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The Game of the Name - Personal Name Domain Names and Applicable Law.

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"Sancho Panza by name, is my own self, if I was not changed in my cradle."

Cervantes, *Don Quixote*.

My parents assure me I wasn't switched at birth and my name is Nandan Kamath. Does this "fact" "entitle" me to the use of the domain name www.nandankamath.com?^[1] Can I justifiably demand and get this domain names transferred to me if someone else has already registered it? Do I have a better chance if I am a celebrity or public figure? Does it matter what use the prior registrant is making of the domain name? What if the prior registrant's name is also Nandan Kamath? What about variants of the domain name such as www.nandan-kamath.com, www.nkamath.com, or even www.nandankamath.org? What would be the legal and policy grounds for reaching conclusions on any of these issues? These are some of questions this paper addresses.

It is difficult for us to imagine a modern world without names. The human mind likes to have memorable and convenient identifiers and this is no different in our virtual world - the Internet.

During the Internet's infancy, networked computer systems identified each other with a complex string of IP^[2] numbers. So long as it was merely computers "talking to" each other, this was fine. Once more of a human element was involved in the use of the Internet, the development of a human-friendly mechanism such as the Domain Name System (DNS)^[3] was inevitable.

Names and Domain Names

"A good name is better than riches"

Cervantes, *Don Quixote*

The aim of introducing alphanumeric domain names was to make things simple by enabling

registrants to establish meaningful and memorable identifiers so that their Internet resources could be easily found. Today, they have become the standard that people and organisations use to identify each other and to construct their own online identities around. However, this success has, unwittingly, given rise to a new set of tensions.

"Good" domain names are valuable assets - they are those that carry an additional significance or "associative value" connected to an already existing name, mark or product.[4] These pre-existing identifiers (Real World Identifiers), like trademarks and personal names, were already with their own complicated rights-paradigms. The fact that a uniquely functioning DNS was picked up and put in the middle of this has not made things any easier. A basic incompatibility between the origins and approaches of our Real World and Virtual World Identifiers is quite evident.[5]

The three factors that exacerbate this conflict are:

* Registration of domain names is done for only a nominal fee on a first-come-first served basis, without regard to the "entitlement" of the registrant to the particular name.

* Domain names are only one of a kind[6] and the fact that the resulting scarcity of domain names with sufficient associative value means that those with significant connotations are of great commercial value.[7]

* People have exploited the systemic incompatibilities for commercial gain.[8]

Partially amending what Cervantes writes, "a good name is the road to riches"...not least on the Internet.

From Trademarks to Personal Names

For some time now, the interplay between Domain Names and Trademark rights has been the subject of significant academic debate and hundreds of judicial and administrative panel decisions. Considering the commercial significance of trademarks, the priority given to these concerns in the context of the Internet is hardly surprising. But, this does not mean that the DNS does not conflict with other identification systems and rights.

The WIPO, considering the state of the law in its *Final Report on the Internet Domain Name Process*, candidly stated:

"the notion of an abusive domain name registration is defined solely by reference to violations of trademark rights and not by reference to violations of other intellectual property rights, such as personality rights".[9]

It was not long before the WIPO concluded that this was not a wholly satisfactory state of affairs. As part of its Second Domain Name Process, in its Request For Comments (RFC2), it has taken up the protection of personal names, *inter alia*, [10] as an issue for serious debate and consideration. It is this initiative that has motivated this paper.

We will proceed with the presumption that Personal Names are Real World identifiers of personalities and Domain Names are general Virtual identifiers. What would justify protection of rights in personal names and especially their corresponding domain names?[11] These personal names are already the subject of laws in different countries and it is a matter of concern that different countries protect rights in names and persona differently.[12] Can we harmonise these to tackle what is, quite obviously, a global issue - personal name domain names? If so, what standards will we use? This will be the subject of the rest of this paper.

Justifying Protection

For this, we can rely on debates over the issue of publicity rights in the US in particular as also other more general arguments. When these are transposed to the context of one-of-a-kind domain names there is a significant case that is made out for protection. For this analysis people's names are to be understood as part of a larger concept of their `persona' or `identity'.

Moral arguments are often used as a starting point to justify protection of the persona. McCarthy [16] argues that "commonsense" demands the protection of people's personas (of which names form a significant part) and so do grounds of fairness. A name often has an associative value and ought to be protected from "poachers," "pirates," or "free riders." This protection ought to be advanced to avoid misappropriation of value created by others. The issue is not really whether the person "deserves" the right to his or her persona, the real question being why a stranger to the process should have the benefits of its use.

Madow [17] dismisses such arguments, believing our conception of "commonsense" to be no more than the expressions of the interests of powerful social groups, grounded in unexamined beliefs. Furthermore, more objections come from the free-speech angle. It is not easy to decide between conflicting liberties and to find any shared notions of "justice" and any line drawn will be seen as unfair by some - moreover, the moral notions of powerful social actors will probably have an over-riding effect.

Nonetheless, supporters of protection maintain that society has a strong and independent moral interest in preventing people from free riding. Complete strangers to the process will be free to get something for nothing - and this should not be encouraged in a meritocracy.

These unjust enrichment and the "free rider" principles have been the very foundation of all attempts to curb those indulging in "cybersquatting" on the **domain names** corresponding to various trademarks. Legislators and courts have been ready to make this moral judgment and characterise this practice as unjustifiable and there seems no valid reason why remedies should not be extended to rights in persona. Both trademarks and personality rights equally rely upon social inputs that add to personal efforts.

Desert-based theories are popular among proponents of rights in persona (especially publicity rights). Locke's [18] labour theory of property was that an individual has a property right in his/her own person and thus also in the labor of his/her body. Nimmer extended this logic, arguing that since a person nurtures a public persona, he/she should be entitled to preserve, for his/her own use, the financial gains accruing from publicity. [19]

There are strong objections to this from critics who state that one's persona (especially so in case of celebrities) is not all a result of the person's own labour. Much of the value-addition occurs in social context and draws upon other resources, institutions, and technologies. [20]

However, as counterpoint, it might be said that this objection would hold good in the context of other intellectual property creations as well, e.g., the "distinctiveness" of a trademark is often the result of public reactions and activity. Why only attack rights in persona?

Looking from the point of view of this desert-based justification, a **domain name** is an essential requirement for anyone to add an online presence to his/her "Real World" one. Every person, regardless of stature, has spent significant time and effort trying to create a secondary/associative meaning to his/her name and by virtue of this ought to be entitled to carry the fruits of this identity-creating labour online. The domain name corresponding to the person's name is the best possible identification mark that the person can have to express himself/herself. Therefore, in order to enjoy

the right to commercial exploitation of one's persona in the online context, the need for a domain name corresponding to the name the person has nurtured is obvious. When we consider that domain names are one-of-a-kind it is quite simple conclude that no one 'deserves' the domain name any more than the person to whose name it corresponds. Standard objections to desert-based justifications are cannot be as strong.

Economic incentive is one of the most oft-cited arguments in favour of protection. This believes that protecting a person's economic interest in his/her identity fosters creativity. The law will protect the value created by people's efforts such that they are encouraged to indulge in socially useful tasks.

