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# Celebrity in Cyberspace: A Personality Rights Paradigm for Personal Domain Name Disputes

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# CELEBRITY IN CYBERSPACE: A PERSONALITY RIGHTS PARADIGM FOR PERSONAL DOMAIN NAME DISPUTES

JACQUELINE D. LIPTON\*

## ABSTRACT

*When the Oscar™-winning actress Julia Roberts fought for control of the <juliaroberts.com> domain name, what was her aim? Did she want to reap economic benefits from the name? Probably not, as she has not used the name since it was transferred to her. Or did she want to prevent others from using it on either an unjust enrichment or a privacy basis? Was she, in fact, protecting a trademark interest in her name? Personal domain name disputes, particularly those in the <name.com> space, implicate unique aspects of an individual's persona in cyberspace. Nevertheless, most of the legal rules developed for these disputes are based on trademark law. Although a number of individuals have successfully used these rules in practice, the focus on trademark law has led to inconsistent and often arbitrary results. Additionally, commentators have questioned recent expansions of trademark law in the Internet context. This Article suggests that if personal names merit legal protection in cyberspace, it should be under an appropriate set of legal rules, rather than through further expansion of trademarks. This Article develops a new framework for personal domain name disputes based on the theories underlying the right of publicity tort. Unlike trademark law, this tort is aimed at the protection of individual names and likenesses. It has not been utilized much in cyberspace largely because of time, cost, and jurisdictional disadvantages of litigation as opposed to the quicker and cheaper, but trademark-based, Uniform Domain Name Dispute Resolution Policy ("UDRP"). This article suggests the creation of a new personal domain name dispute resolution policy ("PDRP") that combines the procedural advantages of the UDRP with the theory underlying the right of publicity tort.*

## TABLE OF CONTENTS

INTRODUCTION .....	
I. PERSONAL DOMAIN NAME DISPUTES AND TRADEMARK LAW .....	
A. Categorizing Personal Domain Name Disputes.....	
1. Celebrities' Names.....	

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CELEBRITY IN CYBERSPACE

2. Politicians’ and Public Figures’ Names...
3. Private Individuals’ Names...
B. Shortcomings of the Existing Legal Framework ...
1. Trademark Infringement ...
2. Trademark Dilution ...
3. The Anti-Cybersquatting Consumer Protection Act, and California’s Business and Professions Code...
4. The Uniform Domain Name Dispute Resolution Policy ...
II. PERSONALITY RIGHTS...
A. The Right of Publicity and Personal Name Disputes...
B. Does a Personality Rights Framework Improve on the Current Situation? ...
1. Personality Rights vs the UDRP ...
2. Case Study 1: Unauthorized Celebrity Websites ...
3. Case Study 2: Unauthorized Political Websites ...
III. CRAFTING A NEW PERSONAL DOMAIN NAME DISPUTE RESOLUTION POLICY (“PDRP”)...
A. Basic Structure and Scope of a PDRP ...
B. The Basis of a PDRP Complaint ...
C. The “Legitimate Interest” Defense Under the PDRP ...
D. Remedies Under the PDRP ...
E. Politicians’ Names: A Special Case?...
F. Duration and Descendability of Personal Name Rights Under the PDRP...
IV. CONCLUSIONS...

INTRODUCTION

When Julia Roberts, the popular Oscar™-winning actress, brought proceedings for control of the domain name <juliaroberts.com>,<sup>1</sup> just what was her beef? Was she concerned that the registrant of the domain name would be unjustly enriched by its use? Or was she rather concerned about unauthorized content that might appear on the associated website? Or both? She was successful in her complaint against Russell Boyd,<sup>2</sup> the registrant, in an arbitration under the Uniform Domain name Dispute Resolution Policy (“UDRP”).<sup>3</sup> But what theoretically was the justification for her

1 Julia Fiona Roberts v Russell Boyd Case No. D2000-0210 , May 29, 2000, WIPO Arbitration and Mediation Center (full text available at http://www.wipo.int/amc/en/domains/decisions/html/2000/d2000-0210.html , last viewed on November 6, 2007).

2 id.

3 The UDRP is a private dispute resolution procedure for domain name disputes that is administered by the Internet Corporation for Assigned Names and Numbers (“ICANN”). The full text of the UDRP is available on ICANN’s website at: http://www.icann.org/udrp/udrp-policy-24oct99.htm , last viewed on November 6, 2007.

success? The justification is actually found in trademark law.<sup>4</sup> The UDRP was implemented to protect trademark holders against the activities of bad faith cybersquatters<sup>5</sup> - those who register domain names speculatively to profit from selling the names to “rightful” trademark owners.<sup>6</sup>

The UDRP is a global online dispute resolution procedure that is incorporated into domain name registration agreements<sup>7</sup> by reference.<sup>8</sup> Domain name registrants are contractually bound to submit to an online arbitration if a third party complains about their registration or use of the domain name.<sup>9</sup> Complaints are premised on the complainant’s assertion of trademark rights corresponding with the relevant domain name.<sup>10</sup> The advantages of the UDRP over litigation are that it is inexpensive and fast,<sup>11</sup>

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<sup>4</sup> The policy basis underlying the result was that Julia Roberts had unregistered trademark rights in her personal name: *Julia Fiona Roberts v Russell Boyd* Case No. D2000-0210, May 29, 2000, WIPO Arbitration and Mediation Center (full text available at <http://www.wipo.int/amc/en/domains/decisions/html/2000/d2000-0210.html>, last viewed on November 6, 2007), ¶ 6 (“the name “Julia Roberts” has sufficient secondary association with Complainant that common law trademark rights do exist under United States trademark law”). The UDRP is premised on protection of trademark interests so individuals bringing actions with respect to personal names under the UDRP must establish trademark rights in those names in order to bring a successful complaint. See discussion in Landon Moreland and Colby Springer, *Celebrity Domain Names: ICANN Arbitration Pitfalls and Pragmatic Advice*, 17 SANTA CLARA COMPUTER & HIGH TECH L J 385, 389 (2001) (“The first potential pitfall in obtaining a favorable judgment under the UDRP is a celebrity’s failure to establish recognized trademark rights in his or her personal or professional name.”)

<sup>5</sup> ANNE GILSON LALONDE, TRADEMARK PROTECTION AND PRACTICE, at § 7A.06 (“Cybersquatters register trademarks in Internet domain names with no intention of developing a viable web site but instead to hold the name for resale to either the trademark owner or a third party.”) [hereinafter, GILSON LALONDE].

<sup>6</sup> For a discussion of this practice, see Jacqueline Lipton, *Beyond Cybersquatting: Taking Domain Name Disputes Past Trademark Policy*, 40 WAKE FOREST LAW REVIEW 1361, 1369-1377 (2005) [hereinafter, “*Beyond Cybersquatting*”].

<sup>7</sup> Notably disputes involving domain names in the <.com>, <.net> and <.org> domain spaces as well as some others. See introductory notes to the UDRP, available at: <http://www.icann.org/udrp/udrp-policy-24oct99.htm>, last viewed on January 23, 2008. The full text of the UDRP is also available at this website.

<sup>8</sup> UDRP, para. 1 (“This Uniform Domain Name Dispute Resolution Policy (the “Policy”) has been adopted by the Internet Corporation for Assigned Names and Numbers (“ICANN”), is incorporated by reference into your Registration Agreement, and sets forth the terms and conditions in connection with a dispute between you and any party other than us (the registrar) over the registration and use of an Internet domain name registered by you. Proceedings under Paragraph 4 of this Policy will be conducted according to the Rules for Uniform Domain Name Dispute Resolution Policy (the “Rules of Procedure”), which are available at [www.icann.org/udrp/udrp-rules-24oct99.htm](http://www.icann.org/udrp/udrp-rules-24oct99.htm), and the selected administrative-dispute-resolution service provider’s supplemental rules.”)

<sup>9</sup> *id.*

<sup>10</sup> UDRP, para 4(a) (“You are required to submit to a mandatory administrative proceeding in the event that a third party (a “complainant”) asserts to the applicable Provider, in compliance with the Rules of Procedure, that: (i) your domain name is identical or confusingly similar to a *trademark or service mark in which the complainant has rights*; and, (ii) you have no rights or legitimate interests in respect of the

compared to litigation,<sup>12</sup> and its reach is effectively global because relevant parties are bound to it by contract, wherever they may physically reside. Thus, it has been the avenue of choice for most domain name complainants.<sup>13</sup>

The problem is that not all disputed domain names correspond with trademarks. Personal names, for example, may or may not be trademarked, depending on the circumstances. UDRP arbitrators often have little guidance as to whether a particular name really operates a trademark, despite regularly being required to make such determinations. This has led to inconsistent and arbitrary decisions. Why, for example, should Julia Roberts<sup>14</sup> and Tom Cruise<sup>15</sup> be regarded as having trademarks in their personal names when the same is not true for Bruce Springsteen,<sup>16</sup> or the late Anna Nicole

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domain name; and, (iii) your domain name has been registered and is being used in bad faith.”) (emphasis added)

<sup>11</sup> Lipton, *Beyond Cybersquatting*, *supra* note \_\_\_, 1372 (“The UDRP is a private, international, inexpensive, relatively fast, and predominantly online dispute resolution procedure for situations in which a complainant is disputing the registration of a domain name. The UDRP does not oust the jurisdiction of national courts. However, all domain name registrants are contractually bound to submit to a mandatory arbitration under the UDRP if a complaint is made under the UDRP about the registration of one or more relevant domain names. This dispute is managed by arbitrators licensed by one of the organizations charged with hearing disputes under the UDRP. It involves the receipt of a complaint and a response by the registrant. The arbitrator or panel then provides a decision and resolution based on this material. There are generally no in-person hearings. The only orders that can be made under the UDRP are orders for cancellation of a disputed name or for transfer of a domain name to the complainant.”)

<sup>12</sup> Costs of judicial proceedings can be prohibitive for private individuals: Moreland, *supra* note \_\_\_, at 385 (“Prior to the establishment of ICANN Arbitration, recovery of celebrity domain names was an expensive and potentially lengthy process.”); Jessica Litman, *The DNS Wars: Trademarks and the Internet Domain Name System*, 4 J. SMALL & EMERGING BUS. L. 149, 155 (2000) (noting the often prohibitive cost of trademark infringement and dilution litigation in early domain name disputes).

<sup>13</sup> Moreland, *supra* note \_\_\_, at 385 (“Prior to the establishment of ICANN Arbitration, recovery of celebrity domain names was an expensive and potentially lengthy process.”)

<sup>14</sup> *Julia Fiona Roberts v Russell Boyd*, WIPO Case No. D2000-0210, 30 May, 2000 (available at <http://www.wipo.int/amc/en/domains/decisions/html/2000/d2000-0210.html> ).

<sup>15</sup> *Tom Cruise v Alberta Hot Rods*, WIPO Case No D2006-0560, 5 July, 2006 (available at <http://www.wipo.int/amc/en/domains/decisions/html/2006/d2006-0560.html>).

<sup>16</sup> *Bruce Springsteen v Jeff Burgar and Bruce Springsteen Club*, WIPO Case No. D2000-1532, Jan. 25, 2001, ¶ 6 (available at <http://arbiter.wipo.int/domains/decisions/html/2000/d2000-1532.html>) (“It appears to be an established principle from cases such as Jeanette Winterson, Julia Roberts, and Sade that in the case of very well known celebrities, their names can acquire a distinctive secondary meaning giving rise to rights equating to unregistered trade marks, notwithstanding the non-registerability of the name itself. It should be noted that no evidence has been given of the name "Bruce Springsteen" having acquired a secondary meaning; in other words a recognition that the name should be associated with activities beyond the primary activities of Mr. Springsteen as a composer, performer and recorder of popular music. In the view of this Panel, it is by no means clear from the UDRP that it was intended to protect proper names of this nature.”)

Smith?<sup>17</sup> Why should Senator Hillary Clinton's name be recognized as a trademark<sup>18</sup> when the same is not true for other politicians such as Kathleen Kennedy Townsend?<sup>19</sup> The reliance on the UDRP to resolve personal domain name disputes raises two related issues. The first is that the UDRP inadvertently encourages the expansion of trademark law into questionable areas: for example, situations where an individual's name is *not* operating as a source indicator for products or services (ie as a trademark or service mark). The second issue is that reliance on trademark-focused regulations for personal domain name disputes appears in practice to have stalled the development of legal rules more appropriately tailored for these disputes.

This Article suggests that these problems could be mitigated by creating a new personal domain name dispute resolution procedure ("PDRP"). This new procedure could retain the time, cost, and jurisdictional benefits of the UDRP, but be based on a theoretical model more focused on protecting individual personas than trademark law. The obvious set of legal rules that protects individual names and likenesses against unauthorized commercial use is the right of publicity – or "personality rights" – tort.<sup>20</sup> Marrying the substance of the right of publicity tort with the procedural benefits of the UDRP is suggested in this Article as a useful way forwards. It would remove the focus

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<sup>17</sup> *Anna Nicole Smith v DNS Research Inc*, Claim No. FA0312000220007, National Arbitration Forum, Feb 21, 2004 (available at: <http://www.adrforum.com/domains/decisions/220007.htm>) (involving *annanicole-smith.com* domain name) ("it is unlikely that the evidence submitted here by Complainant of her career, in and of itself, is sufficient to establish common law trademark rights in the name, which is a requirement for Complainant to prevail on this aspect of the case. While the UDRP does not require a *registered* trademark for protection of a trademark from a confusingly identical domain name, the mere fact of having a successful career as an actress, singer or TV program star does not provide exclusive rights to the use of a name under the trademark laws. The cases require a clear showing of high commercial value and significant recognition of the name as solely that of the performer. The *Humphrey Bogart* case cited by the Complainant is a prime example of the type of case that would be expected to prevail, since virtually no one familiar with the movie industry would fail to recognize his name as that of a famous movie star. The Panel does not believe Complainant's name has yet reached that level of fame.")

<sup>18</sup> *Hillary Rodham Clinton v Michele Dinoia*, National Arbitration Forum Claim No FA0502000414641, March 18, 2005 (full text available at <http://www.arb-forum.com/domains/decisions/414641.htm>) (Senator Clinton was regarded as having an unregistered trademark right in her personal name in connection with both her political activities and her career as an author of a number of books sold in commerce.)

<sup>19</sup> *Kathleen Kennedy Townsend v Birt*, WIPO Case No D2002-0030, April 11, 2002 (available at <http://www.wipo.int/amc/en/domains/decisions/html/2002/d2002-0030.html>) (individual politician in state gubernatorial race held not to hold trademark rights in her personal name).

<sup>20</sup> GILSON LALONDE, *supra* note \_\_\_\_, at § 2.16[1] ("The right of publicity ... is the right of an individual to control the commercial use of his or her name, likeness, signature, or other personal characteristics."). The United States is the only country that has created a specific right of publicity tort. Other jurisdictions may protect similar rights in other ways: for example, Trade Practices Act, § 52 in Australia (prohibiting misleading and deceptive conduct in commerce). In the United Kingdom, privacy laws have been utilized to create a right similar to the right of publicity in practice: see, for example, *Douglas and others v Hello! Ltd*, [2001] 2 All ER 289; [2001] 1 FLR 982, [2002] 1 FCR 289 (U.K.) (concerned with compensation for unauthorized publication of photographs of the Michael Douglas/Catherine Zeta-Jones wedding on a privacy basis in the absence of a right of publicity in the United Kingdom).

from trademark law, thereby avoiding undesirable extensions of trademark law into areas where personal names are not truly functioning as trademarks. It would also facilitate the development of a new jurisprudence focused on identifying and enforcing emerging social norms in relation to the protection of personal names online, whilst balancing these norms against the need to avoid chilling speech in cyberspace. Initially, a new PDRP should ideally be limited in operation to <name.com> versions of an individual's name, as opposed to, say <name.net>, <name.org> or <namesucks.com>. This is because the <name.com> version of an individual's name is likely the most closely associated with the individual's "authorized" online persona.<sup>21</sup> In other words, it is the domain name that most closely approximates an individual's persona in the domain space.<sup>22</sup>

Part I categorizes different classes of personal domain name disputes. It focuses respectively on disputes involving celebrities, politicians and public figures, and private individuals. It also identifies the limitations of trademark-based rules in these disputes. Part II identifies ways in which personality rights jurisprudence is a better, or at least more "honest" substantive fit for these disputes, albeit with inherent practical limitations in the domain name context in terms of jurisdiction and cost. Part III presents a framework for a new PDRP that draws on the substance of the personality rights tort, while maintaining the procedural and cost benefits of the UDRP. Part IV presents conclusions about ways in which a new PDRP would facilitate the evolution of a personality-rights based jurisprudence in cyberspace, while removing disputes that are not really about trademarks from the reach of trademark law.

One might argue that developing a PDRP is unnecessary because: (a) it would over-propertize personal names online and hence chill free speech; and, (b) domain name regulation is irrelevant because sophisticated search engines have taken the place of

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<sup>21</sup> Certainly most of the high profile personal domain name disputes involve <name.com> domain names. See, for example, *Julia Fiona Roberts v Russell Boyd*, WIPO Case No. D2000-0210, 30 May, 2000 (available at <http://www.wipo.int/amc/en/domains/decisions/html/2000/d2000-0210.html>) (involving *juliaroberts.com* domain name); *Tom Cruise v Alberta Hot Rods*, WIPO Case No D2006-0560, 5 July, 2006 (available at <http://www.wipo.int/amc/en/domains/decisions/html/2006/d2006-0560.html>) (involving *tomcruise.com* domain name); *Kevin Spacey v Alberta Hot Rods*, National Arbitration Forum Claim No 114437, August 1, 2002 (available at <http://www.arb-forum.com/domains/decisions/114437.htm>) (involving the domain name *kevinspacey.com*); *Anna Nicole Smith v DNS Research Inc*, Claim No. FA0312000220007, National Arbitration Forum, Feb 21, 2004 (available at: <http://www.adrforum.com/domains/decisions/220007.htm>) (involving *annanicolesmith.com* domain name); *Bjorn Borg v Miguel Garcia*, WIPO Case No. D2007-0591, June 21, 2007 (available at: <http://www.wipo.int/amc/en/domains/decisions/html/2007/d2007-0591.html>) (involving the domain name *bjornborg.com*); *Hillary Rodham Clinton v Michele Dinoia*, National Arbitration Forum Claim No FA0502000414641, March 18, 2005 (full text available at <http://www.arb-forum.com/domains/decisions/414641.htm>) (involving *hillaryclinton.com* domain name); *Bruce Springsteen v Jeff Burgar*, WIPO Case No D2000-1532, Jan 25, 2001 (available at <http://www.wipo.int/amc/en/domains/decisions/html/2000/d2000-1532.html>).

<sup>22</sup> Some might argue that this was the intent of the <.name> domain space. However, that particular domain space has not grown in practice in this way, and most personal domain name disputes revolve around <.com> versions of an individual complainant's name. See *id.*

intuitive domain names as an Internet searching tool.<sup>23</sup> Each of these concerns may be rebutted. The suggested PDRP does little more in practice than is currently done by the UDRP with respect to propertizing personal names. However, it does so in a more consistent and appropriate manner – by developing a jurisprudence that is specific to interests in individual personas as opposed to trademarks. It therefore removes from the trademark arena those disputes that are not really about trademarks, while facilitating the development of a more nuanced personality-rights based jurisprudence.<sup>24</sup> Further, the limitation of the PDRP, at least initially, to <name.com> domains should limit its impact on free speech.

While it is unquestionable that sophisticated search engine technology has a significant role to play in locating information online, the fact that personal domain name disputes are still routinely arbitrated suggests that their control remains an important issue in cyberspace.<sup>25</sup> There are a variety of reasons for this. Even sophisticated search engines use algorithms that prioritize domain names in search results.<sup>26</sup> Additionally,

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<sup>23</sup> Eric Goldman, *Deregulating Relevancy in Internet Trademark Law*, 54 EMORY LAW JOURNAL 507, 548 (2005) (suggesting increasing sophistication of search engines will portend the death of Internet domain names as search tools).

<sup>24</sup> Trademark law has come under attack in recent years for becoming too expansive in scope, particularly in relation to the use of trademarks online. Removing the need to assert trademarks in personal names to prevent some inappropriate uses of those names in the domain space would avoid unnecessary reliance on expanding the boundaries of trademark law in the personal domain name context. For more general discussions of questionable expansions of trademark law in the Internet context, see Gregory Lastowka, *Google's Law*, available at <http://ssrn.com/abstract=1017536>, last viewed on November 8, 2007; Eric Goldman, *Deregulating Relevancy in Internet Trademark Law*, 54 EMORY LAW JOURNAL 507, 546 (2005); Mark Lemley, *The Modern Lanham Act and the Death of Common Sense*, 108 YALE L J 1687, 1698-1699 (1999); Graeme Dinwoodie and Mark Janis, *Confusion Over Use: Contextualism in Trademark Law*, 92 IOWA L R 1597 (2007); Stacey Dogan and Mark Lemley, *Grounding Trademark Law Through Trademark Use*, 92 IOWA L R 1669 (2007); Graeme Dinwoodie and Mark Janis, *Lessons from the Trademark Use Debate*, 92 IOWA L R 1703 (2007).

