

A BETTER UDRP STANDARD FOR PERSONAL NAMES



ROBERTA HORTON is a Partner with the Washington, D.C., office of Arnold & Porter Kaye Scholer LLP. She focuses her practice on trademark, domain name, and copyright law. She handled one of the first cases challenging domain name infringers, and assisted in writing the statute protecting trademark owners against domain name infringers. She litigates both before the federal courts and the Trademark Trial and Appeal Board.

Ms. Horton has represented clients in many industries including: sports, food, telecommunications, tobacco, and hospitality. She also represents numerous nonprofits, including the environmental organization EarthShare and the largest children's literacy organization nationwide, Reading Is Fundamental.

Ms. Horton has been ranked in Chambers (Washington DC region), IP Legal 500 and listed in the 2010 Guide to the World's Leading Women in Business Law. Ms. Horton is a *summa cum laude* graduate of Yale University and a graduate of Yale Law School. Prior to joining the firm, she clerked on the US Court of Appeals for the Fourth Circuit for the Honorable Sam J. Ervin III.



MICHAEL KIENTZLE is an Associate with the Washington, D.C. office of Arnold & Porter Kaye Scholer LLP. He has experience representing clients in a wide range of civil matters before state and federal courts, as well as representing copyright owners before the United States Copyright Office. Additionally, Mr. Kientzle's practice includes advising clients on trademark matters and assisting clients in enforcing their trademark rights, including through arbitration proceedings before the World Intellectual Property Organization and the National Arbitration Forum.

Mr. Kientzle graduated cum laude from Georgetown University Law Center. While at Georgetown, Mr. Kientzle served as a law clerk to Senator Amy Klobuchar, and was a judicial intern to the Hon. Judge Block of the Court of Federal Claims.

The Uniform Domain Name Dispute Resolution Policy (the "UDRP" or the "Policy") frequently provides a welcome remedy for those trademark owners who fall victim to cybersquatters. But the UDRP is not so kind to individuals whose personal names are similarly targeted. UDRP decisions almost always require that an individual demonstrate commercial success in his or her personal name before ordering transfer of a domain name incorporating that personal name.

Imagine the different fates of our fictional characters, the sports hero, "Brute Force" and the environmental activist, "Leafy Greene." Brute plays center for a professional basketball team. Win or lose, this towering figure's name is in the papers throughout the season. He appears on cereal boxes and he endorses athletic shoes for a handsome fee. In a word, "Brute Force" is a commercial success. Under the UDRP, Brute can, very likely, protect the use of his name against cybersquatters who register the likes of "bruteforce.com", "brute-force.online", and "bruteforce.basketball."

Leafy Greene, the CEO of a non-profit forestry protection organization, will not fare so well against cybersquatters under the Policy, despite her notoriety, her TV appearances on nature shows, her many public

lectures, and favorable press on her activities. She is well-schooled on tree diseases and often serves as an expert witness in environmental cases. She has even started a foundation to help troubled youth by engaging young people in environmental projects. But she doesn't sponsor or endorse any products or receive any compensation from her many environmental activities. If cybersquatters seize "leafygreene.org", "leafygreene.net", and "leafygreene.xxx", she might well be out of luck in invoking the UDRP.

This article examines the standards that tribunals administering the UDRP, principally, the World Intellectual Property Organization ("WIPO") and the National Arbitration Forum ("NAF") apply to personal name cases such as Brute's and Leafy's fictional cases. It highlights inconsistencies in the personal name scenarios and the panelists' struggles with drawing the line at where personalities may or may not prevail. It then argues for a more generous application of those standards to protect the rights of individuals in their names. This more "lenient" standard would be consistent with the Policy's mandate that the UDRP should be available as a lower cost alternative to those seeking to redress the wrongs brought about by cybersquatters without engaging in expensive court litigation. It would

also construe the meaning of “trademarks or service marks” more liberally in the context of personal names to encompass non-commercial services rendered for the public good, particularly in obvious situations of cybersquatting.