Madow[21] dismisses the economic incentive justification for creativity as unsupported by any evidence. Furthermore, he believes it is wrong to use copyright-like economic justifications in this situation. He sees the value of the persona as being largely innate, the associative value coming from activities in which the person would probably have indulged regardless of legal protection.

When we consider the economic incentive justification from the angle of **domain names**, it is particularly strong. Today, good domain names are very valuable. A person in possession of such a domain name has much greater incentive to invest time and money in his/her website (and online personality) than someone in possession of an obscure domain name without associative value. By making people "entitled" to domain names corresponding to their names what the law does is gives the person most opportunity to be "found" on the Internet by people they are keen to get the "eyeballs" of. Not only will people using search engines and directory services find the websites but also those who type that domain name into the "Address" bar of their browsers, expecting to find the website of the person whose name corresponds to it. It will also ensure repeat visitors who find the domain name easy to remember because of its associative value.

It is also felt that **consumer protection** and **prevention of deception in advertising** are important, albeit less quantifiable, advantages of protecting rights in persona. Endorsement of products and services by persons has significant effect of consumer behaviour and it is felt that the endorser should be the only one controlling his/her personas this will be the only way the integrity of the market system can be maintained. Unfair competition is avoided and the presence of these rights "promote the flow of useful information about commercial goods and services to the public by ensuring that the public is not confused by a false implication that a particular celebrity has endorsed a particular good." [22]

Critics argue that while this maybe true, it is quite simply prevented, even in cases where they use personalities' names, through the use of disclaimers stating absence of endorsement of any kind.

More seriously, rights in persona enable persons to prevent commercial uses that are not in any way misleading or fraudulent, where there is no danger of consumer confusion. Finally, it is argued that such a justification underestimates consumer awareness - there is no empirical evidence that today's average consumer assumes or infers any authorisation by the person for use of his/her name in every case. Therefore, this is seen as an argument where the tail is wagging the dog.

The efficient management of the DNS and its correspondence to real world legal structures has a large role to play in consumer protection and avoidance of deception. The trademark function of **domain names** is now a matter of accepted law. This need only be extended to rights in persona. The objection that disclaimers can overcome this problem does not hold water. Courts have acknowledged "initial interest confusion" as being sufficient for trademark infringement on the Internet, [23] i.e., it is sufficient if the "consumer confusion" happens when the user types the domain name into the "Address" field of the browser, which means that disclaimers on the site do not even come into play. It is obvious that the correspondence of real world names and domain names will be of great assistance to consumers and will make the online world an easier place to navigate.

Finally, we come to the justification based on **allocative efficiency**. This is based on the "tragedy of the commons" argument that states that freedom in a commons results in over-use of resources, which in turn brings ruin to all. Private and exclusive property rights are seen as solutions that ensure optimal utilisation of scarce resources.

Madow[24] refuses to accept that anything close to the "tragedy of the commons" would result is we were to fail to protect rights in persona, which can hardly be characterised as a "nonrenewable natural resource."

Others argue, with less merit one might add, that there is no reason why the person whose identity is used should be the owner. They argue that there could easily be someone else who could make better use of the resource and facilitate allocative efficiency.

However, the strongest objections are culturally based.[25] It is argued that the law, which ought to promote openness and social dialogue, instead limits opportunities for public discussion and comment when it privatises personality rights. The person ends up controlling what he/she means, preventing any interpretations they do not approve of.[26] Excessive rights in persona are seen as a big threat to the production of cultural meanings, especially in cases of celebrity publicity rights, where wealth is redistributed upwards and private censorship of popular culture results. As Madow concludes, publicity rights are not just about ownership, they are also about meaning.[27]

The allocative efficiency justification seems clearly applicable to **domain names**. Domain names are not part of a common. Domain names do not exist until they are registered and once they are registered they are private property. Once this is accepted, the person whose name corresponds to the domain name is in the best position to make use of it for commercial or other purposes that would be expected of that particular unique domain name. The fact that this person will construct his/her online identity around the domain name will in no way diminish the possibility of social comment or a differing interpretation of popular culture. This maybe a reasonable objection in the context of the larger issue of the general bundle of personality rights, but when we look at it from the domain name context there is little room to object. People are entitled to register as many domain names as they wish and can use them to run sites for social comment, which can be found by anyone using a search engine. There is no reason for them to use the domain name corresponding to the name of the person they are commenting on. Moreover, the Internet is really a wide wild world and one cannot really hope to control the way others conceive of you in popular culture merely by running a website that is identified by a domain name corresponding to your name.

From this analysis, we must conclude that when the justifications for protection of rights in persona are transposed to the domain name context they only look stronger and the objections look more unconvincing. The protection of personal name domain names certainly does not seem to stand on shaky ground. It certainly has stronger foundations than do general personality rights.

Applying existing law

Next, we examine existing laws that may be used to assert rights in personal name domain names. These vary widely depending on the jurisdiction. The following is a strictly principle-based analysis of the relevant laws of two of these jurisdictions - the US and the UK.

In the **United States**, there are a variety of **general laws** that could be used to protect personal names. It would be appropriate to begin with the rights of privacy and publicity.

The **common law right to privacy** has its origin in the famous 1890 article by Warren and Brandeis. [28] This was the foundation for numerous cases dealing with use of a person's name in the press or in advertising without the person's permission. This was often used in conjunction with the tort of

personal injury to dignity and integrity of self in cases of impermissible commercial use of a person's identity.[29]

This privacy-based remedy has come under fire because it tends to lock the non-celebrity plaintiff into the "mental distress" mold - the case will have to be limited to proof of hurt feelings and mental distress, buttressed by stories of sleepless nights and psychiatric care, a far cry from a remedy for a fair market value of one's identity.[30] This would not really provide strong legal backing if one is seeking to claim a personal name domain name from a prior registrant. It is just too cumbersome.

Prosser[31] enlarged this "liberty" based[32] bundle of rights to include rights against:

1. Intrusion upon the plaintiff's seclusion or solitude, or into his private affairs.
2. Public disclosure of embarrassing private facts about the plaintiff.
3. Publicity which places the plaintiff in a false light in the public eye.
4. Appropriation, for the defendant's advantage, of the plaintiff's name or likeness.

For our purposes, the last mentioned of these is crucial. It is the foundation of the tort of appropriation of identity and is available to any person irrespective of fame. Some authors still believe this tort could be the foundation for protection of the persona.[33] Prosser had effectively built the bridge for us to move from privacy rights to publicity rights.

Publicity rights are seen as an innovation arising from privacy law.[34] They are defined by McCarthy, very simply, as the rights of "every person to control the commercial use of his or her identity" and he asserts that the difference between privacy and publicity rights turns not upon the type of activity which constitutes the legal wrong, but upon the nature of the person's right and the kind of injury to that right.[35] Publicity abandons the "mental distress requirement and looks to the commercial damage to the business value of human identity. While privacy remedies are "liberty" based, publicity rights are seen as "property" rights, where the person owns his/her commercial image and has a right to control it.

