Elvis” and “Elvis Presley,” as in the common law, are non-inherently distinctive terms, but acquired secondary meaning over a long period of time through promotions, advertising, and licensed products.⁸⁵ Hence, in order to obtain a service mark, celebrities must show a correlation between use of their names and the services they provide.

The second element, likelihood of confusion, requires the defendant’s use create confusion or deception as to the source of the goods or services.⁸⁶ Courts have found this element satisfied if the plaintiff proves that consumers viewing the mark are likely to think the plaintiff sponsored, licensed or developed the goods or services.⁸⁷ The Ninth Circuit may consider the following factors: 1) the mark’s strength; 2) similarity of the marks; 3) evidence of confusion; 4) marketing channels used and 5) the type of goods or services involved.⁸⁸ As with rights of publicity, traditional trademark law has not been applied to domain name disputes in a sizeable way. However, if a celebrity’s name possesses secondary association and strongly resembles the domain name, a celebrity could probably establish likelihood of confusion.⁸⁹

80. *Visser v. Macres*, 29 Cal. Rptr. 367, 369–70 (Ct. App. 1963) (citing *Academy of Motion Picture Arts and Sciences v. Benson*, 104 P.2d 650, 651–52 (Cal. 1940); *Family Record Plan, Inc. v. Mitchell*, 342 P.2d 10, 15 (Cal. Ct. App. 1959); *Horlick’s Malted Milk Corp. v. Horluck’s, Inc.*, 59 F.2d 13, 15 (9th Cir. 1932); *J.A. Dougherty’s Sons, Inc., v. Dougherty*, 36 F. Supp. 149, 151 (E.D. Pa. 1940)).

81. *See* 15 U.S.C. § 1127.

82. *Estate of Presley*, 513 F. Supp. at 1344.

83. *Id.* at 1363.

84. *Id.*

85. *See id.*

86. *See* 15 U.S.C. § 1125(a).

87. *Estate of Presley*, 513 F. Supp. at 1367, 1371–72 (finding that the public would believe the plaintiff sponsored defendant’s performance).

88. ADAM L. BROOKMAN, TRADEMARK LAW: PROTECTION, ENFORCEMENT AND LICENSING § 6.06[B] (Supp. 2000) (citing *Wendt v. Host Int’l, Inc.*, 125 F.3d 806, 812 (9th Cir. 1997); *AMF, Inc. v. Sleekcraft Boats*, 599 F.2d 341, 348–49 (9th Cir. 1979)). This list is not exhaustive. *Id.* (citing *AMF*, 599 F.2d at 348 n.11).

89. *Cf. infra* Part III.2 (discussing likelihood of confusion under the ICANN dispute procedure).

b. The ACPA

In December of 1999, Congress enacted the ACPA,⁹⁰ an Internet specific supplement to existing trademark law.⁹¹ The drafters intended the ACPA to “fill in the gaps” of trademark law in order to address the newly developed problem of cybersquatting.⁹² The ACPA applies to domain names acquired before and after the law was passed,⁹³ and the mere act of registration is actionable.⁹⁴

In order to succeed under the ACPA, the plaintiff must establish two elements.⁹⁵ The first element considers whether the defendant possessed bad faith intent to profit from the use of a protected name.⁹⁶ The second element considers whether the defendant registered or used a domain name that 1) is “identical or confusingly similar” to a distinctive mark or famous mark or 2) is a “trademarked word or name.”⁹⁷ The “identical or confusingly similar” terminology parallels general trademark theory.⁹⁸

While the ACPA was adopted to protect domain names, its specific applicability to celebrities was not always so clear. According to former Representative James Rogan of California, the ACPA was originally intended to protect *businesses* which possessed an existing trademark.⁹⁹ Yet, in the final analysis of the law, the Act appears to protect personal names as well.¹⁰⁰ The basis for this conclusion is apparent from the text

90. See 15 U.S.C.A. § 1125(d) (Supp. 2000). California has adopted a similar cybersquatting statute, effective January, 2001. See 2000 Cal. Adv. Legis. Serv. 218 (Deering).

91. Martin, *supra* note 24, at 596.

92. *Id.*

93. John Hartje, *Resolving Internet Domain Name Disputes*, INTELL. PROP. TODAY, Aug. 2000, at 38.

94. Siegel & Doran, *supra* note 48, at 4.

95. See 15 U.S.C.A. § 1125(d)(1)(A).

96. *Id.* A court may consider, but is not limited to, nine Internet-specific factors: 1) whether the defendant has “trademark or other intellectual property rights” in the domain name; 2) whether the domain name is the legal name of the defendant or the name that is otherwise commonly used to identify the defendant; 3) the defendant’s prior use of the domain name in connection with the bona fide sale of goods or services; 4) the defendant’s bona fide noncommercial or fair use of the mark on the domain name’s web site; 5) the defendant’s intent to divert consumers from the mark to the owner’s web site; 6) the defendant’s offer to transfer, sell or assign the domain name to the mark owner or third party; 7) whether the defendant provided misleading, false contact information in order to register the domain name; 8) whether the defendant has acquired multiple domain names which the defendant knows are identical or confusingly similar to marks of others; and 9) whether the mark is distinctive and famous. *Id.* § 1125(d)(1)(B)(i)(I–IX).

97. *Id.* § 1125(d)(1)(A)(ii).

98. See *supra* Part II.B.2.a (discussing likelihood of confusion).

99. Donahue, *supra* note 17 (emphasis added).

100. See Martin, *supra* note 24, at 604 (analyzing 15 U.S.C.A. § 1125(d)(1)(A)).

itself, as section 1125 provides “a personal name . . . is protected as a mark under this section.”¹⁰¹ Furthermore, the section’s history reveals in 1999, Congress required the Secretary of Commerce, jointly with the Patent and Trademark Office and the Federal Election Commission, to study protections for personal domain names.¹⁰²

Practitioners also support the view that the law protects celebrities from cybersquatters. For instance, New York attorney Howard Siegel has interpreted the ACPA to provide a cause of action for the bad faith registration of a domain name of a living person, providing injunctive relief and the discretionary award of costs.¹⁰³ Although this cause of action is available, celebrity domain name cases, like purely commercial domain name cases, often settle. For instance, both Brad Pitt and John Tesh settled their domain name disputes against cybersquatters, and obtained control of their names.¹⁰⁴ Therefore, Siegel’s theory remains untested because, as even he acknowledges, decisions involving celebrity plaintiffs have not been reported.¹⁰⁵

In conclusion, general trademark law is weak in that it does not afford complete protection for celebrities. Celebrities must first obtain a valid trademark before bringing an infringement claim against a cybersquatter. The ACPA appears to overcome this weakness given the Act’s direct protection of personal names. However, there is little case precedent on which to rely when bringing a claim.

C. Domain Name Administrative Procedures

Despite the absence of celebrity domain name disputes in the courts, celebrities have not ignored the cybersquatting problem. Rather, they have turned to the Internet community, particularly ICANN, for an alternative solution.

1. History of ICANN’s Dispute Policy

In 1997, President William Jefferson Clinton directed the Secretary of Commerce to privatize the domain name system to increase competition and facilitate international participation.¹⁰⁶ As a result, ICANN, a non-

101. 15 U.S.C.A. § 1125(d)(1)(A).

102. *Id.* § 1125.

103. Siegel, *supra* note 48, at 4.

104. *Id.*

105. *Id.*

106. United States Department of Commerce, *Management of Internet Names and Addresses, National Telecommunications and Information Administration, Statement of Policy*,

profit,¹⁰⁷ private corporation, was founded in October 1998.¹⁰⁸ In addition to having managed the transition of domain name registration to the private sector,¹⁰⁹ ICANN is responsible for a majority of the Internet's technical functions,¹¹⁰ including registration and dispute resolution.¹¹¹

After developing ICANN, the United States invited the WIPO to study the relationship between domain names and intellectual property.¹¹² The WIPO, based in Geneva, was formed through a treaty of 171 countries to "promote the protection, dissemination and use of intellectual property."¹¹³ In April 1999, the WIPO recommended a dispute resolution procedure.¹¹⁴ Until this point, registration companies, such as VeriSign, the first and leading provider of domain name registration since 1991,¹¹⁵ often resolved disputes informally.¹¹⁶

Following the WIPO report, ICANN endorsed the concept of a uniform dispute resolution policy for all domain names in the .com, .net, and .org top-level domains.¹¹⁷ The organization considered additional studies and models,¹¹⁸ and then approved what is now known as the "Uniform Domain Name Dispute Resolution Policy" ("UDRP") in October 1999.¹¹⁹

No. 980212036-8146-02, at <http://www.icann.org/general/white-paper-05jun98.htm> (last visited Jan. 16, 2001).

