Tune in to trade marks

By Wayne Covell

Madonna, Sting, Paul McCartney, The Estate of Jim Morrison, Dire Straits, David Gilmour of Pink Floyd and Jennifer Lopez have all been caught up in domain name disputes. There are many lessons that aspiring musicians can learn from these cases. Perhaps the most important is the value of a trade mark registration. While a trade mark registration is not essential to succeed in a domain name dispute, it certainly helps. The absence of a trade mark registration causes many costly problems. Bands and musicians should secure their domain name and corresponding trade mark registration as soon as possible. But often that does not occur.

ICANN domain name dispute policy

The most important generic top-level domain (gTLD) is still the ".com" domain name. Where a dispute about the domain name occurs these are frequently decided by mediation centres such as those offered by the World Intellectual Property Organization (WIPO) based in Switzerland (see http://www.wipo.int/amc/en/domains/gtld/) and the National Arbitration Forum in the US (see http://domains.adrforum.com/). The two remedies available are limited, namely transfer or cancellation of the domain name, but compared to court proceedings the costs are reasonable.

Such disputes are decided under the ICANN (the Internet Corporation for Ascribed Names and Numbers) policy. This focuses on three elements for settling all gTLD domain name disputes concerning com, info, net and org:

(1) 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

(2) the Respondent has no rights or legitimate interests in respect of the domain name; and

(3) the domain name has been registered and is being used in bad faith.

While bands and musicians can rely on unregistered trade marks or common law passing off rights in proving these elements, it is also certainly true that a trade mark registration will assist greatly in proving the above three elements. The first element does not specifically mention "registered trade marks", but it does mention "identical or confusingly similar to a trademark or service mark." And without question the best and time-honoured way of showing that you have rights in a trade mark is to own a trade mark registration. That's why the top companies in the world (such as Microsoft and Coca-Cola) and the most famous artists and bands (such as the Beatles and Madonna) are all registered trade marks. Short of an Act of Parliament (such as those associated with the Olympic Games), registered trade marks are without question the most powerful trade mark rights that can be obtained.

Identical and/or confusingly similar

Under this first element of the ICANN domain name dispute policy the complainant should establish their rights in an identical or confusingly similar mark. There are many difficulties that face the unregistered trade mark owner. The first is: who is the owner? The owner of a trade mark registration merely has to produce a certified copy

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of the Certificate of Registration to show who the owner is. By contrast, the unregistered trade mark owner has to show that the alleged reputation in the mark is solely attributable to that owner. That is not always easy, particularly for bands with line-up changes (see, for example, the dispute over the Bucks Fizz band name in *Heidi Manton & Ors v David Van Day & Ors*, 27 July 2001, Ch D UK, Jacobs J).

Another difficulty facing unregistered rights holders is establishing the reputation or goodwill in the identical and/or confusingly similar trade mark. Like a passing off action this requires detailed evidence of use and, usually, continuing use. It's an expensive task particularly if there is a ton of evidence to be gathered, collated and presented. By contrast, a trade mark registration is prima facie evidence that the owner does have a right and a public reputation in the mark.

To be sure, it is often the case that well known band names and musicians rely on *both* trade mark registrations *and* evidence of reputation in the name. That's exactly what Madonna's legal representatives did in *Madonna Ciccone, p/k/a Madonna v. Dan Parisi and "Madonna.com"* Case No. D2000-0847. **Madonna** proved that she was the owner of U.S. trademark registrations 1,473,554 and 1,463,601 for **Madonna** covering entertainment services and related goods. She also submitted evidence of her worldwide reputation in **Madonna**. The WIPO Panel was satisfied that the Respondent had no rights or legitimate interests in the domain name www.madonna.com and that it had been registered and used in bad faith. Accordingly, www.madonna.com was transferred to the Complainant.

Certainly the ICANN policy is "broad in scope" and a common law trade mark will be sufficient: *McCarthy on Trademarks and Unfair Competition*, § 25:74.2, Vol. 4 (2000); *Michael Aston v Dena Pierrets - Case No. 117322* (Nat. Arb. Forum Sep 27, 2002). But the complications caused by not having a registration loom in the background.

In this latter case concerning the domain name www.genelovesjezebel.com the Complainant succeeded despite the lack of a trade mark registration because of his longstanding and continuous use of the name **Gene Loves Jezebel**. However, it was

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also noted that the Complainant had a pending US federal trade mark application and that "actively seeking trade mark protection for a mark in question is enough to show rights in the mark sufficient to establish standing."