Publicity rights are statutorily protected in many states in the US and are brought in through the common law in others. But there is some controversy as to their applicability - does one need to be a celebrity to enjoy the right? The foundation of contemporary thinking is that publicity rights are what a celebrity gets in exchange for abandoning his/her right to privacy as a result of entering public life. As a result, only non-celebrities can enjoy the right of privacy and only celebrities can enjoy the publicity rights. However, McCarthy wages a lone, but worthy, battle against this line of thinking. He believes that it is impractical to attempt to draw a line as to who has achieved celebrity status and who has not. McCarthy would rather have all people enjoying right of publicity, though he does acknowledge that the damages a person may claim for infringement of the right will likely turn upon the value of the publicity appropriated, which in turn will largely depend on the degree of fame of the plaintiff.[36] Under this construction, the right may not be of great monetary value in all cases. But McCarthy's formulation is crucial in our context, where the remedy sought is the transfer of a domain name rather than monetary damages - in such cases is there reason to distinguish between celebrities and non-celebrities?

Under a publicity rights regime, a domain name would fit right into the picture. The right to commercial exploitation would include online commercial ventures and the personal name domain name is a quite obvious component of an online presence. If a person has a right to control the use of his/her name in the real world, why shouldn't they enjoy it online, too?

At this stage, it is also vital to take note of McCarthy's point that the test of infringement of publicity

rights is "identifiability" and not "confusion" - it is whether "unaided identification" results in the minds of more than a *de minimis* number of ordinary viewers, not whether there is deception or false endorsement.[37] This means that from the personal name domain names angle we don't need to go into the issue of whether and at what stage the web-surfer is "confused", the issue only is whether there are enough people who appreciate the associative value of the name.

Unfair competition and false endorsement law is our next stop. These laws prevent entities, in trade or commerce, from engaging in misleading or deceptive conduct. They enjoin the representation that goods or services have sponsorship, approval, affiliation, performance characteristics, accessories, uses or benefits that the enterprise does not have. §43(a) of the Lanham Act is the federal law regulating this in the US. It gives room for a private claim against impermissible use of a name.

What distinguishes this from infringement of the right of publicity is that the representation or endorsement must be false, whereas falsity is not a necessary element of infringement of the right of publicity. The impermissible use of a person's identity merely to draw attention to a product or advertisement infringes the right of publicity. There need be no false inference that plaintiff endorses or approves the product. [38]

With the existence of the wider and more established publicity rights, use of unfair competition laws for our purpose does not seem practicable. These laws have much more stringent requirements such as "use in trade or commerce" and "likelihood of confusion", both controversial areas in the developing domain name jurisprudence.[39] Although courts have been brave enough to answer these issues, one can hardly say there is "established" law on the point. When there is this degree of uncertainty, a remedy that relies almost entirely on the interpretation of these two terms is not one we can concretely rely on.

The role of **dilution principles** in tackling our unique issue is quite interesting. Under the US Federal Trademark Dilution Act, "dilution" is the lessening of capacity of a famous mark to identify and distinguish goods and services. This principle applies even in the absence of "competing use" or "likelihood of confusion" and can take the form of dilution by tarnishment, dilution by blurring, etc. However, the most interesting concept to have emerged from the Courts[40] is the extension of the principle to cybersquatting through creation of the principle of "dilution by elimination," i.e., a famous mark is diluted when someone else squats on the domain name and eliminates its use by its owner to identify goods or services on the Internet. This is extremely useful for our analysis - it assumes an "entitlement" to the corresponding domain name for a famous mark. But the fact that it is limited to famous marks severely restricts its applicability - the test for determining "fame" of a mark is also multi-pronged and complex. This problem is magnified in the context of the Generic TLDs where we could expect the "fame" to have a "worldwide fame" standard. These laws are much simpler to implement in the real world of territorial laws.

Recognising the quirks in attempting to analogise these real world laws to the online context, the US Congress included specific provisions for personal names and domain names in its **Anti-cybersquatting Consumer Protection Act (ACPA)**. The ACPA protects personal name marks as domain names and also individuals who use their personal names as domain names and is the most comprehensive law that exists for the protection of personal name domain names.

First, it provides for a civil action[41] for holders of personal names that are protected as marks in case of an attempt *in bad faith* by another person to register, traffic in or use a domain name that is "identical" or "confusingly similar" to that distinctive mark or is dilutive (if the mark is famous). It specifies nine nonexclusive factors intended to guide courts in their determinations of the "bad faith intent." [42]

This effectively lowers the threshold requirement and personal names do not already have to be

registered "famous" marks to get protection. It is sufficient if they are distinctive. This fits in with the "identifiability" requirement of publicity rights law.

Furthermore, when individuals with personal names without trademark rights use their names as domain names, protection against cybersquatting is still provided. The relevant provision states: "Any person who 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 the specific intent to profit from such name by selling [it] for financial gain to that person or any third party...shall be liable..." Here, the substantive standard for determining when a name of a person is being misappropriated by a cybersquatter, the "*intent to profit*" from the name, and is significantly different from the *bad faith* requirement in the provision for distinctive or famous marks.

Of immense interest, is the exception to this *intent to profit* principle, which provides that a person who, in good faith, registers a domain name consisting of the name of another living person, or a name substantially and confusingly similar thereto, will be excepted from civil liability if such name is used in, affiliated with, or related to a protected work of authorship, including a work made for hire, and if the person registering the domain name is the copyright owner or licensee of the work, the person intends to sell the domain name in conjunction with the lawful exploitation of the work, and such registration is not prohibited by a contract between the registrant and the named person. This entire exception was brought in for a specific purpose,^[43] but its application could be controversial because, as we know, the threshold for copyright protection is very low - originality is sufficient. The prospects for misuse are bright.

In addition to this specific exception the ACPA also contains a savings clause^[44].

One may ask: what types of personal names are protected under the ACPA? The US Senate explanation of the bill states that it covers full names (e.g., johndoe.com), surnames (e.g., doe.com) and variations such as john-doe.com or jondoe.com.^[45] Congress did not state whether it intended "name" to include pen names, stage names or widely recognised nicknames, but in McCarthy's opinion, the term "name" is broad enough to include those types of names if they are widely used and understood as the identifier of a specific person.^[46]

With the passage of the ACPA, the holders of personal names need no longer rely on remedies under the law of **registered trademarks** (under which the personal names that have achieved distinctiveness and were registered as trademarks could be protected), or the laws of **common law trademarks** and **passing-off**, all of which we will soon examine in the context of the UK (to which the ACPA, a domestic US law, does not apply) and the ICANN Uniform Dispute Resolution Policy (UDRP).

The **United Kingdom** approaches protection of the persona and identity rights very differently from the US...it does not protect them explicitly at all. Even through application of intellectual property and other laws, it is not at all easy to protect a personal name from impermissible use.

In 1969, albeit in a **copyright** case (and in slightly different circumstances),^[47] the Privy Council stated, "we do not recognise the absolute right of a person to a particular name...whatever cause of annoyance it may be..." More recently, in *Re: Elvis Presley Trademarks, Inc.*,^[48] the application for trademark registration of the name "Elvis Presley" and variations thereon to be used on toiletry products was rejected. The Court noted, "There is nothing akin to copyright in a name...Even if Elvis Presley was still alive, he would not be entitled to stop a fan from naming his son, dog or goldfish. His car or his house "Elvis" or "Elvis Presley" simply by reason of the fact that it was given to him at birth by his parents.^[49] The application was rejected on the ground of "lack of distinctiveness" of the name.

