

**REPORT TO CONGRESS: The Anticybersquatting Consumer Protection Act of 1999,
section 3006 concerning the abusive registration of domain names.**

I. Summary

On November 29, 1999, President Clinton signed into law the Anticybersquatting Consumer Protection Act (ACPA). Generally, the ACPA is intended to protect the public from acts of Internet “cybersquatting,” a term used to describe the bad faith, abusive registration of Internet domain names. Section 3006 of the ACPA directed the Secretary of Commerce, in consultation with the Patent and Trademark Office and the Federal Election Commission, to study and recommend to Congress appropriate “guidelines and procedures for resolving disputes involving the registration or use by a person of a domain name that includes the personal name of another person, in whole or in part, or a name confusingly similar thereto.” The Department of Commerce now presents this report for Congress’ consideration.

Consistent with the comments generated by our *Federal Register* notice and request for comments, the report makes no new recommendations for guidelines and procedures and counsels legislative restraint at this time. The Department of Commerce believes that there is insufficient evidence as of this date to suggest that personal name holders lack redress when their names are abusively registered as Internet domain names. This report also concludes that the current work of the World Intellectual Property Organization being undertaken to explore and make recommendations concerning the bad faith registration of personal names will offer further clarification of these complex issues.

II. Background

Section 3006 of the Anticybersquatting Consumer Protection Act of 1999 (ACPA, or “anticybersquatting legislation”) (Senate bill S. 1255, as incorporated into Public Law 106-113) directs the Secretary of Commerce, in consultation with the Patent and Trademark Office and the Federal Election Commission, to conduct a study and report to Congress with recommendations on guidelines and procedures for resolving disputes involving personal names, the general subject of section 3002(b) of the ACPA.

The anticybersquatting legislation requested that the Department of Commerce consider and recommend guidelines and procedures for protecting personal names from:

- (1) registration by another person as a domain name for the purposes of profiting from the sale or transfer of the domain name;
- (2) bad faith uses of personal names as domain names by others with malicious intent to harm the reputation of the individual or the goodwill associated with the individual's name; or,

- (3) use that is intended or likely to confuse or deceive the consumer as to the affiliation, connection, or association of the domain name registrant, or the domain name site with the individual.

In addition, the anticybersquatting legislation requested that the Department of Commerce consider and recommend guidelines and procedures for protecting the public from the registration of domain names that include personal names of government officials, official candidates and potential candidates for Federal, state or local political office, and the use of such domain names in a manner that disrupts the electoral process or the public's ability to access accurate and reliable information regarding such individuals.

The ACPA asked that the Department of Commerce consider not only the existing remedies at the Federal and state level, for example, trademark law, unfair competition law, and dilution law, but also the guidelines, procedure and policies of the Internet Corporation for Assigned Names and Numbers (ICANN), and the extent to which these existing remedies address congressional concern for the protection of personal names on the Internet.

In order to conduct that study, the Department of Commerce published on February 29, 2000, a *Federal Register* Notice and Request for Comments entitled "Abusive Domain Name Registrations Involving Personal Names; Request for Public Comments on Dispute Resolution Issues Relating to Section 3002(b) of the Anticybersquatting Consumer Protection Act." That notice sought comments from interested members of the public on the resolution of Internet domain name disputes involving personal names. By notice published in the *Federal Register* on April 6, 2000, the Department of Commerce extended the period for public comment until April 21, 2000. Fourteen comments were received.

III. Problems Identified by Public Comments Received

Several of the individuals responding to the notice commented on the costs associated with the unauthorized use of personal names in domain names, especially in the political context, where a person seeking the official or authorized Web site of a political candidate finds himself at a "spoof" site or another electronic destination that does not give either candidate-approved information or accurate factual information about the candidate. Concern was expressed, particularly in the public comments submitted on behalf of the Republican National Committee and the Democratic National Committee, that voters, seeking to educate themselves about candidates, might abandon use of the Internet should it become too difficult or time-consuming to find a site that contains correct, reliable information.

Other comments noted the problems that can arise for individuals or businesses that use a personal name (such as that of the founder or proprietor) in commerce only to find that the corresponding domain name has already been registered by another person. Sometimes, as one correspondent noted, the business must engage in long, difficult, and expensive legal

proceedings to have the false Web site shut down. In the meantime, the reputation of the legitimate business may be significantly damaged.

Each of the 14 public comments may be reviewed at <http://www.uspto.gov/web/offices/dcom/olia/domainnamerep.html>.

