



# Stealing starpower

WIPO's latest decisions on celebrity cybersquatting

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## In summary

- Among the thousands of complaints received every year by the WIPO Arbitration and Mediation Centre are an increasing number of decisions dealing with the rights of celebrities to recover domain names coinciding with their personal names
- Personal names as such are not protected under the UDRP but do not fall short of the criteria for lodging a complaint, since it has consistently been held that the UDRP does not require the Complainant to have a registered trademark or service mark
- The decisions show that international fame is not necessarily required in order to succeed in recovering a domain; a moderate local reputation or a reputation limited to expert circles have also proven sufficient when combined with additional matters of fact that support the bad faith element

**As the courts battle it out to define the right of personality, celebrities are facing a quieter, but no less important legal battle over the right to profit from their own names. Cybersquatting of celebrity names has reached epidemic proportions, and WIPO's Arbitration and Mediation Centre has now issued enough decisions in this field to offer real assistance to those wishing to protect celebrity clients from the cybersquatters. Dr Stefan Abel and Claus M Eckhartt, of Germany's Bardehle Pagenberg Dost Altenburg Geissler, review the cases and offer guidelines for rights owners**

While the internet bubble has burst, cybersquatting has proven not to be a temporary phenomenon. The largest arbitration service provider under the Uniform



Domain-Name Dispute Resolution Policy, WIPO's Arbitration and Mediation Center, continues to receive over 1,000 complaints against abusive domain name registrations per year. The theft of domain names not only concerns the owners of registered trademarks and famous brands, but also well-known artists and other celebrities who find themselves targeted by cybersquatters all over the world.

The WIPO decisions concerning personal names reflect that cybersquatters' activities may reach any personality exposed in the media. An analysis of the WIPO decisions fails to reveal any categorical difference between the activity of the personality or the degree of fame enjoyed. Actors, pop stars, sports stars as well as authors, journalists, religious leaders and scientists have all utilised UDRP proceedings to recover their domain names. The decisions show that international fame is not necessarily required in order to succeed in recovering a domain; a moderate local reputation or a reputation limited to expert circles have also proven sufficient when combined with additional matters of fact that support the bad faith element.

Personal names as such are not protected under the UDRP. However, that does not imply that they fall short of the criteria for lodging a complaint, since it has consistently been held that the UDRP does not require the Complainant to have a registered trademark or service mark. To meet the requirements of the UDRP, it is sufficient for the Complainant to rely on a trademark arising out of use in commerce (common law rights). Therefore, being a personality may be sufficient to prevail in UDRP proceedings and require the transfer of the domain coinciding with a personal name, even if it has not been subject to a trademark registration.

### **Common law mark rights**

Personalities of the sports and entertainment business active in common law countries in most cases did not face difficulties in satisfying the Panel in this respect. The most recent cases involved *Utada Hikado*<sup>1</sup>, an American/Japanese pop singer who had performed on MTV in the United States, and was featured on the cover of Time Magazine; *Joe Cole*<sup>2</sup>, described as a "rising star of British football"; *Terrell Owens*<sup>3</sup> a professional football player for the San Francisco 49ers and a spokesperson for various products; and *Greta van Susteren*<sup>4</sup> a journalist hosting the TV programme *On the record with Greta van Susteren*, broadcast to some 82 million homes in the United States. These personalities were able to easily convince the WIPO Panels that their personal names have indeed acquired common law trade or service mark rights.

Further to that, recent decisions confirm that the acquisition of common law trademark rights is not reserved to the personal names of this group of personali-



ties. Dutch scientist and Professor Emeritus of Maastricht University *Geert Hofstede*<sup>5</sup> was regarded to have developed a reputation and goodwill in respect of his name which was deemed sufficient to give rise to unregistered rights. Spiritual leader *Guru Sri Chinmoy*<sup>6</sup> was also regarded to have achieved common law mark rights. Both findings were essentially attributed to the authorship of several books by these personalities as well as to the consultancy services rendered, or to the evangelistic and ministerial services performed, respectively.

The Panels were more critical with *Gene Edwards*<sup>7</sup>, a well-known Minister of the Christian faith in the United States, who has also undisputedly authored books and with *Ronald Mas*<sup>8</sup>, candidate of a Spanish political party for Community elections in the year 2003. In the first of these two cases, Mr Edwards obviously went somewhat too far in his complaint by emphasizing his purely religious intentions, whilst the Respondent pointed out that his books were not for sale, but were distributed for free. The Panel was therefore led to the conclusion that Mr Edwards has not demonstrated that he had used his name in commerce and denied the complaint.

Regarding Mr Mas, the Panel came to the same conclusion since Mr Mas had not provided any evidence for the use of his name other than in a political context and did not assert any commercial use directed to any identified goods or services. In general, since Mr Mas' business activities did not reach any common law countries but were limited to Spain, the Panel was unwilling to adopt the rather generous approach of unregistered trademarks of common law countries, but had to apply the stricter standards of Spanish trademark law requiring that the name be notoriously used as a mark for distinguishing goods or services.

