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Taking the Sting Out of Domain Name Disputes.

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- [Gordon Sumner p/k/a Sting v Michael Urvan \(Case No D2000-0596\)](#)
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Ever since the world wide web exploded into a highly competitive commercial market-place, players have been vying for their share of the big pie. Internet domain name disputes first arose when squatters sat on the well-known names and trade marks of corporations. In recent years, the squatting has spread to the names of famous persons. Celebrities are increasingly finding their names appear on domain names that they do not own. But whether or not they have the right to kick the domain name holders out of ownership remains a hotly debated issue. This paper will discuss three recent decisions of the World Intellectual Property Organization Arbitration and Mediation Centre involving celebrities. It will be argued that the decisions involving Bruce Springsteen and Sting are to be applauded whilst the decision involving Madonna should not be followed. All the decisions were decided in accordance with the ICANN Uniform Domain Names Dispute Resolution Policy.

Much of the arguments surrounding internet domain names centre on the use of trade marks or trade names in the domain name themselves. When these appear in the top level domains such as .com and .net the owners of the trade marks are particularly anxious. This paper will focus on the use of celebrities' names in domain names.

Madonna Ciccone v Dan Parisi (Case No D2000-0846)

In the Madonna case, the facts were these. The complainant was the well-known entertainer Madonna who owns the mark MADONNA for entertainment services and related goods in the United States. And she has been using the mark since 1979. She has been a singer, an actress and she has also caused a fair amount of controversy with her involvement in sexually explicit materials. She has appeared nude in Penthouse magazine and she has also published a book entitled "Sex" featuring sexually explicit photographs and text.

The respondent was a website developer and he acquired the disputed domain name Madonna.com for \$20,000 in 1998. He also registered MADONNA as a trademark in Tunisia. The Respondent then began operating an "adult entertainment portal web site" featuring sexually explicit photographs and text. The respondent placed a disclaimer on the website stating that "Madonna.com is not affiliated or endorsed by the Catholic Church, Madonna College, Madonna Hospital or Madonna the singer." By the end of May 1999, the site was shut down by the respondent as he purportedly engaged in negotiations to donate his registration of the site to Madonna Rehabilitation Hospital.

Madonna's argument was that the respondent had used her trade mark to attract Internet users to a pornographic web site for commercial gain based on confusion with her name and mark. She also argued that the respondent had no legitimate interest or rights in the domain name.

Under Paragraph 4(a) of the ICANN Policy, the complainant must prove each of the following:

- (i) that the domain name registered by the respondent is identical or confusingly similar to a trademark or service mark in which the complainant has rights; and,
- (ii) that the respondent has no legitimate interests in respect of the domain name; and,
- (iii) that the domain name has been registered and used in bad faith.

As for the first requirement, the Respondent did not dispute that its domain name was identical or confusingly similar to a trademark in which the Complainant had rights. As for the second requirement, the WIPO Panel decided against the respondent. It said that although the respondent had used the domain name for an adult entertainment web site and this could be regarded as a prior use of the domain name in connection with a bona fide offering of goods or services, the respondent had failed to provide a reasonable explanation for the selection of Madonna as a domain name. It went on to say that the word "Madonna" has an ordinary dictionary meaning not associated with the complainant and no evidence was produced to support a conclusion that the respondent adopted and used the term "Madonna" in good faith based on its ordinary dictionary meaning. There is something seriously wrong with this chain of thinking. The word "Madonna" has the current dictionary definition of the Virgin Mary or an artistic depiction of the Virgin Mary. The Virgin Mary is the holiest of holiest women in the Bible; sexually pure and untainted. Madonna the singer on the other hand (who by the way, was born a Catholic), has throughout her career, deliberately involved herself in sexually explicit materials in order to rebel against the Catholic Church. The use of her stage name of "Madonna" completes the mockery of the Church. If Madonna the singer can engage in this sort of mockery, a similar argument can be made for the respondent in this case of using Madonna.com to host a pornographic site and hence, surely a legitimate interest can be found.

Turning to the last requirement of bad faith, the Panel also decided against the respondent. Paragraph 4(b)(iv) of the Policy states that evidence of bad faith registration and use of a domain name includes the following circumstances:

- (iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your web site or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of your web site or location or of a product or service on your web site or location.

The operative words here are "by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship....". The respondent displayed a crystal clear disclaimer on his website disassociating his website with all the named "Madonna's". The panel decided that the disclaimer "may be ignored or misunderstood by Internet users". If users chose to ignore disclaimers, that has nothing to do with the respondent and the respondent has not aided confusion. The Panel does not explain how one can possibly misunderstand the disclaimer, the disclaimer seems crystal clear. The Panel also said the disclaimer does nothing to dispel initial interest confusion that is inevitable from the website name. But again, this does not seem a sound argument as the same could be said of someone typing in Madonna.com thinking it had something to do with the Virgin Mary.

In all, none of the reasons given by the Panel was convincing. The next case I would like to discuss is the Sting case.