107. Hartje, *supra* note 93, at 38.

108. A. Michael Froomkin, *Wrong Turn in Cyberspace: Using ICANN to Route Around the APA and the Constitution*, 50 DUKE L.J. 17, 72 (2000).

109. See *ICANN Fact Sheet*, at <http://www.icann.org/general/fact-sheet.htm> (last visited Jan. 16, 2001).

110. *Id.*

111. See *Overview of ICANN Uniform Domain Name Dispute Resolution Policy and Rules*, at <http://arbiter.wipo.int/domains/registrar/overview.html> (last visited Jan. 16, 2001).

112. *Frequently Asked Questions*, at <http://www.icann.org/general/faq1.htm> (last visited Jan. 23, 2000) [hereinafter *ICANN Frequently Asked Questions*].

113. Final Report of the WIPO Internet Domain Name Process, *supra* note 25.

114. *ICANN Frequently Asked Questions*, *supra* note 112.

115. *About VeriSign GRS*, at <http://www.nsiregistry.net/aboutus/> (last visited Feb. 26, 2001).

116. Hartje, *supra* note 93, at 38.

117. *ICANN Frequently Asked Questions*, *supra* note 112.

118. *Id.*

119. *Uniform Domain Name Dispute Resolution Policy*, at <http://www.icann.org/udrp/udrp-policy-24oct99.htm> (last visited Jan. 16, 2001) [hereinafter *ICANN Uniform Domain Name Dispute Resolution Policy*].

2. The UDRP

All domain registration agreements now refer to the UDRP.¹²⁰ As a consequence, a registrant is required to submit to a mandatory administrative proceeding at one of ICANN's approved dispute resolution providers when a complainant asserts domain name infringement.¹²¹ In most cases, the complainant chooses the provider.¹²² Each dispute resolution service follows its own supplemental rules as well as the general ICANN policy.¹²³ ICANN does not participate in the administrative proceeding.¹²⁴

Additionally, the UDRP limits remedies to either cancellation of the registrant's domain name or transfer of the domain name to the complainant.¹²⁵ Unlike courts of law,¹²⁶ a panel of one or three members will oversee the arbitration proceeding.¹²⁷ The complainant pays a fee that depending on the number of disputed domain names, and the number of members on the panel.¹²⁸

The ICANN policy differs from the previous VeriSign/Network Solutions' approach in the following ways: 1) ICANN will not place the disputed domain name "on hold" during the dispute process;¹²⁹ 2) ICANN panels will issue a definitive result (as mentioned above, the domain name use is allowed, transferred or cancelled);¹³⁰ 3) the ICANN policy "applies

120. *Id.* § 1.

121. *Id.* § 4. ICANN has approved four dispute resolution providers: The CPR Institute for Dispute Resolution, eResolution, The National Arbitration Forum, and the WIPO. *Approved Providers for Uniform Domain Name Dispute Resolution Policy*, at <http://www.icann.org/udrp/approved-providers.htm> (last modified Oct. 17, 2000). Currently, WIPO is the most frequently used dispute resolution provider. *Id.*

122. *ICANN Uniform Domain Name Dispute Resolution Policy*, *supra* note 119, § 4(d).

123. *Id.* § 1.

124. *Id.* § 4(h).

125. *Id.* § 4(i).

126. *See infra* Part V (providing a detailed comparison of the ICANN procedures with traditional court procedures).

127. *Overview of ICANN Uniform Domain Name Dispute Resolution Policy and Rules*, at <http://arbiter.wipo.int/domains/registrar/overview.html> (last visited Jan. 16, 2001).

128. Hartje, *supra* note 93, at 38. If a complainant selects a one-member panel, and the respondent elects to have a three-member panel, which is allowed under the UDRP, the respondent will then have to pay a fee equal to one-half of the fixed fee required for a three-member panel. *Rules for Uniform Domain Name Dispute Resolution Policy*, § 19, at <http://www.icann.org/udrp/udrp-rules-24oct99.htm> (last visited Jan. 23, 2001).

129. *WIPO Guide to the Uniform Domain Name Dispute Resolution Policy*, § G, at <http://arbiter.wipo.int/domains/guide/index.html> (last visited Jan. 16, 2001) [hereinafter *WIPO Guide to the Uniform Domain Name Dispute Resolution Policy*].

130. *Id.*

to common law trademarks as well as registered trademarks”¹³¹ and 4) ICANN considers whether the domain name is confusingly similar or identical to the complainant’s name.¹³²

Although the ICANN policy is fairly new, it is rapidly growing in popularity. For instance, as of the end of January 2000, only twenty-eight complainants had filed cases with the WIPO.¹³³ Yet, by August 2000, 258 cases were filed,¹³⁴ and the total number of cases filed for the year 2000 reached 1,841.¹³⁵ Moreover, a majority of the complaining parties are from the United States, the United Kingdom, France, Spain, and Germany.¹³⁶

3. The Elements of the UDRP Claim

Although the key to a complainant’s successful outcome under the ICANN policy is whether or not a cybersquatter registered and used a name in bad faith,¹³⁷ the panels will examine three elements.¹³⁸

Initially, a panel determines whether the domain name “is identical or confusingly similar to a trademark or service mark in which the complainant has rights.”¹³⁹ A complainant may show trademark rights through formal registration or through use, in other words, common law rights.¹⁴⁰

The second element the panel considers is whether the registrant has any right or legitimate interest in the domain name.¹⁴¹ A registrant may demonstrate this in one of three ways. First, the registrant, before notice of the dispute can use the domain name “in connection with a bona fide offering of goods or services.”¹⁴² Alternatively, registrants can establish they have been “commonly known by the domain name,” even if the registrant did not acquire trademark or service mark rights.¹⁴³ Finally, registrants can fulfill this element by making “a legitimate noncommercial

131. *Id.*

132. *Id.*

133. *Case Filings in 2000*, at <http://arbiter.wipo.int/domains/statistics/filings.html> (last visited Jan. 16, 2001).

134. *Id.*

135. *Id.* This number was obtained by adding together the monthly totals listed.

136. *Geographical Distribution of Parties 2000*, at <http://arbiter.wipo.int/domains/statistics/countries.html> (last visited Jan. 16, 2001).

137. Littlewood, *supra* note 44.

138. See *ICANN Uniform Domain Name Dispute Resolution Policy*, *supra* note 119, § 4(a).

139. *Id.* § 4(a)(i).

140. See *infra* Part III.A (discussing the establishment of rights in a domain name).

141. *ICANN Uniform Domain Name Dispute Resolution Policy*, *supra* note 119, § 4(a)(ii).

142. *Id.* § 4(c)(i).

143. *Id.* § 4(c)(ii).

or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish" the mark.¹⁴⁴

The third and final element of the UDRP is whether the domain name was registered and used in bad faith.¹⁴⁵ There are several ways for the complainant to demonstrate bad faith: if the web site is used for the purpose of selling, rendering, or transferring goods;¹⁴⁶ if the registrant is preventing a mark owner from using the mark in a domain name;¹⁴⁷ if the registrant intended to disrupt a competitor's business¹⁴⁸ or if the registrant is creating confusion for commercial gain.¹⁴⁹

Although the policy requires proof of all three elements,¹⁵⁰ in practice, the complainant will establish trademark or common law rights in the domain name, and generally, that the registrant operated in bad faith.¹⁵¹ The registrant may, however, have the burden of showing legitimate interests in the domain name,¹⁵² and of establishing good faith.¹⁵³

It is also important to note that a web site need not be active to infringe on a celebrity's rights.¹⁵⁴ ICANN considers a web site "used"¹⁵⁵ for the purposes of determining whether a cybersquatter has infringed on

144. *Id.* § 4(c)(iii).

145. *Id.* § 4(a)(iii).

146. *Id.* § 4(b)(i).

147. *ICANN Uniform Domain Name Dispute Resolution Policy*, *supra* note 119, § 4(a)(ii).

148. *Id.* § 4(b)(iii).

149. *Id.* § 4(b)(iv).

150. *Id.* § 4(a). Unlike traditional courts, WIPO panels generally decide issues such as burden of proof, relevance, and materiality on a case-by-case basis. Tricia A. Hoefling, Comment, *The (Draft) WIPO Arbitration Rules for Administrative Challenge Panel Procedures Concerning Internet Domain Names*, 8 AM. REV. INT'L ARB. 173, 195-96 (1997).

151. *See* *Sumner v. Urvan*, No. D2000-0596, §§ 6.2, 6.10 (WIPO July 24, 2000), at <http://arbiter.wipo.int/domains/decisions/html/d2000-0596.html> (last visited Jan. 16, 2001) [hereinafter *Sumner Case*].