A similar result was reached in The *Ian Anderson Group of Companies Ltd v Denny Hammerton & I Schembs* Case No. D2000-0475 which concerned the well known UK band Jethro Tull seeking to recover www.jethrotull.com and www.jethro-tull.com. The band's representatives were successful despite the lack of trade mark registration for **Jethro Tull**. But it was shown that the Complainant had an extensive reputation (including the sale of more than 60 million albums worldwide) and, like **Gene Loves Jezebel**, that it had recently made a trade mark application (in this case in the European Community) which was unopposed and that a Certificate of Registration was to be issued shortly.

Dire Straits were also successful in recovering their domain name www.direstraits.com despite the lack of a trade mark registration: see *Dire Straits (Overseas) Limited v. Alberta Hot Rods*, WIPO Case No. D2007-0778. **Dire Straits** formed in the UK in 1977, became hugely successful winning many awards including two Grammys and it had sold more than 100 million albums worldwide.

The complaint was filed in 2007 against a Canadian entity Alberta Hot Rods which registered www.direstraits.com on 26 November 1996. After receiving notice from **Dire Straits** the Respondent put the following disclaimer on this website:

> "This is an UNOFFICIAL Dire Straits fan site. This site is not affiliated or endorsed in any way by Dire Straits or any other party".

Surprisingly, the band did not produce any evidence that it owned trade mark registrations for the words **Dire Straits**. However, through extensive evidence of use it proved its common law rights in the name.

But while some bands and artists that haven't registered their name as a trade mark may take some comfort from the *Dire Straits case* it is a decision that nonetheless

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should be approached with great caution. For a start, very few bands and artists will achieve the huge fame and success of **Dire Straits**. And even if they do, fame is not itself a guarantee that unregistered common law rights will be recognised in the name.

The *Dire Straits case* may be contrasted with the plight of **Sting** in *Gordon Sumner, p/k/a Sting v Michael Urvan* Case No. D2000-0596. The Respondent, Michael Urvan of Marietta, Georgia, in the United States had registered the domain name www.sting.com in July 1995. The Complainant, Gordon Sumner (better known as Sting) is an English musician who originally shot to fame as the lead singer and bass player for the band **Police**. He'd used the alias **Sting** since 1978. With **Police** and after they broke up he'd recorded twenty albums most of them achieving multi-platinum status in the United States. The Respondent in his response, however, noted that there were 20 trademark registrations of the word **STING** in the US, but none of them were owned by the Complainant Gordon Sumner.

The WIPO Panel found that although "it is accepted that the Complainant is world famous under the name **STING**, it does not follow that he has rights in **STING** *as a trademark or service mark*." The Panel also noted that "the personal name in this case is also a common word in the English language, with a number of different meanings." Each of the three elements in the ICANN policy had not been satisfied. Accordingly www.sting.com was not transferred to Gordon Sumner.

The Sting decision was distinguished on its facts in *Madonna Ciccone, p/k/a Madonna v. Dan Parisi and "Madonna.com"* Case No. D2000-0847. The Panel noted that in:

> "... the Sting decision there was evidence that the Respondent had made bona fide use of the name Sting prior to obtaining the domain name registration and there was no indication that he was seeking to trade on the goodwill of the well-known singer."

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By contrast, in *the Madonna case* there was "no similar evidence of prior use by Respondent and the evidence demonstrates a deliberate intent to trade on the good will of complainant." An additional fact was that **Madonna** (which like 'sting' is also a known English word) had taken the trouble to register her name as a trade mark. **Sting** was stung.

The *Sting case* shows that fame and celebrity is no guarantee of success. In *David Gilmour, David Gilmour Music Limited and David Gilmour Music Overseas Limited v. Ermanno Cenicolla* Case *No*. D2000-1459 concerning the lead guitarist and singer from **Pink Floyd**, the *Sting case* was said to have "distinguished between personal names that have become trademarks (to which the Policy applies) and personality rights (to which the Policy was not intended to apply)."

This issue was further examined in *The Estate of Jim Morrison a/k/a Lou and Pearl Courson v. Rick Sentieri, Communication Services Group* Case No. D2009-0334 (March 25, 2009). The Estate of **Jim Morrison** succeeded in recovering the domain name www.jimmorrison.com despite the lack of a trade mark registration because it proved that **Jim Morrison** had been used as a trade mark. The WIPO panel cited the following passage with approval from J.T. McCarthy, *McCarthy on Trademarks and Unfair Competition*, § 28: 11 at 28-15 (2007):

> "[W]hile every person inherently possesses a right of publicity, every person does not inherently possess a trade or service mark in his or her name, picture, or other elements of persona. Trade or service mark rights arise only if a name or picture is used as a trade or service mark: to identify and distinguish the source of goods or services. To acquire enforceable trade or service mark rights in a personal name, likeness, or any type of symbol, that word or symbol must be *used* as a trade or service mark."