IV. Current Problems Addressed By Current Law

In general, under the U.S. trademark law, personal names require proof of secondary meaning in order to be registered as trademarks. The Lanham (Trademark) Act of 1946, as amended, provides that: "No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it... (c) consists of or comprises a name, portrait, or signature identifying a particular living individual except by his written consent...".
5 U.S.C. §1052.¹

Thus, a mark that consists of or comprises (whether consisting solely of, or having incorporated in the mark) a name, portrait or signature that identifies a particular living individual may only be registered if the mark serves as an indicator of the source of goods or services rather than as merely descriptive of the goods or services. Personal names under the Federal trademark law can be analogized to descriptive terms, terms that generally do not point to a single source for goods or services and can only be registered and protected as trademarks when the term(s) acquire secondary meaning.

The majority of respondents to our Notice and Request for Public Comment, admittedly a small group of 14, favored no change in current Federal and state laws to deal with cybersquatting and counseled caution before creating any new guidelines or procedures. These respondents cited the First Amendment guarantee of freedom of expression as one reason for the Government to proceed cautiously in the area of personal name cybersquatting.

¹ Section 2(c) bars the registration of such marks on the Principal Register and, pursuant to §23(a), 15 U.S.C. §1091(a), the Supplemental Register.

The purpose in section 2(c) of requiring the consent of a living individual to the registration of his or her name, signature or portrait is to protect rights of privacy and publicity that living persons have in the designations that identify them. *University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co., Inc.*, 703 F.2d 1372, 1376; 217 USPQ 505, 509 (Fed. Cir. 1983); *Canovas v. Venezia*, 220 USPQ 660, 661 (TTAB 1983).

The reference to "name" in section 2(c) is not restricted to the full name of an individual but refers to any name regardless of whether it is a full name, or a surname or given name, or even a nickname, which identifies a particular living individual. Further, although a mark may have been devised to be fanciful or arbitrary and not to identify a particular living individual, it nevertheless may name or otherwise identify one or more living individuals. Whether consent to register is required depends upon whether the public would recognize and understand the mark as identifying the person.

One group of comments recommending no action at this time based that opinion on the belief that the "market" should be allowed to sort out the registration of personal names as domain names. These commentators thought that anyone who was not quick enough to register his personal name should be required to buy it back from the person who got to the registry first. Some respondents stated that any requirement that such domain names be surrendered would be an unconstitutional taking of property without just compensation.

A second group of commentators recommending no new laws or procedures based their view on the belief that existing laws already provide enough avenues for the protection of personal names. Among those respondents, several cited to trademark and unfair competition law as a means of protecting personal names if used for business purposes. As the ACPA is presently written, section 3002(a) provides for relief from personal name cybersquatting if the name is protected as a trademark. Others pointed to the libel laws and to state laws of publicity. The uniform dispute resolution policy of ICANN was also cited by commentators as a mechanism for dealing with the abusive registration of personal names.

One correspondent pointed out that the language of section 3002(b)(1) of the ACPA provides relief from the misuse of personal names as domain names. That language establishes civil liability when any person registers a domain name that consists of the name of another living person, or a name substantially and confusingly similar thereto, without that person's consent, with specific intent to profit from such a name by selling the domain name for financial gain. However, as the correspondent noted, no cases have been reported under section 3002(b). Thus, it is too early to determine how effective this section will be in providing protection for personal names that are not marks.²

Another respondent made the following detailed suggestions for changes to the ACPA: (1) clarify that its provisions apply to the personal names of politicians, (2) clarify that the failure to give adequate and correct contact information in the application for the domain name could result in transfer of the domain name, (3) provide protection for the names of deceased celebrities, (4) provide that the fame of the celebrity could be a factor to be considered in an action against a cybersquatter, and (5) provide that where the domain name registrant can show no actual interest or rights in the celebrity name, there would be a presumption of bad faith.

¹ Further, the correspondent noted that section 3002(b) was a late addition to the ACPA and should not be expanded without further scrutiny.

In the same spirit as this particular public comment, in August 2000, the State of California passed a new law to protect the personal names of “living person[s] and deceased personalit[ies]” in the Internet environment. The new California unfair business practices law makes it “unlawful for a person, with a bad faith intent to register, traffic in, or use a domain name of another living person or deceased personality....” California Business and Professions Code, Article 1.6, section 17525 (a) [signed into law August 21, 2000]. The California law sets out nine indicators a court may use to determine bad faith under the statute, eight of which parallel the bad faith indicia now established in 15 U.S.C. §1125(d)(1)(A) pursuant to the anticybersquatting legislation.³

The California law is broader than the protection provided to individual names under ACPA in two respects. First, under the ACPA, a domain name registrant will incur liability for using an individual’s untrademarked name only when the domain name is “register[ed] . . . with the specific intent to profit from such name by selling the domain name for financial gain to that person or any third person,” whereas the California law exposes the domain name registrant to liability based on the range of bad faith indicators that the Federal law reserves for trademark cybersquatting. Second, the California law applies to the names of “deceased personalit[ies]” as well as living persons.