THE CURRENT VIEW: LIMITED PROTECTION FOR PERSONAL NAMES

Unlike a case under the Anti-Cybersquatting Consumer Protection Act (the “ACPA”),¹ which may entail protracted litigation, a UDRP case is a streamlined administrative proceeding, involving only the filing of a complaint and, should the registrant so choose, a response. It is thus an attractive option for brand owners who care only about reclaiming their marks from cybersquatters, rather than making a monetary recovery, which may be available under the ACPA.²

Section 4(a) of the UDRP exacts a three-part test that a complainant must satisfy to prevail: (i) the domain name at issue must be “identical or confusingly similar to a trademark or service mark in which the complainant has rights”; (ii) the domain name registrant must not hold rights or legitimate interests in the domain name; and (iii) the registrant must have registered, and be using, the domain name in bad faith.³ (Emphasis added.). The Policy thus does not expressly contemplate relief for claimants seeking to protect their personal names, as opposed to their brand names.

Decisions applying the Policy do, however, generally afford relief to those claimants who make *commercial* use of their personal names, on the theory that this use establishes their trademark or service mark rights in their names. Specifically, entertainers, authors, athletes and other celebrities who make money off of their personal names have typically been accorded protection, with panels regarding their personal names, if unregistered, as common law marks.

The WIPO Overview 2.0⁴ also reflects this limited view of an individual’s right to redress for the unauthorized registration and use of his or her personal name as a domain name:

While the UDRP does not specifically protect personal names as such, in situations where a personal name unregistered as a trademark is being used for trade or commerce, the complainant may be able to establish common law or unregistered trademark rights in that name. In order to do so,

proof of use of the person’s name as a distinctive identifier of goods or services offered under that name would normally be required. . . . However: *The name in question needs to be actually used in trade or commerce as an identifier of goods or services to establish unregistered trademark rights for the purpose of the UDRP.* Merely having a famous name (such as a businessperson who does not actually use his or her name as an identifier for the business engaged in, or a religious leader), or making broad unsupported assertions regarding use of such name in trade or commerce, would not necessarily be sufficient to show unregistered trademark rights.⁵

(Emphasis added.).

The “Commercial Use” Standard in Practice

The General Distinction Between Commercial and Non-Commercial Use

Many “personal name” cases have turned on whether or not the domain name complainant has made commercial use of his or her name. Some cases draw an express distinction between situations in which the complainant performs services for a fee—or endorses products—and those in which he or she does not.

For example, in *Jay Leno v. Garrison Hintz*, Case No. D2009-0569 (June 26, 2009), the panel found that entertainer Jay Leno had presented solid evidence of common law rights in his name based on his alleged “success and fame as an comedian, entertainer, author and television personality” and thus awarded him transfer of the domain name “weeknightwithjayleno.com.” The panel observed that, in general, “in cases involving entertainers, authors, professional athletes and to a lesser extent business persons, complainants have been found to have common law marks in their names in circumstances *where the name has been used as a marketable commodity, for a fee to promote another’s goods or services, or for direct commercial purposes in the marketing of the complainant’s own goods or services.*” (Emphasis added.). See also *Dustin N. Diamond v. Max Goldberg*, NAF Claim No. FA0402000237446 (Apr. 5, 2004) (complainant who appeared in “numerous television shows and motion pictures” and sold instructional chess video established rights in personal name).

Likewise, in *Arthur Golden v. Galileo Asesores S.L.*, Case No. D2006-1215 (Dec. 15, 2006), the panelist ordered

transfer of “arthurgolden.com” and “arthurgolden.net” to author Arthur Golden, who penned the best-selling novel, *Memoirs of a Geisha*. The panelist wrote that, on the evidence “the name Arthur Golden is associated with the literary products of the Complainant. These facts are sufficient to establish common law rights in the name ARTHUR GOLDEN. In fact, it is precisely the famous nature of the Complainant’s name which is the probable cause of the registration of the domain names by the Respondent.”