<sup>25</sup> See, for example, *Julia Fiona Roberts v Russell Boyd*, WIPO Case No. D2000-0210, 30 May, 2000 (available at <http://www.wipo.int/amc/en/domains/decisions/html/2000/d2000-0210.html>) (involving juliaroberts.com domain name); *Tom Cruise v Alberta Hot Rods*, WIPO Case No D2006-0560, 5 July, 2006 (available at <http://www.wipo.int/amc/en/domains/decisions/html/2006/d2006-0560.html>) (involving tomcruise.com domain name); *Kevin Spacey v Alberta Hot Rods*, National Arbitration Forum Claim No 114437, August 1, 2002 (available at <http://www.arb-forum.com/domains/decisions/114437.htm>) (involving the domain name kevinspacey.com); *Anna Nicole Smith v DNS Research Inc*, Claim No. FA0312000220007, National Arbitration Forum, Feb 21, 2004 (available at: <http://www.adrforum.com/domains/decisions/220007.htm>) (involving annanicolesmith.com domain name); *Bjorn Borg v Miguel Garcia*, WIPO Case No. D2007-0591, June 21, 2007 (available at: <http://www.wipo.int/amc/en/domains/decisions/html/2007/d2007-0591.html>) (involving the domain name bjornborg.com); *Hillary Rodham Clinton v Michele Dinoia*, National Arbitration Forum Claim No FA0502000414641, March 18, 2005 (full text available at <http://www.arb-forum.com/domains/decisions/414641.htm>) (involving hillaryclinton.com domain name); *Bruce Springsteen v Jeff Burgar*, WIPO Case No D2000-1532, Jan 25, 2001 (available at <http://www.wipo.int/amc/en/domains/decisions/html/2000/d2000-1532.html>).

<sup>26</sup> See topranker.in, *Search Engine Optimization*, (“Search engines give top priority for the keyword occurring in domain name in Search Engine Result Pages (SERP).”) (available at

domain names have an important *referential* function. In other words, if I want to recommend a given website to a friend or colleague, I will likely refer to it by its domain name, and not by the search steps I took to find it. An intuitive domain name is therefore still extremely important even in the age of sophisticated search engine technology.

## I. PERSONAL DOMAIN NAME DISPUTES AND TRADEMARK LAW

### A. CATEGORIZING PERSONAL DOMAIN NAME DISPUTES

Different classes of individuals have differing concerns about the use of their names in cyberspace. From past judicial and arbitral decisions, it seems that the major classes of disputes involving personal domain names can be divided into three categories respectively involving: (a) celebrities' names, (b) politicians' and public figures' names, and (c) private individuals' names. These categories, perhaps unsurprisingly, match the categories of persona protected historically by the right of publicity tort. The tort focuses on rights in personas and has developed rules, admittedly somewhat disharmonized,<sup>27</sup> that at least begin to cater to the different needs of these different classes of people, and to balance those needs against competing societal interests in free speech. The right of publicity is not perfect,<sup>28</sup> but could be used, with some tweaking, as the basis for an efficient online arbitration mechanism for personal domain name disputes.

#### 1. Celebrities' Names

The most prominent category of disputes involving personal names in the domain space revolves around celebrities' names: that is, people who are famous for their commercial activities in fields such as music,<sup>29</sup> television,<sup>30</sup> movies,<sup>31</sup> and sports.<sup>32</sup> These

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[http://www.topranker.in/important\\_seo\\_tips\\_for\\_domain\\_name.htm#seo\\_tips\\_for\\_domain\\_name](http://www.topranker.in/important_seo_tips_for_domain_name.htm#seo_tips_for_domain_name), last viewed on November 24, 2007).

<sup>27</sup> GILSON LALONDE, *supra* note \_\_\_\_, at § 2.16[1] (“The publicity right is still developing and the courts are far from unanimous in defining its scope.”); GRAEME DINWOODIE AND MARK JANIS, TRADEMARKS AND UNFAIR COMPETITION: LAW AND POLICY, 813 (2004) (“Most states have recognized either statutory or common law rights of publicity. In the remaining jurisdictions, right of publicity claims have not been asserted in recent reported decisions ...”) [hereinafter, “TRADEMARKS AND UNFAIR COMPETITION”]; Alice Haemmerli, *Whose Who? The Case for a Kantian Right of Publicity*, 49 DUKE L J 383, 389 (1999) (“Existing practice [under the right of publicity] is ... confused, with fifty state regimes protecting differing aspects of identity, for varied terms, and with disparate remedies.”)

<sup>28</sup> It is equally arguable that some other body of law from another jurisdiction, such as privacy rights jurisprudence from Europe, or “misleading and deceptive conduct” jurisprudence in Australia (Trade Practices Act 1974, § 52, Aust.) could be used as the substantive basis for a PDRP. The American law is chosen here because it appears to deal the most directly with the kinds of disputes that are arising in the <name.com> space. This may be because much of the celebrity industry is based in the United States, notably California, and many of these disputes involve celebrity names.

<sup>29</sup> See, for example, *Bruce Springsteen v Jeff Burgar and Bruce Springsteen Club*, WIPO Case No. D2000-1532, Jan. 25, 2001 (available at <http://arbiter.wipo.int/domains/decisions/html/2000/d2000-1532.html>) (involving bruce springsteen.com domain name); *Madonna Ciccone v Dan Parisi*, WIPO Case No. D2000-0847, Oct. 12, 2000 (available at

people probably have the most commercially valuable personal names in the sense that they trade to a large extent on their names and likenesses for their livelihood.<sup>33</sup> However, this kind of trading on a personal name does not automatically mean that the name functions as a trademark. Trademarks are defined in the Lanham Act to include “any word, name, symbol, or device, or any combination thereof...used by a person ... to identify and distinguish his or her goods ... from those manufactured or sold by others and to indicate the source of the goods...”<sup>34</sup>

A celebrity will not theoretically have a trademark or service mark in her name simply by virtue of being famous. There must be products or services associated with her name, and her name must be used to distinguish her products or services from those sold by others. Nevertheless, celebrities have generally relied on the trademark-focused UDRP to bring complaints about unauthorized uses of their names in the domain space. This is largely because the UDRP is the simplest and most cost-effective procedural avenue for them to take,<sup>35</sup> even though it was never intended that the UDRP would

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<http://www.wipo.int/amc/en/domains/decisions/html/2000/d2000-0847.html> (involving Madonna.com domain name); *Experience Hendrix LLC v Denny Hammerton*, WIPO Case No. D2000-0364, August 2, 2000, *aff'd* August 15, 2000 (available at <http://www.wipo.int/amc/en/domains/decisions/html/2000/d2000-0364.html>) (involving jimihendrix.com domain name).

<sup>30</sup> *Anna Nicole Smith v DNS Research Inc*, Claim No. FA0312000220007, National Arbitration Forum, Feb 21, 2004 (available at: <http://www.adrforum.com/domains/decisions/220007.htm>) (involving annanicole-smith.com domain name).

<sup>31</sup> *Julia Fiona Roberts v Russell Boyd*, WIPO Case No. D2000-0210, 30 May, 2000 (available at <http://www.wipo.int/amc/en/domains/decisions/html/2000/d2000-0210.html>) (involving juliaroberts.com domain name); *Tom Cruise v Alberta Hot Rods*, WIPO Case No D2006-0560, 5 July, 2006 (available at <http://www.wipo.int/amc/en/domains/decisions/html/2006/d2006-0560.html>) (involving tomcruise.com domain name); *Kevin Spacey v Alberta Hot Rods*, National Arbitration Forum Claim No 114437, August 1, 2002 (available at <http://www.arb-forum.com/domains/decisions/114437.htm>) (involving the domain name kevinspacey.com).

<sup>32</sup> See, for example *Bjorn Borg v Miguel Garcia*, WIPO Case No. D2007-0591, June 21, 2007 (available at: <http://www.wipo.int/amc/en/domains/decisions/html/2007/d2007-0591.html>) (involving the domain name bjornborg.com).

<sup>33</sup> However, there is some dispute about the extent to which they trade on those names in a “trademark sense”. For a general critique of this point in the domain name context, see Anthony Verna, *www.whatsina.name*, 14 SETON HALL J OF SPORTS AND ENT L 153 (2004).

<sup>34</sup> 15 U.S.C. § 1127. “Service marks” are similarly defined in 15 U.S.C. § 1127 (“The term “service mark” means any word, name, symbol, or device, or any combination thereof—  
(1) used by a person, or  
(2) which a person has a bona fide intention to use in commerce and applies to register on the principal register established by this chapter,  
to identify and distinguish the services of one person, including a unique service, from the services of others and to indicate the source of the services, even if that source is unknown. Titles, character names, and other distinctive features of radio or television programs may be registered as service marks notwithstanding that they, or the programs, may advertise the goods of the sponsor.”)

<sup>35</sup> Costs of judicial proceedings can be prohibitive for private individuals: Moreland, *supra* note \_\_\_\_, at 385 (“Prior to the establishment of ICANN Arbitration, recovery of celebrity domain names was an

inadvertently create a situation where personal names are recognized as trademarks in an expansive and unprincipled way. While many UDRP arbitrators have accepted trademark claims in personal names,<sup>36</sup> others have not.<sup>37</sup> It is difficult to ascertain a principled distinction between the different approaches.

While it is possible that a “Julia Roberts movie” might be regarded as a product involving a “Julia Roberts” trademark, this seems unlikely. Audiences may go to see a movie because Julia Roberts stars in it, or they may associate a certain quality of performance with Ms Roberts, but they are unlikely to regard Ms Roberts as the *source* of the movie in a trademark sense. The movie studio that produced the film is more likely to be regarded as the *source* of the movie. It is possible that Ms Roberts’ name is a trademark or service mark when she sells her performance services to movie producers and movie studios. However, this does not seem to be the basis on which UDRP arbitrators decided that she had trademark rights in her name.<sup>38</sup> There was very little discussion of the point in the *Roberts* arbitration, other than the arbitrators acknowledging that a mark does not have to be registered to attract the protection of the UDRP.<sup>39</sup> There is a suggestion in the *Roberts* arbitration, and in other UDRP decisions involving personal names, that the name of an *author* of a creative work, such as the

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expensive and potentially lengthy process.”); Jessica Litman, *The DNS Wars: Trademarks and the Internet Domain Name System*, 4 J. SMALL & EMERGING BUS. L. 149, 155 (2000) (noting the often prohibitive cost of trademark infringement and dilution litigation in early domain name disputes).

<sup>36</sup> See, for example, *Julia Fiona Roberts v Russell Boyd*, WIPO Case No. D2000-0210, 30 May, 2000, ¶ 6 (available at <http://www.wipo.int/amc/en/domains/decisions/html/2000/d2000-0210.html>); *Tom Cruise v Alberta Hot Rods*, WIPO Case No D2006-0560, 5 July, 2006 (available at <http://www.wipo.int/amc/en/domains/decisions/html/2006/d2006-0560.html>); *Kevin Spacey v Alberta Hot Rods*, National Arbitration Forum Claim No FA0205000114437, August 1, 2002, available at <http://domains.adrforum.com/domains/decisions/114437.htm>, last viewed on November 8, 2007.

<sup>37</sup> *Bruce Springsteen v Jeff Bugar and Bruce Springsteen Club*, WIPO Case No. D2000-1532, Jan. 25, 2001, ¶ 6 (available at <http://arbiter.wipo.int/domains/decisions/html/2000/d2000-1532.html>); *Anna Nicole Smith v DNS Research Inc*, National Arbitration Forum Claim No FA0312000220007, Feb 21, 2004 (available at <http://www.adr-forum.com/domains/decisions/220007.htm>, last viewed on October 25, 2007); *The Hebrew University of Jerusalem v Alberta Hot Rods*, WIPO Case No. D2002-0616, October 7, 2002, (available at <http://www.wipo.int/amc/en/domains/decisions/html/2002/d2002-0616.html>) (involving a complaint with respect to the domain name <alberteinstein.com>); *Gordon Sumner aka Sting v Michael Urvan*, WIPO Case No D2000-0596, July 20, 2000, ¶ 6.5 (available at <http://www.wipo.int/amc/en/domains/decisions/html/2000/d2000-0596.html>), last viewed on November 8, 2007 (“In the opinion of this Administrative Panel, it is doubtful whether the Uniform Policy is applicable to this dispute. 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.”).

<sup>38</sup> *Julia Fiona Roberts v Russell Boyd*, WIPO Case No. D2000-0210, 30 May, 2000, ¶ 6 (available at <http://www.wipo.int/amc/en/domains/decisions/html/2000/d2000-0210.html>).

<sup>39</sup> *id.* (“A recent decision citing English law found that common law trademark rights exist in an author’s name. The Policy does not require that the Complainant should have rights in a registered trademark or service mark. It is sufficient that the Complainant should satisfy the Administrative Panel that she has rights in common law trademark or sufficient rights to ground an action for passing off.”)

author of a book, may be regarded as a trademark.<sup>40</sup> However, even if this test for trademark status is correct, an actor in a film is not the film's author.<sup>41</sup> Under this analysis, it would be more likely that the writer or director of the film was its author – and therefore it would be more sensible to regard their names as trademarks in the context of the film.<sup>42</sup>

Celebrities may have valid reasons for asserting some control over their personal names in the domain space, particularly in the <name.com> space which is probably viewed by most Internet users as the most likely site for a celebrity's authorized online presence. Celebrities may want to control this domain for their own commercial motives – which seems reasonable, particularly if this is in line with current Internet usage norms. For example, Tyra Banks' management company, Bankable Inc, appears to have registered the domain name <tyrabanks.com> precisely for this purpose.<sup>43</sup> It is an official website authorized and operated by Ms Banks, including details about her and her career.<sup>44</sup> Another example is <parishilton.com> which appears to be an authorized website for Paris Hilton, including details of her proposed public appearances and her recently released album.<sup>45</sup>

Celebrities may also want to control relevant domain names to prevent unjust enrichment. In other words, celebrities who may not themselves necessarily want to

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<sup>40</sup> *id.* (“A recent decision citing English law found that common law trademark rights exist in an author's name.”). See also *Hillary Rodham Clinton v Michele Dinoia*, National Arbitration Forum Claim No FA0502000414641, March 18, 2005 (full text available at <http://www.arb-forum.com/domains/decisions/414641.htm>) (Senator Clinton was regarded as having an unregistered trademark right in her personal name in connection with both her political activities and her career as an author of a number of books sold in commerce.).

<sup>41</sup> Verna, *supra* note \_\_\_\_, at 162-163 (“If an author has trademark rights in his or her name, then it must come from the rather singular nature of a novel. Yes, there are editors in the writing process, however, editors do relatively little work compared to the author. A movie, on the other hand, has many other people involved in the process .... Looking at the credits of any major motion picture, there are writers, assistant directors, and people who need to operate the microphone and the camera. There may be more than one scriptwriter. The actors and actresses are just a small part of the motion picture.”)

<sup>42</sup> Although some people would disagree even with this analysis because of the collective creative nature of a motion picture. See Verna, *supra* note \_\_\_\_, at 162-163 (“If an author has trademark rights in his or her name, then it must come from the rather singular nature of a novel. Yes, there are editors in the writing process, however, editors do relatively little work compared to the author. A movie, on the other hand, has many other people involved in the process .... Looking at the credits of any major motion picture, there are writers, assistant directors, and people who need to operate the microphone and the camera. There may be more than one scriptwriter. The actors and actresses are just a small part of the motion picture.”).

<sup>43</sup> See <http://www.whois-search.com/whois/tyrabanks.com>, last viewed on November 7, 2007.

<sup>44</sup> See [www.tyrabanks.com](http://www.tyrabanks.com), last viewed on November 7, 2007.

<sup>45</sup> See [www.parishilton.com](http://www.parishilton.com), last viewed on November 7, 2007. Other examples of apparently official websites run by a famous notable personality are [www.donaldtrump.com](http://www.donaldtrump.com) and [www.trump.com](http://www.trump.com) for Donald Trump.

make commercial profits from using a domain name may nevertheless wish to prevent others from profiting from their name online. If we are at least initially limiting the scope of a PDRP to <name.com> domain names this seems reasonable. It seems sensible to allow a presumption that celebrities' rights in the <name.com> version of their name extend to preventing others from using the name to make a commercial profit from Internet users who are actually seeking the authorized website of the relevant celebrity. This would likely be the result in applying the right of publicity to a <name.com> case where the registrant was making an unauthorized commercial use of the domain name.<sup>46</sup>

Unjust enrichment situations may be broken down into sub-categories. One sub-category might be where a domain name registrant seeks to profit from selling a relevant domain name to someone else even if the registrant herself did not use, or intend to use, the name. This is, in effect, cybersquatting on the domain name.<sup>47</sup> Another sub-category would be where the registrant seeks to derive a commercial profit herself from using the domain name in an unauthorized way. Domain name registrants have, in the past, used <name.com> domain names for websites selling advertising that is unconnected with the celebrity in question. In other words, the registrant uses the celebrity's name in the domain name to draw custom to an advertising website that is otherwise unconnected with that celebrity.<sup>48</sup>

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<sup>46</sup> In fact, a right of publicity action may well support such an action in relation to some other iterations of the name in the domain space, such as <name.net> and <name.org>. However, these actions are seldom taken in current practice because of the costs and jurisdictional issues involved in litigation, as contrasted with a UDRP arbitration: see Part II.B.1 *infra*. This article suggests initially restricting the operation of a PDRP based on the right of publicity to <name.com> names largely as a trial run to see how arbitrators reflect emerging social norms in decisions in respect of the <name.com> space. If there was a later perceived need to expand or otherwise alter the scope of the PDRP, this could be achieved later on in light of developments in <name.com> cases.

<sup>47</sup> However, in the absence of a legitimate trademark interest in the personal name, this conduct should not theoretically run afoul of anti-cybersquatting laws, except for 15 U.S.C. § 1129(1)(A) which does not require the plaintiff to establish a trademark in her personal name: "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 the domain name for financial gain to that person or any third party, shall be liable in a civil action by such person."

<sup>48</sup> *Tom Cruise v Alberta Hot Rods*, WIPO Case No D2006-0560, 5 July, 2006, ¶ 4 (available at <http://www.wipo.int/amc/en/domains/decisions/html/2006/d2006-0560.html>) (respondent had used tomcruise.com domain name to draw custom to a website that advertised products and services unrelated to the well-known actor Tom Cruise). Yet another example of a potential unjust enrichment based claim would be a situation where a registrant is using a domain name in order to sell "vanity emails" that utilize a celebrity's name in the domain server part of the name: for example, <john@jimihendrix.com>: See discussion in Miriam Claire Beezy, *Good Marksmanship*, 29 LOS ANGELES LAWYER 20, 23-24 (2006) (discussion of domain name dispute involving the domain name jimihendrix.com in which the registrant was offering vanity email addresses for sale including the jimihendrix.com domain); *Experience Hendrix LLC v Denny Hammerton*, WIPO Case. No. D2000-0364, August 2, 2000, *aff'd* August 15, 2000 (available at <http://www.wipo.int/amc/en/domains/decisions/html/2000/d2000-0364.html>) (involving jimihendrix.com domain name). If it is true that there is a presumption that famous individuals have some rights to the <name.com> versions of their domain names, then the sale of such vanity emails by someone other than the individual in question, or her authorized representatives, may be unjustified. This does not necessarily mean that another variation of the vanity emails should not be permitted without the person's consent: for example, <john@jimihendrix.org> or <john@jimihendrixfan.com>. This approach thus

Alternatively, a celebrity might want to control a <name.com> domain name to *avoid* any authorized web content about her. In other words, some celebrities may wish to control <name.com> versions of their names to telegraph to the public that they have not authorized any web content about them. Thus, Internet users will find nothing relating to the celebrity under the <name.com> name, and they will be aware that any web content they find under other iterations of the celebrity's name is likely to be unauthorized content. In some ways, this analogizes to a kind of privacy protection allowing the celebrity to communicate to the public her desire not to exploit her own image online, and perhaps implicitly requesting privacy considerations from others. Examples of this are found in the *Julia Roberts*<sup>49</sup> and *Tom Cruise*<sup>50</sup> UDRP arbitrations. In each of these cases, the celebrity in question arbitrated successfully for control of a relevant <name.com> domain name. Currently, the related websites host no content about either of them. Again, such a result does not necessarily chill speech about celebrities online. Many other domain names are available for fans and critics who want to communicate about those people. Search engines will also help Internet users find unauthorized content about individuals posted under less intuitive domain names.