152. *Id.* § 6.8. In Bruce Springsteen's dispute concerning www.springsteen.com, the panel's analysis conflicted on the issue of the burden of proof regarding legitimate rights. *Springsteen v. Burgar*, No. D2000-1532, § 6 (WIPO Jan. 25, 2001), at <http://arbiter.wipo.int/domains/decisions/html/d2000-1532.html> (last visited Feb. 26, 2001) [hereinafter *Springsteen Case*]. Two panel members required the complainant to prove that the registrant lacked legitimate rights. *Id.* However, the panel advised respondents to offer evidence of their rights. *Id.* Further, the third panel member acknowledged that the UDRP states that the complainant has the burden, but claimed that "an assertion by Complainant that Respondent has no rights in the mark . . . is sufficient to shift the burden." *Id.* (Page, R., dissenting).

153. *See* *Winterson v. Hogarth*, No. D2000-0235, § 6.21 (WIPO May 22, 2000), at <http://arbiter.wipo.int/domains/decisions/html/d2000-0235.html> (last visited Jan. 16 2001) [hereinafter *Winterson Case*]. *But cf.* *Springsteen Case*, *supra* note 152, § 6 (claiming that the *Winterson* panel erred by suggesting that respondents have the burden of proof).

154. Jennifer E. Bagalawis, *Philippines: WIPO Offers Fast Resolution of Cyber-Squatting Disputes*, COMPUTERWORLD (PHILIPPINES), Aug. 14, 2000.

155. *Id.*

the domain name, even if the name was registered, but never developed into a functioning web site.¹⁵⁶ The ACPA features a similar policy.¹⁵⁷ Thus, a celebrity can have a claim against a cybersquatter immediately upon registration of the site.

4. Application of the UDRP to Celebrity Domain Names

The application of the UDRP to celebrity rights was tested early in the policy's first year when the administrative panel in *Sumner v. Urvan*¹⁵⁸ considered the dispute over the domain name, www.sting.com.¹⁵⁹ The panel found "personality rights were not intended to be made subject to the proposed dispute resolution procedure."¹⁶⁰ The panel formed its reasoning according to an early report prepared by the WIPO on which the UDRP was based.¹⁶¹

In this report, WIPO analysts recommended the dispute service initially focus on trade name violations, and then expand to cover other intellectual property rights only after it had perfected the trade name system.¹⁶² Thus, when ICANN adopted the UDRP, it eliminated certain provisions, such as celebrity rights, or "personality rights", which meant celebrities were not specifically protected.¹⁶³ Consequently, in July 2000, the WIPO began a second study to address the provisions not included in the present UDRP.¹⁶⁴ The WIPO Assistant Director General, Francis Gurry, believes issues regarding personality rights will be put "back on the table."¹⁶⁵ Directors of the study expect to publish their findings in early 2001.¹⁶⁶

In light of this debate, it is evident that in practice, ICANN's policy is used to protect celebrity rights.¹⁶⁷ For instance, although the panel in

156. *Id.*

157. *See supra* Part II.B.2.b.

158. *Sumner Case*, *supra* note 151, § 2. This was not the first case that decided a dispute over a celebrity's domain name; however, the panel in *Sumner* was one of the first to expressly question whether the UDRP should apply to celebrities. *Id.* §§ 6.4–6.9.

159. *Id.* § 2.1.

160. *Id.* § 6.4.

161. *Id.*

162. *Id.*

163. Steven Bonisteel, *Cybersquatting Rules Delayed-WIPO*, NEWSBYTES, Aug. 15, 2000.

164. *Second WIPO Internet Domain Name Process*, at <http://wipo2.wipo.int/process2/index.html> (last visited Jan. 16, 2001) [hereinafter *Second WIPO Internet Domain Process*].

165. Bonisteel, *supra* note 163.

166. *Second WIPO Internet Domain Process*, *supra* note 164.

167. *See infra* Part III (providing an analysis of cases decided within a year of *Sumner* that applied the UDRP to celebrities).

Sumner found it “doubtful whether the Uniform Policy is applicable,” it proceeded to decide the case according to the established procedure.¹⁶⁸ As such, numerous celebrities, like Julia Roberts and Madonna, have turned to ICANN for protection under the UDRP.¹⁶⁹ Therefore, the current policy is expansive enough to protect celebrities, despite *Sumner’s* acknowledgement that it does not contain specific provisions applicable to them.¹⁷⁰

III. ANALYSIS OF RECENT CELEBRITY NAME DISPUTES

As highlighted in Part II, UDRP panels focus their analysis on three elements: whether the celebrity possesses rights in the name, whether the registrant possesses rights or legitimate interests in the name, and whether the registrant operated in bad faith.¹⁷¹

A. Celebrities’ Rights to Their Names

The first element of a domain name claim may be broken down into two sub-parts.¹⁷² At the onset, the panel will determine whether the complainant has trademark or service mark rights in the domain name.¹⁷³ The panel will then determine whether the domain name is similar or identical to that mark.¹⁷⁴ Formal trademark registration of their names is generally not required in order for celebrities to succeed in domain name disputes. Instead, celebrities can establish rights in their names through use.

1. Trademark or Service Mark Rights

To date, there is one existing case in which a celebrity complainant won control of the domain name, and established rights based entirely on a traditional trademark or service mark.¹⁷⁵ In Chef Emeril Lagasse’s dispute,

168. See *Sumner Case*, *supra* note 151, § 6.5.

169. See *Roberts v. Boyd*, No. D2000-0210, §§ 4, 6 (WIPO May 29, 2000), at <http://arbiter.wipo.int/domains/decisions/html/d2000-0210.html> (last visited Aug. 27, 2000) [hereinafter *Roberts Case*] (Julia Roberts filed a complaint with WIPO to obtain control of www.juliaroberts.com); *Ciccone v. Parisi*, No. D2000-0847, § 5 (WIPO Oct. 12, 2000), at <http://arbiter.wipo.int/domains/decisions/html/2000-0847.html> (last visited Oct. 21, 2000) [hereinafter *Ciccone Case*] (Madonna filed a complaint with WIPO to obtain control of www.madonna.com).

170. See *Sumner Case*, *supra* note 151, § 6.5.

171. See *ICANN Uniform Domain Name Dispute Resolution Policy*, *supra* note 119, § 4(a).

172. *Roberts Case*, *supra* note 169, § 6.

173. *Id.*

174. *Id.*

175. See *Lagasse v. VPOP Techs.*, No. FA0003000094373 (NAF May 8, 2000), at

the panel briefly concluded the complainant established the first element of the UDRP simply because he possessed a registered mark in his name.¹⁷⁶ As this case illustrates, evidence of registration appears the most direct way to prove rights in a name.

However, celebrities do not generally possess such registration.¹⁷⁷ This could prove problematic because as recently as Spring of 2000, commentators predicted living celebrities could not use the ICANN procedure unless their names were part of a valid trademark.¹⁷⁸ Yet, contrary to these commentators' beliefs, ICANN panels have found rights in a name absent the formal registration present in *Lagasse*. Specifically, an early panel decision clarified that the UDRP does not "require that the Complainant's trademark be registered by a government authority or agency for such a right to exist."¹⁷⁹ In this decision, Jeanette Winterson, a British author, succeeded in gaining control of three domain names.¹⁸⁰ Winterson claimed she had achieved international recognition and critical acclaim for many novels, books, and screenplays.¹⁸¹ The author did not rely on a registered trademark, however, the panel recognized common law rights in her real name based on her accomplishments and public persona.¹⁸²

Within a few days of *Winterson*, Julia Roberts succeeded in her attempt to gain control of the domain name, www.juliaroberts.com.¹⁸³ Again, the panel concluded that Roberts, a famous actress "widely featured in celebrity publications, movie reviews, and entertainment publications and television shows," did not need to register "Julie Roberts" as a trademark or service mark to establish rights in her name.¹⁸⁴ Thus, the

<http://www.arbforum.com/domains/decisions/94373.htm> (last visited Aug. 31, 2000) [hereinafter *Lagasse Case*].

176. *Id.*

177. See *infra* Part II.B.2 (discussing the requirements of federal registration in terms of celebrities).

178. See Siegel & Doran, *supra* note 48, at 5.

179. *Winterson Case*, *supra* note 153, § 6.3.

180. *Id.* § 7.

181. *Id.* § 4.1.

182. *Id.* § 6.12. Furthermore, the panel considered whether Winterson established a claim for "passing-off," which is similar to a right of publicity claim. Even though the panel concluded that Winterson established such a claim, the decision emphasized that the primary issue was whether the complainant has rights in the name "sufficient to constitute a trade mark for the purposes of" the UDRP. *Id.* §§ 6.11, 6.12. As a result, it is not sufficient to establish a right of publicity claim under ICANN. A celebrity complainant must establish trademark rights.