So, too, UDRP panels have applied this reasoning in the sports context to the “Brute Forces” of the world. For example, in ordering transfer of “danmarino.com” to professional quarterback Dan Marino, the arbitrator stressed that the sports hero had “spent 17 years as the quarterback for the Miami Dolphins, has been a sports commentator, has acted in movies and has been recognized for community service”, all evidence sufficient to establish his common law rights in “Dan Marino” as a mark. *Daniel C. Marino, Jr. v. Video Images Prods.*, WIPO Case No. D2000-0598 (Aug. 2, 2000). See also *Dirk Nowitzki v. Happy Bulldawg Entertainment*, NAF Claim No. FA1107001400861 (Sept. 8, 2011) (concluding that basketball star had established rights in his first name “Dirk” through success in NBA, establishment of a charitable foundation, and large Twitter following and ordering transfer of “dirkswish.com” to him).⁶

Conversely, panels have denied other complainants relief, even when they have been well-known figures, where they did not plainly make commercial use of their names. A number of UDRP complaints have been brought by executives such as the fictional “Leafy Greene” who were primarily famous for their significant leadership roles at large companies or organizations. In these cases, UDRP panelists have been disinclined to find that the executives have rights in their personal names, even when there is evidence that these executives provide valuable, well-known public services in their own name, such as by giving interviews and lectures and publishing their views.

Perhaps the most prominent example involved the then-President of Planned Parenthood Federation of America, Inc., Gloria Feldt. *Planned Parenthood Federation of Am., Inc. v. Chris Hoffman*, WIPO Case No. D2002-1073 (Feb. 21, 2003). The panelist in that dispute recognized Gloria Feldt’s fame, that she had frequently appeared in public to express views on women’s reproductive rights, and that she was also the author

of many articles on that subject. Nevertheless, the panelist found that Ms. Feldt did not have rights in her personal name because none of her public work was commercial in nature and declined to award her transfer of the domain names “gloriafeldt.com”.

While the Gloria Feldt example is well-known, it is hardly the only decision under the Policy unfavorable to the leader of an organization whose name—although associated with significant public works or philanthropic efforts—was not used commercially. In *Israel Harold Asper v. Communication X Inc.*, WIPO Case No. D2001-0540 (June 11, 2001), the complainant, a successful businessman, author and politician known as “Izzy” Asper, unsuccessfully sought the transfer of several domain names that incorporated his unusual name, such as “izzyasper.com”. In one of the most extensive analyses on the personal names issue, the panelist ruled that “Izzy” Asper had not provided any evidence that his name, despite being well-known, had been used to identify commercial services or products. The panelist specifically ruled that Izzy’s donations to a university (which named a building after him) and his philanthropic endeavors (the Asper Foundation and the Asper Jewish Community Campus) did not suffice to establish common law rights in his name because “it is not argued on [Asper’s] behalf that there was any commercial consideration given to his name being included in the name of any of these bodies.”

The same is true as to UDRP complaints made by business persons against domain name registrants co-opting their personal names. For instance, in denying transfer of “megwhitmanforgovernor.com”, “megwhitman2010.com”, “meg2010.com”, “whitmanforgovernor.com”, and “whitman2010.com” to Meg Whitman, then-CEO of eBay, another panelist found that Meg Whitman held no rights in her personal name. This, despite the fact that, during her tenure at eBay, Whitman received several awards, made “numerous speeches, presentations and public appearances to promote eBay”, and was “featured on television and in numerous publications . . .” *Margaret C. Whitman v. Domains for Sale*, Case No. D2008-1534 (Dec. 1, 2008). The panelist nonetheless rejected the idea that this created rights in Whitman’s personal name, stating: “Merely having a ‘famous’ name is not sufficient to establish common law trademark or service mark rights in the name To be entitled to protection under the Policy, however, a personal name must function as a trademark, and for common law trademark rights to exist,

the Complainant's personal name must have come to be recognized by the public as a symbol which identifies particular goods or services with a single source." The panelist concluded that Whitman did not use the name "Meg Whitman" "as a source-indicator to a segment of the relevant buying public."