The difference in activities that trigger liability for unauthorized use of personal names between the ACPA and the new California law will, in time, allow us to observe the effect of these two different mechanisms in practice. In this respect, California may serve as a legislative “laboratory” on this issue.⁴ We lack present evidence, however, to suggest that an aggrieved personal name holder does not have redress under current law. Under the combination of section 3002(b) of the ACPA, unfair competition laws, libel laws, and other causes of action under state law, individuals who are victims of the bad faith registration of a personal name appear able to seek effective legal remedies.

³ The California law does not include 15 U.S.C. §1125(d)(1)(A)(IX) (“the extent to which the mark incorporated in the person’s domain name registration is or is not distinctive and famous within the meaning of subsection (c)(1) of section 43”) because the California law pertains to individuals’ names, not trademarks. Instead, the California law includes a final bad faith indicator, distinct from anything in the ACPA, which provides that a California court determining “bad faith” will consider “whether the person alleged to be in violation of this article sought or obtained consent from the rightful owner to register, traffic in, or use the domain name.” It is not clear what is meant by “rightful owner” in this provision, since the law concerns personal names that are not “owned” *per se*; we assume that the California law is intended to instruct a court to consider whether the domain name registration sought or obtained the consent of the individual whose name appears in the domain name.

⁴ Courts and commentators have frequently recognized that the States may serve as “laboratories” for the development of new social, economic, and legal ideas. *See, e.g., Chandler v. Florida*, 449 U.S. 560, 578 (1981); *Reeves, Inc. v. Stake*, 447 U.S. 429, 441 (1980); *New State Ice Co. v. Liebmann*, 285 U.S. 262, 311 (1932) (Brandeis, J., dissenting).

V. Considerations Particular to Political Candidates and Campaigns

The anticybersquatting legislation specifically requested that the Department of Commerce consider the problem of unauthorized domain name registration that includes personal names of government officials or candidates for Federal, state, or local political office. The legislation further asks whether (and to what degree) such domain names disrupt the electoral process or the public's ability to access accurate and reliable information.

In addressing these issues, many commentators focused on: (a) use of a dedicated second level domain within the .us country code top-level domain (TLD) for politicians and political candidates, and (b) the Federal Election Commission (FEC) as the best possible government candidate to maintain an authoritative, centralized list of political candidates and campaigns and their Web sites. But, in a letter of March 21, 2000, from Lawrence M. Noble, the General Counsel of the FEC to Andrew Pincus, then General Counsel of the Department of Commerce, Mr. Noble stated that the Commission would have neither the resources to act as the registry administrator for a .us TLD for the purpose of maintaining a list of Web sites for candidates and officeholders, nor did it have a legislative mandate to do so.

Even if the FEC were provided with the legislative mandate and financial resources to take on such a task, other systemic problems would need to be addressed. First, the FEC does not become involved with a candidate until his or her candidacy reaches a certain stage. Often candidates are raising funds and running for office long before they must make contact with the FEC. For example, candidates may launch Web sites before they have "officially" announced their campaigns or filed statements of candidacy with the FEC. Yet, any alternative to relying on the statement of candidacy filing to determine who would be eligible to be on the FEC Web site list would require the creation of a separate and perhaps unwieldy application process at the Commission.

Even then, questions would remain. For example, what would be the proper way to treat exploratory committees? Second, although the FEC could maintain the list of "official" Web sites, there is no evidence that citizens looking for official or correct information concerning candidates would be likely to go to the FEC site without the FEC first launching a campaign to advertise the Web site's availability. Finally, it is not clear that the Federal Government should be involved in creating and maintaining a list of "official" political Web sites when both the private sector and state governments have already begun to develop innovative, effective methods of facilitating public access to political Web sites with unbiased, factual information about candidates.

On this last point, public comments suggested that independent sites and services might serve as authoritative, centralized lists of official candidate Web sites. The Internet is evolving as a tool for political communications, and both profit and non-profit entities have developed services that help fulfill the need for quick guidance to official candidate Web sites.