Gordon Sumner p/k/a Sting v Michael Urvan (Case No D2000-0596)

This case involved another famous pop singer, Sting. Sting however did not own a registered trade mark in "Sting" like Madonna had in the mark "Madonna". There was no doubt that the domain sting.com was identical or confusingly similar to the singer's stage name of "Sting". However, the Panel had to determine whether being known under a particular name is the same as having rights in that name as a "trademark or service mark". After considering the *Report of the WIPO Internet Domain Name Process* of April 30, 1999, on which ICANN based the Uniform Policy, it concluded that personality rights were not intended to be made subject to the proposed dispute resolution procedure. In adopting the procedure proposed in the WIPO Report, ICANN did not vary this limitation on its application. The panel accepted that the Complainant was world famous under the name STING, but it did not follow that he had rights in STING as a trademark or service mark. The Panel also went on to explain that unlike the personal names in issue in the cases such as *Julia Fiona Roberts v Russell Boyd*, *Jeannette Winterson v Mark Hogarth*, and *Steven Rattner v BuyThisDomainName (John Pepin)*, the personal name in this case was also a common word in the English language, with a number of different dictionary meanings.

In determining whether the respondent had rights or legitimate interests in the domain name, the Panel took a rather high standard. Although the Respondent provided ample evidence that he had used the name "Sting" as a "username" or nickname or screen name for various services, this was according to the Panel not a sufficiently substantive use of the word "Sting". Further, it said gaming services did not fall into the category of being in connection with a bona fide offering of goods or services. The decision seems quite unclear as to what might constitute a sufficient legitimate interest in the domain name. Does one need to be rich and famous through use of a word to be able to own the domain name? Or perhaps five years is not a sufficiently long period of use?

On the issue of whether the respondent registered the domain name in bad faith, the Panel decided that the complainant did not satisfy the burden of proof required and did not prove any conduct pointing to bad faith. After the complainant lodged the dispute, the respondent had used the website in various capacities, including providing a link to a third-party operated unauthorised web site relating to the complainant.

This decision is clearly a much more satisfactory decision. Perhaps the lack of owning a mark worked to the disadvantage of the complainant and having a stage name that is a common dictionary word also did not help the complainant's cause. It is interesting to note that this Panel decided that there was no bad faith in the using the domain name to link to an unauthorised website related to the complainant. When compared with the Madonna decision, the Madonna decision seems evidently incorrect in holding bad faith when a clear disclaimer appeared on the website.

The final decision I want to discuss is the Bruce Springsteen Case.

Bruce Springsteen v Jeff Burgar (Case No D2000-1532)

This decision is by far the most correct one to date regarding personality rights. Not surprisingly, there was a dissenting member on the panel but the majority produced a terrific decision. Bruce Springsteen is yet another well known singer but who does have an official site at bruce.springsteen.net. The respondent is the registered owner of bruce.springsteen.com along with around 1,500 other domain names. Many of these domain names take the user to the respondent's website "celebrity1000.com". The respondent relied heavily on the analogy of a magazine, stating that the mere use of the name of a celebrity on the front page of a magazine does not mean the magazine is claiming any kind of specific rights in relation to the name, but rather, that it contains an article about the celebrity.

With respect to the first issue under Paragraph 4 of the UDRP, the complainant did not hold any registered trade mark in his own name. However, the Panel did not decide on whether the UDRP was intended to protect proper names but proceeded on the assumption that it did.

The Panel's discussion of the second requirement of rights or legitimate interests was very thorough. For our purposes, I will concentrate on the issue of whether the respondent was "making a legitimate non-commercial or fair use of the domain name, without intent for commercial gain to misleadingly divert customers or to tarnish the trade mark or service mark at issue". Dealing with the concept of "misleading", the Panel gave the example of a user who types in "Bruce Springsteen" as a search term. This search literally gives thousands of hits and the Panel reasoned that the average user would realise that not all of these are official or authorised sites. Furthermore, if the user chose the respondent's site, the user would be taken to celebrity1000.com and it would be apparent to the user that they would not be on the right track to finding instructed material on Bruce Springsteen himself. Hence, the user could go back to the original search list and try another site. The Panel concluded that the use of the domain name brucespringsteen.com by the respondent could not be said to be misleading. On the issue of tarnishing Bruce Springsteen's reputation, the Panel could not find any evidence of this either. None of the links contained pornographic or other regrettable material. In short, the Panel did regard the respondent's use as fair use and possibly followed the magazine analogy raised by the defendant.

On the third issue of bad faith, the Panel relied heavily on the fact that the respondent only registered the brucespringsteen.com domain and none of the other top level domains available at the time, namely brucespringsteen.net and brucespringsteen.org. The complainant was subsequently thus able to register brucespringsteen.net to host his official site. Through this, the Panel concluded that the respondent did not prevent the complainant from owning a domain name with his own name in it.

This decision is to be highly commended. For the first time, the Panel looked closely at the practices of internet users and the context in which users use domain names. The previous Panels have too easily and too quickly jumped to protecting trade and service marks as well as personality rights. This leads me to the point about the inherent unsuitability of using trade marks law in the arena of internet domain names. Trade marks law have traditionally relied on national boundaries as well as product or service categories. The top level internet domain names have neither national boundaries nor product or service categories. Traditional trade mark law simply would not work without these two compartmentalisations. These compartmentalisations seem to have been ignored by many who assert their trade marks rights. In terms of personality rights, the lack of compartmentalisation is further compounded by the fact that many people share the same name. How uncommon a name is Julia Roberts? If another Julia Roberts, say a young and talented gymnast who happen to be an Australian filed a complaint, how would the WIPO Panel decide? On what basis would they make their decision? I take heart in finally seeing the Panel in the Bruce Springsteen decision having the courage to protect the rights of the average net citizen. Intellectual property rights such as trade marks law have as their original rationale, the protection of consumers. If we are to stretch intellectual property laws to the internet, this rationale must not be lost through the bullying by celebrities and trade mark owners, as then, the fine balance struck by the law will also be lost.