Similarly, in *Jonathan Ive v. Harry Jones*, WIPO Case No. D2009-0301 (May 5, 2009), the panelist determined that the well-known product designer at Apple, Inc., Sir Jonathan Ive, did not have common law trademark rights in his name despite being frequently approached in his personal capacity to perform design work, where this designer admitted to only accepting a small number of such engagements. The panel thus refused to transfer "jonathan-ive.com", "jonathanive.com", "jony-ive.com", and "jonyive.com" to Mr. Ive.

Inconsistencies in Personal Name Decisions

Although many cases apply the distinction between commercial and noncommercial use in deciding whether a complainant has established common law trademark rights in his or her name, others do not adhere to this distinction. Or, the cases reach a conclusion with little or no analysis, merely resting on the fame of the complainant in awarding relief.

For example, even when an individual has used his well-known name in connection with the sale of merchandise, this has not always sufficed to establish rights in his personal name. In *John Theodore Geiger a/k/a Teddy Geiger v. Premium Design*, NAF Claim No. FA0512000604896 (Jan. 17, 2006), the arbitrator ruled that a professional performer and actor who gave concerts throughout country, released albums, appeared on television, and sold t-shirts under his name "Teddy Geiger", did not have rights in personal name and could not obtain third-party registrations of "teddygeiger.com" and "teddygeiger.net". With little or no analysis, the arbitrator merely stated that Mr. Geiger did not allege common law rights in his name.

Likewise, in another case, a best-selling author did not prevail on his claim to protect his personal name against a registrant registering that exact name in his second level domain, "robertgreene.com." *Robert Greene v. Bob Greene*, Claim Number: FA1106001391921 (July 12, 2011). This decision gave short shrift to the secondary meaning discussion: "Complainant contends that his ROBERT GREENE mark has developed secondary meaning and is therefore fully associated with Complainant.

Complainant asserts that he is the author of a number of books, four of which have appeared on the New York Times Bestseller List. Complainant avers that he wrote *The 48 Laws of Power*, *The Art of Seduction*, *The 33 Strategies of War*, and *The 50th Law*. Additionally, Complainant claims that he frequently lectures at universities and businesses about the content developed under the mark. While Complainant has alleged an extensive amount of information about his use of the ROBERT GREENE mark, Complainant has failed to provide any dates or supporting evidence of its allegations. Therefore, the Panel concludes that Complainant has failed to provide sufficient evidence of common law rights in its ROBERT GREENE mark under Policy ¶ 4(a)(i)."

There is no clear or logical distinction between the Robert Greene case and that of Arthur Golden, author of *Memoirs of a Geisha*, who succeeded on his claim to seize unauthorized registration of domain names incorporating his personal name. Similarly, in the authors' view, there is no easy answer as to why Michael Crichton, author of the sci-fi work *The Andromeda Strain*, succeeded in reclaiming his name in a domain name, where Mr. Greene did not. See *Dr. Michael Crichton v. In Stealth Mode*, Case No. D2002-0874 (Nov. 25, 2002) (awarding transfer of "michael-crichton.com" to author Michael Crichton and observing: "Complainant has claimed to be the author of the numerous works already identified. Respondent has not contested this. The Panel therefore infers that Complainant has, through use, acquired common law trademark rights in his name.").

Moreover, as noted above, some cases take success on the screen as enough on its own to establish rights in a personal name, without requiring more. In other words, a complainant's fame alone has at times entitled he or she to succeed in a UDRP proceeding.

In one of the early and oft-cited cases on the subject, *Julia Fiona Roberts v. Russell Boyd*, WIPO Case No. D2000-0210 (May 29, 2000), the arbitrator ordered transfer of "juliaroberts.com" to actress Julia Roberts, star of movies such as "Notting Hill" and "Erin Brockovich." This decision stated, with little or no analysis, that the actress Julia Roberts had developed common law rights in her name by virtue of being "a famous motion picture actress" and found that the domain name "juliaroberts.com" should be hers.