For example, Voter.com maintains an extensive Web site at <http://www.voter.com> and bills itself as a general political information portal.⁵

Further, non-profit organizations like Common Cause (<http://www.commoncause.org>) and the League of Women Voters (LWV)(<http://www.lwv.org>) maintain multi-faceted Web sites that could provide an appropriate forum for such a candidates' site list. Again, as an example of the potential for private action in this area, the LWV of California maintains a Web site called "SmartVoter"(<http://www.smartvoter.org>) that allows the user to search for a California candidate -- any level from congressional to school board races -- and be connected to a LWV fact page on that candidate. It would only be a small step to link to the candidate's official site.

These are just a few examples of how the private sector has responded and can be expected to further respond to citizens' need for accurate and efficient information sources about political candidates, including easy methods of finding their official Web sites and other contact information.

Similarly, many state government secretaries of state already have Web sites that provide centralized lists of candidates with contact information about the candidates. For example, the California Secretary of State site http://www.ss.ca.gov/elections/elections_e.htm offers full contact information for campaigns, including e-mail addresses (but not Web links); the Ohio Secretary of State offers mailing addresses http://www.state.oh.us/sos/2000_candidates_guide.htm and the Georgia Secretary of State <http://www.sos.state.ga.us/elections/qual2000.htm> offers mailing addresses and telephone numbers.

Further development of such sites to include candidates' Web site information, if not active links to official candidate sites, would be more practical than a *de novo* effort at the Federal level. It is also arguable that similar mechanisms implemented at the local level, rather than centralized at the Federal level, could be better tailored to meet the candidate information needs of the relevant community of local or district voters. In short, at this stage in the Internet's evolution, there are too many possible avenues by which effective and efficient communication of official candidate Web sites might develop for the Department to determine that a centralized FEC facility is needed.

VI. The Procedure and Policies of the Internet Corporation for Assigned Names and Numbers

^M From the homepage at Voter.com, one can move immediately to a "candidates" page that provides a search engine for candidates either by last name and/or state. This search function takes one quickly to an internal Voter.com page for the candidate that includes e-mail and official Web site information.

On June 5, 1998, the Department of Commerce issued a Statement of Policy entitled Management of Internet Names and Addresses (the "White Paper") setting forth the Administration's policy for privatizing management of the domain name system in a pro-competitive manner that would also facilitate global participation.⁶ The White Paper called upon the private sector to create a new, not-for-profit corporation to assume responsibility, over time, for the management of certain aspects of the domain name system. The Department ultimately entered into agreements with ICANN, a non-profit corporation formed by the private sector, to undertake this transition.

As described in the White Paper, the United States sought the assistance of the World Intellectual Property Organization (WIPO) to initiate a balanced and transparent international process to: 1) develop a set of recommendations for an approach to resolving trademark/domain name disputes involving cyberpiracy; 2) develop recommendations for the protection of well-known marks in the generic TLDs; and 3) evaluate the effects of adding new TLDs and related dispute resolution procedures on domain name and trademark holders. The results of the study were to be submitted to the board of the new, not-for-profit corporation for consideration.

WIPO undertook a thorough process to investigate the complex issues that included convening an experts committee from around the world, conducting a series of international consultations, and soliciting public comment on the issues. On April 30, 1999, WIPO released its final report, entitled The Management of Internet Names and Addresses: Intellectual Property Issues.⁷ This report identified for ICANN a range of considerations and recommendations on questions arising out of the interface between intellectual property rights and the global domain name system. With respect to conflicts arising from the bad faith registration of trademarks as domain names, the WIPO report recommended a speedy online administrative system for dispute resolution that would not limit a party's right to seek relief in a court of law.⁸

^N The White Paper may be found on the Department of Commerce, National Telecommunications and Information Administration Web site at http://www.ntia.doc.gov/ntiahome/domainname/6_5_98dns.htm

^E This report may be found online at <http://wipo2.wipo.int/process1/report>

^O WIPO noted in its April 30, 1999, report that areas requiring further consideration and

investigation included “the problem of bad faith, abusive domain name registrations that violate intellectual property rights other than trademarks or service marks, for example, geographical indications and personality rights.” The Management of Internet Names and Addresses: Intellectual Property Issues, Executive Summary, “First Steps and Outstanding Issues,” pp. (vii)-(viii).