What both these statements do recognise is that grant of the rights of the nature of publicity rights

amounts to granting a person a copyright over the name, and the derivative rights to control its use. Clearly, the person has had little or no role in determining his/her name and "originality" of "expression" is certainly lacking. This makes grant of copyright-like rights questionable.

However, it must be mentioned that these two judicial comments noted above dealt with the use by another person of the name purely as a name and do not deal with attempts to commercially exploit another's name.

Nonetheless, this reluctance does not stop at copyright law. Before the rejection of the application for **trademark** in the *Elvis case* on the grounds of lack of distinctiveness, the Court of Appeal had rejected a trademark on the name "Tarzan"[50] on the ground that it had passed into common language.[51] This is completely different from the manner in which a US court would have approached the matter. In the US, the more famous the name the more likely that it will be seen as "distinctive" and the better chance that it will have to pass muster at the trademark office. From *Tarzan*, it appears that the more famous the person, the more chance that his/her name will pass into common usage and the lower the chance that he/she will be able to get a trademark on the name.

The *Elvis case* did not fail to consider the issue of commercial appropriation of identity. One of the judges even stated his belief that the general public really does not care who has sold or licensed merchandise using the person's character. This approach is understandable, considering that trademark law is considered more as a protection of customers rather than as a right of the holder. But this is definitely far removed from the publicity rights principles of US law, in which are embedded the rights of the person to exploit the rights in persona - it has more than just the consumer protection angle.

One possibility of remedy seems to be under the tort law principle of **passing off**. The plaintiff is required to prove a "misrepresentation" that is made by the defendant in the "course of trade" which results in the "likelihood of confusion" to consumers and results in a loss of income to the plaintiff. But for this the plaintiff must first establish goodwill or reputation in the name.[52] One commentator is of the belief that although U.K. courts have applied passing off as a means of protection in the field of character merchandising, it is unlikely that the courts will apply these principles to a real person where there is no underlying copyright.[53] In the context of personal name domain names the application of passing off law is not all that straightforward. Does the registration of a domain name amount to a representation (in order to be classified as misrepresentation)? Is registration of a domain name sufficient to make a finding of use in the "course of trade"? Will we need to examine the contents of the site associated with the domain name or is this not required in order to make a finding of "likelihood of confusion" (i.e., is the likelihood of confusion requirement satisfied when the websurfer types the web address into the browser expecting to find the site of the person whose name corresponds to the domain name? These are all questions that have not been examined in the UK courts in the same depth as they have in the US. [54] It would be fair to say that we might find it difficult to rely solely on passing off law to support a claim based on a personal name domain name in the UK.

As a result of the state of the law, Courts in the UK have only two options: either to not protect publicity rights at all or to use convoluted logic[55] to adapt existing legal principles to the rights in persona.

However, with the Human Rights Act now in force in the UK, there will be the possibility of litigating on the "right to respect for private and family life" in domestic British courts. But this is hardly sufficient to deal with issue of commercial exploitation of persona and names, especially in the online context.

In short, the laws in the UK and the US couldn't be more different in this area of law.

International Regulation

One of the most significant developments of recent times on the Internet is the establishment of the Internet Corporation for Assigned Names and Numbers (ICANN), which has overall supervision of the .com, .net and .org TLDs. Among its important functions, it brought into effect the Uniform Domain-Name Dispute Resolution Policy (UDRP) and drafted Rules for its implementation. These are applicable to disputes in the three TLDs that ICANN manages.[\[56\]](#)

The UDRP is a unique procedure with mandatory administrative proceedings in case of dispute (this does not rule out the parties proceeding in a court of competent jurisdiction or even later challenging the award in the domestic court). It is an expeditious option for disputants and does not involve as much time or money as going to a court of law and can be looked at as a sort of supra-national dispute resolution process.

The dispute resolution process applies when a complainant complains that

- (i) A registered domain name is identical or confusingly similar to a *trademark or service mark* in which he/she/it has rights; and
- (ii) The person who has registered the domain name has no rights or legitimate interests in respect of that domain name; and
- (iii) That the domain name has been registered and is being used in bad faith.

To be successful under the UDRP proceedings, the complainant has to prove all 3 of these requirements. The registrant has the opportunity to prove legitimate use on grounds including "fair use".

Circumstances cited in favour of a holding of "bad faith" include:

Registration of the domain name

- * primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor, for valuable consideration in excess of documented out-of-pocket costs directly related to the domain name

- * in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, with proof of a pattern of such conduct

- * primarily for the purpose of disrupting the business of a competitor; or

- * and use to intentionally attempt to attract, for commercial gain, Internet users to the 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 the web site or of a product or service on the web site.

While this provision does talk of false endorsement and misrepresentation of source, what is most cognisable is that these remedies are available only to trademark and service mark holders. So what of holders of personal names? On the face of it, it looks like there is little or no remedy for such persons. But the resolution service providers seem to have been imaginative in deciding cases of this kind. Next, we will examine how the WIPO Panel has handled the recent flurry of cases of personal name domain names that have come before it.

WIPO Administrative Panel Decisions

The WIPO is one of the ICANN recognised dispute resolution providers and personal names have been the subject of quite a few complaints in this forum.

While some domain names have been transferred based on existing trademarks in names,[\[57\]](#) the ones that are of most interest to us are those involving personal names that are not registered as trademarks. Some of the early ones were the *Julia Roberts decision*,[\[58\]](#) the *Jeanette Winterson decision*[\[59\]](#) and the *Steve Rattner decision*.[\[60\]](#)

In these cases the panels had to resort to a finding of common law trademarks rights that Roberts the actress, Winterson the author and Rattner the financial analyst, had earned, in order to transfer the domain names to each of them. The panelists had less trouble, however, in finding facts supporting the "illegitimacy" and "bad faith" of each of the respondents' domain name registrations.

Things, however, came to a pass in the *Sting case*[\[61\]](#) where the complainant, the famous pop star who has come to be better known as "Sting" was unable to secure transfer of [www.sting.com](#) from a prior registrant based on the common law trademark rights that preceding complainants had been successful in asserting. Interestingly, the panel candidly stated that "...the ICANN did not intend the procedure to apply to personality rights."[\[62\]](#) It went on to deny the complaint on findings that "Sting" was a word in common English usage, i.e., the associative value could not be held to be linked only to Gordon Sumner, the singer, and hence he does not hold a trademark or service mark for the purposes of the UDRP. Moreover, the domain name had been registered 5 years previously and there was some evidence to show that the respondent had often used the Screen name "sting" over the years.