The interests identified above in both commercial control of <name.com> names and in privacy protections of a celebrity persona match the emphases of the right of publicity tort much more so than trademark law. The right of publicity tort has been explained variously on the basis of economic property rights in an individual's name or likeness,<sup>51</sup> a need to prevent free riding or unjust enrichment,<sup>52</sup> and the need to protect a

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allows individuals to make expressive uses of their idols' names without unduly interfering with presumptions about what the individual may have authorized in cyberspace.

<sup>49</sup> *Julia Fiona Roberts v Russell Boyd* Case No. D2000-0210, May 29, 2000, WIPO Arbitration and Mediation Center (full text available at <http://www.wipo.int/amc/en/domains/decisions/html/2000/d2000-0210.html>, last viewed on November 6, 2007).

<sup>50</sup> *Tom Cruise v Alberta Hot Rods*, WIPO Case No D2006-0560, 5 July, 2006 (available at <http://www.wipo.int/amc/en/domains/decisions/html/2006/d2006-0560.html>).

<sup>51</sup> Various justifications have been put forward for a property basis for personality rights, and have equally been criticized over the years. For a discussion of property theory in this context, see Dogan and Lemley, *Right of Publicity*, *supra* note \_\_\_\_, 1181-1183 (critique of Lockean labor theory justifications for personality rights as property); Mark McKenna, *The Right of Publicity and Autonomous Self-Definition*, 67 U PITT L REV 225, 247 (2005) ("It might be true that identity is sufficiently similar to other objects the law regards as property and therefore deserves at least some of the sticks in the traditional bundle of property rights. But far too few courts and commentators have offered a theory as to why any of the traditional property justifications lead to that conclusion."); 251-267 (critique of Lockean labor theory justifications for property rights in personal identity); Haemmerli, *supra* note \_\_\_\_, 388 ("Both proponents and critics of the right of publicity generally perceive it as a property claim grounded in Lockean labor theory."); 407-8 (noting dual property and privacy justifications for right of publicity actions), 412 ("To the extent that commentators specifically address publicity rights, they tend to do so within this property context, and to use Lockean labor theories of property to explain the assertion of a property right in identity or persona."); Roberta Kwall, *Fame*, 73 INDIANA LJ 1, 15 (1997) [hereinafter, *Fame*] ("This Article ... contends that a property-based conception for publicity rights is the natural outgrowth of our cultural norms as well as our theoretical conceptions of property."); David Westfall and David Landau, *Publicity Rights as Property Rights*, 23 CARDOZO ARTS AND ENT LJ 71 (2005) (examining property basis for rights of publicity); Eileen Rielly, *The Right of Publicity for Political Figures: Martin Luther King, Jr, Center for Social Change, Inc*

person's privacy from unauthorized commercial interference.<sup>53</sup> Personality rights jurisprudence has also dealt extensively with issues of balancing the public's interest in free speech about a celebrity with the celebrity's interest in controlling her public persona.<sup>54</sup> Although these are difficult issues that have not been definitively resolved even within the right of publicity, this body of law has at least started to meaningfully address these concerns and develop responses to them. Trademark law, on the other hand, even the trademark laws focused on preventing cybersquatting, are not geared

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*v American Heritage Products*, 46 U PITT L REV 1161, 1165-9 (1985) (describing development of a property rights rationale for the right of publicity). See also Diane Zimmerman and Melissa Jacoby, *Foreclosing on Fame: Exploring the Uncharted Boundaries of the Right Of Publicity*, 77 N.Y.U. L. REV. 1322 (2002).

<sup>52</sup> Dogan and Lemley, *Right of Publicity*, *supra* note \_\_\_, at 1181-3 (critique of unjust enrichment explanation of rights of publicity); Sarah Kinsky, *Publicity Dilution: A Proposal for Protecting Publicity Rights*, 21 SANTA CLARA COMPUTER AND HIGH TECH L J 347 (2005) (recognition of unjust enrichment, along with Lockean theory and several other theoretical justifications as explanations for the right of publicity); McKenna, *supra* note \_\_\_, at 247-248 (critique of unjust enrichment theories of the right of publicity); Michael Madow, *Private Ownership of Public Image: Popular Culture and Publicity Rights*, 81 CALIF L REV 125, 196-204 (1993) (critique of unjust enrichment rationales for the right of publicity).

<sup>53</sup> Dogan and Lemley, *Right of Publicity*, *supra* note \_\_\_, 1208-1210 (critique of privacy based justifications for the right of publicity); Madow, *supra* note \_\_\_, 167-8 (discussion of privacy rights basis for some early right of publicity cases); McKenna, *supra* note \_\_\_, at 285 ("Since all individuals share the interest in autonomous self-definition, every individual should be able to control uses of her identity that interfere with her ability to define her own public character."), 286 ("Compelling a person to express a message herself presents a particular sort of threat to her freedom of belief: It threatens her ability to control what she tells the world about who she is and what she holds important ..."); Haemmerli, *supra* note \_\_\_, at 407-8 (describing theoretical muddle between property and privacy theory underlying rights of publicity claims); Eileen Rielly, *The Right of Publicity for Political Figures: Martin Luther King, Jr, Center for Social Change, Inc v American Heritage Products*, 46 U PITT L REV 1161, 1164-5 (1985) (description of privacy foundations of the right of publicity).

<sup>54</sup> Haemmerli, *supra* note \_\_\_, at 441-458 (analysis of First Amendment issues arising with respect to the right of publicity); Peter Felcher and Edward Rubin, *Privacy, Publicity, and the Portrayal of Real People by the Media*, 88 YALE LJ 1577, 1590 (1979) ("The First Amendment inevitably defines the operation and extent of the right of publicity; once the defendant can establish that the expression in question is protected, he will almost invariably prevail."); Roberta Kwall, *The Right of Publicity vs. the First Amendment: A Property and Liability Rule Analysis*, 70 INDIANA L J 47 (1994) [hereinafter, *First Amendment*] (suggesting a property versus liability rule basis for balancing First Amendment concerns against right of publicity claims); Eileen Rielly, *The Right of Publicity for Political Figures: Martin Luther King, Jr, Center for Social Change, Inc v American Heritage Products*, 46 U PITT L REV 1161, 1172-4 (1985) (balancing First Amendment concerns with the publicity rights of public figures and politicians); Madow, *supra* note \_\_\_, at 140 (description of the role of the consumer as an active and creative participant in the creation of cultural commodities); Kwall, *Fame*, *supra* note \_\_\_, at 46-7 ("We do not deprive the owners of famous trademarks or the copyright owners of popular works of art or literature of their rights just because the public has played some role in placing a value on these works. Therefore, right-of-publicity critics must justify why the cachet of a person's fame should be treated differently."). See also Diane Zimmerman, *Who Put the Right in the Right of Publicity?*, 9 DEPAUL-LCA J. ART & ENT. L. 35 (1998).

towards such balances of interests. They are aimed predominantly<sup>55</sup> at protecting valuable trademarks against unauthorized commercial uses.<sup>56</sup> Where trademark cases have dealt with free speech, the inquiry has focused on balancing the integrity of commercial source indicators against First Amendment concerns,<sup>57</sup> rather than on balancing the integrity of individual personas against the First Amendment. Personality rights jurisprudence has developed responses to questions about balancing First Amendment concerns against rights in individual personas.<sup>58</sup> Thus, the personality rights tort is more suited to personal domain name disputes than trademark law in most cases.

## 2. Politicians' and Public Figures' Names

Politicians and other public figures may also have concerns about the use of their personal names in domain names. These concerns may differ in some ways from those of celebrities, and may be valid to the extent that they do not unduly interfere with freedom of expression in the political process.<sup>59</sup> Again, trademark law is not a good fit for

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<sup>55</sup> The cyberpiracy provisions in 15 U.S.C. § 1129(1) are an exception to this as they are premised on the protection of personal names against cyberpiracy and do not require the plaintiff to establish a trademark interest in her personal name to succeed on a claim under the provision.

<sup>56</sup> Outside of the UDRP, see, for example, 15 U.S.C. § 1114 (infringement of registered trademark by creating consumer confusion as to source of goods or services); 15 U.S.C. § 1125(a) (infringement of unregistered mark); 15 U.S.C. § 1125(c) (trademark dilution through tarnishment or blurring); 15 U.S.C. § 1125(d) (cybersquatting in relation to domain names corresponding with trademarks), § 1129(1) (cyberpiracy in relation to domain names corresponding with personal names).

<sup>57</sup> See, for example, *Mattel, Inc v MCA Records, Inc*, 296 F 3d 894 (2002) (balancing expressive interests of popular singers in using the “Barbie” trademark in their “Barbie Girl” song). It is worth noting that some cases have dealt with the balance of free speech against trademark claims and right of publicity claims in the alternative: see, for example *Rogers v Grimaldi*, 875 F 2d 994 (1989) (dealing with the use of Ginger Rogers’ personal name in a movie title for a movie about two cabaret performers who imitated Ginger Rogers and Fred Astaire).

<sup>58</sup> Haemmerli, *supra* note \_\_\_\_, at 441-458 (analysis of First Amendment issues arising with respect to the right of publicity); Peter Felcher and Edward Rubin, *Privacy, Publicity, and the Portrayal of Real People by the Media*, 88 YALE LJ 1577, 1590 (1979) (“The First Amendment inevitably defines the operation and extent of the right of publicity; once the defendant can establish that the expression in question is protected, he will almost invariably prevail.”); Kwall, *First Amendment*, *supra* note \_\_\_\_ (suggesting a property versus liability rule basis for balancing First Amendment concerns against right of publicity claims); Eileen Rielly, *The Right of Publicity for Political Figures: Martin Luther King, Jr, Center for Social Change, Inc v American Heritage Products*, 46 U PITT L REV 1161, 1172-4 (1985) (balancing First Amendment concerns with the publicity rights of public figures and politicians); Madow, *supra* note \_\_\_\_, at 140 (description of the role of the consumer as an active and creative participant in the creation of cultural commodities); Kwall, *Fame*, *supra* note \_\_\_\_, at 46-7 (“We do not deprive the owners of famous trademarks or the copyright owners of popular works of art or literature of their rights just because the public has played some role in placing a value on these works. Therefore, right-of-publicity critics must justify why the cachet of a person’s fame should be treated differently.”). See also Diane Zimmerman, *Who Put the Right in the Right of Publicity?*, 9 DEPAUL-LCA J. ART & ENT. L. 35 (1998).

<sup>59</sup> See, for example, *New York Magazine v The Metropolitan Transit Authority and the City of New York*, 987 F Supp 254 (1997), *aff’d in part, vacated in part, New York Magazine v The Metropolitan Transit Authority and the City of New York*, 136 F.3d 123 (1998) (on balancing Mayor Rudolph Giuliani’s rights of privacy and publicity against the First Amendment); Eileen Rielly, *The Right of Publicity for*

balancing competing interests in such names. Even if some famous celebrities, such as authors,<sup>60</sup> have trademarks in their names for reasons explained *supra*, politicians are less likely to hold such trademarks.<sup>61</sup> Most politicians do not use their names as source indicators as required by trademark law.<sup>62</sup> Rather, they use their names to raise public awareness about particular issues<sup>63</sup> and, in the case of politicians, often in the context of a political campaign. These names often have a temporal quality that is particularly significant to the democratic process. If, for example, electors are voting on a particular issue, a given domain name might be extremely valuable in the lead-up to an election and much less valuable thereafter<sup>64</sup> - both in the hands of the person whose name it is and in the hands of others.

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*Political Figures: Martin Luther King, Jr, Center for Social Change, Inc v American Heritage Products*, 46 U PITT L REV 1161, 1172-4 (1985) (describing need to balance First Amendment interests in political debate against the publicity rights of politicians and public figures); *Wilson v Brown*, 73 N.Y.S. 2d 587, 589 (Sup. Ct. Kings Co. 1947) (“One who takes an office, whether it is in government or in outside organizations, must be deemed to have agreed to any reasonable public use of, or reference to, his name .... Persons who accept high positions ought not to be so tender about the mention of their names; they must bear “the white light that beats upon a throne.” If they want peace and privacy they should stay out of public life; if they object to having their names legitimately mentioned they need only to resign and they will quickly subside into happy obscurity.”)

<sup>60</sup> Of course, where a politician is also an author, she may assert trademark rights in her name under this analysis. See, for example, *Hillary Rodham Clinton v Michele Dinoia*, National Arbitration Forum Claim No FA0502000414641, March 18, 2005 (full text available at <http://www.arb-forum.com/domains/decisions/414641.htm>) (Senator Clinton was regarded as having an unregistered trademark right in her personal name in connection with both her political activities and her career as an author of a number of books sold in commerce.)

<sup>61</sup> Jacqueline Lipton, *Who Owns Hillary.com? Political Speech and the First Amendment in Cyberspace*, 49 BOSTON COLLEGE L REV 55 (2008); Report of the Second WIPO Internet Domain Name Process, Sept 3, 2001, ¶ 188, available at <http://www.wipo.int/amc/en/processes/process2/report/html/report.html#5>, last viewed on November 11, 2007 (“the names of political figures, religious leaders, scientists and historical persons may never have been used in commerce and, thus, are unlikely to have trademarks associated with them.”). However, some politicians have been regarded as having commercial trademark rights in their personal names in relation to certain commercial activities: *Hillary Rodham Clinton v Michele Dinoia*, National Arbitration Forum Claim No FA0502000414641, March 18, 2005 (full text available at <http://www.arb-forum.com/domains/decisions/414641.htm>) (Senator Clinton was regarded as having an unregistered trademark right in her personal name in connection with both her political activities and her career as an author of a number of books sold in commerce.)

<sup>62</sup> See definitions of “trademark” and “service mark” in 15 U.S.C. § 1127.

<sup>63</sup> That is not to say that celebrities do not also get involved in public interest issues – it is just more typical of politicians in their day to day activities.

<sup>64</sup> There can also obviously be temporal aspects to a celebrity’s fame. However, the temporal issues can be more pronounced and more important in the lead-up to an election where election day is effectively the deadline for a politician to get her message across to the electorate. The temporal issues in politics are also much more significant to the operation of a representative democracy than temporal issues relating to a celebrity’s fame which are likely to have more to do with the creation and waning of public interest in cultural commodities at any given point in time.

The kind of balancing exercise needed to protect a politician's interests in her personal identity against the need of the public to engage in discourse about her will be different to balancing speech and commerce under trademark law. The First Amendment is likely to be more seriously implicated in the political context than in the commercial context.<sup>65</sup> This is yet another area in which personality rights jurisprudence may be helpful because of its developed focus on protecting different classes of individuals against improper use of their names and personas. The right of publicity has already developed rules for protecting politicians and public figures against certain unauthorized intrusions,<sup>66</sup> while at the same time promoting society's interests in free speech where these interests should override a public figure's desire not to have her name or likeness used in a certain way.<sup>67</sup>

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<sup>65</sup> *New York Magazine v The Metropolitan Transit Authority and the City of New York*, 987 F Supp 254, 262 (1997), *aff'd in part, vacated in part*, *New York Magazine v The Metropolitan Transit Authority and the City of New York*, 136 F.3d 123 (1998) (discussing continuum of protections available under the First Amendment for political versus commercial speech about politicians in the right of publicity context).

<sup>66</sup> Notable examples of right of publicity cases in which courts were concerned about the personality rights of politicians or public figures include: *New York Magazine v The Metropolitan Transit Authority and the City of New York*, 987 F Supp 254 (1997), *aff'd in part, vacated in part*, *New York Magazine v The Metropolitan Transit Authority and the City of New York*, 136 F.3d 123 (1998) (involving then New York City Mayor Rudolph Giuliani's public image in relation to an advertising campaign on city buses); *Rosa Parks v LaFace Records*, 329 F 3d 437 (2003) (involving publicity rights of Rosa Parks in the context of a song title using her name in relation to a hip hop recording that had nothing in particular to do with her or her work); *Martin Luther King Jr, Center for Social Change Inc v American Heritage Products*, 694 F 2d 674 (11<sup>th</sup> Cir. 1993) (the estate of Martin Luther King Jr sought an injunction to prevent the defendant from selling plastic busts of Dr King).

<sup>67</sup> *New York Magazine v The Metropolitan Transit Authority and the City of New York*, 987 F Supp 254, 266 (1997), *aff'd in part, vacated in part*, *New York Magazine v The Metropolitan Transit Authority and the City of New York*, 136 F.3d 123 (1998) ("as a highly visible public figure Giuliani's interest in his privacy is very limited. One who chooses to be the Mayor of the "Big Apple" must expect that he will be the subject of all kinds of public comments, even in advertisements.") Of course publicity rights jurisprudence is not perfect in the political context. It is disharmonized common law that has not yet had an international reach: GILSON LALONDE, *supra* note \_\_\_, at § 2.16[1] ("The publicity right is still developing and the courts are far from unanimous in defining its scope."); GRAEME DINWOODIE AND MARK JANIS, *TRADEMARKS AND UNFAIR COMPETITION: LAW AND POLICY*, 813 (2004) ("Most states have recognized either statutory or common law rights of publicity. In the remaining jurisdictions, right of publicity claims have not been asserted in recent reported decisions ...") [hereinafter, "TRADEMARKS AND UNFAIR COMPETITION"]; Alice Haemmerli, *Whose Who? The Case for a Kantian Right of Publicity*, 49 DUKE L J 383, 389 (1999) ("Existing practice [under the right of publicity] is ... confused, with fifty state regimes protecting differing aspects of identity, for varied terms, and with disparate remedies."); Report of the Second WIPO Internet Domain Name Process, Sept 3, 2001, ¶ 173, available at <http://www.wipo.int/amc/en/processes/process2/report/html/report.html#5>, last viewed on November 11, 2007 ("Because of the diversity of interests affected by the treatment of personal names, the legal principles and policies that can be deployed to protect personal names are similarly diverse and vary, as might be expected, from country to country. These legal principles and policies include the right to publicity or the right to control the commercial use of one's identity, recognized in many States of the United States of America; the tort of unfair competition; the tort of passing-off (conceptually treated, in many cases, as part of the law of unfair competition), recognized generally in common-law countries; and the right to privacy."). Nevertheless, it is the most developed attempt at creating workable interests in individual personas, and balancing those interests against the rights of the public to engage in discourse about famous people.

Politicians and public figures will naturally have some concerns about unauthorized uses of <name.com> domains that mirror those of celebrities. An obvious example is cybersquatting. A cybersquatter may well register either a celebrity's name or a politician's name in the hopes of making a commercial profit from its transfer. There may be situations in which cybersquatting is more serious for a politician than a celebrity in terms of practical consequences of failing to secure control of a given name. For example, in the lead-up to an election, a politician will likely have a strong desire to control a domain name relating to her personal name, particularly the <name.com> version, as the Internet has become a very important tool for communicating with the electorate and also for political fundraising.<sup>68</sup>

Like celebrities, politicians and public figures will also have concerns about situations where a domain name registrant is not cybersquatting on a given name, but rather wants to use the name herself for some expressive or commercial purpose. Where the purpose is purely commercial, the right of publicity would presumably proscribe the conduct on the basis that the tort prohibits unauthorized commercial exploitations of a person's name or likeness.<sup>69</sup> Where the purpose is expressive, it is likely that the registrant's intention is to harm the politician in question. Given the temporal importance of political domain names, particularly in the lead-up to elections, a supporter of a politician would presumably not wish to keep the name from the politician.<sup>70</sup> However, a critic may well want to use the name to express views critical of the politician.

An opposing party or candidate may be highly motivated to engage in such conduct. Because of the importance of free speech in the political process, these uses of a

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<sup>68</sup> Most politicians now run websites where supporters can donate funds to their campaigns. See, for example, [www.hillaryclinton.com](http://www.hillaryclinton.com) (last viewed on November 8, 2007), [www.barackobama.com](http://www.barackobama.com) (last viewed on November 8, 2007). Senator Obama's website has a rather sophisticated fundraising project where individuals can set up accounts and set fundraising goals that they plan to achieve to support the senator's campaign – see <http://my.barackobama.com/page/outreach/login/main>, last viewed on November 8, 2007. Little has been written about the impact of the Internet on political fundraising to date. For a survey of Howard Dean's use of the Internet in his run for the 2004 presidential ticket, see Abigail Brown, *Politics, Innovation, and the Internet: A Source of Howard Dean's Fundraising Success?* (September 6, 2007) (available at [http://papers.ssrn.com/sol3/papers.cfm?abstract\\_id=1012481](http://papers.ssrn.com/sol3/papers.cfm?abstract_id=1012481), last viewed on November 8, 2007) (examining Dean's use of the Internet to set up town hall meetings for campaign and fundraising purposes). On domain name use in politics more generally, see Matthew Coleman, *Domain Name Piracy and Privacy: Do Federal Election Regulations Offer a Solution?*, 19 YALE L & POL'Y REV 235 (2000).