Based on these recommendations and after additional public consultation, ICANN approved rules and implementing documents for a uniform domain name dispute resolution policy (UDRP) for the resolution of disputes arising from trademark/domain name conflicts.⁹ The UDRP is designed to be an expeditious, inexpensive process for resolving disputes, with remedies consisting of transfer or cancellation of the disputed registration to successful complainants. Complaints brought under the UDRP are administered by approved dispute resolution service providers.¹⁰ The proceedings are conducted by administrative panels appointed by the dispute resolution service providers. UDRP dispute resolution providers have rendered over 1,500 determinations in cases alleging cybersquatting.¹¹

Although the policies and procedures of the UDRP were not developed specifically to address allegations of personal name cybersquatting, several dispute determinations have been rendered under the UDRP that apply the policy to cases of abusive domain name registration involving personal names, or variations of personal names.¹² (For further description of key personal name decisions rendered under the UDRP, please refer to Appendix A of this report). In those cases, determinations in favor of complainants have been rendered where the complainant has demonstrated trademark-based or other rights in the personal name that, in the judgment of the administrative panel, would satisfy the requirement of the UDRP.¹³ Such determinations have resulted in the transfer of the contested domain name, as provided under the UDRP.¹⁴ In our informal study, we were unable to identify any cases where an American complainant whose

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- Π General information on ICANN's UDRP, including a time line describing the process undertaken by ICANN to adopt the policy and rules, is located at <http://www.icann.org/udrp/udrp.htm>
 - ⊙H Information on UDRP dispute resolution service providers is located at <http://www.icann.org/udrp/approved-providers.htm>
 - ⊙⊙ ICANN maintains an active online list of all of these administrative proceedings and the decisions rendered under the UDRP. This list may be found at <http://www.icann.org/udrp/proceedings-list-name.htm>
 - ⊙I In the online context of memorable domain names, a cybersquatter may use common typographical errors to confuse users about the origin of a product or service that the cybersquatter is offering. For example, a cybersquatter may purposefully transpose the lettering of a personal name and then register a resulting domain name that is confusingly similar to a well-known or trademarked personal name.
 - ⊙K Administrative decisions held under the UDRP have stated that disputes involving personal names do not require registration of a personal name with a government agency to be considered under the procedure.
 - ⊙Λ We note that while several personal domain name cases have been arbitrated under the ICANN UDRP, issues regarding the appropriateness of employing the UDRP, as currently written, to resolve such disputes will likely be considered through additional work by ICANN and WIPO.

rights were grounded in a personal name brought a civil action in the United States contesting an adverse decision of a UDRP panel.

VII. Next Steps

Indeed, disputes arising from use of personal names in the domain name space present a variety of complicated issues requiring careful review, study and consideration. Further, because of the global nature of the Internet and the fact that domain name disputes can involve parties in different jurisdictions, the Department of Commerce believes that the most effective mechanisms for resolution of personal name/domain name conflicts will result from a globally applicable solution. Recognizing the difficulties associated with the global protection of personal names, on June 22, 2000, the United States joined with 19 other countries to request that WIPO undertake further work to study and develop recommendations in relation to the bad faith, abusive, misleading or unfair use of personal names within the domain name system.¹⁵

WIPO welcomed the request and affirmed its commitment to promoting a reliable environment in cyberspace.¹⁶ The work will take advantage of WIPO's past work on Internet domain names, and, in particular, WIPO's thorough process of consultation and advisement. The decision by the United States to commend this study to WIPO ensures that interested stakeholders will be involved in determining a carefully considered approach to personal name/domain name conflicts that carries with it international momentum. Moreover, the request for work asked that WIPO's findings and recommendations be submitted to the members of WIPO for consideration by the Internet community, including ICANN.

WIPO has already begun its Second Process of consultation with WIPO members and stakeholders, and plans to cooperate closely with ICANN to consult on and coordinate developments related to issues addressed in the process, including personal name cybersquatting. WIPO has issued two Requests for Comment that delineate the scope of issues to be covered in the study. In its second Request for Comment, WIPO asked commentators to provide information on, among other subjects, the types and extent of any problems or abuses in the domain name system related to personal names. WIPO also asked the public to comment on the range of personal names needing protection (for example, first and last names, surnames, nicknames, fictitious (character) names, names of famous persons, names of public officials or other persons in the public eye, and/or names of living or deceased persons).¹⁷

⊙M In addition to personal names, WIPO was also requested to undertake work on other issues identified in their April 30, 1999, report as requiring additional study including international nonproprietary names (INN) for pharmaceutical substances; names of international intergovernmental organizations; geographical indications, geographical terms, or indications of source; and tradenames. See letter of request posted at <http://wipo2.wipo.int/process2/rfc/letter2.html>