183. *Roberts Case*, *supra* note 169, § 7.

184. *Id.* § 4.

panel found “Julia Roberts” had sufficient secondary association.¹⁸⁵ Similarly, a WIPO panel found comedian Rita Rudner possessed rights in her name.¹⁸⁶ Although the panel acknowledged Rudner did not formally register her name, the panel concluded she met the “rights” element because “Rita Rudner” is associated with books, movies, comedy routines, and other goods and services.”¹⁸⁷

Although it appears celebrities will always meet the “rights” element if they can demonstrate the extent of their fame, this has not always proven true. Problems arise when the celebrity’s name is a common, generic word. For instance, Gordon Sumner, who performs under the name Sting, lost his case against an American cybersquatter because “sting” is not a distinctive word.¹⁸⁸ As in the previously discussed cases, Sumner did not possess trademark or service mark rights to his name.¹⁸⁹ The panel considered *Winterson* and *Roberts*, but distinguished them on the basis that “sting” is “a common word in the English language, with a number of different meanings” unlike that of Jeanette Winterson and Julia Roberts.¹⁹⁰ The panel enumerated more than ten meanings of “sting” from an English-language dictionary.¹⁹¹

In addition to examining whether a name is generic, panels have also examined the origin of the name to determine whether a celebrity has rights. In *Ian Anderson Group of Cos. v. Hammerton*, the panel awarded the thirty-year-old musical band, Jethro Tull, rights to its domain name.¹⁹² In doing so, the panel found the band took the name from a famous English agronomist, agriculturalist and inventor, but made it clear “this derivation of the name in no way disentitle[d]” Jethro Tull to protection.¹⁹³ In this case, the band happened to adopt the name of a famous figure from the early eighteenth century. Yet, it raises the question of what would happen if a band or celebrity named itself after someone or something in present day society who might assert domain name rights of their own, assuming

185. *Id.* § 6.

186. *Rudner Case*, *supra* note 15, § 6.

187. *Id.* § 5.

188. *Sumner Case*, *supra* note 151, §§ 6.5, 6.8.

189. *Id.* § 6.2.

190. *Id.* § 6.5.

191. *Id.*

192. *Ian Anderson Group of Cos. v. Hammerton*, No. D2000-0475, § 7 (WIPO July 12, 2000), at <http://arbiter.wipo.int/domains/decisions/html/d2000-0475.html> (last visited Aug. 31, 2000). Although the band had a trademark application pending with the European Community during the administrative proceeding, the panel decided whether common law rights existed and did not base its decision on the existence of a formal registration of the band’s name as in the *Lagasse* case. *See id.* §§ 5, 6.

193. *Id.* § 6.

that the name was distinctive but not trademarked. The next WIPO report will have to address this area.

2. Identical or Confusingly Similar

Beyond determining whether the complainant possesses rights to a name, the panel must also compare the domain name to the complainant's name, and determine if the two are either identical or confusingly similar.¹⁹⁴ This appears to be a "slam dunk" in many celebrity disputes because more often than not, the domain name mirrors the name of the celebrity.¹⁹⁵ To illustrate, the domain names at issue in Jeanette Winterson's dispute were exact duplicates of the author's name: www.jeanettewinterson.com, www.jeanettewinterson.org and www.jeanettewinterson.net.¹⁹⁶

As simple as this seems, registrants have challenged the identical or confusingly similar requirement. For example, in the dispute over the domain name of Jimi Hendrix, the respondent argued "a word with a '.com' on the end is not identical to a word without .com on the end."¹⁹⁷ However, the panel clarified that the suffix, .com, is only a mere description of the registry service.¹⁹⁸ As such, it would only examine the second level domain, "jimihendrix," to determine whether the domain name was identical or confusingly similar.¹⁹⁹

194. ICANN Uniform Domain Name Dispute Resolution Policy, *supra* note 119, § 4(a)(i). See, e.g., *Roberts Case*, *supra* note 169, § 6. It should be noted that the term "confusingly similar" differs from trademark law's term "likelihood of confusion." Under the UDRP, the panel will compare the domain name to the mark side-by-side, "without any contextual setting." Barbara A. Solomon, *Two New Tools to Combat Cyberpiracy—A Comparison*, 90 TRADEMARK REP. 679, 686–87 (2000); see also BROOKMAN, *supra* note 88, § 6.06 (providing a discussion of the factors of likelihood of confusion).

195. See *List of Proceedings Under Uniform Domain Name Dispute Resolution Policy*, at <http://www.icann.org/udrp/proceedings-list-name.htm> (last visited Oct. 18, 2000). Two examples include princessdiana.com and tinaturner.com. *Id.*

196. *Winterson Case*, *supra* note 153, § 2.

197. *Experience Hendrix, L.L.C. v. Hammerton*, No. D2000-0364, § 7 (WIPO Aug. 15, 2000), at <http://arbitrator.wipo.int/domains/decisions/html/d2000-0364.html> (last visited Aug. 31, 2000) [hereinafter *Experience Hendrix Case*].

198. *Id.* § 7.

199. *Id.* Furthermore, panels have found that a registrant cannot add a common or generic term to, use a different punctuation, or misspell a name to avoid a finding of similarity under the UDRP. See *Reuters Ltd. v. Global Net 2000, Inc.*, No. D2000-0441, § 6.6 (WIPO July 13, 2000), at <http://arbitrator.wipo.int/domains/decisions/html/2000/d2000-0441.html> (last visited Feb. 28, 2001) (finding reutersnews.com confusingly similar to the Reuters trademark); *The Channel Tunnel Group, Ltd. v. Powell*, No. D2000-0038, § 6.3 (WIPO Mar. 17, 2000), at <http://arbitrator.wipo.int/domains/decisions/html/2000/d2000-0338.html> (last visited Feb. 28, 2001) (finding euro-tunnel.com confusingly similar to the Eurotunnel trademark); *Eddie Bauer, Inc. v. White*, No. AF-0246, § 6.5 (EResolution Aug. 1, 2000), at <http://www.eresolution.ca/services/>

Therefore, the first element of the UDRP as applied to celebrities has primarily focused on whether the celebrity has achieved a substantial amount of fame with a distinctive name. Whether the domain name mirrors the celebrity's name has not proven significant in a majority of decisions because the domain name and the celebrity's name are usually identical.

B. Registrant's Right or Legitimate Interest

The second element of an ICANN claim is whether the registrant possesses legitimate rights in the domain name.²⁰⁰ When a celebrity claims the registrant lacks such rights, it is generally difficult for respondents in celebrity domain name disputes to overcome this presumption.²⁰¹ As registrants do not generally possess formal rights in a celebrity's name, they must demonstrate that they are commonly known by the name, possess a license to use the name, or have sold goods or services in connection with the name.²⁰²

In *Winterson*, the respondent claimed he registered the complainant's name to create a web site "devoted" to writers, containing book extracts, reviews, author information and links to online book sellers.²⁰³ The panel found this use was insufficient to establish rights to the name, Jeanette Winterson, because his proposed use did not qualify as a legitimate interest.²⁰⁴ The panel also found Winterson did not issue the respondent a valid license for use of her name.²⁰⁵ As a result, the panel concluded the respondent had no rights.²⁰⁶

Additionally, the respondent in *Roberts* asserted rights in www.juliaroberts.com because he registered and used the domain name, and had a "sincere interest in the actor."²⁰⁷ The panel did not specifically address the claim that an interest in a celebrity creates rights in a domain name, however, as in *Winterson*, the respondent's appreciation for the celebrity was insufficient.²⁰⁸ Instead, the panel found the evidence did not

dnd/decisions/0246.htm (last visited Feb. 28, 2001) (finding eddiebower.com confusingly similar to the Eddie Bauer trademark).

200. ICANN Uniform Domain Name Dispute Resolution Policy, *supra* note 119, § 4(a)(iii).

201. *See supra* note 150 (discussing issues such as burden of proof).

202. *See, e.g., Roberts Case, supra* note 169, § 6; *Winterson Case, supra* note 153, § 6.17.

203. *Winterson Case, supra* note 153, § 4.4.

204. *Id.* § 6.17.

205. *Id.*

206. *Id.*

207. *Roberts Case, supra* note 169, § 6.