<sup>69</sup> GILSON LALONDE, *supra* note \_\_\_\_, at § 2.16[1] (“The right of publicity ... is the right of an individual to control the commercial use of his or her name, likeness, signature, or other personal characteristics.”).

<sup>70</sup> This may be true of supporters of celebrities in many cases. For example, the registrants of [annanicoeamith.com](http://annanicoeamith.com) argued in a UDRP that they had offered to transfer the name to Ms Smith's management at no cost to them: *Anna Nicole Smith v DNS Research Inc*, National Arbitration Forum Claim No FA0312000220007, Feb 21, 2004 (available at <http://www.adr-forum.com/domains/decisions/220007.htm>, last viewed on October 25, 2007). This situation may be contrasted with the recent dispute over various intellectual property rights allegedly belonging to the popular singer Prince, who is now threatening operators of certain fan websites for their unauthorized use of his image in their websites: see [www.princefansunited.com](http://www.princefansunited.com), last viewed on November 7, 2007.

<name.com> domain name raise important competing aspects of the need for the electorate to communicate effectively about politicians. On the one hand, if *all* political speech is to be protected, regardless of content or forum, then anyone should arguably be entitled to register and use a <name.com> domain name about a politician for any expressive purpose. On the other hand, if there is an expectation that <name.com> domains will resolve to websites authorized by relevant politicians, it could be misleading to allow even purely expressive unauthorized messages about a politician under those domain names. Internet users could be misled in these cases as to the identity of the speaker, and it could make it more difficult for Internet users to find authorized messages by the politicians in question.

There are two recent examples of this conduct in Montana. One involves Bob Keenan, a Republican candidate running for the United States Senate. The domain name <bobkeenan.com> has been registered by the Montana Democratic Party and hosts a website critical of Keenan's past policies and practices. The second example involves a Democratic candidate for Montana Secretary of State, Linda McCulloch. The Montana Republican State Central Committee has registered the domain name <lindamcculloch.com> and is using it for a website critical of McCulloch. Given the lack of likely trademark interest in these politicians' names,<sup>71</sup> it is unlikely that trademark law would help either candidate. The conduct would not even run afoul of the personal name provisions in § 1129(1)(A) of the Lanham Act (which does not require a trademark interest) because technically the registrants of the domain names are not cybersquatters. Section 1129(1)(A) requires an attempt to sell a domain name for profit for liability to attach.<sup>72</sup> The registrants in these scenarios are rather utilizing the names to communicate messages critical of the politicians in question. They are not attempting to sell the names.

There is some state legislation in California that indirectly addresses this question by prohibiting fraudulent and misleading conduct on the Internet in relation to a ballot measure.<sup>73</sup> This would likely catch certain instances of misleading Internet users by registering a domain name similar to a politician's name, particularly in the lead up to an election. However, this approach has not yet been picked up in other states within the United States, let alone at a more global level. In any event, it is not targeted specifically at the protection of individual names from unauthorized uses, but rather deals with ballot measures more generally.<sup>74</sup> Thus, it would not apply outside the electoral context. There

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<sup>71</sup> Often, local politicians, as compared with some federal politicians, are not regarded as having sufficient trademark interests in their names to support trademark-related actions. See, for example, *Kathleen Kennedy Townsend v Birt*, WIPO Case No D2002-0030, April 11, 2002 (available at <http://www.wipo.int/amc/en/domains/decisions/html/2002/d2002-0030.html>) (individual politician in state gubernatorial race held not to hold trademark rights in her personal name).

<sup>72</sup> 15 U.S.C. § 1129(1)(A) ("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 the domain name for financial gain to that person or any third party, shall be liable in a civil action by such person.").

<sup>73</sup> Political Cyberfraud Abatement Act, Cal. Elec. Code, §§ 18320-23.

<sup>74</sup> Cal. Elections Code, § 18320(c)(1) ("Political cyberfraud" means a knowing and willful act concerning a political Web site that is committed with the intent to deny a person access to a political Web

is also some Californian state legislation that deals specifically with unauthorized registrations and uses of domain names corresponding with personal names.<sup>75</sup> This covers all personal names, whether relating to politicians or public figures<sup>76</sup> or otherwise. However, again it only exists in California and is therefore probably not a realistic option to address these issues at least in the short term.

The development of specific principles dealing with uses of personal names in general, and politicians' names in particular, under a new PDRP would be able to more directly deal with the kinds of situations described here. Such an approach would also have the advantage of being globally harmonized. Additionally, a PDRP would not be limited to the electoral context, but would cover all politicians and public figures attempting to use their names to promulgate messages on the Internet, regardless of whether an election was looming at a given time. Importantly, it would take disputes about free speech in the political process away from trademark policy by avoiding UDRP complaints involving politicians' names. The development of online jurisprudence related to free speech in the political process should not be decided by focusing on trademark principles where the conflict in question is not about balancing commercial trademarks against the First Amendment.<sup>77</sup>

### 3. *Private Individuals' Names*

Private individuals' names are different again than those of celebrities or politicians in the issues they raise in the domain space. These names are perhaps less

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site, deny a person the opportunity to register a domain name for a political Web site, or cause a person reasonably to believe that a political Web site has been posted by a person other than the person who posted the Web site, and would cause a reasonable person, after reading the Web site, to believe the site actually represents the views of the proponent or opponent of a ballot measure.”)

<sup>75</sup> California Business and Professions Code, §§ 17525-17526. See, in particular, § 17525(a) (“It is unlawful for a person, with a bad faith intent to register, traffic in, or use a domain name, that is identical or confusingly similar to the personal name of another living person or deceased personality, without regard to the goods or services of the parties.”)

<sup>76</sup> In fact, there is specific mention of using a domain name corresponding with an individual person's name in bad faith to mislead electors: See § 17526(j), California Business and Professions Code, including as a bad faith factor: “The intent of a person alleged to be in violation of this article to mislead, deceive, or defraud voters.”

<sup>77</sup> Nevertheless, disputes about politician's names in domain names have been brought under the UDRP in the past and the focus has been on establishing trademark interests – or lack thereof – in a relevant politician's name, rather than on the balance of speech interests in the political context. See, for example, *Hillary Rodham Clinton v Michele Dinoia*, National Arbitration Forum Claim No FA0502000414641, March 18, 2005 (full text available at <http://www.arb-forum.com/domains/decisions/414641.htm>) (In respect of a dispute involving the <hillaryclinton.com> domain name, Senator Clinton was regarded as having an unregistered trademark right in her personal name in connection with both her political activities and her career as an author of a number of books sold in commerce); *Kathleen Kennedy Townsend v Birt*, WIPO Case No D2002-0030, April 11, 2002 (available at <http://www.wipo.int/amc/en/domains/decisions/html/2002/d2002-0030.html>) (individual politician in state gubernatorial race held not to hold trademark rights in her personal name).

important in the context of this discussion than celebrities' and public figures' names. There are significantly fewer disputed situations involving unauthorized registration and use of private individuals' names on the Internet.<sup>78</sup> A number of disputes involving private individuals' names actually *do* relate to trademark uses of those names where a name has acquired secondary meaning<sup>79</sup> as being synonymous with the relevant person's business activities.<sup>80</sup> Thus, trademark-focused laws, including the UDRP, will, in fact, be appropriate avenues for dispute resolution in many of these cases.

Where a private individual's name is not a trademark in the commercial context, it is unlikely to raise many conflicts in the <name.com> space. There is much less profit to be made by cybersquatting on non-famous names, and little reason to set up gripe sites or parody sites about private individuals. However, one obvious example of where such a situation might arise would be the case where more than one person shares the same personal name and one person controls the name without the consent of the other.<sup>81</sup> This situation is analogous to the case where more than one company legitimately shares the same or similar trademarks in different product or geographic markets.<sup>82</sup> In the absence

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<sup>78</sup> Although there are some cases on record involving the names of private individuals: *Paul Wright v Domain Source Inc.*, 2002 U.S. Dist. LEXIS 16024 (2002); *Trudeau v Lanoue*, 2006 U.S. Dist. LEXIS 7956 (2006); *Stephan Schmidheiny v Steven Weber*, 285 F. Supp. 2d 613 (2003). All of these cases involved personal names used in conjunction with businesses conducted by the complainant.

<sup>79</sup> GILSON LALONDE, *supra* note \_\_\_, at § 2.03[4][d] ("Just as with descriptive terms, a trademark or trade name that consists of a personal name (first name, surname, or both) is entitled to legal protection only if it attains secondary meaning.").

<sup>80</sup> Many businesses, in fact, use their chief officers' names as business names and trademarks: for example, The Trump Organization (owned by Donald Trump). See [www.trump.com](http://www.trump.com), last viewed on January 23, 2008. Of course, because of his participation in the television show "The Apprentice", it is possible that Trump's name also functions as a celebrity name. Nevertheless, due to his business activities (and perhaps also his authorship of several books), Trump's name is likely a trademark. Trump has also registered a variety of permutations of his personal name as registered marks with respect to particular goods and services: <http://tess2.uspto.gov/bin/gate.exe> (result of United States Patent and Trademark Office Search for "Trump" trademark conducted on January 23, 2008).

<sup>81</sup> Ultimately, this was what happened in the paulwright.com dispute: *Paul Wright v Domain Source Inc.*, 2002 U.S. Dist. LEXIS 16024 (2002). Although the plaintiff was successful in an action to have the domain name paulwright.com transferred back to him by a defendant cybersquatter, the order was conditional on no third party having acquired bona fide rights in the name. Another person called Paul Wright had the paulwright.com domain name transferred to him before the court order went into effect so the plaintiff never regained control of the name.

<sup>82</sup> Stuart Weinstein, *The Cyberpiracy Prevention Act: Reconciling Real Space Sectoral and Geographic Distinctions in the Use of Internet Domain Names Under the Lanham Act*, 9 U MIAMI BUS L REV 145, 158 (2001) ("an entity may use an identical mark as another, as long as he does not use that mark within the same sector or industry. As with geographical protection of a user's mark, the scope of protection is determined as an evidentiary matter, looking at the likelihood of consumer confusion."); David Barrett, *The Future of the Concurrent Use of Trademarks Doctrine in the Information Age*, 23 HASTINGS COMM AND ENT LJ 687, 689-692 (2001) (examining American legislative history of the "concurrent use" doctrine in trademark law which allows different trademark holders to use similar marks in different geographic areas); *Dawn Donut Co v Hart's Food Stores, Inc.*, 267 F 2d 358 (2d Cir. 1959) (holding no likelihood of confusion in case where plaintiff and defendant used similar marks in different product markets and different jurisdictions); *National Association for Healthcare Communications, Inc v Central Arkansas Area*

of some kind of domain name sharing strategy,<sup>83</sup> it may be that the “first come, first served” rule has to apply here.<sup>84</sup>

More relevant to this discussion would be the admittedly less usual case where someone registered one or more domain names relating to private individuals’ names either in the hope of extracting money from those individuals for transfer of the names,<sup>85</sup> or, perhaps more likely, extracting money for offering web hosting services under the names. The first iteration of this conduct – the pure sale motive – sounds like cybersquatting, but probably is not covered by trademark law because private, non-commercial personal names will generally not be trademarked.<sup>86</sup> It may be covered in the United States by § 1129(1)(A) of the Lanham Act which does not require a trademark in a personal name to support a cybersquatting action.<sup>87</sup> The second iteration may or may

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*Agency on Aging Inc.*, 257 F.3d 732 (8<sup>th</sup> Cir. 2001) (granting injunction against federal trademark owner in order to allow user of the same mark to use it in established six county area in California); Jessica Litman, *The DNS Wars: Trademarks and the Internet Domain Name System*, 4 J. SMALL & EMERGING BUS. L. 149, 152 (2000) (“Out here in meat space, we can have a whole bunch of different owners of Acme as a trademark - the last time I counted there were more than a hundred different trademark registrations, in addition to all the local unregistered Acme marks you can find by just looking in the telephone book. On the Internet, only one person can own acme.com.”); Jacqueline Lipton, *A Winning Solution for Youtube and Utube? Corresponding Trademarks and Domain Name Sharing*, (forthcoming, HARVARD JOURNAL OF LAW AND TECHNOLOGY, 2008) (suggesting a domain name sharing mechanism for situations where two legitimate trademark holders are asserting rights in the same domain name simultaneously).

<sup>83</sup> Jacqueline Lipton, *A Winning Solution for Youtube and Utube? Corresponding Trademarks and Domain Name Sharing*, (forthcoming, HARVARD JOURNAL OF LAW AND TECHNOLOGY, 2008) (suggesting a domain name sharing mechanism for situations where two legitimate trademark holders are asserting rights in the same domain name simultaneously); Eric Goldman, *Deregulating Relevancy in Internet Trademark Law*, 54 EMORY LAW JOURNAL 507, 546 (2005) (“some domain names resolve to a “gateway page” (also referred to as a “shared page” or “intermediate page”) for the sole purpose of allowing multiple trademark owners or licensees to “share” the domain name through links on the page to their respective sites”).

<sup>84</sup> Jessica Litman, *The DNS Wars: Trademarks and the Internet Domain Name System*, 4 J. SMALL & EMERGING BUS. L. 149, 151 (2000) (“Network Solutions registered .com domain names on a first-come first-served basis, just as all the Internet domain names had always been allocated.”); Stephen Moccaldi, *Do Any Viable Solutions Exist to Prevent The Exploitation of Trademarks Used as Internet Domain Names?*, 21 SUFFOLK TRANSNAT'L L. REV. 179, 182-183 (1997) (“Network Solutions, Inc. (NSI), a United States business, controls the registration of internet domain names worldwide. Under the original registration policy, NSI simply registered domain names on a first-come, first-served basis with no requirement that the registrant actually intend to use the name in commerce. The method enabled domain name pirates to register famous trademarks as domain names without ever using them in commerce. Many pirates registered popular names and auctioned them off to the highest bidder. Trademark holders filed suits against the pirates for trademark infringement, and against NSI for contributory infringement.”)

<sup>85</sup> See, for example, *Paul Wright v Domain Source Inc.*, 2002 U.S. Dist. LEXIS 16024 (2002) (involving the paulwright.com domain name); *Stephan Schmidheiny v Steven Weber*, 285 F. Supp. 2d 613 (2003) (involving the schmidheiny.com domain name).

<sup>86</sup> GILSON LALONDE, *supra* note \_\_\_\_, at § 2.03[4][d] (“Just as with descriptive terms, a trademark or trade name that consists of a personal name (first name, surname, or both) is entitled to legal protection only if it attains secondary meaning.”)

<sup>87</sup> 15 U.S.C. § 1129(1)(A) (“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

not be cybersquatting depending on whether the registrant would be prepared to release the name to the relevant person without receiving a profit in the event that the person in question did not want to accept the web hosting services. If the registrant is only holding the name in the hope of selling web hosting services and is prepared to give it up if the relevant person does not agree, then it will not likely amount to cybersquatting. However, if the registrant seeks a profit to transfer the name, it will likely amount to cybersquatting and would be covered by § 1129(1)(A) of the Lanham Act.<sup>88</sup>

## B. SHORTCOMINGS OF THE EXISTING LEGAL FRAMEWORK

Before turning to ways in which the substance of the personality tort might usefully inform the development of a new PDRP, it is worth briefly surveying the shortcomings of the current trademark-focused options, in particular the UDRP. It may seem counter-intuitive to say that the UDRP has shortcomings in the personal domain name dispute context, as a number of celebrities and some politicians have used it successfully in the past to gain control of relevant domain names.<sup>89</sup> Ironically, the very success of personal domain name complaints under the trademark-focused UDRP may evidence a serious problem with the current system. The major problem with the UDRP in this context is that it requires complainants to establish trademark rights in their

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consent, with the specific intent to profit from such name by selling the domain name for financial gain to that person or any third party, shall be liable in a civil action by such person.”)

<sup>88</sup> One permutation of this conduct that is occurring with increasing frequency with respect to personal names and other names, is where an individual has registered his own name as a domain name and then accidentally lets the registration lapse. Some online businesses quickly register lapsed domain names of all kinds and then try to extort money from selling the names back to the original registrants or to someone else with an interest in the name. See, for example, *Paul Wright v Domain Source Inc.*, 2002 U.S. Dist. LEXIS 16024 (2002) (defendant registered plaintiff’s domain name – paulwright.com – when plaintiff accidentally let it lapse and then attempted to resell it to plaintiff for almost \$2,000). This is basically a new form of cybersquatting that differs from traditional cybersquatting only in terms of timing. Traditional cybersquatters registered domain names in a more *anticipatory* way: that is, the cybersquatter would estimate what domain names would likely be valuable to “rightful owners” in the future and would register those names in the hope of extorting money for their transfer. This new permutation relates to names that have been valuable to someone in the past, and the cybersquatter hopes that that person, or someone else with a competing interest in the name, will pay significant sums for transfer of the name, after its original registration has lapsed. This conduct will be caught by the anti-cybersquatting legislation assuming that second registrant – the cybersquatter- has no legitimate interest in the name other than seeking to make a profit from its sale back to the original owner or perhaps to someone else with an interest in the name.

<sup>89</sup> See, for example, *Julia Fiona Roberts v Russell Boyd*, WIPO Case No. D2000-0210, 30 May, 2000 (available at <http://www.wipo.int/amc/en/domains/decisions/html/2000/d2000-0210.html>) (involving juliaroberts.com domain name); *Tom Cruise v Alberta Hot Rods*, WIPO Case No D2006-0560, 5 July, 2006 (available at <http://www.wipo.int/amc/en/domains/decisions/html/2006/d2006-0560.html>) (involving tomcruise.com domain name); *Kevin Spacey v Alberta Hot Rods*, National Arbitration Forum Claim No 114437, August 1, 2002 (available at <http://www.arb-forum.com/domains/decisions/114437.htm>) (involving the domain name kevinpacey.com); *Hillary Rodham Clinton v Michele Dinoia*, National Arbitration Forum Claim No FA0502000414641, March 18, 2005 (full text available at <http://www.arb-forum.com/domains/decisions/414641.htm>) (involving hillaryclinton.com domain name).

personal names.<sup>90</sup> Personal names, like other descriptive marks, are only trademarkable if they attain secondary meaning.<sup>91</sup> The question as to whether a particular name has acquired such a meaning can be quite a difficult one as has generally been left to the courts within domestic trademark systems.

Asking UDRP arbitrators to resolve these questions raises several concerns. For one thing, UDRP arbitrators, unlike courts, will generally not have the benefit of detailed judicial precedent on the question of secondary meaning in front of them when making a decision.<sup>92</sup> In any event, they are not bound by judicial precedent. This has led to inconsistent, and often arbitrary or superficial, reasoning in personal domain name arbitrations.<sup>93</sup> Secondly, the fact that the UDRP is the easiest and most cost effective avenue for domain name disputes results in most personal domain name disputes being

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<sup>90</sup> UDRP, para 4(a) (“You are required to submit to a mandatory administrative proceeding in the event that a third party (a “complainant”) asserts to the applicable Provider, in compliance with the Rules of Procedure, that: (i) your domain name is identical or confusingly similar to a *trademark or service mark in which the complainant has rights*; and, (ii) you have no rights or legitimate interests in respect of the domain name; and, (iii) your domain name has been registered and is being used in bad faith.”) (emphasis added).

<sup>91</sup> GILSON LALONDE, *supra* note \_\_\_\_, at § 2.03[4][d] (“Just as with descriptive terms, a trademark or trade name that consists of a personal name (first name, surname, or both) is entitled to legal protection only if it attains secondary meaning.”).

<sup>92</sup> Although complainants under the UDRP are required to assert legitimate trademark interests, the proceedings do not require registered trademark interests, or detailed discussions of the nature of a complainant’s alleged trademark interest. The *Julia Roberts* arbitration is a good example of how little time is often spent on the trademarkability question with respect to a personal name: *Julia Fiona Roberts v Russell Boyd*, WIPO Case No. D2000-0210, 30 May, 2000, ¶ 6 (available at <http://www.wipo.int/amc/en/domains/decisions/html/2000/d2000-0210.html>) (“A recent decision citing English law found that common law trademark rights exist in an author’s name. The Policy does not require that the Complainant should have rights in a registered trademark or service mark. It is sufficient that the Complainant should satisfy the Administrative Panel that she has rights in common law trademark or sufficient rights to ground an action for passing off.”).