### **Legitimate interest and bad faith**

A second and third element to be made out by the Complainant are the lack of a legitimate interest of the Registrant in respect of the domain name as well as bad faith of the Registrant both at the time of registration of the domain and at the time of the decision (para 4 a (ii), (iii) UDRP).

A lack of legitimate interest and bad faith often is inferred from the probability that the domain name Registrant was aware of having registered the name of a celebrity if the circumstances do not include any indication of legitimate interests or good faith<sup>9</sup>. However, in many cases, additional circumstances are given that render such presumption of bad faith and lack of legitimate interest doubtful.



Some WIPO decisions have been asked to address cases in which the celebrities' names represent a common word or a generic term in a certain language. This argument has proved to be a very effective one in these decisions.

Gordon Sumner, the British musician known as Sting, lost his case for *www.sting.com*<sup>10</sup> as he was not able to rebut the Registrant's argument stipulating that he had registered the domain name for the English meaning of the word "sting" only, ie not with Mr Sumner in mind. The same problem occurred in the complaint of the German rockband *The Scorpions*<sup>11</sup>, where the Panel generally pointed out that trademarks which are capable of other connotations can be a burden difficult for the Complainant to discharge. This finding leads to the conclusion that the American rapper Ice-T and The Rolling Stones might fall short with a complaint under the UDRP, too.

A second argument often raised in the context of celebrities' names is the Registrants' assertion that the domain serves for a fan club website of the Registrant. The internationally famous rock musician *Bruce Springsteen*<sup>12</sup> was not able to recover the domain *www.brucespringsteen.com* from the Registrant Bruce Springsteen Club for that reason in an early decision with a dissenting opinion.

However, the above-cited recent *Joe Cole* decision has made it clear that there must be at least demonstrable preparations to build a fan website on the domain name, and that a mere ascertainment in a letter stating an intention to develop fan sites is not enough. Moreover, the dissenting opinion in the *Bruce Springsteen* decision has recently been supported by the *Geert Hofstede* case also cited previously.

In this case, the domain name of scientist Professor Hofstede has been used for a tribute site dealing with works of Mr Hofstede. Therefore, the Panel has found that the Complainant's reputation and goodwill are out of his hands and rest with the Respondent and therefore create substantial damage that counter-balances the Registrant's legitimate interests. It was also held in this decision that deliberately registering a person's name/trademark and using it to connect a website dealing with that person and/or his/her work is abusive and establishes the bad faith element on the basis that it will inevitably lead to a confusion of internet users.

This approach in favour of celebrities has been confirmed and refined in another recent Panel decision cited above. In the case *gretavansusteren.com*, the Panel had to deal with a disclaimer on the website stating that this site was not her official site and not approved by Ms Van Susteren. The Panel found that such a disclaimer was not appropriate to counter-balance the argument that bad faith lies with the deliberate confusion of internet users who expect an official and author-



ized website under a celebrity's name. Such a disclaimer would not assist the Respondent on the bad faith argument, since the damage (misleading diversion of internet browsers to the Registrant's website) is already done by the time the internet visitor reads the disclaimer.

In another attempt to establish legitimate interest and to counter-balance bad faith, the Registrant in a case involving the name of the famous actress *Julia Roberts* put forward that he had registered the domain hoping to receive a call from Julia Roberts, for he considered her to be "nifty crazy wacko cool". However, this argument was not sufficient to satisfy the Panel and will presumably remain unique in the history of the Uniform Domain Name Dispute Resolution Policy.

#### Notes

1. WIPO case no D2003-0686 - utadahikaru.net.
2. WIPO case no. D2003-0843 -joecole.com.
3. *Terrell Owens* WIPO case no. D2003 0463.
4. WIPO case no. D2003-0407 - gretavansusteren.com.
5. WIPO case no. D2003-0646 - geert-hofstede.com.
6. WIPO case no D2003-00248 - aboutsrichinmoy.com
7. WIPO case no. D2003-0339 - geneedwards.org.
8. WIPO case no. DTV2003-0005 - arturmas.tv
9. See WIPO case D2003-0248 - aboutsrichinmoy.com; WIPO case no. D 2003-0646 - geert-hofstede.com
10. WIPO case no. D2000-0596 - sting.com.
11. WIPO case No. D2001-0787 - scorpions.com)
12. WIPO no. D2000-1532 - brucesteen.com)

#### About the authors

**Dr. Stefan Abel** is an attorney-at-law with the Intellectual Property law firm Bardehle Pagenberg in Munich. His areas of practice are counseling and litigation in all matters of intellectual property and unfair competition, particularly domain name conflicts and software licensing. He is a Panellist of the World Intellectual Property Organization (WIPO) Arbitration and Mediation Center, Geneva

**Claus Eckhartt**, a partner with the Bardehle firm, is a trademark specialist, and a member of Trademark World's editorial board.

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