So, too, in *Jim Carrey v. BWI Domains*, WIPO Case No. D2009-0563 (June 16, 2009), the panelist declared that the complainant's name "Jim Carrey" "provides a strong indication of source" by "virtue of the success of his numerous films" and his personal renown as "one of the world's most famous actors", and awarded transfer of "jimcarrey.com" to the comedian Jim Carrey. See also *Anna Nicole Smith c/o CMG Worldwide v. DNS Research, Inc.*, NAF Claim No. FA0312000220007 (Feb. 21, 2004). There, the panelist did express some doubt that pop icon star, the late Anna Nicole Smith, held common law trademark rights in her name because "the mere fact of having a successful career as an actress, singer or TV program star does not provide exclusive rights to the use of a name under the trademark laws." Continuing, however, the decision explained: "The Humphrey Bogart case cited by Complainant is a prime example of the type of case that would be expected to prevail, *since virtually no one familiar with the movie industry would fail to recognize his name as that of the famous movie star. The Panel does not believe Complainant's name has yet reached that level of fame.*" (Emphasis added in part). The panel nonetheless assumed Anna Nicole Smith's showing of such common law rights for purpose of its analysis. This analysis, again, suggests that, if a celebrity demonstrates a sufficient level of fame—without more—he or she may establish common law rights in his or her personal name, without use of that name to accompany a specific product or service.

The inconsistencies in these decisions, reflected in the above cases involving entertainers and authors, may stem from the fact that individual panelists from around the world, bringing their unique perspectives to bear on each case, are the decision-makers. The decision-makers are not bound to any specific judicial system and are not required to adhere to precedent. There is no appellate authority to harmonize their decisions. See *Public Storage v. Deer Valley Mini Storage*, WIPO Case No. D2012-1149 (Aug. 21, 2012). As this decision observed:

Each UDRP case involves its own specific and unique set of facts, with each panel bringing its collective knowledge, expertise, experience and wisdom to the task of deciding the issues involved. Doing so, as with adjudication, necessarily involves some degree of analytic subjectivity whether in assessing the facts and/or the pertinent law, and/or applying that law to the facts to achieve a result, which, in turn, will from time to time yield

variable results from one panel to the next. UDRP decisions are not precedential. . . . UDRP panels have no authority to . . . function as an appellate body tasked with reviewing another UDRP panel decisions . . . UDRP panels are co-lateral.").

And, whatever the reason for these inconsistencies, a more generous standard in the personal name context is warranted.

As explained in the next section, the authors believe that a complainant should succeed in a UDRP case where he or she uses his or her name prominently in the non-profit, as well as the for-profit, sense, and thereby gains public recognition for his or her name.

A CALL FOR AN EXPANDED STANDARD

The More "Generous" Standard for Personal Names

The current standard embraced by virtually all UDRP cases—that the claimant must show commercial use of her personal name to succeed—is simply too stringent. As demonstrated above, most cases brought by prominent persons who do not market products or services in their own names, including those in the non-profit field, do not result in the transfer of domain names incorporating their own names. This may be so, even where the complainant can show that she engages in philanthropic activities in her name, or lectures or performs public service in her name. See *Planned Parenthood Federation of Am., Inc. v. Chris Hoffman*, WIPO Case No. D2002-1073 (Feb. 21, 2003), discussed *supra*. Indeed, even in cases where the complainant's personal name was also included in the name of his company, or in his or her public service works, many—such as the "lizzy" Aspers of the world or the fictional "Leafy Greene" do not—succeed in establishing rights in their personal name.

No one would argue with an individual's right to register his or her name as part of a domain name. Why, then, should he or she be barred from protecting that name, simply because he or she is not using it to reap financial gain? As a policy matter, there is something inherently inequitable about the heightened domain name protection afforded persons who reap commercial success from their names, as compared to those who have engaged in useful business or other visible endeavors, including non-profit activities for the public good, under their names.

The call for an expanded view would extend protection in personal name cases to those individuals who use their names prominently in, and gain public recognition for, highly visible ventures, even if they do not entail commercial success. Principal among these would be non-profit uses of a person's name. Thus, an "Izzy" Asper establishing a well-known Jewish community campus, and engaging in philanthropic activities, in his name, or "Leafy Greene", providing environmental preservation information on the website "leafygreene.com", and engaging prominently as an activist to save the forests, under her name, would succeed in pursuing cybersquatters.