<sup>93</sup> Why, for example, should Julia Roberts and Tom Cruise be regarded as having trademark interests in their personal names when the same is not necessarily true for Bruce Springsteen, or the late Anna Nicole Smith? Why should “Hillary Clinton” be recognized as a trademark when the same is not true for other politicians such as Kathleen Kennedy Townsend? See, for example, *Julia Fiona Roberts v Russell Boyd*, WIPO Case No. D2000-0210, 30 May, 2000 (available at <http://www.wipo.int/amc/en/domains/decisions/html/2000/d2000-0210.html>) (involving juliaroberts.com domain name); *Tom Cruise v Alberta Hot Rods*, WIPO Case No D2006-0560, 5 July, 2006 (available at <http://www.wipo.int/amc/en/domains/decisions/html/2006/d2006-0560.html>) (involving tomcruise.com domain name); *Anna Nicole Smith v DNS Research Inc*, Claim No. FA0312000220007, National Arbitration Forum, Feb 21, 2004 (available at: <http://www.adrforum.com/domains/decisions/220007.htm>) (involving annicolesmith.com domain name); *Hillary Rodham Clinton v Michele Dinoia*, National Arbitration Forum Claim No FA0502000414641, March 18, 2005 (full text available at <http://www.arbforum.com/domains/decisions/414641.htm>) (involving hillaryclinton.com domain name); *Bruce Springsteen v Jeff Burgar*, WIPO Case No D2000-1532, Jan 25, 2001 (available at <http://www.wipo.int/amc/en/domains/decisions/html/2000/d2000-1532.html>); *Kathleen Kennedy Townsend v Birt*, WIPO Case No D2002-0030, April 11, 2002 (available at <http://www.wipo.int/amc/en/domains/decisions/html/2002/d2002-0030.html>).

directed to UDRP arbitrators, rather than courts.<sup>94</sup> This compounds the difficulties for UDRP arbitrators because of the sheer volume of disputes in the personal name area they need to adjudicate without the benefit of much detailed judicial precedent on the trademarkability question.

This Part considers the development of trademark practice from the early days of the domain name system through to the adoption of the UDRP. Its aim is to illustrate how we arrived at a situation where the UDRP is, by default, the best available avenue for personal domain name disputes, despite its shortcomings. Parts II and III then focus on how an online dispute resolution mechanism based largely on the substance of the right of publicity tort could improve matters.

### *1. Trademark Infringement*

In the early days of the domain name system, litigants turned to existing trademark law – trademark infringement and dilution actions – to protect their valuable source-identifiers in cyberspace. The trademark infringement action<sup>95</sup> protects a trademark holder against an unauthorized use of the mark in commerce that is likely to confuse consumers as to the source of a particular product or service.<sup>96</sup> It was applied successfully in early domain name cases involving trademarks on the basis that unauthorized registration and use of domain names corresponding with someone else’s trademark would likely confuse consumers.<sup>97</sup>

It was not often applied to disputes involving personal names.<sup>98</sup> Perhaps personal name litigants did not feel that they could support a trademark infringement action because of concerns that they might not be able to establish a trademark interest in their names. It may also have been that the cost of judicial proceedings in trademark law was

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<sup>94</sup> Moreland, *supra* note \_\_\_, at 385 (“Prior to the establishment of ICANN Arbitration, recovery of celebrity domain names was an expensive and potentially lengthy process.”).

<sup>95</sup> 15 U.S.C. §§ 1114 (infringement of registered trademarks); 1125(a) (infringement of unregistered trademarks).

<sup>96</sup> GILSON LALONDE, *supra* note \_\_\_, at § 5.01 (the general aim of trademark law is to prevent consumer confusion about the source of products or services).

<sup>97</sup> *Planned Parenthood Federation of America Inc v Bucci*, 42 U.S.P.Q. 2d 1430 (S.D.N.Y. 1997) (defendant’s use of *plannedparenthood.com* domain name for messages critical of the Planned Parenthood organization was likely to confuse consumers as to the source of various services provided by the plaintiff); *Brookfield Communications Inc v West Coast Ent Corp*, 174 F.3d 1036 (9<sup>th</sup> Cir 1999) (use of “*moviebuff.com*” domain name by one video library was likely to confuse customers of one of its competitors where each had some association with an iteration of the term “Movie Buff” in its trademark).

<sup>98</sup> There are some notable exceptions of cases that do involve personal names and have been litigated under trademark law largely on the basis of trademarks in personal names: *Lamparello v Falwell*, 420 F.3d 309, 320 (2005) (involving an intentional misspelling of the Reverend Falwell’s name as a domain name); *Trudeau v Lanoue*, 2006 U.S. Dist. LEXIS 7956 (2006) (involving Mr Kevin Trudeau’s name as a domain name); *Stephan Schmidheiny v Steven Weber*, 285 F. Supp. 2d 613 (2003).

## CELEBRITY IN CYBERSPACE

prohibitive for private individuals,<sup>99</sup> even those most likely to be able to establish trademark interests in their own names. This is probably the reason why most disputes involving personal domain names have been brought under the faster and less expensive UDRP.<sup>100</sup> Trademark based actions can also raise jurisdictional concerns that do not arise under the UDRP.<sup>101</sup> The actor Kevin Spacey, for example, failed to establish personal jurisdiction over a defendant in litigation for control of the domain name <kevinspacey.com>.<sup>102</sup> He then went on to successfully obtain control of the name in a UDRP proceeding.<sup>103</sup>

Even in situations where the complainant is able to bear the cost of trademark litigation and can establish a trademark interest in her name, there will be the problem of satisfying the “consumer confusion” element of a trademark infringement action.<sup>104</sup> Consumer confusion is the key to a successful trademark infringement suit.<sup>105</sup> Many situations involving personal domain names will not involve consumer confusion in the trademark sense. It may be that a person is making unauthorized commercial use of a domain name, but it is clear that the registrant does not represent the person whose name is used in the domain name.<sup>106</sup> This could happen where the registrant is simply using the name as a “draw” to attract unrelated commercial custom.<sup>107</sup>

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<sup>99</sup> Costs of judicial proceedings can be prohibitive for private individuals: Moreland, *supra* note \_\_\_, at 385 (“Prior to the establishment of ICANN Arbitration, recovery of celebrity domain names was an expensive and potentially lengthy process.”); Jessica Litman, *The DNS Wars: Trademarks and the Internet Domain Name System*, 4 J. SMALL & EMERGING BUS. L. 149, 155 (2000) (noting the often prohibitive cost of trademark infringement and dilution litigation in early domain name disputes).

<sup>100</sup> Moreland, *supra* note \_\_\_, at 385 (“ICANN Arbitration provides an inexpensive and extremely quick means of recovering a domain name. In addition, celebrities have come to enjoy a very high success rate in arbitration.”)

<sup>101</sup> See, for example, *Paul Wright v Domain Source Inc.*, 2002 U.S. Dist. LEXIS 16024, ¶¶ 1-3 (2002) (discussion of jurisdictional issues raised in complaint against cybersquatter’s registration of paulwright.com domain name).

<sup>102</sup> Kieren McCarthy, *Kevin Spacey Loses Pivotal Cybersquatting Court Case*, THE REGISTER, Nov 26, 2001 (available at [http://www.theregister.co.uk/2001/11/26/kevin\\_spacey\\_loses\\_pivotal\\_cybersquatting/](http://www.theregister.co.uk/2001/11/26/kevin_spacey_loses_pivotal_cybersquatting/), last viewed on November 8, 2007).

<sup>103</sup> *Kevin Spacey v Alberta Hot Rods*, National Arbitration Forum Claim No FA0205000114437, August 1, 2002, available at <http://domains.adrforum.com/domains/decisions/114437.htm>, last viewed on November 8, 2007.

<sup>104</sup> GILSON LALONDE, *supra* note \_\_\_, at § 5.01 (the general aim of trademark law is to prevent consumer confusion about the source of products or services).

<sup>105</sup> *id.*

<sup>106</sup> There may be an argument that the right of publicity should not prohibit such conduct. However, if there is something significant about protecting the integrity of individual personas online, theories of personhood as well as property would come into play here, and they might support an argument for a right of publicity action here, even if such an action would not arise under trademark law. On personhood theories as a basis for the right of publicity, see generally Haemmerli, *supra* note \_\_\_; McKenna, *supra* note \_\_\_\_.

There would still be an open question in the celebrity cases at least as to whether the misleading use of the mark was “in commerce” in the sense required by trademark law. If the domain name registrant was not actually using the unauthorized website for commercial purposes in the sense of selling any goods or services, the use of the name purely to attract Internet users may not be sufficiently “in commerce” to support a trademark infringement action. There is some case law in the domain name context suggesting that any unauthorized use of a trademark as a domain name could be sufficiently “in commerce” for a trademark infringement action on the basis that the nature of the Internet itself is a multi-jurisdictional commercial communications medium.<sup>108</sup> On this reasoning, any use of a trademarked personal name in a domain name could potentially give rise to a trademark infringement action. However, it remains to be seen whether future courts would follow this line of reasoning.<sup>109</sup>

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<sup>107</sup> Such conduct could amount to trademark infringement under the “initial interest confusion” doctrine or perhaps to trademark dilution. However, both these approaches to domain name disputes under domestic trademark principles have come under attack for over-extending the boundaries of trademark law in cyberspace. On initial interest confusion see, for example, Lastowka, *supra* note \_\_\_\_, 35-36 (“With respect to search engines ... a ... significant expansion of trademark law is the doctrine of initial interest confusion. Traditionally, and not surprisingly, most courts have focused analysis of consumer confusion on the time period proximate to consumer purchases. The doctrine of initial interest confusion shifts the focus of confusion analysis to a time prior to the time of purchase. Initial interest confusion can be found to exist even if that confusion was not present at the time of purchase.”); see also Jennifer Rothman, *Initial Interest Confusion: Standing at the Crossroads of Trademark Law*, 27 CARDOZO L REV 105 (2005); Goldman, *supra* note \_\_\_\_, 559 (“[Initial interest confusion] lacks a rigorous definition, a clear policy justification, and a uniform standard for analyzing claims. With its doctrinal flexibility, [it] has become the tool of choice for plaintiffs to shut down junior users who have not actually engaged in misappropriative uses.”). On dilution, see discussion in Part I.B.2 *infra*.

<sup>108</sup> *Planned Parenthood Federation of America Inc v Bucci*, 42 U.S.P.Q. 2d 1430, ¶ 11 (S.D.N.Y. 1997) (“Internet users constitute a national, even international, audience, who must use interstate telephone lines to access defendant's web site on the Internet. The nature of the Internet indicates that establishing a typical home page on the Internet, for access to all users, would satisfy the Lanham Act's "in commerce" requirement.”) See also *American Libraries Association v Pataki*, 969 F. Supp. 160, 45 (S.D.N.Y. 1997) (“In addition, many of those users who are communicating for private, noncommercial purposes are nonetheless participants in interstate commerce by virtue of their Internet consumption. Many users obtain access to the Internet by means of an on-line service provider, such as America Online, which charges a fee for its services. "Internet service providers," including plaintiffs Panix, Echo, and NYC NET, also offer Internet access for a monthly or hourly fee. Patrons of storefront "computer coffee shops," such as New York's own CyberCafe, similarly pay for their access to the Internet, in addition to partaking of food and beverages sold by the cafe. Dial-in bulletin board systems often charge a fee for access.”)

<sup>109</sup> Gregory Lastowka, *Google's Law*, 64, available at <http://ssrn.com/abstract=1017536>, last viewed on November 8, 2007 (“[I]t is not clear how *Bucci* had used the Planned Parenthood mark in commerce, given that he lacked any product or service. Those who advocate for an expansion of trademark use often criticize *Bucci* for this reason.”).

Of course, right of publicity jurisprudence also has an “in commerce” requirement<sup>110</sup> which may or may not be interpreted in the same way as trademark law’s “in commerce” requirement in cyberspace. Whether or not this requirement is interpreted in the same way for the right of publicity, there is a good argument that unauthorized non-commercial uses of even a <name.com> name should not be proscribed under a new PDRP. These uses may well, for the most part, be purely expressive uses that are protected by the First Amendment. The balance of the First Amendment against personality rights in personal domain names is considered further in Part III.

## 2. Trademark Dilution

Trademark dilution<sup>111</sup> also has limited application to personal domain name disputes because of its requirement of a trademark interest in the personal name, and because of the time, cost and jurisdictional problems often associated with litigation. Dilution differs from trademark infringement in that it is not focused on the prevention of consumer confusion, and does not require a showing of consumer confusion on the part of the plaintiff. Rather, it protects famous marks<sup>112</sup> from blurring<sup>113</sup> or tarnishment.<sup>114</sup> Dilution at the federal level is designed to prevent people from creating “noise” around a mark that might have the effect of lessening the strength of the mark in terms of its capacity to identify the plaintiff’s goods or services.<sup>115</sup> Thus, a dilution action could prevent the sale of Sony potato chips as potentially dilutive of the Sony corporation’s marks for audio-visual and electronic equipment.<sup>116</sup> There is a non-commercial use exception from trademark dilution liability.<sup>117</sup> Additionally, under revisions to the

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<sup>110</sup> GILSON LALONDE, *supra* note \_\_\_\_, at § 2.16[1] (“The right of publicity ... is the right of an individual to control the *commercial use* of his or her name, likeness, signature, or other personal characteristics.”) (emphasis added).

<sup>111</sup> 15 U.S.C. § 1125(c).

<sup>112</sup> 15 U.S.C. § 1125(c)(2)(A) (statutory definition of “famous mark” as inserted into the Lanham Act under the Trademark Dilution Revision Act, H.R. 683 of 2006).

<sup>113</sup> 15 U.S.C. § 1125(c)(2)(B) (defines “blurring” as an “association arising from the similarity between a mark or trade name and a famous mark that impairs the distinctiveness of the famous mark”).

<sup>114</sup> 15 U.S.C. § 1125(c)(2)(C) (defines “tarnishment” of a famous mark as an “association arising from the similarity between a mark or trade name and a famous mark that harms the reputation of the famous mark.”)

<sup>115</sup> Mark Lemley, *The Modern Lanham Act and the Death of Common Sense*, 108 YALE L J 1687, 1698-1699 (1999) (“Dilution laws are directed against the possibility that the unique nature of a mark will be destroyed by companies who trade on the renown of the mark by selling unrelated goods, such as Kodak pianos or Buick aspirin.”); GILSON LALONDE, *supra* note \_\_\_\_, at § 5A.01[1] (“Federal dilution law protects famous trademarks from unauthorized uses that are likely to impair their distinctiveness or harm their reputation. It enables owners of those marks to maintain their value as source indicators and as symbols of good will. While the law benefits only famous trademarks, it adds a potent weapon against the whittling away of the hard-to-measure distinctive quality of those marks.”)

<sup>116</sup> *id.*

<sup>117</sup> 15 U.S.C. § 1125(c)(3)(C).

Lanham Act in 2006,<sup>118</sup> there is an expanded fair use defense that contemplates various forms of commentary on a trademark holder as a defense to the action.<sup>119</sup>

Trademark dilution actions were used successfully by trademark holders in the early days of the domain name system.<sup>120</sup> These actions were particularly effective in cases involving cybersquatters.<sup>121</sup> This is because the use of someone else's trademark in a domain name for no particular purpose other than to sell the name to the trademark holder – or perhaps to a competitor of the trademark holder – could be said to be creating noise around the mark in the dilution sense. Early courts held that a domain name corresponding to a trademark is integral to a business' ability to engage in commerce on the Internet such that cybersquatting on such a name would be prohibited as interfering with this ability.<sup>122</sup>

However, a dilution action requires that the plaintiff establish not only a trademark interest, but that she holds a *famous* mark.<sup>123</sup> Despite the fact that it has historically been reasonably easy in practice for commercial plaintiffs to establish that their mark is sufficiently famous to bring a dilution action,<sup>124</sup> this may not be the case with respect to personal names. Personal names are often not trademarks at all, even with respect to some rather well-known celebrities.<sup>125</sup> Recent amendments to the federal

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<sup>118</sup> Trademark Dilution Revision Act, H.R. 683 of 2006 (“TDRA”).

<sup>119</sup> 15 U.S.C. § 1125(c)(3)(A)(ii).

<sup>120</sup> See, for example, *Panavision Int'l L.P. v Toeppen*, 141 F 3d 1316 (9<sup>th</sup> Cir 1998) (successful trademark dilution action against cybersquatter who was not using the name for any purpose other than attempting to sell it to the corresponding trademark holder).

<sup>121</sup> *id.*

<sup>122</sup> *id.*, 1327 (“We reject [defendant’s] premise that a domain name is nothing more than an address. A significant purpose of a domain name is to identify the entity that owns the web site.”), 1327 (“[Defendant’s] use of Panavision.com also puts Panavision’s name and reputation at his mercy.”)

<sup>123</sup> 15 U.S.C. § 1125(c)(1) (“Subject to the principles of equity, the owner of a famous mark that is distinctive, inherently or through acquired distinctiveness, shall be entitled to an injunction against another person who, at any time after the owner’s mark has become famous, commences use of a mark or trade name in commerce that is likely to cause dilution by blurring or dilution by tarnishment of the famous mark, regardless of the presence or absence of actual or likely confusion, of competition, or of actual economic injury.”). “Famous mark” is now defined for these purposes in 15 U.S.C. § 1125(c)(2)(A).

<sup>124</sup> Mark Lemley, *The Modern Lanham Act and the Death of Common Sense*, 108 YALE L J 1687, 1698-1699 (1999). However, since the enactment of the TDRA in 2006, it may be more difficult to establish that a mark is famous than in the past due to the new definition of “famous mark” now inserted into 15 U.S.C. § 1125(c)(2)(A). At least courts may have to undertake an analysis of whether a mark is famous or not with regard to this provision.

<sup>125</sup> See, for example, Moreland, *supra* note \_\_\_, at 390 (comparing UDRP arbitrations where celebrities have not been able to establish trademark rights in their personal names); *Bruce Springsteen v Jeff Burgar and Bruce Springsteen Club*, WIPO Case No. D2000-1532, Jan. 25, 2001, ¶ 6 (available at <http://arbiter.wipo.int/domains/decisions/html/2000/d2000-1532.html>) (“It appears to be an established principle from cases such as Jeanette Winterson, Julia Roberts, and Sade that in the case of very well

dilution statute may make it more difficult for individuals, even famous individuals, to establish that their personal names operate as famous marks. The new definition of “famous mark” inserted into the Lanham Act in October 2006 contemplates the notion of a famous mark in very consumer-oriented terms with respect to the source of goods or services.<sup>126</sup> Many famous individual’s names will not, in fact, operate in this way. Thus, it may be more difficult in theory at least for a plaintiff to establish trademark dilution with respect to a personal name than even to establish trademark infringement. Celebrities to one side, presumably most politicians, public figures and private individuals will not be able to show marks at all, or at least marks with sufficient fame, to bring a successful dilution action. This coupled with the costs of litigation make a trademark dilution action an inappropriate and unlikely avenue for the future resolution of personal domain name disputes.

### ***3. The Anti-Cybersquatting Consumer Protection Act, and California’s Business and Professions Code***

The ACPA was enacted in 1999 to address some of the specific concerns of trademark holders in relation to cybersquatting. It is focused on protecting trademarks in cyberspace, although it does make some specific provision for personal names – the only law to have done so in the Internet context. The ACPA inserted two new provisions into

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known celebrities, their names can acquire a distinctive secondary meaning giving rise to rights equating to unregistered trade marks, notwithstanding the non-registerability of the name itself. It should be noted that no evidence has been given of the name "Bruce Springsteen" having acquired a secondary meaning; in other words a recognition that the name should be associated with activities beyond the primary activities of Mr. Springsteen as a composer, performer and recorder of popular music. In the view of this Panel, it is by no means clear from the UDRP that it was intended to protect proper names of this nature.”); *Anna Nicole Smith v DNS Research Inc*, National Arbitration Forum Claim No FA0312000220007, Feb 21, 2004 (available at <http://www.adr-forum.com/domains/decisions/220007.htm>), last viewed on October 25, 2007 (“it is unlikely that the evidence submitted here by the Complainant of her career, in and of itself, is sufficient to establish common law trademark rights in the name, which is a requirement for Complainant to prevail on this aspect of the case. While the UDRP does not require a *registered* trademark for protection of a trademark from a confusingly identical domain name, the mere fact of having a successful career as an actress, singer or TV program star does not provide exclusive rights to the use of a name under the trademark laws.”); *Gordon Sumner aka Sting v Michael Urvan*, WIPO Case No D2000-0596, July 20, 2000, ¶ 6.5 (available at <http://www.wipo.int/amc/en/domains/decisions/html/2000/d2000-0596.html>), last viewed on November 8, 2007 (“In the opinion of this Administrative Panel, it is doubtful whether the Uniform Policy is applicable to this dispute. 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. Unlike the personal names in issue in the cases *Julia Fiona Roberts v Russell Boyd*, *Jeannette Winterson v Mark Hogarth*, and *Steven Rattner v BuyThisDomainName (John Pepin)*, the personal name in this case is also a common word in the English language, with a number of different meanings.”)