208. *Id.*

rebut the presumption that the respondent lacked legitimate rights because he did not use the domain name in connection with goods or services, and was not commonly known as Julia Roberts.²⁰⁹

In the *Hendrix* dispute, the respondent, The Jimi Hendrix Fan Club, claimed it operated its web site as an Internet-based fan club.²¹⁰ As in *Winterson*, the panel noted the respondent did not have a license to use Jimi Hendrix's name.²¹¹ Although the web site was used to advertise e-mail addresses, the panel did not consider this a proper offering of sales or goods because the e-mail addresses incorporated the name, Jimi Hendrix. Thus, the respondent could not establish rights in the name.²¹²

The respondent in *Hendrix* further asserted the right to use the name because of his First Amendment right to free speech.²¹³ The panel did not consider this argument because the respondent did not offer any evidence to support the claim.²¹⁴ Even so, the question arises whether a right to free speech would give a registrant a legitimate right to use a domain name. This argument is attractive because over-regulation of the Internet is a subject of heated debate within the legal and general communities.²¹⁵

209. *Id.*

210. *Experience Hendrix Case*, *supra* note 197, § 6.

211. *Id.* § 7.

212. *Id.*

213. *Id.*

214. *Id.*

215. James Love, Director of the Consumer Project on Technology, believes ICANN reduces free speech in favor of protecting commercial interests. He frames the issue as the right to call attention to information using a domain name. Laurie J. Flynn, *New Economy; Whose Name Is It Anyway? Arbitration Panels Favoring Trademark Holders in Disputes over Domain Names*, N.Y. TIMES, Sept. 4, 2000, at C3. Furthermore, fans or critics may want to create a web site to voice their opinions about a celebrity. The panel in *Springsteen* found in favor of the Bruce Springsteen Fan Club, whereby it stated, "[t]he 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." *Springsteen Case*, *supra* note 152, § 6. Thus, under the UDRP, noncommercial use, such as creating a pure fan site, may be a legitimate interest. See *ICANN Uniform Domain Name Dispute Resolution Policy*, *supra* note 119, § 4(c). *But see* Gwendolyn Mariano & Evan Hansen, *Parody Sites Sucked into Cybersquatting Squabbles*, at <http://news.cnet.com/news/0-1005-202-2604599.html> (last modified Aug. 24, 2000). Courts have also addressed the tension between trademark and First Amendment protection. See *Planned Parenthood Fed'n of Am., Inc. v. Bucci*, 42 U.S.P.Q.2d (BNA) 1430, 1440 (S.D.N.Y. 1997) (holding the defendant's use of *plannedparenthood.com* was not part of a communicative message but served to identify an item, thereby undeserving of First Amendment protection); *Bally Total Fitness Holding Corp. v. Faber*, 29 F. Supp. 2d 1161, 1164-65 (C.D. Cal. 1998) (noting an individual who wants to participate in consumer commentary must have the same range of marks as the trademark owner). The ACPA implies First Amendment protection because one of the factors of bad faith intent is the defendant's bona fide noncommercial or fair use of the mark on the domain name's web site. 15 U.S.C.A. § 1125(d) (Supp. 2000).

However, panels have applied narrow interpretations of registrant's rights,²¹⁶ and therefore, it appears unlikely they would accept a First Amendment argument in this context.

Finally, in cases where the name is generic, a registrant, like a celebrity, will face difficulties when attempting to establish legitimate rights to a domain name.²¹⁷ As previously mentioned, the name Sting is indistinctive. The *Sumner* panel found it "most likely is used by numerous people in cyberspace."²¹⁸ Accordingly, the registrant, who proved his nickname was "Sting", could not use his nickname to show he was widely known as "Sting."²¹⁹ The panel instead interpreted this to mean the indistinctive name provided the respondent with "anonymity" rather than with an identity.²²⁰ Furthermore, while the respondent prepared to operate a web site, he could not establish the web site was actively used to offer goods or services.²²¹

C. Bad Faith

Similar to the first element of the UDRP, some panels analyze the third element, bad faith, in two sub-parts: bad faith registration and bad faith use.²²² Furthermore, the bad faith element is broadly defined, and is not limited to the examples below.²²³

1. Bad Faith Registration

The celebrity complainant must demonstrate to the panel that the respondent registered the domain name in bad faith.²²⁴ A panel will find bad faith if the respondent had knowledge, at the time of registration, that the complainant or some other party owned rights to the domain name in question.²²⁵ It is clear that ignorance of this fact is an insufficient defense to bad faith registration.²²⁶ For instance, in *Winterson*, the registrant asserted that he did not know any of the authors had trademark or service

216. *See supra* Part III.B.

217. *Sumner Case*, *supra* note 151, § 6.8.

218. *Id.*

219. *Id.*

220. *Id.*

221. *Id.*

222. *See, e.g., Winterson Case*, *supra* note 153, § 6.18.

223. *ICANN Uniform Domain Name Dispute Resolution Policy*, *supra* note 119, § 4(b).

224. *Id.* § 4.

225. *Winterson Case*, *supra* note 153, § 6.19.

226. *Id.* § 6.20.

mark protection.²²⁷ The panel responded that a registrant has a duty to check the existence of and applications for registered marks by searching with “the appropriate authority.”²²⁸ Thus, the panel found bad faith on the part of the registrant.²²⁹

This raises the question of what happens in the case where a celebrity has not registered the celebrity name as a service mark.²³⁰ The *Winterson* panel found that under the UDRP, if a general right to one’s name exists, a respondent is placed on constructive notice that registering another person’s name as a domain name constitutes bad faith.²³¹ This broad view of knowledge makes it exceptionally easy for a celebrity or even a non-celebrity to demonstrate a registrant acted in bad faith.

Moreover, it is likely celebrities will succeed in establishing bad faith if they can show the respondent registered the domain name with an intent to profit financially.²³² For example, in *Roberts*, where the respondent placed the domain name on the auction web site, eBay, an intent to profit clearly existed.²³³ This intent to profit was also present in *Winterson*, where the registrant allegedly contacted multiple famous authors and offered to sell them their domain names, which he had registered.²³⁴ The registrant admitted he did this to finance web sites devoted to authors, however he claimed he would have voluntarily transferred the domain names to unhappy authors at his cost.²³⁵ Regardless, the panel found bad faith because the offer to sell the domain name was for profit.²³⁶

Panels will not, however, assume intent to profit in the absence of sufficient evidence. For example, the panel in musician Sting’s case considered conflicting statements about an offer to sell the domain name for \$25,000, and found the evidence insufficient to prove intent.²³⁷ The panel concluded while the general facts tended to support the registering of the site with the intent to profit, the fact that the site was registered five

227. *Id.* § 6.19.

228. *Id.*

229. *Id.* § 6.21.

230. It also raises a practical problem of requiring a registrant to conduct searches throughout the world because the trademark system is not centralized. See Hoefling, *supra* note 150, at 178–79.

231. *Winterson Case*, *supra* note 153, § 6.21.

232. See *Roberts Case*, *supra* note 169, §§ 4, 6.

233. *Id.* § 4.

234. *Winterson Case*, *supra* note 153, § 4.5.

235. *Id.* § 4.6.

236. *Id.* § 6.21.

237. *Sumner Case*, *supra* note 151, § 6.10.

years earlier tended to show good faith as well.²³⁸ Conversely, complainants in *Experience Hendrix* were able to meet their burden by submitting copies of a web page advertisement offering www.jimihendrix.com for one million dollars.²³⁹

Another factor indicating bad faith is registration of numerous domain names by a single respondent. For instance, the *Rudner* panel stated, “[f]urther evidence of Respondent’s bad faith is that it has registered other domain names that contain the names of celebrities.”²⁴⁰ Again, in *Roberts*, the panel considered the respondent’s admission that he had “registered other domain names [sic] Including several famous movie and sports stars.”²⁴¹ In *Winterson*, the respondent registered the domain names of approximately 130 authors in addition to the complainant’s.²⁴² In *Experience Hendrix*, the complainants offered news articles identifying the respondent as someone as a frequent registrant and peddler of domain names.²⁴³ While this factor alone was not determinative in the Hendrix dispute, it furthered the notion that a respondent engaged in a “pattern of conduct” of registering domain names without legitimate rights, operates in bad faith.²⁴⁴

Finally, bad faith registration occurs when the registrant engages in a pattern of registering domain names to prevent other parties from using them.²⁴⁵ For example, in *Lagasse*, the panel concluded the mark holder was precluded from using the mark by the respondent who registered it, thus, the respondent acted in bad faith.²⁴⁶ The respondent did not answer the complaint, but the panel regardless concluded that “[i]t would stretch the imagination to conceive how the domain name . . . could be used by the Respondent in a manner that would not infringe” on Lagasse’s rights.²⁴⁷ Yet, the panel acknowledged there was no evidence the registrant engaged in a pattern of such conduct.²⁴⁸ It is unclear whether this expansive opinion was dependent on Lagasse’s possession of the formal mark registration.