This is not to say that a claimant would succeed simply by arguing that he or she runs a non-profit or otherwise engages in work for the public good. A claimant would still have to show prominent use of his or her name in connection with a publicly recognized activity. Evidence such as news reports and press releases featuring the claimant leading the activity or non-profit organization, and describing the organization's services, may suffice, as would social media recognition for the claimant involved in the non-profit's or other public work's activities. In other words, gone would be the sharp commercial/non-commercial distinction in situations where the domain name complainant can otherwise show public recognition for himself or herself and the cause under his or her name.

To those that say an individual should, instead, invoke any protections that the right of publicity laws, unfair competition laws (or even the anticybersquatting laws) may afford, should not be the answer. Pursuing either of these routes—at least under U.S. law—would require engaging in litigation that may be protracted, time-consuming, and costly.

This has been true for plaintiffs who have filed ACPA complaints based on the use of their personal names in domain names. See, e.g., *Bogoni v. Gomez*, 11-CV-08093 (S.D.N.Y. 2011). In *Bogoni*, a successful real estate developer brought an ACPA claim in federal district court in New York against the registrant of two domain names incorporating the developer's exact first and last names, "paulbogoni.com" and "paulbogoni.org." While Mr. Bogoni eventually won a default judgment, he did so only after a year of litigating against a pro se defendant who, it is apparent, overly escalated the cost of litigation. In his motion for attorney's fees in that case, Mr. Bogoni stated that he had paid his lawyers more than

\$70,000 to litigate the case well in excess of the amount that an average UDRP proceeding would entail.

The same is true in the corporate context. For example, in *Newport News Holdings Corp. v. Virtual City Vision, Inc.*, Docket No. 4:08-cv-00019 (E.D. Va. 2008), the plaintiff brought a claim under the Anti-Cybersquatting Consumer Protection Act of the Lanham Act, the U.S. federal Trademark Act, based on the defendant's use of plaintiffs' "Newport News" mark in the domain name "newportnews.com." Unlike a UDRP proceeding, this federal court action was lengthy and therefore costly. Plaintiff filed its complaint in the United States District Court for the Eastern District of Virginia in February, 2008; the trial court's judgment for the plaintiff was confirmed on appeal to the Fourth Circuit *three years* later, in 2011—and after hundreds of docket filings in the trial court, including numerous motions relating to registering the trial court's order in foreign jurisdictions.

Indeed, these time-consuming, costly litigations are precisely the disadvantages that the UDRP are designed to address, particularly when it is the reclamation of the domain names, not a monetary award, that is most important to the complainant. This has been true since WIPO's infancy. See Final Report of the First WIPO Internet Domain Name Process, at ¶¶ 148–151 (Apr. 30, 1999) (<http://www.wipo.int/export/sites/www/amc/en/docs/report-final1.pdf>) (the "WIPO Report"). This Report summarized the work of the "WIPO Process", a years' long review of the relationship between the domain name system and intellectual property, and reflected the input of a myriad of governments, professional associations, and corporations worldwide. Emphasizing the "several limitations" of court litigation in addressing domain name disputes, the WIPO Report observed: "[T]he cost of litigation stands in stark contrast to the cost of obtaining a domain name registration." *Id.* ¶ 149." To this purpose, the WIPO Report recommended: "The [domain name dispute resolution] procedure should permit the parties to resolve a dispute expeditiously and at a low cost." *Id.* at 150(i).

In fact, there is already a basis in the U.S. law for this expanded view of affording UDRP protection outside the ambit of commercially successful complainants. As one noted authority explains:

Certain eleemosynary organizations function in commerce and, in form, resemble business

enterprises. Such nonprofit organizations and enterprises are equally entitled to protection against unfair competition. The fact that they are nonprofit-seeking ventures, and therefore spared some of the rigors of competition, does not entirely eliminate the element of competition, nor does it disentitle them to protection against the unfair competition of similar organizations.”