Dan Marino, the famous quarterback, was more successful.[\[63\]](#) He was able to receive transfer of the domain name [www.danmarino.com](#) when the panel held he had common law trademark rights in the name, but then his was a more distinctive name. It is interesting to note that the panel did recognise his right in [www.danmarino.com](#) rather than only [www.danielmarino.com](#), a view that supports McCarthy's "identifiability" criterion. This was also the case in the *Sade case*[\[64\]](#) where the respondent pleaded the *Sting* factors but the panel held in favour of transfer on the ground that "Sade" was a "highly distinctive" name and could not be compared to "Sting". A clear case of "illegitimacy" and "bad faith" registration only made this easier.

An interesting development in the *Madonna decision*,[\[65\]](#) was when the respondent, who had run a pornographic site on [www.madonna.com](#) for some time, claimed that Madonna couldn't claim "tarnishment" of her trademark because she had come to be associated with sexually explicit creative work. This innovative argument was not accepted and moreover there were facts to support a holding of "illegitimacy" and "bad faith" registration, notable among them being the respondent's registration of the trademark "Madonna" in Tunisia.[\[66\]](#)

A few more cases went along similar lines, [\[67\]](#) an interesting one being the *Bridget Jones case*[\[68\]](#) where it was held that an author can have common law trademark rights in the name of a fictional character she has spent time developing.

From all these decisions there are some things that are clear:

Panels are finding it difficult to fit in the concept of personality rights in the UDRP process. This is not surprising considering that it was never drafted for cases of this nature. But the panels are being forced to innovate to accommodate what they see as legitimate claims. What really constrains panels is having to go through the three-pronged analysis that was structured to deal with trademarks. They are forced to concentrate on little facts to come up with a holding of "illegitimacy" or "bad faith". The question is whether personality rights deserve entry through the front door instead.

All these concerns are best illustrated by considering one of the most recent cases under WIPO. This is the *Edward Van Halen decision*, [69] wherein transfer of the domain name was denied to the world-famous musician. While acknowledging Van Halen's common law trademark rights, which even the Respondent conceded, the panelist urged his inability to find facts to hold a "bad faith" registration. The Respondent claimed to be a fan setting up an Internet fan club [70] for Van Halen but had not used the domain name at all. The panelist held that lack of use was insufficient to allow for a holding of "bad faith" and it could not find any "illegitimacy" in this. The value of "free expression" was given priority over the rights of the person in his own name. This decision just does not seem right, especially when we consider the sound jurisprudential footing for rights in personal name domain names. If the panelist was right in holding that he UDRP could not come to Van Halen's aid, then this law needs change.

Choice of Law

As if things were not complicated enough, the stark absence of uniformity in the laws relating to names raises significant issues of applicable law when the domain name dispute involves parties domiciled in different jurisdictions. The various principles that can and have been used in such cases are the complainant's place of domicile, the place of forum, the place of greatest infringement, etc. [71] The position is certainly unsettled and only exacerbated by the transnational functions of domain names.

Certainty in the law is a virtue we would all like to enjoy and this is good ground to have some harmony in the manner in which we tackle this issue. Moreover, fairness demands some sense of equality of treatment at a global level.

Newsworthiness, Freedom of Expression, Fair Use & Fair Dealing

Since rights in names fall in that ambiguous space between copyright and trademark, between privacy and publicity and between liberty rights and property rights, anyone of the above defences/exceptions could be asserted to a complaint requesting transfer of a domain name by the holder of the corresponding personal name. Should these be entertained. It is submitted not. These are appropriate where non-exclusive use of the personal name is possible, e.g., in journalism or literary criticism. But this is not so in the case of domain names. Either the person whose name corresponds to the domain name can use it or someone else can. There is good reason to favour the former. Moreover, granting rights in domain names based on the principle of "identifiability" and "associative value" does not deny others the opportunity to register numerous other domain names [72] for criticism, comment or the like, which anyone interested will be able to access. All told, therefore, these exceptions and defences should not apply to cases where the domain name is identical or confusingly similar to one with identifiability and "associative value"

Descendibility

The right of publicity is descendible in some states of the US and this is applicable to personal names as well. Now, should this be extended to domain names? This seems undesirable. Although this would result in distinguishing between the descendants of those who are already dead and those who are living, [73] this distinction is justified on the grounds that "confusion" is unlikely since no one expects the dead person to be running the site on the domain name, descendant's do not have the "moral" or "economic incentive" justifications to back their claim and the dead person is no longer around to make best use of the domain name from the "allocative efficiency" standpoint. The standard should therefore be similar to that adopted in some jurisdictions where the publicity right is descendible/claimable by descendants only if the person in question has actually asserted his/her publicity rights during his/her lifetime. The principle should be extrapolated to personal name domain names, where descendants will have no special rights to a domain name, which their ascendants had not already registered during his/her lifetime. This position has enough justificatory

basis.

Preemptive solutions

An important question we can ask at this stage is - are remedial laws really the solutions to such problems? Is it possible that systemic changes in the way the Internet works be used to find solutions?

Internet Keywords is one of the proposed solutions. This system allows a user to type company names or trademarks, rather than URLs, into the address box on his/her web browser. The system then directs the user to the relevant site. Two different versions of Internet Keywords are available to users and owners of marks and names today. There are two keywords systems that are worth considering. The one that works with Internet Explorer is one that requires subscription (it is run by RealNames.com)[74], while there is a free one (called SmartBrowsing) that Netscape has developed and runs.[75]

The concern with the RealNames.com system is that it requires subscription. Importantly, it also fails to resolve the uniqueness issue since the registered keyword is only one of a kind and can redirect the websurfer to only one site. This means that we could be in for the same landrush mentality that we have with domain names.

On the other hand, no subscription is necessary for Netscape's SmartBrowsing. That Keywords system is based on the Internic domain database, so if any trademarks are registered as domain names they should be included in the system. It is also successful in handling the uniqueness issue, because if there are multiple matches to the search all of them show up in a list with descriptions and the person can choose the site he/she was looking for from among these. However, at the moment, it is unclear how this database works and whether it would include a parody or commentary site that uses a domain name similar to a trademark. This system is seen as allowing Netscape to play "God" on the Internet.[76]

Moreover, in effect, this is nothing more than a directory service, which uses the existing DNS database. Until it gets very wide acceptance it will not have a significant effect on reducing the premium on the unique domain names.

Solutions of this preemptive nature could be especially crucial where there is **more than one person with a legitimate interest** in the particular personal name domain name.

The development of general **directory or listing services**, along the lines of Netscape's SmartBrowser system. These could be very helpful for persons to locate peoples' web addresses and websites and if implemented well will not leave much room for confusion. One would, however, look to non-private organisations (read ICANN or the WIPO) to lead such an initiative, to avoid determination of system design and management by private actors.

Another possible solution is the creation of **gateway or portal pages** associated with particular personal name domain names, redirecting users to sites of various legitimate users of the domain name space using hyperlinks on the gateway site. However, it looks like it will be some time before these gateway or portal pages are imposed on users.[77] Until then, they will be viable, but volitional solutions to the issue of multiple legitimate users. One "solution" that is within the existing DNS structure is the addition of **the .name TLD** for personal use.[78]

Under this, the domain name space service provider controls all Second Level Domains and permits registration of the third level domains on a first-come-first-served basis. Therefore, with a name like Nandan Kamath, I will only be permitted to register nandan.kamath.name or similar variants[79] in the kamath.name domain.