238. *Id.*

239. *Experience Hendrix Case*, *supra* note 197, § 7.

240. *Rudner Case*, *supra* note 15, § 5.

241. *Roberts Case*, *supra* note 169, § 6.

242. *Winterson Case*, *supra* note 153, § 4.2.

243. *Experience Hendrix Case*, *supra* note 197, § 7.

244. *Id.*

245. *ICANN Uniform Domain Name Dispute Resolution Policy*, *supra* note 119, § 4(b).

246. *Lagasse Case*, *supra* note 175.

247. *Id.*

248. *Id.*

Thus, it is questionable whether this rule would extend to the case where a celebrity relies on common law rights to a name.²⁴⁹

2. Bad Faith Use

Panels may also examine the manner in which the registrant uses the site for purposes of determining bad faith.²⁵⁰ Panels focus on whether the registrant has attempted to attract visitors to the web site for commercial gain or to disrupt the business of a competitor.²⁵¹

The decisions appear to yield inconsistent results regarding the linking of sites for financial profit. For instance, some panels have significantly relaxed the requirement. The *Rudner* panel found a registrant who linked other celebrity domain names to sexually-explicit web sites, but had not yet linked the complainant's domain names, operated in bad faith.²⁵² This is a liberal treatment of bad faith because Rudner did not prove any actual act on behalf of the registrant.²⁵³ The registrant had not actually used the site to attract visitors for commercial gain, rather the panel merely predicted he would.²⁵⁴ This prediction was sufficient to find bad faith.²⁵⁵

Conversely, some panels appear restrictive in their analysis of bad faith use. The *Sumner* panel rejected the argument that the registrant operated in bad faith when he linked the domain name to the web site, Gunbroker.com.²⁵⁶ The link, without evidence of intent to attract visitors to the linked site, was insufficient.²⁵⁷ The disparity may be explained by the fact that in *Rudner*, the registrant did not submit a response to the panel and engaged in a pattern of similar behavior²⁵⁸ whereas in *Sumner*, the registrant claimed he had not intentionally linked the sites.²⁵⁹

249. See *Springsteen Case*, *supra* note 152, § 6 (claiming "previous Panels have all too readily concluded that the mere registration of the mark . . . is evidence of an attempt to prevent the legitimate owner" from obtaining a domain name).

250. See *Winterson Case*, *supra* note 153, § 6.21; *Sumner Case*, *supra* note 151, §§ 6.10–12.

251. *ICANN Uniform Domain Name Dispute Resolution Policy*, *supra* note 119, § 4(b).

252. *Rudner Case*, *supra* note 15, § 5.

253. *Id.*

254. *Id.*

255. *Id.*

256. *Sumner Case*, *supra* note 151, § 6.11.

257. *Id.*

258. *Rudner Case*, *supra* note 15, § 4.

259. *Sumner Case*, *supra* note 151, § 6.11.

IV. THE EFFECT OF MADONNA.COM ON FUTURE CELEBRITY DOMAIN NAME DISPUTES

A complaint that Madonna, a superstar-musician, filed with the WIPO provides a slightly new interpretation of the UDRP and its specific application to celebrity domain name disputes. In August, 2000, the musician asked for control over www.madonna.com because, according to her publicist, “[i]f people use her name it reflects back on her.”²⁶⁰ Although ICANN decisions are not binding on other panels,²⁶¹ the Madonna panel offers insight into future celebrity domain dispute proceedings.

A. Is “Madonna” a Common Word?

In finding for Madonna, the panel did not address whether Madonna possesses common law rights in her name.²⁶² Instead, the panel briefly noted the respondent did not dispute that the domain name was identical to a trademark in which Madonna had rights.²⁶³ The panel did make one reference to the distinctiveness issue, but only to provide the dictionary meaning of the word.²⁶⁴ As a result, the question of ownership was based on formal registration.²⁶⁵ Still, the issue of whether Madonna would have common law rights in the word, Madonna, was highly debated among commentators. When the case was filed, Internet Law Professor Michael Geist suggested, “[i]t is not clear Madonna has a clear right to the domain name” because Sting’s loss “would appear to hurt” her case.²⁶⁶ At the same time, trademark attorney Neil Smith believed Madonna’s fame outweighed that of the Virgin Mary,²⁶⁷ and thus, would provide her with enough secondary association to possess rights in the name.

260. Robert Thompson, *Material Girl Wants Madonna.com*, NAT’L POST, Aug. 26, 2000, at D1.

261. See *infra* Part V.B (discussing the precedential value of ICANN panel decisions).

262. *Ciccone Case*, *supra* note 169, § 7.

263. *Id.* § 5.B. This is surprising given that Dan Parisi, the registrant, previously posted the following argument on the web site in question: “We do not believe that because Ms. Ciccone named her act after the Virgin Mary that gives her the right to stop any other party from using the word.” Nick Mead, *Madonna Asks UN for Her Internet Name*, PRESS ASS’N NEWSFILE, Aug. 25, 2000, available at LEXIS, News Group File, Most Recent Two Years. Parisi’s failure to make this argument is most likely explained by the fact that Madonna showed that she possessed two U.S. trademarks in the name and was not relying solely on common law rights in the dispute. *Ciccone Case*, *supra* note 169, § 4.

264. *Ciccone Case*, *supra* note 169, § 4.

265. *Id.* § 6.D.

266. Thompson, *supra* note 260.

267. Swartz, *supra* note 5.

Consequently, it is questionable whether Madonna would have such rights. As with Sting, the word “Madonna” is generic. For example, Madonna is an icon of the Catholic religion.²⁶⁸ A spokesperson for the Canadian Conference of Catholic Bishops stated Madonna is a “sacred, generic term for mother.”²⁶⁹ The difference, however, is that Madonna possessed formal registration for her name, whereas Sting did not.²⁷⁰ Hence, it is possible that in future cases, a celebrity with a common name can prevail in establishing rights if formal registration exists.

B. A Deeper Understanding of Legitimate Rights

The panel addressed the issue of whether Dan Parisi, the registrant, possessed rights in the domain name in greater detail than its discussion of Madonna’s rights.²⁷¹ Parisi presented three arguments tending to show he met the requirement, but the panel dismissed each, providing analysis of issues not yet addressed in prior decisions.

First, Parisi argued he operated the web site prior to the dispute in connection with a bona fide offering of goods and services, namely an adult entertainment site.²⁷² The panel found, however, that Parisi only chose the name in order to capitalize on the musician’s fame.²⁷³ The panel distinguished this situation from a possible scenario where the registrant innocently chooses a name in connection with a business only to later discover the name belongs to someone famous.²⁷⁴ As a consequence, the offering was not made in good faith.²⁷⁵ The panel explained if it found otherwise, a respondent could hypothetically take any protected word or name and use it in any way in order to meet the legitimate interest requirement.²⁷⁶

Second, Parisi argued he had trademark rights in the name because he registered it in Tunisia before the dispute ensued.²⁷⁷ The panel developed the following test to apply to a dispute where both parties assert formal

268. *Id.*

269. Thompson, *supra* note 260.

270. *Sumner Case*, *supra* note 151, § 6.2.

271. *Ciccione Case*, *supra* note 169, § 6.C.

272. *Id.*

273. *Id.*

274. *Id.* This may appear to conflict with the constructive notice issue in *Winterson*. See *supra* Part III.C.1. However, a distinction could be drawn between a business named after someone or something other than the owners of that business and an individual registrant who takes the personal name of someone else.

275. *Ciccione Case*, *supra* note 169, § 6.C.

276. *Id.*

277. *Id.*

registration: A registrant must show the overall circumstances establish the site was registered in good faith “for the purpose of making bona fide use of the mark in the jurisdiction where the mark is registered, and not obtained merely to circumvent the application of the Policy.”²⁷⁸ Ultimately, Parisi’s argument failed because he admitted that he obtained the mark to protect his interests, and he did not reside in Tunisia nor conduct business there.²⁷⁹

Third, Parisi argued he offered to transfer the domain name to the Madonna Hospital in Nebraska, and that this was a legitimate noncommercial use.²⁸⁰ The panel rejected this argument because the transfer was incomplete, and prohibited the hospital from transferring the domain name to Madonna.²⁸¹ The panel suggested Parisi only made the offer because of the domain name dispute, and that he did not have a legitimate interest in the name independent of the celebrity, Madonna.²⁸²

To conclude, the new rules provided by the panel in the Madonna.com decision clarify the second element of the UDRP. The respondent provided several failed arguments. Therefore, the Madonna decision may make it more difficult for registrants to establish possession of legitimate rights in a celebrity’s domain name.