Even though in the *Jim Morrison case* the Complainant was able to surmount this hurdle it also showed the costs dilemma faced when there is no trade mark registration. The WIPO panel was critical of the evidence of reputation initially

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presented because it focussed on the band **The Doors** rather than **Jim Morrison**. It then required the filing of "supplemental evidence". The best way of avoiding this cost dilemma is to ensure that the name in issue is registered as a trade or service mark. Of course there are many other benefits too. For example, the registration will, in most cases, block others seeking to register the same or confusingly similar band name. It is also something that can be easily licensed, sold or even mortgaged.

Rights or Legitimate Interests

Again it is not essential under this element to have a trade mark registration. As noted above, despite the lack of a trade mark registration Dire Straits succeeded in *Dire Straits (Overseas) Limited v. Alberta Hot Rods*, WIPO Case No. D2007-0778 in establishing that the respondent had no rights or legitimate interests in the domain name. The Respondent was not using the domain name as a fan site but, rather, the references to the band and its members was "mere window dressing" designed to attract web traffic and advertising revenue.

Again it will be easier to show this element if the Complainant has a trade mark registration. Equally, if the Respondent has legitimately obtained a trade mark registration then it will be able to establish that it has a right or legitimate interest in the disputed domain name.

Registered and Used in Bad Faith

Having a trade mark registration will certainly help here. Typically the complainant will try to show that the domain name was registered after the complainant established its name. If the trade mark registration predates the domain name registration then it's easier to make this point. The *Sting case* also shows another risk in not having a trade mark registration. It may be harder to establish bad faith where

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the name in issue is a common English word. The Respondent was able to show that it had legitimately used the word "sting" as it had a number of ordinary English meanings.

However, a feature of celebrity cases are the activities of serial cyber squatters and this often becomes the focus of the enquiry under this element. In the *Dire Straits case* the band established that the Respondent had used and registered the domain name in bad faith because in many previous WIPO decisions the Respondent and its associates had an "established pattern" of registering celebrity domain names including Tom Cruise, Celine Dion, Jeffrey Archer, Michael Crichton, Julie Brown, Kevin Spacey, Bruce Springsteen, Larry King, Pamela Anderson and others. In each case the Respondent had used and registered the domain name in bad faith. The Respondent was found to be "a serial cyber squatter specializing in the misappropriations of celebrity names and marks."

Similarly, bad faith was shown in MPL Communications Limited v Denny Hammerton - Case No. 95633 (Nat Arb Forum, Oct 25, 2000) where the Respondent had registered:

- www.paulmccartney.com
- www.lindamccartney.com
- www.linda-mccartney.net

All three domain names were ordered to be transferred to the Complainant. It was noted that the Respondent had "demonstrated a pattern of conduct of registering the domain names of famous recording artists and using those domain names for his own personal gain". *See Madonna Ciccone, p/k/a Madonna v. Dan Parisi and "Madonna.com"* D2000-0847 (WIPO Oct. 12, 2000).

Before leaving this topic it is important to note for Australian readers a difference between the ICANN policy and the .au Dispute Resolution Policy (see http://www.auda.org.au/policies/auda-2008-01/). In the former the Complainant has to show both registration and use in bad faith whereas in the latter either registration or subsequently used in bad faith will suffice.

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Conclusion

While a trade mark registration is not essential to protecting or recovering your band or musician name as a domain name, it is still the best and easiest way to protect that name. Without it you will need to gather extensive evidence of use. This is always costly. Maybe that's okay for **Madonna**, **Paul McCartney** (who also owned their trade mark registrations too), **David Gilmour** and **Dire Straits**, but where does that leave the rest of the world's musicians? Without a trade mark registration you'll also need to navigate the legal niceties surrounding common English words (if they are used) and the distinction "between personal names that have become trademarks (to which the Policy applies) and personality rights (to which the Policy was not intended to apply)". See *David Gilmour, David Gilmour Music Limited and David Gilmour Music Overseas Limited v. Ermanno Cenicolla* Case *No.* D2000-1459.

Don't get stung like **Sting**. Register your band name, personal name or alias as a trade mark as soon as possible along with the associated domain name.

For further information contact
email@worthyofthename.com

PO Box 443 Burwood NSW 1805 Australia
T +61 2 9744 6657 M +61 (0) 402 125 790 F +61 2 9744 1415

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