All Registrants are required to "certify" their bona fide interest in registering the domain name for "personal use". There are no pre-screening procedures because these are seen as virtually impossible to implement.^[80] The service provider states that the existence of an existing trademark does not necessarily exclude its availability for personal use, but at the same time proposes to introduce a system by which holders of these marks can be notified of potential infringements.

It is proposed that all disputes in this TLD will be subject to the UDRP.

It is believed that since registrations will only be possible on the third level, the incentive to "squat on" or "warehouse" names is greatly reduced, due to the higher availability of preferred addresses. But this does not in itself solve the issue of conflicting legitimate users, since the domain names will still be only one-of-a-kind. Moreover, this does not solve the conflicts over personal names domain names in the existing TLDs. It merely presents another region in which conflicts can occur. Finally, it is mentioned that the UDRP will be resorted to in case of dispute. Pray what provision of the UDRP at present caters to resolution of personal name domain name disputes?

Nonetheless, this is definitely a step in the right direction - towards seeing domain names as non-scarce commodities.

Future policy

The future policy direction for solving this problem is having many, many TLDs, possibly in the thousands. The result will be no dearth of domain names with associative value, even enough for every type of literary or other criticism possible.

This can be elaborated with an online analogy. I may be disappointed when I am looking for a free email address at www.hotmail.com with the login nandankamath@hotmail.com and realise that it has already been taken. But this is definitely not something I would think about for too long. Why? Because I could just go to another provider of free emails like www.yahoo.com or www.netaddress.com where I could get an email address with my preferred prefix. Plurality of these services ensures that eventually I'll find what I'm looking for...and the registration of nandankamath@hotmail.com by someone else doesn't concern me much. This should become the case with domain names as well. What the flooding of cyberspace with TLDs would mean is that we give up the vanity or convenience value of domain names because there will be so many types and so many in number that surfers will no longer be guessing domains and there will be too many to remember offhand (this is the whole range of websurfers that holders of catchy domain names are keen on catching). People will have to resort to other systems such as advanced search engines or directory services for assistance. It is not normal for an individual to buy a house because of its catchy address. Why? It is because they don't expect their visitors to remember it. They know that anyone interested in visiting them could just look up a directory, find directions to it and turn up. Domain names should become so numerous that the same result is achieved in the online context. The result will only be a minor change in user habits with little, if any, loss in efficiency - a worthwhile tradeoff.

Getting people (especially trademark holders) to accept this is not going to be easy. Those who oppose addition of new TLDs argue that they should not be added until appropriate safeguards are in place. Considering the nature of these proposed "safeguards"^[81] consensus will take time. But this should be the long-term policy goal to be implemented cleverly.

A proposed legal model

Technological innovation or systemic change may soon make this entire discussion obsolete. But in the meanwhile we need to have a predictable and certain framework governing personal name domain names.

The most obvious solution is the addition of provisions to UDRP for the protection of personal names. This seems the right path to follow. But the strongest objection to this is that the UDRP is supposed to *replicate* the legal rights one would have in court, not reduce or enhance them. Personal name protection varies with jurisdiction and any uniform principle will end up reducing or enhancing rights in most jurisdictions.

However, as described earlier, there is enough reason to give heightened protection to personal names reflected in domain names. Nothing prevents the ICANN from enhancing its jurisdiction. After all, domain names are still privately traded goods and need not be subject to national laws in all circumstances. Laws of cyberspace seem to have got caught in the rut of always needing analogies in the real world. It is time we realise that the Internet creates situations that do not always have direct analogies in the real world. New situations demand new legal principles. What might these be in the personal name domain name context?

The following could be the principles on which ICANN dispute resolution may occur:

Names of **all living persons**^[82] should be subject to this procedure, whether the subject of trademark rights or not. This avoids the problem of making a controversial value judgment granting rights based on "fame" or even rejecting them on grounds of "notoriety".

Protection will be given to names on grounds of "**identifiability**". All variants of the name, e.g., surnames, nicknames will be covered so long as they satisfy the criteria listed below.

There will be a two stage process for every personal name holder.

Part 1 of this will be a "Double Identifiability" test. This would require that

* The person in question should be the person/thing that a *de minimis* number of persons identify/associate with the personal name most. This would not give protection to names such as "Sting", which more people would identify as a word in the English language rather than a singer's name.

* This should also be the most common manner in which the person is identified. For example, the name "Pelé" would satisfy this criterion instead of "Edson Arantes do Nascimento".

What results from this is one single name with which the person is most identified. This deserved heightened protection in the domain name context. This can be ensured by providing that if he/she makes a complaint, and is able to satisfy this "double identifiability" test, the onus is now shifted to the respondent to prove a legitimate interest in the domain name based on *both* **identifiability** and proof of **related goodwill**. Among the legitimate defences could be legitimate trademark rights (bogus trademarks will not get protection since they will not satisfy the goodwill), organisations/businesses/persons who can prove goodwill associated with the domain name they have registered as a result of investment of time and effort, and finally, others who have the same name and are identified by it. This procedure cannot be used by those who have already consensually transferred these domain names to get them back forcibly from the transferee. Such safeguards are required to ensure that these principles, introduced into existing situations, do not take from legitimate holders.

Thus, such a person will have rights in domain names in the various TLDs in case of failure of respondent to prove a defence.

Part 2 of the test would be for those personal names satisfying the first prong of the "double identifiability" test but not the other. Regardless of whether the person has been successful in obtaining the domain name under Part 1 or not, they will have entitlements under this part. For these

Part 2 names, the procedure could be similar to that under the ACPA in the US, where there is a right to get transfer where the registrant has "specific intent" to profit from the registration by selling it to the personal name holder or a third party. A provision similar to that of "bad faith" could also be included to ensure that persons do not trade on the name and goodwill associated with the personal name. Deliberate non-use of the domain name could well fall under this category.

This would give enough width for free speech but would not permit commercial exploitation by third parties without legitimate interests in the name.

At first glance, this may seem a complicated and inappropriate way of going about things. But on further reflection, strong merits are evident.

A serious objection may be made on the ground that Part 1 is unfair and unreasonable since some people might not get the domain name they "deserve" because of multiple incidences on the name or a pre-existing trademark held by another. But this is exactly where it is forward-looking.

The result of this 2 part procedure will be that most domain names will be in the possession of persons who are best equipped to use them efficiently (a good sign from the "allocative efficiency" perspective). This coupled with the fact that there will be a feeling of being "entitled" to and having been unable to obtain the domain name will have a net (pun intended) positive effect. Not only will it create a market demand for holders of domain names corresponding to personal names with multiple incidences to run relatively cheap directory services and portal pages, but, in the long run, it will mean demand for more TLDs in which to assert rights. As mentioned earlier, this is a wholly appropriate and desirable goal.

Another obvious objection would be that this model is impractical because it would result in an unbelievable and uncontrollable amount of litigation. But is this really true? It is likely that the domain names that will be litigated over most are those that both that registrant and the name holder see as valuable. It is unlikely that people will cybersquat or have already cybersquatted on random personal name domain names. Moreover, the WIPO procedure is not highly complicated and it is possible to deal with these disputes efficiently and with strong time deadlines. More litigation may result. But this only means that the Internet is becoming a more inclusive place where more and more individuals are getting involved.