<sup>126</sup> 15 U.S.C. § 1125(c)(2)(A) (“For purposes of paragraph [15 U.S.C. § 1125(c)(1)], a mark is famous if it is widely recognized by the general consuming public of the United States as a designation of source of the goods or services of the mark’s owner. In determining whether a mark possesses the requisite degree of recognition, the court may consider all relevant factors, including the following: (i) The duration, extent, and geographic reach of advertising and publicity of the mark, whether advertised or publicized by the owner or third parties. (ii) The amount, volume, and geographic extent of sales of goods or services offered under the mark. (iii) The extent of actual recognition of the mark...”)

the Lanham Act – one directed at the prevention of cybersquatting with respect to trademarks,<sup>127</sup> and the other directed at the prevention of cybersquatting with respect to personal names.<sup>128</sup> Both provisions prohibit the registration of a domain name with a bad faith profit motive<sup>129</sup> where there is no other legitimate purpose for using the name.<sup>130</sup> The trademark-focused provision is of limited use to personal name holders again because many personal names will not be trademarks.<sup>131</sup> However, the personal name provision - § 1129(1)(A) - is available to people who are concerned about cybersquatters registering their names as domain names.<sup>132</sup> This should provide some comfort to those concerned about having to pay exorbitant sums of money for return of a name that should “rightfully” be theirs. However, interestingly, the provision has not been utilized much in practice, particularly in comparison with the UDRP.<sup>133</sup> This is probably because the UDRP is faster and cheaper,<sup>134</sup> even though it is premised on the existence of a trademark interest.

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<sup>127</sup> 15 U.S.C. § 1125(d).

<sup>128</sup> 15 U.S.C. § 1129(1).

<sup>129</sup> 15 U.S.C. § 1125(d)(1)(A)(ii) prohibits registering, trafficking, or using a domain name in bad faith for a profit while § 1129(1)(A) contemplates an attempted sale of the name in bad faith.

<sup>130</sup> 15 U.S.C. §§ 1125(d)(1)(A)(i), 1129(1)(A).

<sup>131</sup> GILSON LALONDE, *supra* note \_\_\_\_, at § 2.03[4][d] (“Just as with descriptive terms, a trademark or trade name that consists of a personal name (first name, surname, or both) is entitled to legal protection only if it attains secondary meaning.”).

<sup>132</sup> Examples of cases where this section was argued in situations involving cybersquatting on personal names include: *Paul Wright v Domain Source Inc.*, 2002 U.S. Dist. LEXIS 16024 (2002) (successful action under 15 U.S.C. § 1129(1)(A) with respect to the paulwright.com domain name); *Stephan Schmidheiny v Steven Weber*, 285 F. Supp. 2d 613 (2003) (successful action under § 1129(1) of the Lanham Act for transfer of the schmidheiny.com domain name to the plaintiff, Mr Schmidheiny, and injunction against the defendant registering any further iterations of the plaintiff’s name as a domain name). Note also discussion of these provisions by UDRP arbitrator in *Kathleen Kennedy Townsend v Birt*, WIPO Case No D2002-0030, April 11, 2002 (available at <http://www.wipo.int/amc/en/domains/decisions/html/2002/d2002-0030.html>) (“The Panel finds that the protection of an individual politician's name, no matter how famous, is outside the scope of the Policy since it is not connected with commercial exploitation as set out in the Second WIPO Report. This does not mean that Complainant is without remedy. The ACPA contains express provisions protecting the rights in personal names. Complainant is free to pursue her claims in that forum. And, as mentioned, the committee may have rights in the marks that are sufficiently commercial as to entitle the committee to protection under the Policy.”)

<sup>133</sup> Moreland, *supra* note \_\_\_\_, at 386 (noting high success rate of celebrities in personal domain name disputes under the UDRP, and citing Statistical Summary for Proceedings under the Uniform Domain Name Dispute Resolution Policy (February 26, 2001), 394 (“A plethora of disputes involving personal names have been submitted to ICANN Arbitration.”)).

<sup>134</sup> Moreland, *supra* note \_\_\_\_, at 385 (“ICANN Arbitration provides an inexpensive and extremely quick means of recovering a domain name.”)

One significant limitation of the ACPA is that it does not cover situations where the registrant is not a cybersquatter, but is using a domain name for some other purpose which may be commercial, or may be expressive, or may be a combination of both.<sup>135</sup> Some registrants of <name.com> names will use them to attract commercial custom through advertising, for example. If they can make more money by doing this than by selling the name, they will not be a cybersquatter under § 1129(1)(A). Unauthorized uses of personal domain names for purely expressive purposes raise more difficult policy questions. Should there be an overriding presumption that <name.com> names in particular “rightfully” belong to people with corresponding names, regardless of the use a registrant is making of the domain name? Such a presumption may well trample on First Amendment concerns where the registrant’s use of the name is purely expressive.

Issues of the First Amendment versus the rights of trademark holders have arisen already in trademark disputes that do not involve personal names: for example, some UDRP arbitrators have suggested that legitimate commentary about a trademark holder should be protected on the Internet.<sup>136</sup> This might include allowing an unauthorized use of a domain name that corresponds in some way with a registered trademark for, say, a gripe site about the trademark holder.<sup>137</sup> However, judges and arbitrators in the trademark context have not generally accepted that commentators should be allowed to utilize the most intuitive domain name corresponding to the trademark – that is, the <trademark.com> version of the name.<sup>138</sup> They have been relegated to “lesser” forms of

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<sup>135</sup> Beezy, *supra* note \_\_\_, at 24 (“the distinction between cybersquatter and cybergriper – that is, the difference between bad faith registration and use of a domain name that incorporates another’s mark and permissible registration and use, albeit unauthorized, of another’s mark – will become difficult to discern.”).

<sup>136</sup> *Bridgestone Firestone v Myers*, WIPO Case No, D2000-0190, July 6, 2000, (available at <http://www.wipo.int/amc/en/domains/decisions/html/2000/d2000-0190.html>) (“Although free speech is not listed as one of the [UDRP’s] examples of a right or legitimate interest in a domain name, the list is not exclusive, and the Panel concludes that the exercise of free speech for criticism and commentary ... demonstrates a right or legitimate interest in the domain name under Paragraph 4(c)(iii). The Internet is above all a framework for global communication, and the right to free speech should be one of the foundations of Internet law.”).

<sup>137</sup> *id.* There is some judicial authority suggesting the same thing: *Bosley v Kremer*, 403 F 3d 672, 679-80 (9<sup>th</sup> Cir., 2005) (“Kremer is not Bosley’s competitor; he is their critic. His use of the Bosley mark is not in connection with a sale of goods or services - it is in connection with the expression of his opinion about Bosley’s goods and services. The dangers that the Lanham Act was designed to address are simply not at issue in this case. The Lanham Act ... does not prohibit all unauthorized uses of a trademark ... . Any harm to Bosley arises not from a competitor’s sale of a similar product under Bosley’s mark, but from Kremer’s criticism of their services. Bosley cannot use the Lanham Act either as a shield from Kremer’s criticism or as a sword to shut Kremer up.”)

<sup>138</sup> *Bridgestone Firestone v Myers*, WIPO Case No, D2000-0190, July 6, 2000, (available at <http://www.wipo.int/amc/en/domains/decisions/html/2000/d2000-0190.html>) (“In the cybersquatting cases, the domain names in question generally were www.trademark.com domain names, which prevented the trademark holder from utilizing the customary commercial domain name for its “official” site .... Here, however, the domain name registrant has not usurped the <.com> domain, but has utilized only the <.net> domain, has posted disclaimers on the website homepage, and has included criticism or commentary on the site so that a reasonably prudent Internet user can tell that the site is not the trademark holder’s “official” site.”).

the domain name, such as those using a different generic Top Level Domain (“gTLD”) such as <.org> or <.net>, or those using a “qualifier” at the end of the domain, such as <trademarksucks.com>.<sup>139</sup> On this analogy, there perhaps is, or should be, a presumption that well known people such as celebrities and public figures do have rights to the <name.com> versions of their names if this is an identifiable Internet usage norm. If this presumption is correct, the ACPA will not assist with its development or enforcement because of its focus on cybersquatting, as opposed to web commentary.

Interestingly, one state – California – has experimented with legislation directed at personal name cybersquatting. The relevant provisions can be found in §§ 17525-17526 of California’s Business and Professions Code. Section 17525(a) provides that:

It is unlawful for a person, with a bad faith intent to register, traffic in, or use a domain name, that is identical or confusingly similar to the personal name of another living person or deceased personality, without regard to the goods or services of the parties.

This legislation is broader than § 1129(1)(A) of the Lanham Act in that it contemplates deceased as well as living persons and that it includes a list of “bad faith factors” that are somewhat broader than those in § 1129(1)(A). The Californian legislation also includes as a bad faith factor an intention on the part of the registrant to “mislead, deceive, or defraud voters.”<sup>140</sup> This may be relevant to situations where a politician is complaining about unauthorized use of her name in a corresponding domain name, at least if the use of the name is misleading or fraudulent in some way.<sup>141</sup> However, it is an open question as to whether the legislation would, or indeed should, cover pure political gripe sites, such as the <bobkeenan.com> and <lindamcculloch.com> examples described in Part I.A.2. This is because a legitimate criticism of a politician may not be regarded as misleading, deceiving or defrauding voters, provided it is clear from the context that these websites are not endorsed by the politician in question. On the other hand, if the view is taken that using a <name.com> domain name for a website other than that authorized by the person in question is automatically a misleading use of the name because Internet users would expect the domain name to resolve to an

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<sup>139</sup> Although, some arbitrators have held that even domain names employing pejorative qualifiers should be in the control of the trademark holder rather than anyone else. See, for example, *Societe Air France v. Virtual Dates, Inc.*, WIPO Case No. D2005-0168 (WIPO Arb. and Mediation Ctr., Admin. Panel Decision, May 24, 2005), available at <http://arbitrator.wipo.int/domains/decisions/html/2005/d2005-0168.html> (majority panelists decided that *airfrancesucks.com* domain name should be transferred to the trademark holder and ought not be controlled by a gripe site operator).

<sup>140</sup> California Business and Professions Code, § 17526(j).

<sup>141</sup> On this point, see also Cal. Elections Code, § 18320 which prohibits certain activities described as “political cyberfraud”. This legislation, although not specifically targeted at personal name protection, may have the same results in practice as the Business and Professions Code with respect to some uses of politician’s names in the lead-up to elections. For a more general discussion of the operation of both Californian statutes in the political domain name context, see Jacqueline Lipton, *Who Owns Hillary.com? Political Speech and the First Amendment in Cyberspace*, 49 BOSTON COLLEGE L REV 55 (2008).

authorized website, then the section might have some application. Time will tell whether, and how effectively, these provisions are utilized in practice.

#### 4. *The Uniform Domain Name Dispute Resolution Policy*

This brings us back to the most popular avenue for personal domain name disputes<sup>142</sup> – the UDRP – which was adopted at the same time that the ACPA was enacted. The UDRP is global in jurisdictional scope because of its incorporation into relevant<sup>143</sup> domain name registration agreements.<sup>144</sup> It thus does away with some of the jurisdictional problems inherent in both trademark and personality rights based litigation.<sup>145</sup> Again, the UDRP is aimed at preventing cybersquatting over trademarks.<sup>146</sup> The two major hurdles for a personal domain name complainants under the UDRP are that: (a) a trademark must be established in the personal name, and (b) the UDRP will only apply to cybersquatting.<sup>147</sup> The UDRP contains a specific defense for domain name

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<sup>142</sup> Beezy, *supra* note \_\_\_, at 23-24 (noting high success rate of celebrities in personal domain name proceedings under the UDRP and surveying some of the recent decisions); Moreland, *supra* note \_\_\_, at 386 (noting high success rate of celebrities in personal domain name disputes under the UDRP, and citing Statistical Summary for Proceedings under the Uniform Domain Name Dispute Resolution Policy (February 26, 2001), 394 (“A plethora of disputes involving personal names have been submitted to ICANN Arbitration.”))

<sup>143</sup> ICANN, UDRP Notes, Note 2, available at <http://www.icann.org/udrp/udrp-policy-24oct99.htm>, last viewed on November 10, 2007, (“This policy has been adopted by all accredited domain-name registrars for domain names ending in .com, .net, and .org. It has also been adopted by certain managers of country-code top-level domains (e.g., .nu, .tv, .ws).”)

<sup>144</sup> UDRP, clause 1 (“This Uniform Domain Name Dispute Resolution Policy (the "Policy") has been adopted by the Internet Corporation for Assigned Names and Numbers ("ICANN"), is incorporated by reference into your Registration Agreement, and sets forth the terms and conditions in connection with a dispute between you and any party other than us (the registrar) over the registration and use of an Internet domain name registered by you.”)

<sup>145</sup> See, for example, *Paul Wright v Domain Source Inc.*, 2002 U.S. Dist. LEXIS 16024, ¶¶ 1-3 (2002) (discussion of jurisdictional issues raised in complaint against cybersquatter’s registration of paulwright.com domain name). The movie actor Kevin Spacey was also initially unsuccessful in a cybersquatting claim against the registrant of kevinpacey.com on jurisdictional grounds, but later succeeded under a UDRP proceeding: Kieren McCarthy, *Kevin Spacey Loses Pivotal Cybersquatting Court Case*, THE REGISTER, Nov 26, 2001 (available at [http://www.theregister.co.uk/2001/11/26/kevin\\_spacey\\_loses\\_pivotal\\_cybersquatting/](http://www.theregister.co.uk/2001/11/26/kevin_spacey_loses_pivotal_cybersquatting/), last viewed on November 8, 2007). For completeness, it should also be noted that the ACPA contains some *in rem* provisions to simplify jurisdictional issues for actions taken under 15 U.S.C. § 1125(d)(1). See 15 U.S.C. § 1125(d)(2).

<sup>146</sup> UDRP, clause 4(a)(i) (“You are required to submit to a mandatory administrative proceeding in the event that a third party (a "complainant") asserts to the applicable Provider, in compliance with the Rules of Procedure, that (i) your domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights...”)

<sup>147</sup> Beezy, *supra* note \_\_\_, at 24 (“the distinction between cybersquatter and cybergriper – that is, the difference between bad faith registration and use of a domain name that incorporates another’s mark and permissible registration and use, albeit unauthorized, of another’s mark – will become difficult to discern.”); Moreland, *supra* note \_\_\_, at 390-2 (noting that the UDRP will not assist a complainant where a

registrants making a “legitimate noncommercial or fair use of the relevant domain name”.<sup>148</sup> It has not been clear what will constitute “fair use” in this context, although noncommercial use should be relatively easy to identify in practice. Further, it is unclear whether the UDRP is intended to cover personality rights in individual names.<sup>149</sup> A World Intellectual Property Organization (“WIPO”) Report on the subject specifically suggested that these rights are not covered under the UDRP.<sup>150</sup> However, some UDRP arbitrators have felt that in the absence of any specific prohibition on the protection of such rights, they are covered by the UDRP.<sup>151</sup> Thus, to the extent that complainants are specifically basing claims on personality interests rather than trademark rights, there will be some confusion as to whether or not they should be successful in the absence of a trademark right.<sup>152</sup>

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domain name registrant is using a domain name for commentary or otherwise to refer to the complainant in a legitimate manner).

<sup>148</sup> UDRP, clause 4(c)(3).

<sup>149</sup> Moreland, *supra* note \_\_\_, at 394-5 (citing WIPO report to the effect that personality rights were never intended to be covered by the UDRP).

<sup>150</sup> Second WIPO Internet Domain Name Process, Sept 3, 2001, available at <http://www.wipo.int/amc/en/processes/process2/report/html/report.html#5>, last viewed on November 11, 2007, ¶199 (“It is clear that many sensitivities are offended by the unauthorized registration of personal names as domain names. It is clear also that UDRP does not provide solace for all those offended sensitivities, nor was it intended to do so, as originally designed. The result is that there are some perceived injustices. Persons who have gained eminence and respect, but who have not profited from their reputation in commerce, may not avail themselves of the UDRP to protect their personal names against parasitic registrations. The UDRP is thus perceived by some as implementing an excessively materialistic conception of contribution to society. Furthermore, persons whose names have become distinctive in countries that do not recognize unregistered trademark rights are unlikely to find consolation in the UDRP in respect of bad faith registration and use of their personal names as domain names in those countries.”), ¶ 202 (“It is recommended that no modification be made to the UDRP to accommodate broader protection for personal names than that which currently exists in the UDRP.”)

<sup>151</sup> Second WIPO Internet Domain Name Process, Sept 3, 2001, available at <http://www.wipo.int/amc/en/processes/process2/report/html/report.html#5>, last viewed on November 11, 2007, ¶181-184 (surveying decisions in which UDRP arbitrators have ordered transfers of domain names based on personal names); *Kevin Spacey v Alberta Hot Rods*, National Arbitration Forum Claim No 114437, August 1, 2002 (available at <http://www.arb-forum.com/domains/decisions/114437.htm>) (“Respondent has argued that the Final Report of the WIPO Internet Domain Name Process reveals that “personality” disputes are outside the scope of the Policy. We would find the report persuasive on this issue as “legislative history” if we found some ambiguity in the Policy itself. Because the Policy does not purport to exclude the category of disputes involving “personality rights,” we join the many other Panels that have recognized that the Policy does, indeed, protect such interests.”)

<sup>152</sup> See, for example, *Kevin Spacey v Alberta Hot Rods*, National Arbitration Forum Claim No 114437, August 1, 2002 (available at <http://www.arb-forum.com/domains/decisions/114437.htm>) (“Respondent has argued that the Final Report of the WIPO Internet Domain Name Process reveals that “personality” disputes are outside the scope of the Policy. We would find the report persuasive on this issue as “legislative history” if we found some ambiguity in the Policy itself. Because the Policy does not purport to exclude the category of disputes involving “personality rights,” we join the many other Panels that have recognized that the Policy does, indeed, protect such interests.”)

The current application of the UDRP to personal domain name disputes is certainly confused in terms of the scope of the policy over personal names. Some arbitrators are more prepared to recognize protectable interests in personal names than others, usually on the basis of an unregistered trademark right. Julia Roberts<sup>153</sup> and Tom Cruise<sup>154</sup> were found to have trademark interests in their personal names, but a majority panel of UDRP arbitrators felt that Bruce Springsteen did not have such rights.<sup>155</sup> A UDRP arbitrator also held that the late Anna Nicole Smith was not sufficiently famous to assert a trademark interest in her personal name.<sup>156</sup> In the political context, “Hillary Clinton” has been recognized as a trademark under the UDRP,<sup>157</sup> but the same was not true for the Maryland gubernatorial candidate Kathleen Kennedy Townsend.<sup>158</sup>

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<sup>153</sup> *Julia Fiona Roberts v Russell Boyd*, WIPO Case No. D2000-0210, 30 May, 2000 (available at <http://www.wipo.int/amc/en/domains/decisions/html/2000/d2000-0210.html> ).

<sup>154</sup> *Tom Cruise v Alberta Hot Rods*, WIPO Case No D2006-0560, 5 July, 2006 (available at <http://www.wipo.int/amc/en/domains/decisions/html/2006/d2006-0560.html>).

<sup>155</sup> *Bruce Springsteen v Jeff Burgar and Bruce Springsteen Club*, WIPO Case No. D2000-1532, Jan. 25, 2001, ¶ 6 (available at <http://arbitrator.wipo.int/domains/decisions/html/2000/d2000-1532.html>) (“It appears to be an established principle from cases such as *Jeanette Winterson*, *Julia Roberts*, and *Sade* that in the case of very well known celebrities, their names can acquire a distinctive secondary meaning giving rise to rights equating to unregistered trade marks, notwithstanding the non-registerability of the name itself. It should be noted that no evidence has been given of the name “Bruce Springsteen” having acquired a secondary meaning; in other words a recognition that the name should be associated with activities beyond the primary activities of Mr. Springsteen as a composer, performer and recorder of popular music. In the view of this Panel, it is by no means clear from the UDRP that it was intended to protect proper names of this nature.”)