⊙N The press release announcing WIPO's investigation of new issues relating to domain name abuse may be found at <http://wipo2.wipo.int/process2/press/235.html>

⊙Ξ For general information on the WIPO Second Process and the Request for Comments, see

The deadline for the comment period on WIPO's second Request for Comment was December 29, 2000. In conjunction with its public comment activities, WIPO is now conducting regional consultations so that interested parties around the world have the opportunity to present their views on these issues. We believe that this process will facilitate the development of important consensus across jurisdictions regarding the protection of personal name disputes that occur online, and, accordingly, we look forward to this process to shed light on these complex issues. We expect that the current WIPO process will result in thoughtful recommendations concerning the manner in which to address the practice of abusive registration of personal names as Internet domain names. The final report on this process is expected by July 2001.

VIII. Conclusion

We conclude that the time is not ripe for further Federal legislation to protect personal names from abusive registration as domain names. In the political area, we see no need at this time for the FEC to intervene to create a centralized accurate list of official candidates and potential candidates for Federal, state or local offices. With regard to existing remedies available under trademark law, unfair competition, and dilution, we observe that aggrieved personal name holders are eligible for protection under these laws. Further, the ACPA provides relief from the misuse of personal names as domain names when any person registers a domain name that consists of the name of another person, or a name substantially and confusingly similar thereto, without that person's consent, with specific intent to profit from such a name by selling the domain name for financial gain. Finally, the Department of Commerce believes that WIPO's ongoing process to study and consider issues arising from bad faith registration of personal names will hold particular value in further informing current discussions on these complicated issues and holds promise to result in the development of globally functional recommendations regarding the resolution of related disputes.

<http://wipo2.wipo.int/process2/rfc/index.html> For the full list of personal name questions posed in the Second Request for Comments, please refer to WIPO2 RFC-2, paragraph 20.

APPENDIX A

Generally, under the UDRP, a Complainant will be required to prove the following three elements: (1) that the domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights, (2) that the domain name holder does not have legitimate interests in the domain name, and (3) that the name was registered and being used in bad faith.¹⁸ The domain name holder, or Respondent, must thereafter demonstrate in a response whether he possesses legitimate interests in the domain name. This proof of legitimate interest should include whether: (1) the name used in the domain name is connected to the bona fide offering of goods or services; (2) the domain name holder is commonly known by the name used as a domain name; or (3) the domain name holder is making a legitimate noncommercial or a fair use of the domain name without intent to divert consumers or tarnish the trademark at issue.¹⁹

Administrative Proceedings Involving Personal Names

In reviewing the following examples of personal name disputes arbitrated within the UDRP, it is not the Department of Commerce's purpose to comment on the judgments, but simply to relay the facts of particular cases to demonstrate trends which may be of use in further study of these issues.²⁰

In several UDRP decisions, panelists have clarified the requirement that the Complainant prove that he has *demonstrable* trademark rights. A Complainant must prove, according to these cases, that he or she is the owner of either a trademark or service mark in the personal name by a registration of the mark, or in other cases by offering evidence of his or her common law rights to the personal name.

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- ⊙O Uniform Domain Name Dispute Resolution Policy, ¶4(a), available at <http://www.icann.org/udrp/udrp-policy-24oct99.htm> (hereinafter UDRP Policy); *see also* Rules for Uniform Domain Name Dispute Resolution Policy, ¶3(b)(ix), available at <http://www.icann.org/udrp/udrp-rules-24oct99.htm>
- ⊙Π UDRP Policy, ¶4(c), *see supra* note 18.
- ⊙H For purposes of this report to Congress, we will not analyze cases involving celebrity fan club Web sites of a commercial nature operated by interests not affiliated with the personal name itself. *See, e.g., Experience Hendrix, L.L.C. v. Denny Hammerton and The Jimi Hendrix Fan Club* (Case No. D2000-0364) (WIPO August 2, 2000, decision) (prevailing Complainant was a company formed in 1995 by the family of the late Jimi Hendrix, an internationally known guitarist and musician, and was the owner and administrator of substantially all rights relating to Jimi Hendrix, including rights in his music, name, image, and recordings), *Helen Folsade Adu p/k/a Sade v. Quantum Computer Services Inc.* (Case No. D2000-0794) (WIPO September 26, 2000, decision) (successful Complainant -- a world-famous singer, songwriter and recording artist -- had not registered or made an application to register the name "SADE" as a trademark or service mark in any jurisdiction).

1. Several UDRP Decisions have Relied Upon Registration of Personal Name as Trademarks to Find in Favor of the Complainant.