C. *The Breadth of Bad Faith*

The Madonna panel’s analysis of the third element of the UDRP, bad faith registration, also raises several important points that will affect how famous domain name cases are argued in the future. Specifically, the panel revealed two factors upon which it did not rely. The first is whether the respondent engaged in a pattern of conduct.²⁸³ Madonna claimed Parisi acted in bad faith because Parisi was involved in several domain name disputes.²⁸⁴ Parisi registered what he refers to as the “Sucks 500,” which includes domain names of Fortune 500 companies, such as www.microsoftsucks.com.²⁸⁵ He spent approximately \$100,000 to purchase these sites.²⁸⁶ However, the panel in this case was clear that while

278. *Id.*

279. *Id.*

280. *Id.*

281. *Ciccone Case*, *supra* note 169, § 6.C.

282. *Id.*

283. *Id.*

284. *Id.*

285. *Justify My Website*, NAT’L. J. TECH. DAILY, Aug. 23, 2000, available at LEXIS, News Group File, Most Recent Two Years.

286. Swartz, *supra* note 5.

there was evidence of such conduct, it was not conclusive.²⁸⁷ This differs from past decisions, such as *Roberts*, *Winterson*, and *Experience Hendrix*, where panels considered even less evidence yet found bad faith patterns of conduct.²⁸⁸ The result in Madonna's case suggests celebrity plaintiffs may have to meet a high burden in proving a pattern of conduct.

The second factor on which the panel did not rely was whether the registrant, by operating the site, harmed the complainant's reputation.²⁸⁹ Parisi argued his site was incapable of tarnishing Madonna's reputation because "she has already associated herself with sexually explicit creative work."²⁹⁰ The panel did not consider this argument when it arrived at its ultimate decision, but it did disagree with Parisi's argument.²⁹¹ It stated Madonna's reputation could be tarnished because she could not control the content on the web site.²⁹² Thus, it is unclear whether future dispute policies will consider this factor.

The panel went on to weigh the actual act of registration.²⁹³ Parisi purchased the domain name from a third party, and the panel noted that for purposes of bad faith, it did not matter that Parisi was not the original registrant.²⁹⁴ The panel relied on a provision in the UDRP policy equating acquisition with registration.²⁹⁵ Thus, a respondent acquiring a domain name is held to the same standards as the original registrant of the site.²⁹⁶ A respondent acquiring a site in bad faith will meet the bad faith requirement.²⁹⁷

Furthermore, the panel found Parisi acted in bad faith because he could not explain why the domain name was worth the 20,000 dollars he paid.²⁹⁸ The panel concluded Parisi chose the name for his adult entertainment site in order to profit from Madonna's association with sex; for as Parisi himself claimed, she appeared in Penthouse magazine and

287. *Ciccone Case*, *supra* note 169, § 6.D. This deviation may be explained by the fact that the Panel had other evidence to establish bad faith and wanted to make clear that it was basing its decision on these factors as opposed to just the prior questionable acts of the registrant.

288. *See infra* Part III.C.1 (discussing cases where panels considered pattern of conduct and found it indicative of bad faith).

289. *Ciccone Case*, *supra* note 169, § 6.D.

290. *Id.*

291. *See id.*

292. *Id.*

293. *See id.*

294. *Id.*

295. *Ciccone Case supra* note 169, § 6.D; *ICANN Uniform Domain Name Dispute Resolution Policy*, *supra* note 119, § 4(b)(i).

296. *See Ciccone Case*, *supra* note 169, § 6.D.

297. *See id.*

298. *Id.*

published a book about sex.²⁹⁹ Thus, future panels may consider the purchase of a domain name from an original registrant for a large sum of money per se bad faith.

Finally, Parisi argued he did not act in bad faith because he posted a disclaimer on the web site.³⁰⁰ Citing a California federal court,³⁰¹ the panel held the disclaimer insufficient.³⁰² It explained that Internet users may ignore disclaimers and that disclaimers do not eliminate a user's initial confusion when the user first visits the site.³⁰³

In conclusion, the most significant development in the Madonna decision is likely the panel's reluctance to consider a registrant's prior pattern of conduct when analyzing bad faith. This impacts future domain name disputes in that a complainant may have to establish the registrant intended to profit by using that particular celebrity's domain name. General facts that the registrant has registered other celebrity names could be insufficient to meet the third element of the UDRP, and thus increase the difficulty of establishing bad faith.

V. WHY THE UDRP IS BENEFICIAL DESPITE ITS WEAKNESSES

The results in the Madonna dispute, as well as the other panel decisions discussed, indicate the large majority of celebrities have turned to ICANN with favorable outcomes. There are also several practical reasons why ICANN's dispute system is preferable to the traditional court system. The following discusses the strengths and weaknesses of the policy.

A. Strengths of the UDRP

The first advantage of the UDRP is the ability to readily obtain jurisdiction. In the traditional court system, it is difficult to gain jurisdiction over a party in another country. For example, under the ACPA, a complainant must file in a court having jurisdiction where the registrant³⁰⁴ or registry³⁰⁵ is located. ICANN, alternatively, is international. Any

299. *Id.*

300. *Id.*

301. *Id.* (citing *Brookfield Comm. Inc. v. West Coast Entm't*, 174 F.3d 1036 (9th Cir. 1999)).

302. *Ciccone Case*, *supra* note 169, § 6.D.

303. *Id.*

304. Siegel & Doran, *supra* note 48.

305. 15 U.S.C.A. § 1125(d) (Supp. 2000).

person in the world may file a complaint.³⁰⁶ Furthermore, as previously mentioned, jurisdiction is mandatory because registrants automatically submit to ICANN arbitration when they register a domain name.³⁰⁷ The UDRP is also preferable because unlike the court system, a celebrity is not required to physically locate the domain name registrant to file a dispute with an ICANN panel.³⁰⁸ Rather, the dispute provider will use the contact information from the registry.³⁰⁹ This information is assumed correct “at the domain name registrant’s peril.”³¹⁰

Second, ICANN arbitration is generally less expensive and faster than the U.S. court system.³¹¹ In particular, the current cost of filing a WIPO complaint ranges from 1500 to 4000 U.S. dollars,³¹² and a National Arbitration Forum complaint ranges from 750 to 3750 U.S. dollars.³¹³ It takes an average of forty-five days for the panel to resolve a dispute.³¹⁴ Furthermore, the process is less formal.³¹⁵ The parties may choose their representation regardless of nationality or professional qualification.³¹⁶ The process is also quite simple. The arbitration forums provide forms and guidelines, and a complainant can file over the Internet.³¹⁷

Third, unlike courts of law, some panels are comprised of experts in “international trademark law, electronic commerce, and Internet-related issues.”³¹⁸ While this does not guarantee success, one can expect

306. *WIPO Guide to the Uniform Domain Name Dispute Resolution Policy*, *supra* note 129, § A. For example, in *Springsteen*, the complainant, Bruce Springsteen, was from the United States, and the registrant was from Canada. *Springsteen Case*, *supra* note 152, § 1.

307. *ICANN Uniform Domain Name Dispute Resolution Policy*, *supra* note 119, § 1.

308. Solomon, *supra* note 194, at 708.

309. *Id.*

310. *Id.*

311. *Domain Name Administrative Proceeding*, at <http://www.eresolution.ca/services/dnd/arb.htm> (last updated Jan. 4, 2001).

312. *Schedule of Fees under the ICANN Policy*, at <http://arbiter.wipo.int/domains/fees/index.html> (last visited Jan. 23, 2001).

313. *Dispute Resolution for Domain Names Schedule of Fees*, at <http://www.arbforum.com/domains/domain-fees.html> (last visited Jan. 23, 2001).

314. Claire Barliant, *Can You Think of a Way to End a Dispute? ICANN; Rather than Go to Court, Cyberspace Squabbles Are Settled Via E-mail and the Internet*, TEX. L., Aug. 14, 2000, at 46.

315. *WIPO Guide to the Uniform Domain Name Dispute Resolution Policy*, *supra* note 129, § A.

316. *Complete Listing of the Arbitration Rules*, § 2, art. 13, at <http://arbiter.wipo.int/arbitration/arbitration-rules/complete.htm> (last visited Jan. 23, 2001).

317. *WIPO Guide to the Uniform Domain Name Dispute Resolution Policy*, *supra* note 129, § C.