<sup>156</sup> *Anna Nicole Smith v DNS Research Inc*, Claim No. FA0312000220007, National Arbitration Forum, Feb 21, 2004 (available at: <http://www.adrforum.com/domains/decisions/220007.htm>) (involving *annanicole-smith.com* domain name) (“it is unlikely that the evidence submitted here by Complainant of her career, in and of itself, is sufficient to establish common law trademark rights in the name, which is a requirement for Complainant to prevail on this aspect of the case. While the UDRP does not require a *registered* trademark for protection of a trademark from a confusingly identical domain name, the mere fact of having a successful career as an actress, singer or TV program star does not provide exclusive rights to the use of a name under the trademark laws. The cases require a clear showing of high commercial value and significant recognition of the name as solely that of the performer. The *Humphrey Bogart* case cited by the Complainant is a prime example of the type of case that would be expected to prevail, since virtually no one familiar with the movie industry would fail to recognize his name as that of a famous movie star. The Panel does not believe Complainant’s name has yet reached that level of fame.”)

<sup>157</sup> *Hillary Rodham Clinton v Michele Dinoia*, National Arbitration Forum Claim No FA0502000414641, March 18, 2005 (full text available at <http://www.arb-forum.com/domains/decisions/414641.htm>) (Senator Clinton was regarded as having an unregistered trademark right in her personal name in connection with both her political activities and her career as an author of a number of books sold in commerce.)

<sup>158</sup> *Kathleen Kennedy Townsend v Birt*, WIPO Case No D2002-0030, April 11, 2002 (available at <http://www.wipo.int/amc/en/domains/decisions/html/2002/d2002-0030.html> ) (individual politician in state gubernatorial race held not to hold trademark rights in her personal name).

Although one could attempt some factual distinctions, it appears that Roberts, Cruise, Springsteen and the late Anna Nicole Smith are all basically entertainers who do not sell products or services under their names in a trademark sense unless you consider their names to be marks for the movies or television shows they appear in or the songs they perform.<sup>159</sup> If the marks work in this way, it is not clear why Bruce Springsteen would not be a mark in the same way as Julia Roberts and Tom Cruise. A UDRP arbitrator recognized a trademark interest in Hillary Clinton's name partly on the basis that she had authored books under her name.<sup>160</sup> If this is the basis for a trademark interest in a personal name, shouldn't "Bruce Springsteen" also be a trademark as the writer and performer of songs? If the test for trademarkability relates to whether a person has written a song or book or appeared in a movie, then would this not lead to peculiar results? For example, would all politicians and public figures have to write an autobiography in order to achieve protected trademark status for their personal names under the UDRP? What about merchandising to establish trademark rights?<sup>161</sup> Senator Barack Obama currently sells a series of "Obama 2008" merchandise on his campaign website,<sup>162</sup> as does Senator Clinton with respect to her own presidential campaign.<sup>163</sup> Would the use of the Senators' respective names on t-shirts, blankets and keyrings amount to a trademark use?<sup>164</sup>

Obviously rules relating to the protection of trademark interests are not automatically geared towards protecting personal names, although they may cover

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<sup>159</sup> Verna, *supra* note \_\_\_\_ (questioning why certain famous personalities are able to establish trademark rights in their personal names for UDRP purposes while others are not).

<sup>160</sup> *Hillary Rodham Clinton v Michele Dinoia*, National Arbitration Forum Claim No FA0502000414641, March 18, 2005 (full text available at <http://www.arb-forum.com/domains/decisions/414641.htm>) (Senator Clinton was regarded as having an unregistered trademark right in her personal name in connection with both her political activities and her career as an author of a number of books sold in commerce.)

<sup>161</sup> See Stacey Dogan and Mark Lemley, *The Merchandising Right: Fragile Theory or Fait Accompli?* 54 EMORY L J 461, 465 (2005) (describing merchandising right as the protected use of a trademark not as a source indicator but as a desirable feature of a product) [hereinafter, *Merchandising Right*]; Dogan and Lemley, *Right of Publicity*, *supra* note \_\_\_\_, 1175-1178 (discussion of merchandising right in trademark law).

<sup>162</sup> See [www.barackobama.com](http://www.barackobama.com), last viewed on November 11, 2007.

<sup>163</sup> Senator Clinton, in fact, has a stand-alone website for merchandising purposes. See [www.hillarystore.com](http://www.hillarystore.com), last viewed on November 11, 2007.

<sup>164</sup> In Senator Obama's case, it should be noted that he has already authored two books, so, following the reasoning of the UDRP arbitrator in the <hillaryclinton.com> case, Senator Obama would arguably already have trademark rights in his personal name on that basis: *Hillary Rodham Clinton v Michele Dinoia*, National Arbitration Forum Claim No FA0502000414641, March 18, 2005 (full text available at <http://www.arb-forum.com/domains/decisions/414641.htm>) (Senator Clinton was regarded as having an unregistered trademark right in her personal name in connection with both her political activities and her career as an author of a number of books sold in commerce.)

personal names in some cases.<sup>165</sup> Creating a new PDRP that replaces the UDRP's trademark focus with a personality rights model would help here. It would lead to more predictable results, and to the development of a more nuanced jurisprudence geared at balancing the integrity of individual personas against other interests such as free speech. It would remove the need for arbitrators to explain why certain individuals should have trademark rights in their personal names while others would not. In so doing, it would prevent an inappropriate expansion of trademark law into the personal name context in cyberspace.

## II. PERSONALITY RIGHTS

### A. THE RIGHT OF PUBLICITY AND PERSONAL NAME DISPUTES

The right of publicity has been described as, “the right of an individual to control the commercial use of his or her name, likeness, signature, or other personal characteristics.”<sup>166</sup> It derives originally from the right of privacy.<sup>167</sup> Admittedly, this genesis has caused some confusion about the scope of the modern day tort which covers both privacy and some property-like aspects of an individual's persona.<sup>168</sup> Over the years, the right has developed in different states sometimes as a matter of common law<sup>169</sup> and sometimes under state legislation.<sup>170</sup> High profile examples include situations relating to unauthorized uses of Elvis Presley's name and likeness after his death,<sup>171</sup> John Wayne's

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<sup>165</sup> The obvious case is where the personal name is, in fact, used as a trademark in a business context. See, for example, *Trudeau v Lanoue*, 2006 U.S. Dist. LEXIS 7956 (2006) (involving Mr Kevin Trudeau's name as a domain name); *Stephan Schmidheiny v Steven Weber*, 285 F. Supp. 2d 613 (2003).

<sup>166</sup> GILSON LALONDE, *supra* note \_\_\_\_, at § 2.16[1].

<sup>167</sup> *id.*, at § 2.16[5]; Haemmerli, *supra* note \_\_\_\_, at 406 (“It is worth asking why we are here, why the doctrinal confusion is so extreme. One reason is that the doctrine [of the right of publicity] may have taken a wrong turn forty-six years ago, when Second Circuit Judge Jerome Frank severed the right of publicity from the right of privacy.”); GILSON LALONDE, *supra* note \_\_\_\_, at §2.16[1][a] (“some courts view the right of publicity as a direct descendant of the right of privacy”); Madow, *supra* note \_\_\_\_, at 167 (“As Thomas McCarthy tells the story, the right of publicity was “carved out of the general right of privacy” – “like Eve from Adam's rib.” In my view, this simile is ... misleading. The right of publicity was created not so much from the right of privacy as from frustration with it.”)

<sup>168</sup> Haemmerli, *supra* note \_\_\_\_, at 407-8 (“The doctrine ... developed in a schizoid manner: publicity rights were purely economic property rights, as distinct from “personal” privacy rights (thereby enabling publicity rights to become transferable and descendible); but publicity rights, even though economic in nature, were also part of the tort of invasion of privacy, thereby implying that they should be viewed as a species of personal privacy rights, and as such nonassignable and nondescendible.”); Dogan and Lemley, *Right of Publicity*, *supra* note \_\_\_\_, 1208-9 (noting that privacy based justifications for right of publicity are legitimate and are different from economic trademark rationale for publicity rights).

<sup>169</sup> Kentucky, for example, has a common law basis for the right of publicity: see discussion in DINWOODIE AND JANIS, TRADEMARKS AND UNFAIR COMPETITION, *supra* note \_\_\_\_, at 823-827.

<sup>170</sup> See, for example, Indiana Code Title 32 (Property), Art. 36 (Publicity), Chap. 1 (Rights of Publicity).

<sup>171</sup> *Estate of Elvis Presley v Russen*, 513 F Supp 1339 (1981).

likeness on greeting cards,<sup>172</sup> Martin Luther King's likeness on unauthorized plastic busts,<sup>173</sup> Rosa Parks' name as a song title,<sup>174</sup> Arnold Schwarzenegger's likeness as a bobblehead doll,<sup>175</sup> and Rudolph Giuliani's likeness on an advertisement run on city buses in New York City.<sup>176</sup>

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<sup>172</sup> See discussion in Madow, *supra* note \_\_\_\_, 141-143.

<sup>173</sup> *Martin Luther King Jr, Center for Social Change Inc v American Heritage Products*, 694 F 2d 674 (11<sup>th</sup> Cir. 1993) (the estate of Martin Luther King Jr sought an injunction to prevent the defendant from selling plastic busts of Dr King).

<sup>174</sup> *Rosa Parks v LaFace Records*, 329 F 3d 437 (2003) (involving publicity rights of Rosa Parks in the context of a song title using her name in relation to a hip hop recording that had nothing in particular to do with her or her work)

<sup>175</sup> Charles Harder and Henry L Self III, *Schwarzenegger vs. Bobbleheads: The Case for Schwarzenegger*, 45 SANTA CLARA L REV 557 (2005); William Gallagher, *Strategic Intellectual Property Litigation, the Right of Publicity, and the Attenuation of Free Speech: Lessons from the Schwarzenegger Bobblehead Doll War (and Peace)*, 45 SANTA CLARA L REV 581 (2005); David Welkowitz and Tyler Ochoa, *The Terminator as Eraser: How Arnold Schwarzenegger Used the Right of Publicity to Terminate Non-Defamatory Political Speech*, 45 SANTA CLARA L REV 651 (2005).

<sup>176</sup> *New York Magazine v The Metropolitan Transit Authority of the City of New York*, 987 F Supp 254 (1997); *aff'd in part, vacated in part, New York Magazine v The Metropolitan Transit Authority and the City of New York*, 136 F.3d 123 (1998). Mayor Giuliani ultimately failed in his appeal on free speech grounds. The right of publicity tort has also been extended to "lookalikes" and "soundalikes" of famous people, notably the use of a Vanna White lookalike robot in a television commercial (*Vanna White v Samsung Electronics America Inc*, 971 F 2d (9<sup>th</sup> Cir 1992); *cert denied*, 508 U.S. 951 (1993)), and the use of imitators of Bette Midler's and Tom Waits' distinctive singing voices in advertising campaigns: *Bette Midler v Ford Motor Company*, 849 F 2d 460 (1988); *Tom Waits v Frito-Lay Inc*, 978 F 2d 1093 (1992).

Because the right is arguably based both on aspects of property theory<sup>177</sup> and aspects of personhood,<sup>178</sup> it is uniquely able to protect individual personas in ways that more purely economically based laws – such as trademark law – cannot. Most importantly, it protects aspects of an individual’s persona regardless of commercial trademark rights in the person’s name. It can thus protect personas of celebrities, public figures and private individuals against unauthorized commercial exploitations. Past practices have demonstrated that the combination of interests people want to protect in their names online<sup>179</sup> corresponds to the same mixture of morally and economically based protections derived from the right of publicity.<sup>180</sup> A PDRP based on personality rights

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<sup>177</sup> Various justifications have been put forward for a property basis for personality rights, and have equally been criticized over the years. For a discussion of property theory in this context, see Dogan and Lemley, *Right of Publicity*, *supra* note \_\_\_, 1181-1183 (critique of Lockean labor theory justifications for personality rights as property); McKenna, *supra*, note \_\_\_, 247 (“It might be true that identity is sufficiently similar to other objects the law regards as property and therefore deserves at least some of the sticks in the traditional bundle of property rights. But far too few courts and commentators have offered a theory as to why any of the traditional property justifications lead to that conclusion.”); 251-267 (critique of Lockean labor theory justifications for property rights in personal identity); Haemmerli, *supra* note \_\_\_, 388 (“Both proponents and critics of the right of publicity generally perceive it as a property claim grounded in Lockean labor theory.”), 407-8 (noting dual property and privacy justifications for right of publicity actions), 412 (“To the extent that commentators specifically address publicity rights, they tend to do so within this property context, and to use Lockean labor theories of property to explain the assertion of a property right in identity or persona.”); Kwall, *Fame*, *supra* note \_\_\_, 15 (“This Article ... contends that a property-based conception for publicity rights is the natural outgrowth of our cultural norms as well as our theoretical conceptions of property.”); David Westfall and David Landau, *Publicity Rights as Property Rights*, 23 CARDOZO ARTS AND ENT LJ 71 (2005) (examining property basis for rights of publicity); Eileen Rielly, *The Right of Publicity for Political Figures: Martin Luther King, Jr, Center for Social Change, Inc v American Heritage Products*, 46 U PITT L REV 1161, 1165-9 (1985) (describing development of a property rights rationale for the right of publicity). See also Diane Zimmerman and Melissa Jacoby, *Foreclosing on Fame: Exploring the Uncharted Boundaries of the Right Of Publicity*, 77 N.Y.U. L. REV. 1322 (2002).

<sup>178</sup> See, for example, McKenna, *supra* note \_\_\_, at 285 (“Since all individuals share the interest in autonomous self-definition, every individual should be able to control uses of her identity that interfere with her ability to define her own public character.”), 286 (“Compelling a person to express a message herself presents a particular sort of threat to her freedom of belief: It threatens her ability to control what she tells the world about who she is and what she holds important ...”); Haemmerli, *supra* note \_\_\_, at 390 (“Viewing the right of publicity as an extension of human worth and autonomy, rather than as a purely economic interest, also changes the nature of the exercise that balances the right against competing social claims .... [A] Kantian grounding is preferable to a Lockean justification not only because a Kantian foundation forces the realization that the balancing challenge is complex, but because it more accurately reflects the value of the human being behind the persona at issue.”); Rielly, *supra* note \_\_\_, 1164-5 (description of privacy foundations of the right of publicity).

<sup>179</sup> For example, rights to control the economic value of their personas in cyberspace (e.g. Prince threatening legal action against unauthorized fan sites’ exploitation of images and information about him) as well as an interest in protecting individual privacy rights (e.g. the desires of some celebrities to prevent anyone using a <name.com> version of their personal name, such as Julia Roberts and Tom Cruise).

<sup>180</sup> GILSON LALONDE, *supra* note \_\_\_, at § 2.16[5] (noting different courts’ approaches to treating the right of publicity either as a property-based or a privacy-based right); Haemmerli, *supra* note \_\_\_, at 407-8 (“The doctrine ... developed in a schizoid manner: publicity rights were purely economic property rights, as distinct from “personal” privacy rights (thereby enabling publicity rights to become transferable and descendible); but publicity rights, even though economic in nature, were also part of the tort of invasion of

theory can draw on the policy justifications underpinning protection of an individual's persona against unauthorized use. This would include protections of an individual's online privacy as well as supporting that notion that individuals should have some economic control of at least the <name.com> versions of their personal names.

Another advantage of personality rights theory is that it can effectively address situations that fall somewhere in between privacy, defamation, copyright, and trademark law. Consider, for example, a case where a person manufactures and sells an unauthorized coffee mug bearing a photograph of Britney Spears. It may difficult for Ms Spears to bring an invasion of privacy action when her persona has been developed largely for public consumption. In other words, it is hard to claim invasion of privacy for something that she herself has put into public view – her image and likeness<sup>181</sup> – unless the image on the coffee mug was taken in an unauthorized private context: for example, by a photographer using a telephoto lens to shoot her in the privacy of her own home.<sup>182</sup> Further, if the coffee mug does not suggest anything defamatory about Ms Spears, there will be no remedy in defamation law.<sup>183</sup> Copyright, also, will be an unlikely avenue for Ms Spears unless she can bring a copyright infringement action with respect to the

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privacy, thereby implying that they should be viewed as a species of personal privacy rights, and as such nonassignable and nondescendible.”); Dogan and Lemley, *Right of Publicity*, *supra* note \_\_\_, 1208-9 (noting that privacy based justifications for right of publicity are legitimate and are different from economic trademark rationale for publicity rights); Kwall, *Fame*, *supra* note \_\_\_, 36-7 (“[Other than economic harm], the right of publicity protects another type of incentive, one that focuses on moral rather than economic concerns. For most celebrities, the cachet of fame is attributed to an image that the publicity plaintiff has a reputational interest in controlling. The author has argued elsewhere that “the unauthorized use of an individual’s persona potentially poses the maximum harm [to that individual] when the persona is being appropriated in an objectionable context or for an objectionable purpose.” Although some celebrities still might want to pursue the limelight even if the law sanctioned such unauthorized appropriations, other celebrities, particularly those with strong moral philosophies, might not. The impact of the decisions regarding the use of a celebrity’s persona are felt more directly by the celebrity since it is the celebrity, rather than anyone in the celebrity’s entourage, whose reputation is at stake.”

<sup>181</sup> Madow, *supra* note \_\_\_, at 168 (“Claims of ... emotional injury [under privacy law] were not nearly as convincing when they came from celebrities ... After all, how could a movie star or professional athlete, who had deliberately and energetically sought the limelight, complain of embarrassment or hurt feelings when an advertiser or merchandiser simply gave his face some *additional* publicity?”); Kwall, *Fame*, *supra* note \_\_\_, 36 (“Some courts ... hold that celebrities cannot maintain right-of-privacy actions, although this view is not universal.”); Dogan and Lemley, *Right of Publicity*, *supra* note \_\_\_, 1171 (noting that privacy actions were not generally much use to celebrities because they were regarded as having purposely sought out the limelight so there was no obvious invasion of privacy).

<sup>182</sup> For a summary of the genesis of privacy rights based on media intrusion into personal space, see, for example, Madow, *supra* note \_\_\_, at 167-170.

<sup>183</sup> Kwall, *Fame*, *supra* note \_\_\_, 36 (“Another significant disadvantage [for celebrities protecting their personality rights] derives from the law of defamation, under which celebrities enjoy less protection than other citizens. Defendants in defamation actions involving public officials and public figures must meet the higher, “actual malice” standard of liability that requires knowledge of falsity as to the libelous statement or reckless disregard as to its truth.”)

photograph in question.<sup>184</sup> She does not hold a copyright interest in her own person, although she may own copyright in a particular photograph.

Trademark law, as we know, is also potentially problematic here. Trademark law protects source indicators of products and services to prevent consumer confusion<sup>185</sup> and to encourage investment in developing those products and services.<sup>186</sup> Thus, if Ms Spears could establish trademark rights in her image, and could establish that the coffee mugs in question were confusing consumers as to source, origin, or affiliation with her, she may be able to establish a trademark infringement claim. Alternatively, if she could establish a trademark in her image, and also that the coffee mugs were blurring or tarnishing the mark in the marketplace, she may be able to sustain a claim in trademark dilution.<sup>187</sup> However, it is not clear whether Ms Spears actually has a trademark in her name or image.<sup>188</sup>

Even if Ms Spears could establish a trademark interest in her likeness, would it be sufficiently connected to the sale of merchandise, like coffee mugs, to support a successful trademark infringement action? It would seem more likely that any mark that did exist would relate to concerts and music products and not merchandising of coffee

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<sup>184</sup> Copyright generally subsists in the author of an original work, which would typically include a photographer in the case of a photograph, or the person who hired the photographer to take the photograph under the “works for hire” doctrine. See 17 U.S.C. § 201(a) (“Copyright in a work protected under this title vests initially in the author or authors of the work.”), § 201(b) (“In the case of a work made for hire, the employer or other person for whom the work was prepared is considered the author for purposes of this title, and, unless the parties have expressly agreed otherwise in a written instrument signed by them, owns all of the rights comprised in the copyright.”)

<sup>185</sup> GILSON LALONDE, *supra* note \_\_\_, at § 5.01 (the general aim of trademark law is to prevent consumer confusion about the source of products or services); DINWOODIE AND JANIS, TRADEMARKS AND UNFAIR COMPETITION, *supra* note \_\_\_, 16-17 (citing S. Rep No. 1333, 79<sup>th</sup> Cong, 2d Sess 3 (1946)) (“In the United States, two primary justifications have traditionally been offered in support of trademark protection: to “protect the public so that it may be confident that, in purchasing a product bearing a particular trademark which it favorably knows, it will get the product which it asks for and which it wants to get”; and to ensure that “where the owner of a trademark has spent energy, time and money in presenting to the public the product, he is protected in his investment from its appropriation by pirates and cheats.”)