In several disputes resolved through the UDRP, it was noted and/or relied upon that the Complainant possessed a trademark registration for the personal name in dispute. On February 13, 2000, the private company Harrods Limited submitted a Complaint to WIPO Arbitration and Mediation Center seeking a domain name transfer of <dodialfayed.com>. *Harrods Limited v. Robert Boyd* (Case No. D2000-0060) (WIPO March 16, 2000, decision). Harrods, the owner of a European Community trademark in the words “DODI FAYED,” maintained that the Respondent in the case had registered the disputed domain name and was offering the domain name for sale in an effort to capitalize unjustly on the public interest in the late Mr. Emad Mohamed al-Fayed, who died in the accident that also killed Princess Diana of Wales.

The administrative panel in Harrods turned to an examination of the three UDRP factors. Regarding the trademark rights element, the panel concluded that the name “Dodial Fayed” was simply a more formal version of a nickname which would be confusingly similar to the European Community trademark. This similarity satisfied the first requirement of the UDRP. The panel further found that Complainant’s European Community trademark (there was no evidence that Complainant had pursued a trademark in the United States) demonstrated legitimate rights that the Respondent could not claim. The Respondent’s bad faith use of the mark was implied from his sales offer which, according to the panel further demonstrated that the Respondent did not have a legitimate interest in the name. Consequently, the panel decided the proceeding in favor of Complainant and ordered the domain name transferred.²¹

¹⁰ Other UDRP cases involving personal names for which trademark (or service mark) protection was previously obtained include *CMG Worldwide, Inc. v. Alessandro Bottai* (Case No. FA0004000094661) (National Arbitration Forum May 31, 2000, decision) (domain

2. Several UDRP Decisions have Relied Upon “Common Law Rights” in Personal Names to Find in Favor of the Complainant.

Several UDRP decisions have been in favor of the Complainant regardless of whether he could demonstrate a prior registration of the name as a mark within some jurisdiction. These decisions have relied upon mostly common law rights with a basis in English or U.S. law, such as a right against passing off and acquiring secondary meaning, respectively.

For an example, in May of 2000, *Jeanette Winterson v. Mark Hogarth* (Case No. D2000-0235) (WIPO May 22, 2000, decision), decided in favor of this British author stating that she had “common law rights” in her name. In dispute were the following domain names: <jeanettewinterson.com>, <jeanettewinterson.net>, and <jeanettewinterson.org>. The Respondent had registered not only these names, but also the domain name <writerdomains.com> with the declared intention of developing Web sites devoted to over 100 writers of renown. Complainant, a Booker Prize-winning author, could claim no registered or pending trademarks in her name, but instead asserted that the mark “JEANETTE WINTERSON” had come to be recognized by the general public as indicating an association with her works. Complainant initiated proceedings under the UDRP on March 30, 2000, after the Respondent telephoned her offering the domain name for sale.

name transfer of <chuckberry.com> to Complainant, an international licensor of celebrity marks); *Yanni Management, Inc. v. Progressive Industries* (Case No. FA0006000095063) (National Arbitration Forum August 2, 2000, decision) (domain name transfer to Complainant, a famous musician); *Madonna Ciccone, p/k/a Madonna v. Dan Parisi and “Madonna.com”* (Case No. D2000-0847) (WIPO October 12, 2000, decision) (domain name transfer of <madonna.com> to Complainant, an internationally known entertainer, from Respondent who *also* held a bona fide trademark in Tunisia in the word “MADONNA”). In the UDRP decision *Calvin Klein, Inc. v. Spanno Industries* (Case No. FA0007000095283) (WIPO August 21, 2000, decision), the administrative panelists transferred to Complainant retailer Calvin Klein the domain name <CALVINKLINE.COM>. Calvin Klein had previously obtained registered marks in both the United Kingdom and the United States. Respondent Spanno Industries failed to file a response to the Complaint in the case, and the uncontested facts of the case indicated that Spanno was a bad faith user of the domain name. More particularly, the Respondent registered the domain name years after the retailer registered its own identifying trademarks, used the subject domain name to display obscene and terrorist materials, was not commonly known by the domain name, and was not licensed or otherwise authorized to use the Calvin Klein mark.