Finally, it may be argued that this approach gives personal names more protection than trademarks get in respect of domain names. But is there anything patently unjust with this? Obviously, trademarks have far more commercial significance. But it is wrong to reduce the Internet to the status of a commercial marketplace.^[83] There is so much more to it. Individuals have crucial roles to play in Cyberspace. This could be one of the first steps to begin bridging one of the many digital divides that exist - one between businesses and individuals.

[1] The .com Top Level Domain (TLD) domain names are, at present, the most coveted domain names. This does not mean there cannot be disputes over names in other TLDs.

[2] IP stands for "Internet Protocol", the language used by computers to communicate with each other on the Internet. IP specifies the format of packets, and the addressing scheme. Most networks combine the IP with another protocol called *Transport Control Protocol (TCP)*, which establishes a virtual connection between a destination and a source.

[3] Domain Names are alphanumeric proxies for the IP numbers that identify computer systems that are part of the Internet. The DNS was designed to meet the need of network users to address any public node on the network by means of an alphanumeric name lookup system rather than with an unintelligible number. The databases matching domain names with actual network addresses have

grown into a widely distributed database system

[4] As mentioned earlier, those, primarily in the .com Top Level Domain (TLD), as also those in the .net and .org TLDs are the most valuable, having an international connotation - an important feature for transacting on the Internet.

[5] The DNS is largely privately administered, and registration of a domain name results in a worldwide presence. Rights relating to Real World Identifiers are publicly administered and territorially based and exercisable only in the territory concerned.

See, *The Managements of Internet Names and Addresses: Intellectual Property Issues: Final Report of the WIPO Internet Domain Name Process*, at <http://wipo2.wipo.int>

[6] That is, there can be only one possible Second Level Domain (SLD) Name per Top Level Domain (TLD).

[7] This conflicts with territorially based intellectual property laws. For example, identical trademarks can be legitimately used by different entities in different countries or even by two entities in the same country but in different businesses. But domain names are one of a kind and are global in nature.

[8] This would include cybersquatters who deliberately, and in bad faith, register domain names closely associated with trademarks and other identifiers, in the hope that they can sell these to the owners of those marks or competitors.

[9] *Supra.*, n. 5.

[10] Other issues being considered in relation to domain names are International Nonproprietary Names (INNs), names of International Intergovernmental Organisations (IGOs), Geographical Indications and indications of source and Tradenames.

[11] The reasons for conflict between rights in names and domain names are similar to those relating to trademarks, but the rights surrounding these personal names are, although analogous, significantly different.

[12] This was not something that was encountered when dealing with the trademarks-domain names nexus as most countries have substantively similar trademark regimes.

[13] Since they are one-of-a-kind.

[14] This follows from the fact that those with requisite "associative value" are scarce.

[15] They are the industry standard at the present time.

[16] J. Thomas McCarthy, *The Rights Of Publicity and Privacy* 1.11[C] (1995) (Clark Boardman, New York, rev. 1995).

[17] See, Michael Madow, "Private Ownership of Public Images: Popular Culture and Publicity Rights", 81 Cal. L. Rev. 125, (1993) available at <http://cyber.law.harvard.edu/ipcoop/93mado1.html>. (accessed)

[18] See, John Locke, *The Second Treatise Of Government*. **Edition, Publisher**

[19] Melville B. Nimmer, *The Right of Publicity*, 19 Law & Contemp. Probs. 203, 216 (1954)

[20] Edwin C. Hettinger, Justifying Intellectual Property, 18 Phil. & Pub. Aff. 31, 37-40 (1989)

[21] *Supra.*, n. 17.

[22] Douglas G. Baird, Note, "Human Cannonballs and the First Amendment: Zacchini v. Scripps-Howard Broadcasting Co.," 30 *Stan. L. Rev.* 1185, 1187 (1978).

[23] *See, Brookfield Communications Inc. v. West Coast Entertainment Group*, 174 F. 3d 1036 (9th Cir. 1999). This approach, albeit taken in relation to meta-tags is crucial to our analysis.

[24] *Supra.*, n. 17.

[25] *See*, Jonathan Kahn, *Bringing Dignity Back to Light: Publicity Rights and the Eclipse of the Tort of Appropriation of Identity*, 17 *Cardozo Arts & Ent LJ* 213 (1999), at 246,247, citing Madow, *supra.*, n. 14 at 134, 238-240.

[26] Rosemary J. Coombe, "Objects of Property and Subjects of Politics: Intellectual Property Laws and Democratic Dialogue", 69 *Tex. L. Rev.* 1853, 1876 (1991)

[27] *Supra.*, n 17.

[28] Samuel D. Warren & Louis Brandeis, "The Right to Privacy", 4 *Harv. L.Rev.* 193 (1890).

[29] J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition*, Fourth Edition, 28:3.

[30] J. Thomas McCarthy, Melville B. Nimmer and the Right of Publicity: A Tribute, 34 *UCLA L. Rev.* 1703, 1710 (1987).

[31] **William L.** Prosser, "Privacy" (1960) 48 *Cal. L. Rev.* 383

[32] As opposed to the "property" based right of publicity that is discussed later.

[33] **Kahn**, *supra.*, n. 25.

[34] The right is seen as having its birth in the landmark *Haelan case* -

[35] J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition*, Fourth Edition, 28:6.

[36] McCarthy, *supra.*, n. 30.

[37] J. Thomas McCarthy, "The Spring 1995 Horace S. Manges lecture - The Human Persona as Commercial Property: The Right of Publicity", *Columbia-VLA Journal of Law and the Arts*, Spring/Summer 1995, 129.135.

Incidentally, this distinction seems to have received recognition in the 1995 *Restatement, Third, of the Law of Unfair Competition* from the American Law Institute.

[38] J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition*, Fourth Edition, 28:14.

[39] One of the biggest areas of dispute is whether mere registration of a domain name amounts to a "use in commerce. *See*, Giorgio Nicolò Vergani, *Electronic Commerce and Trademarks in the USA: Domain Names, Trademarks and the 'Use In Commerce' Requirement on the Internet (Trademarks As Property? A Comparison To Europe)*, 4.2 *J. TECH. L. & POL'Y* 0,

<<http://journal.law.ufl.edu/~techlaw/4-2/foreword.html>> (1999).

[40] *See, Avery Dennison Corp v. Sumpton* 189 F.3d 868, 51 U.S.P.Q.2d1801 (9th Cir. 1999).

[41] The court may award injunctive relief, including the forfeiture or cancellation of the domain name or the transfer of the domain name to the plaintiff. The court may also, in its discretion, award costs and attorneys fees to the prevailing party. But there is no provision for damages.

[42] These factors include: trademark rights in the domain name, *extent to which the domain name consists of a legal name or a nickname of a person*, prior use, bona fide noncommercial use or fair use of the mark in a Web site, intent to divert consumers from the mark owner's online location, the person's provision of material and misleading false contact information, registration of multiple domain names which that person knows are confusingly similar to marks of others, and level of distinctiveness or fame of the mark.