318. *Id.* § E. It should be noted that not all providers are experts. The National Arbitration Forum, for example, is not an intellectual property organization, but rather a general arbitration provider. See *An Overview of the Forum*, at <http://www.arbforum.com/about/aboutintro.html>

heightened familiarity with intellectual property principles and more consistent decisions from the panels than from courts spanning the globe.³¹⁹

Fourth, because one country's trademark laws may not be enforceable in another country, international complainants may encounter problems enforcing their own country's laws in traditional courts.³²⁰ However, under the ICANN policy, any country submitting to the convention must enforce the ICANN decision regardless of its particular laws. Furthermore, complainants from countries other than the United States will benefit from the ICANN procedure. Canada, for example, does not have cybersquatting laws or effective right of publicity laws.³²¹

Finally, complainants may receive substantially similar remedies under the UDRP as they would in U.S. courts. Under the ACPA, a plaintiff in a name dispute case can receive injunctive relief, costs and attorney's fees at the court's discretion.³²² As a result, in both forums, the complainant's success will probably rest with receipt of the domain name.

B. Weaknesses of the UDRP

Although there are many benefits to the UDRP, the procedure suffers from certain weak points as well. The main disadvantage to the UDRP is that the parties can commence an action in court before, during or after the arbitration.³²³ If a party files a judicial proceeding before, or within ten days after the conclusion of an arbitration hearing, ICANN will stay its action.³²⁴ Accordingly, a respondent could prevent a celebrity from taking advantage of the ICANN procedure by forcing the complainant to litigate in court.

(last visited Jan. 24, 2001). Information about panel members is often available on an ICANN provider's web site. See, e.g., *List of Qualified Dispute Resolution Panelists*, at <http://www.arbforum.com/domains/domain-judges.html> (last visited Jan. 24, 2001).

319. Hoefling, *supra* note 150, at 179.

320. *Id.* at 178.

321. Lisa Stangret, *Notable Names for Sale in Cyberspace: Harris, Lastman Become Targets of Cybersquatters*, NAT'L POST, July 18, 2000, at C7.

322. Siegel & Doran, *supra* note 48. It should be noted that the ACPA does contain a provision for statutory damages "as the court considers just." Solomon, *supra* note 194, at 707. However, one trademark attorney has noted that it is difficult to prove profits and damages, and it is unclear whether a registrant will have enough assets to permit the plaintiff to recover. Solomon, *supra* note 194, at 707.

323. Hartje, *supra* note 93, at 38.

324. *Id.*

Similarly, ICANN decisions are not binding on the courts.³²⁵ A panel can issue a decision, but if one of the parties is unhappy with the outcome that party can still bring the issue before a traditional court.³²⁶ For instance, soon after the WIPO panel in *Roberts* issued its finding for the actress, the respondent filed a claim against the actress in a U.S. court to regain control over the domain name.³²⁷ The same situation occurred in the dispute over *Madonna.com*.³²⁸ So although an ICANN panel could award a celebrity the domain name, it is uncertain whether the celebrity will maintain ownership.

Another possible weakness is that ICANN Panels are not bound by prior panel decisions.³²⁹ However, commentators believe panels may adhere to the results in other disputes for two reasons.³³⁰ First, panels have easy access to decisions because ICANN publishes them on the Internet.³³¹ Second, panels want to preserve the perception of fairness.³³² Thus, they have an interest in issuing consistent decisions. In practice, it appears panels are increasingly citing other results when evaluating a dispute.³³³ For example, in *Madonna's* domain name dispute, the panel referred to the decision in *Sting's* case when analyzing bad faith,³³⁴ and in *Winterson*, the WIPO panel considered an ICANN panel's decision from the National Arbitration Forum when analyzing common law rights in a name.³³⁵ Above all, the panel in *Rudner* cited both *Roberts* and *Winterson* in

325. *Id.* See generally *Weber-Stephen Prod. v. Armitage Hardware and Bldg. Supply, Inc.*, No. 00C1738, 2000 U.S. Dist. LEXIS 6335, at *7 (N.D. Ill. May 3, 2000) (determining WIPO proceeding was non-binding, and staying the case because it was unclear what weight should be given to the WIPO decision).

326. See *Stangret*, *supra* note 321; *BroadBridge Media v. Hypercd.com*, 106 F. Supp. 2d 505, 509 (S.D.N.Y. 2000) (finding plaintiff did not waive the right to proceed in federal court after filing a complaint under ICANN).

327. See *Stangret*, *supra* note 321.

328. James Barron, *Public Lives*, N.Y. TIMES, Oct. 26, 2000, at B2, at <http://nytimes.8pass.com/8pass-archives> (last visited Feb. 17, 2001).

329. *Hartje*, *supra* note 93.

330. *Id.*

331. *Id.*

332. *Id.*

333. As of July 3, 2000, 32 percent of panel decisions cited at least one prior panel decision. *The ICANN Cybersquatting Decisions #5*, at 2, at <http://eon.lae.harvard.edu/udrp/decisions/2000-5.html> (last visited Feb. 17, 2001). "Although the trend appears to be that prior decisions will have at least some persuasive weight, the final determination will be left to the discretion of each panel." *Analysis of Key UDRP Issues*, § D, at <http://eon.law.harvard.edu/udrp/analysis.html> (last visited Jan. 24, 2001) [hereinafter *Analysis of Key UDRP Issues*]. Panels are also criticizing prior decisions. See *Springsteen Case*, *supra* note 152, § 6 (claiming that *Winterson* and *Roberts* erroneously determined the burden of proof for bad faith).

334. *Ciccone Case*, *supra* note 169, § 6.D.

335. See *Winterson Case*, *supra* note 153, § 6.6.

awarding the comedian common law rights in her name.³³⁶ This suggests panels in celebrity domain name cases have established precedent, albeit informal.

Along similar lines, a UDRP panel has discretion in choice of law.³³⁷ For example, where parties are from the same country, panels have applied the legal principles of that particular country to decide matters ranging from the weight of evidence to what constitutes bad faith in some cases.³³⁸ This is problematic in that the UDRP is supposed to provide a unified procedure to resolve global disputes where parties are diverse.³³⁹ A panelist in a non-celebrity dispute, where the complainant had contacts with New Zealand and England, and the registrant had contacts with Australia and the United States, described his approach as a “broad and common sense interpretation” of legal principles appropriate for the Internet.³⁴⁰ This issue has not been the focus of celebrity domain name disputes thus far, however, it could arise and should be another factor to consider when choosing the UDRP over other courses of action.

VI. CONCLUSION: THE FUTURE OF CELEBRITY DOMAIN NAME DISPUTES

Celebrities, especially performers, undoubtedly benefit from the ability to reach audiences world wide via the Internet. However, inherent in this benefit is the risk of cybersquatting. As more domain name disputes arise and become public knowledge, it is likely celebrities will take a defensive position and register their names before others can exploit them. Celebrities who find their names already registered most likely will have to bring an action, whether in the courts or through ICANN, to gain control of their domain names.

Despite its weaknesses, ICANN’s dispute procedure is the preferential tool in the battle against celebrity cybersquatting. Although the drafters of the policy may not have intended the policy to protect celebrities per se, it has served this purpose. ICANN’s dispute procedure has proved the most widely utilized method to solve domain name conflicts, and the resulting

336. See *Rudner Case*, *supra* note 15, § 5.

337. *Analysis of Key UDRP Issues*, *supra* note 333, § D. “[A] Panel shall decide a Complaint . . . in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable.” *ICANN Uniform Domain Name Dispute Resolution Policy*, *supra* note 119, § 15(a).

338. *Analysis of Key UDRP Issues*, *supra* note 333, § D.

339. *Id.* § C.

340. *Id.*; see also *Tourism and Corporate Automation Ltd. v. TSI Ltd.*, No. AF-0096 (Resolution Mar. 16, 2000), at <http://eresolution.ca/services/dnd/decisions/0096.htm> (last visited Jan. 23, 2001).

case precedent overwhelmingly favors celebrities. And with the WIPO's second report scheduled for release within the next year, the UDRP may surpass traditional causes of action in terms of its specific application to celebrity domain name protection. In a more general sense, the ICANN forum reflects the current societal trend toward embracing all that technology has to offer. ICANN affords a preliminary step to avoid timely and costly litigation. As such, all indicators point to increased future use of this international dispute procedure.

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* I offer my sincere thanks to the members of the Loyola of Los Angeles Entertainment Law Review, particularly Fara Blecker, Brigit Connelly, Alisa Edelson, and Brian Lerner for their time, hard work, and patience. I also want to acknowledge the production efforts of Shivani Rosner, Steven Koliass, Aida Darakjian, Corey Kagan, Erika Brauch, Gil Dan, Sherrie Soon Diveglia, Katherine Mast, Jeffrey Renzi, Carmen Snuggs, and Rebecca Sorgen. My gratitude extends to Kristy Koopman and Meegan Maloney for their encouragement, and to Professor Laurence Helfer for his assistance during the early development of this Comment. *Special thanks to Craig Falzone.*