The panelist in the *Jeanette Winterson* case determined that the “main issue” to be decided was: “Is a trademark *required* to be registered?” In the course of this decision, the panelist sought guidance from the WIPO April 30, 1999, Report,²² applicable common law rights, and trademark decisions of the English court, primarily decisions on passing off of well-known personalities, to arrive at the conclusion that Complainant was entitled to have the three contested domain names transferred to her.²³

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- II Paragraphs 149-150 belong to that section of the Report entitled “Guiding Principles for the Design of the Administrative Dispute-Resolution Policy.” Most pertinent is paragraph 149, which reads:

In addition to the perceived limitations of litigation, a number of commentators have expressed dissatisfaction with current dispute-resolution policies in the gTLDs. One of their important deficiencies results from their reliance on the ability of the parties to produce certain trademark certificates, without any review of the question of use of the domain name and alleged infringement. These policies are seen as not sufficiently allowing for the consideration of all legitimate rights and interests of the parties (which are not necessarily reflected in a trademark certificate), opening the door to unjust results, including for those who are not trademark owners. In light of these difficulties, a substantial majority of commentators favored the adoption of a form of administrative dispute-resolution more suited to the proper review and consideration of the rights and interests of all parties involved in a dispute.

Compare The Management of Internet Names and Addresses: Intellectual Property Issues, at paragraphs 165-168.

- IK ¹□□□□□² May 2000, a WIPO administrative panel reached a decision in the celebrity case of *Julia Fiona Roberts v. Russell Boyd* (Case No. D2000-0210) (WIPO May 29, 2000, decision) (in relying upon *Jeannette Winterson*, the panel concluded that motion picture actress Julia Roberts had common law trademark rights in the domain name <juliaroberts.com>. The domain name was transferred from Respondent, whose relation to the mark was his fondness for the actress). *See also* *Monty and Pat Roberts, Inc. v. Bill Keith* (Case No. D2000-0299) (WIPO June 9, 2000, decision) and *Monty and Pat Roberts, Inc. v. Bill Keith* (Case No. D2000-0300) (WIPO June 9, 2000, decision) (domain name transfers of <montyroberts.net> and <montyroberts.org> to well-known Complainant, a corporation in the business of selling and training horses who had registered and used in connection with these services the domain name <montyroberts.com>); *Daniel Marino, Jr. v. Video Images Productions, et al.* (Case No. D2000-0598) (WIPO August 2, 2000, decision) (domain name transfer of <danmarino.com> to Complainant, a seventeen-year professional football player, based on panel’s finding that the name had acquired sufficient secondary meaning to constitute a valid common law trademark); *Mick Jagger v. Denny Hammerton* (Case No. FA0007000095261) (National Arbitration Forum September 11, 2000, decision) (transferring to Complainant, a world-famous rock musician, the domain name <mickjagger.com> based on Complainant’s common law commercial use of the mark for over 35 years).

In July 2000, *Steven Rattner v. BuyThisDomainName (John Pepin)* (Case No. D2000-0402) (WIPO July 3, 2000, decision) was decided. This UDRP dispute raised questions about the birth name of an individual, the nickname by which an individual is known, and the effect of these alternate names to domain name disputes. At issue in the *Steven Rattner* case was the domain name <stevenrattner.com>. Steven Lawrence Rattner, a high profile investment banker and financial advisor, announced his resignation as deputy chairman of the financial services firm Lazard Freres on March 1, 2000. Two days later, John Pepin, the Respondent in the case, registered the disputed domain name. No initial use was made of the domain name. After a representative of the Complainant contacted Respondent Pepin, Pepin decided to offer the domain name for auction at a separate Web site.

Rattner initiated administrative proceedings against Pepin on May 9, 2000. Complainant Rattner claimed no registered trademark or service mark in the name “Steven Rattner,” but instead relied on a “very strong common law service mark in the United States” in his Complaint. The Complainant charged Respondent with acquiring the domain name <stevenrattner.com> strictly for purposes of selling, renting, or transferring the domain name to the Complainant for profit.²⁴ The panel in the case rejected the Respondent’s arguments, and transferred the domain name to the Complainant. In the supporting decision, the panel maintained that the Complainant had legitimate common law rights in connection with the investment banking and corporate advisory services for which he was well-known. The panel further established that the Complainant’s rights in the mark were not diminished simply because the Complainant also answered to variations of the name Steven Rattner. Although the panel acknowledged the commonality of the name Steven Rattner, the panel found that the Respondent had not satisfactorily proven the existence of his alleged same-name friend.

^{1A} The Respondent argued that the actual name of the Complainant was “Steven Lawrence Rattner” (a domain name Respondent never sought to register), that the Complainant was commonly known as “Steve Rattner” (another domain name Respondent never sought to register), and that there exists countless individuals named “Steven Rattner” (including an alleged friend of the Respondent, in whose interest Respondent claimed to have registered the disputed domain name).