[43] It was intended to protect record and film producers from potential liability, if they registered the personal names of their recording artists/ performers as domain names in order to promote the sale of their records/movies and then sought to transfer it to a production house for the promotion of the record/movie. *See*,

[44] *Nothing in this title shall affect any defense available to a defendant under the Trademark Act of 1946 (including any defense under section 43(c)(4) of such Act or relating to fair use) or a person's right of free speech or expression under the first amendment of the United States Constitution.* Thus, any defense available under the Lanham Act is also available to a defendant to a charge of cybersquatting a person's name.

These include:

* Fair use of a famous mark by another person in comparative commercial advertising or promotion to identify the competing goods or services of the owner of the famous mark.

* Noncommercial use of a mark.

* All forms of news reporting and news commentary.

[45] Senate Section-by-Section Analysis, Congressional Record, p. S14715 (November 17, 1999) *cited from*, J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition*, Fourth Edition, 25:80.

[46] McCarthy, *Ibid*.

[47] *Du Boulay v. Du Boulay*, 2 L.R.-P.C. 430 (1869). In *Du Boulay*, the illegitimate son of a female slave and her master adopted the master's surname. The master's family sued to prevent the son from using the family name. The court rejected their arguments, holding that there is no exclusive right to the use of a family name, *cited from*, Hayley Stallard, "Symposium International Rights Of Publicity: The Right Of Publicity In The United Kingdom", 18 Loy. L.A. Ent. L.J. 565, 566.

[48] 1997 R.P.D. & T.M. 543 (Ch.)

[49] *Cited from*, Stallard, *supra.*, n. 47.<

[50] *Re: Tarzan Trademark*, 1978 R.P.D & T.M. 485 (C.A.).

[51] Cited from, Stallard, *supra.*, n. 47., at p. 569.

[52] *Erven Warnink BV v. J Townend (Hull) Ltd*, [1979] AC 731 (House of Lords).

[53] *Supra.*, Stallard at pp. 570-1.

[54] One of the cases in the UK to have dealt with these is *British Telecommunications plc. v. One in a Million*, (1999) FSR 1 (C.A.).

[55] Worthy of mention is the WIPO panel decision under ICANN's UDRP in *Jeanette Winterson v. Mark Hogarth*, Case No. D2000-0235. The panel, citing UK law, had to resort to recognition of a "common law trademark" (essentially the same as passing off) in the complainant's name to provide protection.

The ICANN UDRP and personal name cases under it are discussed *infra*.

[56] Registrants and complainants in the other TLDs can invoke the UDRP by mutual consent.

[57] See, *Harrods Ltd. v. Robert Boyd*, Case No. D2000-0060, www.dodialfayed.com *Experience Hendrix, L.L.C. v. Denny Hammerton and The Jimi Hendrix Fan Club*, Case No. D2000-0364, www.jimihendrix.com *Louis Vuitton Malletier v. J.N. Prade*, Case No. D2000-1115, www.louisvuitton.com

[58] *Julia Fiona Roberts v. Russell Boyd*, Case No. D2000-0210, www.juliaroberts.com

[59] *Jeanette Winterson v. Mark Hogarth*, Case No. D2000-0235, www.jeanettewinterson.com

[60] *Steve Rattner v. BuyThisDomainName (John Pepin)*, Case No. D2000-0402, www.steverattner.com

[61] *Gordon Sumner, p/k/a Sting v. Michael Urvan*, Case No. D2000-0596, www.sting.com

[62] *Id.*, para 6.4. It is difficult to find any fault with this analysis.

[63] *Daniel C. Marino v. Video Images Productions, et al.*, Case No. D2000-0598, www.danmarino.com

[64] *Helen Folsade Adu known as Sade v. Quantum Computer Services Inc*, Case No. D2000-0794, www.sade.com

[65] *Madonna Ciccone, p/k/a Madonna v. Dan Parisi and "Madonna.com"*, Case No. D2000-0847, www.madonna.com

[66] *Id.* Para 6C.

[67] *Isabelle Adjani v. Second Orbit Communications, Inc.*, Case No. D2000-0867, www.isabelle-adjani.net

David Gilmour, David Gilmour Music Limited and David Gilmour Music Overseas Limited v. Ermanno Cenicolla, Case No. D2000-1459, www.davidgilmour.com

[68] *Helen Fielding v. Anthony Corbert aka Anthony Corbett*, Case No. D2000-1000, www.bridgetjones.com

[69] *Edward Van Halen v. Deborah Morgan*, Case No. D2000-1313, www.edwardvanhalen.com

[70] A defence asserted, almost unanimously unsuccessfully, in most of the cases cited above.

[71] Richard Cameron Cray, "Choice of Law in Right of Publicity", 31 UCLA L. Rev. 640 (1984).

[72] Even possibly to criticize person xyz, *See, Bally Total Fitness v. Faber*, 29 F. Supp. 2d 1161 (C.D. Cal. 1998), www.xyzsucks.com *Wal-Mart Stores, Inc. v. Walsucks and Walmarket Puerto Rico*, Case No. D2000-0477. www.ballysucks.com

[73] This distinction is based on the assumption that domain names are inheritable property and that those who hold them today will transfer them to their heirs on their own death.

[74] In order for the RealNames system to locate an organisation using a keyword, the organization must register for a RealName. To do so, the organization must log on to the RealNames site, check the availability of a name and pay a fee to register the word if it is available. Once a RealName is registered, when a customer enters a word in a RealNames-enabled browser, the request is sent to the RealNames server. If a company hasn't registered a RealName, the main screen will indicate that there is no web address that matches the search.

[75] If the web surfer types in a word or name into the locator box of a Keywords enabled browser, the computer will send the word to the Internet Keywords system at Netscape. The Keywords system matches those words to a URL and redirects the surfer's browser.

[76] *See*, "Alternatives to Domain Names", part of the *Intellectual Property in Cyberspace* online course at <http://cyber.law.harvard.edu>

[77] *See*, Paragraph 9 of the Final Report of the WIPO Internet Domain Name Process at <http://wipo2.wipo.ne> There seems to be reluctance on the part of owners of marks to sharing, as they prefer to preserve their own unique identities.

[78] *See*, <http://www.theglobalname.org>

[79] For details, *see, id.* There are no restrictions on how a name may be articulated.

[80] It is difficult to document what a name is due to the diversity of language and culture in respect to how an individual is recognised and it is unlikely that all possible combinations (including nicknames) can be captured and maintained in a list.

[81] These include improved domain registration procedures, speedy and effective uniform dispute resolution procedures and, most controversially, the adoption of a system of famous and well-known trademarks across all gTLDs. They also prefer a slow and controlled introduction of new TLDs. *See, WIPO supra., n.*

[82] This paper specifically does not deal with rights in names of fictional characters either portrayed by or created by humans.

[83] Internet practice has hardly kept to the original plan that only commercial ventures would involve themselves in the .com TLD. It is as much the scene of social, political, economic and religious dialogue as it is commercial.