Louis Altman and Malla Pollack, 1 Callmann on Unfair Competition, Trademarks and Monopolies §1.2 (4th Ed. 2016). Such non-profit activities should be placed on an even footing in UDRP disputes; in cases involving personal names, there should be no basis, at least as a matter of U.S. trademark law, to limit that category of activities that suffice to demonstrate rights in a personal name to “commercial” activities. Indeed, both the courts and the U.S. Patent and Trademark Office acknowledge that non-profit entities may develop trademark rights in their names. See, e.g., *Am. Diabetes Assoc. v. Nat’l Diabetes Assoc.*, 681 F. 2d 804 (3d Cir. 1982) (affirming trial court determination that American Diabetes Association had developed secondary meaning, and therefore common law trademark rights, in its trade name); U.S. Registration No. 2976273 for the trademark “Habitat for Humanity.”

It is thus a short—and warranted—inferential leap to say that the *leaders* of such non-profits and other public works organizations, who names are closely and publicly associated with those organizations, should prevail in UDRP proceedings against those who register and use their names as domain names. To take but one real-life example, “Sidney Kimmel”, the noted philanthropist and founder of the “Sidney Kimmel Foundation”, a non-profit dedicated to funding cancer research, should be accorded protection against domain name registrants like Domain Admin/Domains for Sale, which has, in fact, registered “sidneykimmel.com” and pointed this name to a website offering it for sale. See https://www.hugedomains.com/domain_profile.cfm?d=sidneykimmel&e=com. This is the right result, regardless of whether or not Mr. Kimmel is a celebrity or a “commercial success” offering “Sidney Kimmel” products under his name.

A Heightened Presumption of Bad Faith Registration and Use

Added to this expanded standard would be an added presumption: Where the registrant’s domain name is

accompanied by disparaging terms or registered in connection with potentially disparaging top level domains such as “.porn”, “.xxx”, or “.wtf”, this should tip the scales in favor of finding bad faith use and registration.

In the authors’ view, there is something unique about a complainant’s personal name, and thus about a third party’s unauthorized registration of that name. There may be a more forceful argument than in a case involving misappropriation of a brand name (particularly one that is not very distinctive) that the third party registrant is acting in bad faith in registering others’ personal names, particularly when combined with tarnishing or disparaging elements.

Numerous UDRP cases demonstrate the potential for reputational harm—not to mention personal dismay—that can result from refusing to protect individuals whose well-known names are used to point to websites hosting tarnishing content, including pornography. Happily, some individuals so targeted have been found to meet the standard for personal name protection as it currently is written. For instance, the Buddhist Monk known as His Holiness Phakchok Rinpoche was able to secure the transfer of the domain name “phakchokrinpoche.com”, which had been used to point to a website containing numerous pornographic links, including links that appeared to refer to illegal child pornography. See *Tendzin Jigmey Drakpa v. Kim Joe*, WIPO Case No. D2006-0328 (June 7, 2006). Critically, the monk could demonstrate that he had used his name to market educational and religious services as well as books, magazines, postcards and brochures, and thus the panel determined that he had developed common law rights in his name.

Others have not been so fortunate. A panel denied relief to the noted publishing executive David Pecker, declining to order the transfer of “davidpecker.com”, which was used to point to a domain name parking service hosting links to pornographic websites. *David Pecker v. Mr. Ferris*, WIPO Case No. D2006-1514 (Jan. 15, 2007). Despite Mr. Pecker’s submission of evidence that he was CEO of a major publishing company, and that his name was widely-known and carried significant goodwill, the panelist found that he had not developed rights in his personal name and denied transfer. Under the new standard proposed here, the businessman may have protected himself through the UDRP from the use of his personal name to promote links to pornographic websites.

So, too, in the notorious case involving the use and registration of Dr. Jerry Falwell's name in "jerryfalwell.com" and "jerryfallwell.com", the Reverend Falwell did not obtain relief under the Policy. Instead, finding that Dr. Falwell specifically avowed commercial use of his name, the panel Dr. Falwell to the ACPA as a possible avenue for relief. Indeed, as the panelist in the Buddhist Monk case explained, drawing the commercial/non-commercial line between that case and Dr. Falwell's:

[T]he evidence submitted by Complainant thus stands in sharp contrast to the evidence submitted in *Reverend Dr. Jerry Falwell and The Liberty Alliance v. Gary Cohn, Profile.net, and God.info*, WIPO Case No. D2002-0184 (June 3, 2002). In that case, the panel noted that "Complainant is careful to avoid any suggestion that he has exploited his name for 'materialistic' or 'commercial' purposes. Complainant is an educator and religious minister. He has used his name to advance his views as to morality and religion." Complainant in this case similarly claims to be an educator and religious teacher, but he also claims to have used his name commercially for educational and charitable purposes, and those allegations are sufficient to establish common law trademark rights.

CONCLUSION

The widely shared view among panelists that public figures may only benefit from the protections of the UDRP if they can demonstrate that they use their names commercially to market products or services leaves too many well-known individuals unprotected from bad-faith attempts to capitalize on the goodwill these individuals have developed in their names. Numerous well-known public figures have been unable to succeed in seeking the streamlined, low-cost relief afforded by the UDRP—even in situations where their personal names are being used to host obscene or other offensive content—because they used their names only in connection with providing non-commercial services or doing other "good works." A new approach recognizing the goodwill that such individuals develop in their personal names through these non-commercial activities would prevent others from wrongly capitalizing on that goodwill, without forcing claimants to travel the far longer and costlier path of federal court litigation. 📌

Notes

- 1 15 U.S.C. § 1125(d).
- 2 The Lanham Act, 15 U.S.C. §1117(d), provides that in cases of willful infringement, a cybersquatter may be liable for \$100,000 per domain name infringed. The UDRP, on the other hand, does not afford any monetary remedies.
- 3 The UDRP is set forth in full at <http://www.icann.org/en/help/dndr/udrp/policy>.
- 4 This Overview, which addresses questions that commonly arises in WIPO proceedings, is posted at <http://www.wipo.int/amc/en/domains/search/overview2.0/#16>. As noted on this site, "[t]he WIPO Center's identification of questions and careful and conservative evaluation of opinions is based on some 20,000 UDRP cases it has administered through March 31, 2011."
- 5 WIPO Overview 3.0, adopted since initial publication of this article, adopts essentially the same restricted perspective on the protection of personal names incorporated in domain names. Largely echoing the language in WIPO Overview 2.0, Section 1.5.2 of the new Overview states: "The UDRP does not explicitly provide standing for personal names which are not registered or otherwise protected as trademarks. In situations however where a personal name is being used as a trademark-like identifier in trade or commerce, the complainant may be able to establish unregistered or common law rights in that name for purposes of standing to file a UDRP case where the name in question is used in commerce as a distinctive identifier of the complainant's goods or services. Merely having a famous name (such as a businessperson or cultural leader who has not demonstrated use of their personal name in a trademark/source-identifying sense), or making broad unsupported assertions regarding the use of such name in trade or commerce, would not likely demonstrate unregistered or common law rights for purposes of standing to file a UDRP complaint."
- 6 Where professional athletes have not fared so well, their cases have, in the authors' view, presented exceptional circumstances. See, e.g., *Adrian Lewis Peterson v. AdrianPeterson.com*, NAF Claim No. FA1208001456431 (Aug. 30, 2012) (despite football star's "celebrity status", he presented scant evidence that he made commercial use of his name, submitting only a screenshot of his National Football League profile page, held insufficient to establish his rights in "adrianpeterson.com" to warrant transfer of that name to him). In *Brayden T. Quinn a/k/a Brady Quinn v. Randy Darr*, NAF Claim No. FA0906001267051 (July 20, 2009), the panelist held that the complainant quarterback's "sportive accomplishments" were insufficient to establish rights in his personal name where "Brady Quinn" was not sufficiently well-known before respondent registered domain names incorporating his name.