<sup>186</sup> DINWOODIE AND JANIS, TRADEMARKS AND UNFAIR COMPETITION, *supra* note \_\_\_, 16-17 (citing S. Rep No. 1333, 79<sup>th</sup> Cong, 2d Sess 3 (1946)) (“In the United States, two primary justifications have traditionally been offered in support of trademark protection: to “protect the public so that it may be confident that, in purchasing a product bearing a particular trademark which it favorably knows, it will get the product which it asks for and which it wants to get”; and to ensure that “where the owner of a trademark has spent energy, time and money in presenting to the public the product, he is protected in his investment from its appropriation by pirates and cheats.”)

<sup>187</sup> 15 U.S.C. § 1125(c).

<sup>188</sup> A search of the United States Patent and Trademark Office’s Trademarks Database as of November 11, 2007 shows that Britney Spears has, in fact, registered her name as a trademark for various products and services. However, the mere fact of registration does not prove that a trademark is valid: DINWOODIE AND JANIS, TRADEMARKS AND UNFAIR COMPETITION, *supra* note \_\_\_, at 315 (“Trademark registration ... does not create rights; it only confirms the existence of rights.”)

mugs and associated products.<sup>189</sup> While there are some trademark cases that accept trademark infringement in the merchandising context,<sup>190</sup> this use of trademark law has been criticized as straying from the basis of trademark infringement law in protecting marks *per se* rather than marks used as trademarks.<sup>191</sup>

Of course, there is also a possibility of a trademark dilution action, but, again, Ms Spears would have to establish the existence of a trademark right in her image to begin with, as well as establishing that the use of the picture on the coffee mug blurred or tarnished her mark in some way. By increasing circulation of her image in the marketplace, it may actually enhance the value of her mark rather than blurring or tarnishing it.<sup>192</sup> Additionally, the dilution action is limited to “famous marks”,<sup>193</sup> and the name of a famous person is not necessarily a famous *mark*.

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<sup>189</sup> A search of the United States Patent and Trademark Office’s Trademarks Database as of November 11, 2007 shows that Britney Spears has registered her name as a mark for a variety of products including arts and craft kits, desk organizers and backpacks. However, there does not appear to be a registration specifically for coffee mugs.

<sup>190</sup> For a detailed critique of the merchandising right in trademark law, see Dogan and Lemley, *Merchandising Right*, *supra* note \_\_\_\_.

<sup>191</sup> In fact, there is currently a significant debate as to whether “trademark use” by a defendant is an essential element of a trademark infringement action in the United States: Graeme Dinwoodie and Mark Janis, *Confusion Over Use: Contextualism in Trademark Law*, 92 IOWA L R 1597 (2007); Stacey Dogan and Mark Lemley, *Grounding Trademark Law Through Trademark Use*, 92 IOWA L R 1669 (2007); Graeme Dinwoodie and Mark Janis, *Lessons from the Trademark Use Debate*, 92 IOWA L R 1703 (2007); Lastowka, *supra* note \_\_\_\_, 45-47.

<sup>192</sup> Madow, *supra* note \_\_\_\_, at 168 (“Claims of ... emotion injury [under privacy law] were not nearly as convincing when they came from celebrities .... After all, how could a movie star or professional athlete, who had deliberately and energetically sought the limelight, complain of embarrassment or hurt feelings when an advertiser or merchandiser simply gave his face some *additional* publicity?”) There is also some debate about whether increased circulation of a name or image actually increases or rather decreases the value of the celebrity identity: McKenna, *supra* note \_\_\_\_, at 269-270 (“Landes and Posner argue that overgrazing on identity leads to “face wearout,” a reduction in the value of one’s persona due to declining interest in the person as her persona is increasingly used. Their argument is at odds with the well-known maxim that “all publicity is good publicity,” though both sentiments are oversimplifications of the phenomenon of fame. Publicity tends to feed off of itself and, as a result, many uses actually increase the value of a celebrity’s identity, whatever the character of those uses. But additional publicity will increase the value of an individual’s identity only until a certain point, after which interest may wane, along with the value of the identity. In other words, early additional uses may create “network effects” that increase the value of an identity, but at some point the number of uses will lead consumers to tire of the identity and it no longer will capture their attention. In most cases, consumers lose interest in particular cultural objects simply because something has come along that better defines them at that point in time. The point of tedium, however, may be accelerated, at least in terms of chronological time, as a result of overexposure. Some celebrities have more enduring cultural significance than others and, as a result, almost every aspect of an identity’s long-term value will vary from individual to individual: the rate at which value is added by early uses, the point at which additional uses begin to erode value and the value of the persona at that point, and the rate at which the value will decline beyond the wearout point.”).

<sup>193</sup> 15 U.S.C. § 1125(c)(2)(A) (statutory definition of “famous mark” as inserted into the Lanham Act under the Trademark Dilution Revision Act, H.R. 683 of 2006).

People other than sports and entertainment celebrities may have greater difficulties with trademark focused laws. A politician, public figure, or private individual may have more trouble establishing trademark rights in her name or likeness than a sports or entertainment celebrity.<sup>194</sup> Thus, if the above hypothetical involved Rudolph Giuliani coffee mugs, rather than Britney Spears coffee mugs, Giuliani may have much more trouble establishing a trademark interest in his name or likeness, simply because he does not sell any goods or services in connection with his name or likeness in the trademark sense.

These are the kinds of situations where personality rights may be extremely helpful in substance, if not in terms of process or procedure.<sup>195</sup> Personality rights cover celebrity personas of course.<sup>196</sup> However, they have also been used by politicians,<sup>197</sup> public figures,<sup>198</sup> and private individuals<sup>199</sup> to provide remedies against unauthorized commercial uses of their personas. Although generally regarded as an “economic” tort protecting against commercial harm on the basis of a property-like right in a famous person’s identity,<sup>200</sup> it has also been recognized as having “moral” elements.<sup>201</sup> The key

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<sup>194</sup> Report of the Second WIPO Internet Domain Name Process, Sept 3, 2001, ¶ 188, available at <http://www.wipo.int/amc/en/processes/process2/report/html/report.html#5>, last viewed on November 11, 2007 (“the names of political figures, religious leaders, scientists and historical persons may never have been used in commerce and, thus, are unlikely to have trademarks associated with them.”).

<sup>195</sup> There are a number of procedural disadvantages of the right of publicity as opposed to a fast and inexpensive dispute resolution mechanism such as the UDRP. Judicial proceedings are more costly and time-consuming than private arbitration. Additionally, jurisdictional problems arise with right of publicity actions that do not arise under the UDRP. The procedural advantages of the UDRP were discussed in Part I.B.4.

<sup>196</sup> GILSON LALONDE, *supra* note \_\_\_, at § 2.16[1][b] (“The right of publicity is generally available only to celebrities, the Luciano Pavarottis, the John McEnroes, the Robert Redfords. Cases involving unknowns are usually brought under the older right of privacy.”)

<sup>197</sup> *New York Magazine v The Metropolitan Transit Authority and the City of New York*, 987 F Supp 254 (1997), *aff’d in part, vacated in part, New York Magazine v The Metropolitan Transit Authority and the City of New York*, 136 F.3d 123 (1998) (action with respect to then Mayor Rudolph Giuliani’s personality rights).

<sup>198</sup> *Rosa Parks v LaFace Records*, 329 F 3d 437 (2003) (involving publicity rights of Rosa Parks in the context of a song title using her name in relation to a hip hop recording that had nothing in particular to do with her or her work); *Martin Luther King Jr, Center for Social Change Inc v American Heritage Products*, 694 F 2d 674 (11<sup>th</sup> Cir. 1993) (the estate of Martin Luther King Jr sought an injunction to prevent the defendant from selling plastic busts of Dr King).

<sup>199</sup> GILSON LALONDE, *supra* note \_\_\_, at § 2.16[1][a] (“The first successful right of privacy action for appropriation of name and likeness was designed to enable a non-public figure to retain his anonymity. The courts gave effect to the right by enjoining the unauthorized commercial use of the plaintiff’s name and likeness, and they awarded general damages for injury to individual feelings, much as is done for libel and slander.”); *Tellado v Time-Life Books, Inc.*, 643 F Supp 904 (D.N.J. 1986) (unauthorized use of image of private individual plaintiff in Vietnam war for book and advertising materials relating to book); see also discussion in Kwall, *First Amendment*, *supra* note \_\_\_, 96-100.

<sup>200</sup> Haemmerli, *supra* note \_\_\_, at 392 (“The right of publicity is traditionally formulated as the right to exploit the commercial value of personal identity.”); Kwall, *Fame*, *supra* note \_\_\_, 15 (“a property-based

moral harm that has been protected by the right of publicity is more like a privacy protection than a property protection. The obvious example is where unauthorized commercial use is made of an individual's name or likeness in circumstances where that individual wants to maintain privacy of her image, rather than control commercial profits derived from her image. Another advantage of a right of publicity framework is that courts have already engaged in balancing exercises between personality rights and the First Amendment in a variety of contexts.<sup>202</sup> Such jurisprudence is more relevant to the personal domain name dispute context than that relating to the balance between trademark interests and the First Amendment.

Questions have arisen under the right of publicity as to whether purely expressive conduct by the defendant, not necessarily resulting in a commercial profit, should be compensable. *Rogers v Grimaldi*,<sup>203</sup> for example, is a case in which the expressive speech

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conception for publicity rights is the natural outgrowth of our cultural norms as well as our theoretical conceptions of property"); Dogan and Lemley, *Right of Publicity*, *supra* note \_\_\_, 1172-1174 (note growth of the right of publicity as an economic right); Konsky, *supra* note \_\_\_, 349 ("most courts and commentators now ground the right of publicity in property rationales."); McKenna, *supra* note \_\_\_, at 226 ("Because the right of publicity has focused entirely on the economic value of a celebrity's identity, courts considering claims have no basis to differentiate among the variety of ways in which others might exploit that value.")

<sup>201</sup> McKenna, *supra* note \_\_\_, at 231 ("All individuals have a legitimate interest in autonomous self-definition, and celebrities deserve protection against uses of their identities that implicate that interest."); Haemmerli, *supra* note \_\_\_, at 390 ("Viewing the right of publicity as an extension of human worth and autonomy, rather than as a purely economic interest, also changes the nature of the exercise that balances the right against competing social claims .... [A] Kantian grounding is preferable to a Lockean justification not only because a Kantian foundation forces the realization that the balancing challenge is complex, but because it more accurately reflects the value of the human being behind the persona at issue."); Kwall, *First Amendment*, *supra* note \_\_\_, 50 ("In evaluating the nature of the harm to the plaintiff, this Article asserts that economic harms are typically far less onerous than nonmonetizable harms which derive from uses the plaintiff would never have condoned. These nonmonetizable, or morally based, harms can include reputational damage, distasteful associations, or uses which advance a substantive argument the plaintiff finds objectionable. In addition, the potential for consumer deception is particularly strong where the use is one to which the plaintiff would never have consented.")

<sup>202</sup> Haemmerli, *supra* note \_\_\_, at 441-458 (analysis of First Amendment issues arising with respect to the right of publicity); Peter Felcher and Edward Rubin, *Privacy, Publicity, and the Portrayal of Real People by the Media*, 88 YALE LJ 1577, 1590 (1979) ("The First Amendment inevitably defines the operation and extent of the right of publicity; once the defendant can establish that the expression in question is protected, he will almost invariably prevail."); Kwall, *First Amendment*, *supra* note \_\_\_ (suggesting a property versus liability rule basis for balancing First Amendment concerns against right of publicity claims); Eileen Rielly, *The Right of Publicity for Political Figures: Martin Luther King, Jr., Center for Social Change, Inc v American Heritage Products*, 46 U PITT L REV 1161, 1172-4 (1985) (balancing First Amendment concerns with the publicity rights of public figures and politicians); Madow, *supra* note \_\_\_, at 140 (description of the role of the consumer as an active and creative participant in the creation of cultural commodities); Kwall, *Fame*, *supra* note \_\_\_, at 46-7 ("We do not deprive the owners of famous trademarks or the copyright owners of popular works of art or literature of their rights just because the public has played some role in placing a value on these works. Therefore, right-of-publicity critics must justify why the cachet of a person's fame should be treated differently."). See also Diane Zimmerman, *Who Put the Right in the Right of Publicity?*, 9 DEPAUL-LCA J. ART & ENT. L. 35 (1998).

<sup>203</sup> 875 F 2d 994 (1988).

elements of the defendant's use of the plaintiff's name and likeness were not compensable under trademark law or under the right of publicity.<sup>204</sup> In that case, the defendant had used the title "Ginger and Fred" in a film about a cabaret act that impersonated Ginger Rogers and Fred Astaire.<sup>205</sup> The court held that the defendants had used no more of Ms Rogers' identity than was necessary for expressive artistic purposes.<sup>206</sup> Ms Rogers was therefore unsuccessful on her claims in both trademark law and publicity rights.

In the Internet context, one analog to the *Rogers* facts might be the use of a personal domain name resolving to a website that commented on the person in question. The commentary could be a fan website, a parody, or a website critical of the person. Assuming the domain name registrant did not receive any commercial profit from the use of the domain name, the right of publicity may not provide any compensation to the plaintiff. However, if the registrant was attempting to make a profit from the name either by selling the name itself – that is, cybersquatting – or by using the name to attract customers to the website for commercial purposes, a right of publicity claim would more likely be successful.

## B. DOES A PERSONALITY RIGHTS FRAMEWORK IMPROVE ON THE CURRENT SITUATION?

### 1. *Personality Rights vs the UDRP*

Despite the theoretical suitability of personality rights law for personal domain name disputes, most disputes are currently brought under the UDRP?<sup>207</sup> There are a number of reasons why this has been the case, relating to cost, timing, and general

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<sup>204</sup> *id.*

<sup>205</sup> *id.*, 996-7.

<sup>206</sup> *id.*, 1005 (“[W]e hold that section 43(a) of the Lanham Act does not bar a minimally relevant use of a celebrity's name in the title of an artistic work where the title does not explicitly denote authorship, sponsorship, or endorsement by the celebrity or explicitly mislead as to content. Similarly, we conclude that Oregon law on the right of publicity, as interpreted by New York, would not bar the use of a celebrity's name in a movie title unless the title was "wholly unrelated" to the movie or was "simply a disguised commercial advertisement for the sale of goods or services.”)

<sup>207</sup> There are only a small handful of cases where the right of publicity has been argued in the domain name context. See, for example, *Kevin Trudeau v George Lanoue*, 2006 U.S. Dist. LEXIS 7956 (2006) (in which a right of publicity claim was made, amongst other unfair competition claims, in a dispute involving a domain name corresponding with the plaintiff's personal name); *Paul Wright v Domain Source Inc.*, 2002 U.S. Dist. LEXIS 16024 (2002) (plaintiff brought a claim under § 17525 of the Californian Business and Professions Code, which is a cyberspace analog to right of publicity law in some respects as it protects personal names in the domain space against certain unauthorized uses); *Beezy*, *supra* note \_\_\_, at 23-24 (noting high success rate of celebrities in personal domain name proceedings under the UDRP and surveying some of the recent decisions); *Moreland*, *supra* note \_\_\_, at 386 (noting high success rate of celebrities in personal domain name disputes under the UDRP, and citing Statistical Summary for Proceedings under the Uniform Domain Name Dispute Resolution Policy (February 26, 2001), 394 (“A plethora of disputes involving personal names have been submitted to ICANN Arbitration.”)).

accessibility for individual complainants when compared to litigation under either trademark or right of publicity law.<sup>208</sup> Judicial proceedings will be more costly and time and resource intensive than online arbitration.<sup>209</sup> Compared even with federal trademark law, the right of publicity has a number of procedural disadvantages. For one thing, it is state law that is not harmonized nationally within the United States,<sup>210</sup> let alone globally. This potentially causes conflicts of law issues, including problems of asserting jurisdiction over an out of state defendant,<sup>211</sup> as well as choice of law issues.<sup>212</sup>

Apart from these problems with litigation, it is likely that complainants are simply more focused on the UDRP for *any* domain name dispute than with the right of publicity. When complainants and their legal counsel think of personal domain name disputes, they probably instinctively categorize them as “domain name disputes”, rather than “personal name disputes” and so focus on the set of rules geared towards resolving the former.<sup>213</sup> In many ways, this is a problem of classification. If one classifies a given dispute as a “domain name dispute” rather than as a “dispute to protect the integrity of an individual’s persona”, one will tend to think of domain name focused rules, rather than personal identity rules.

This article identifies advantages in marrying the substance of the personality rights tort with the procedural advantages of the UDRP to arrive at the best solutions regardless of whether the dispute is classified as being primarily “about domain names”

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<sup>208</sup> Moreland, *supra* note \_\_\_, at 395 (“ICANN Arbitration offers celebrities and their lawyers a quick, cost effective and usually successful means to recover domain names registered by third parties that incorporate the celebrity’s name.”)

<sup>209</sup> *id.*

<sup>210</sup> Haemmerli, *supra* note \_\_\_, at 389 (“Existing practice [under the right of publicity] is ... confused, with fifty state regimes protecting differing aspects of identity, for varied terms, and with disparate remedies.”); GILSON LALONDE, *supra* note \_\_\_, at § 2.16[1] (“The publicity right is still developing and the courts are far from unanimous in defining its scope. Precedent (or the lack of it) in the selected forum may thus dictate reliance on trademark rights and unfair competition claims to the exclusion of, or in addition to, the publicity right.”); *Rogers v Grimaldi*, 875 F 2d 994, 1002-1004 (1988) (court discussing problems of applying Oregon’s right of publicity law in a New York forum).

<sup>211</sup> This has been an issue with respect to personal domain name disputes in the past. See *Paul Wright v Domain Source Inc.*, 2002 U.S. Dist. LEXIS 16024, ¶¶ 1-3 (2002) (discussion of jurisdictional issues raised in complaint against cybersquatter’s registration of paulwright.com domain name). The movie actor Kevin Spacey was also initially unsuccessful in a cybersquatting claim against the registrant of kevinpacey.com on jurisdictional grounds, but later succeeded under a UDRP proceeding: Kieren McCarthy, *Kevin Spacey Loses Pivotal Cybersquatting Court Case*, THE REGISTER, Nov 26, 2001 (available at [http://www.theregister.co.uk/2001/11/26/kevin\\_spacey\\_loses\\_pivotal\\_cybersquatting/](http://www.theregister.co.uk/2001/11/26/kevin_spacey_loses_pivotal_cybersquatting/), last viewed on November 8, 2007).

<sup>212</sup> See, for example, *Rogers v Grimaldi*, 875 F 2d 994, 1002-1004 (1988) (court discussing problems of applying Oregon’s right of publicity law in a New York forum).

<sup>213</sup> Of course, there are some legislative provisions that could be categorized as aimed at both domain name disputes and personal names: for example, 15 U.S.C. § 1129(1)(A). However, these laws require expensive domestic litigation as opposed to inexpensive online arbitration.

or “about personality”. Under a new PDRP, one could achieve the time and cost benefits of the UDRP, but with a clearer focus on the aspects of an individual’s persona that should be protected in the domain space as a substantive policy matter. One could also avoid undesirable expansions of trademark law into matters involving personal names that do not really operate as trademarks, as well as minimizing inconsistencies in arbitrations about which personal names should be accepted as trademarks.

In substance, what would a personality rights based PDRP do differently than the UDRP? Take, at a broad level of generality, the two major classes of conduct that concern potential personal domain name complainants. The first are cybersquatting situations where a registrant has registered or used a domain name corresponding with the plaintiff’s personal name with the intent to sell it for a profit. The second are situations where a registrant does not want to sell the domain name, but wants to use it for commercial or commentary purposes. With respect to the first class – cybersquatting – a personality rights framework improves on the UDRP in several ways. It does not require the complainant to establish a trademark interest in her personal name.<sup>214</sup> Thus, it applies equally to extremely famous celebrities<sup>215</sup> as to politicians,<sup>216</sup> public figures,<sup>217</sup> and

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<sup>214</sup> Of course, infringement under legislative provisions such as 15 U.S.C. § 1129(1)(A) does not require establishment of a trademark in a personal name, but it does require often expensive litigation.

<sup>215</sup> The right of publicity has its most obvious applications in the case of celebrity personas: GILSON LALONDE, *supra* note \_\_\_, at § 2.16[1] (“The right of publicity, a developing common law right of great value to the celebrity ...”); Dogan and Lemley, *Right of Publicity*, *supra* note \_\_\_, 1164 (conceiving right of publicity in terms of protecting celebrities’ names and likenesses); *Bette Midler v Ford Motor Company*, 849 F 2d 460 (1988) (right of publicity action involving Bette Midler’s distinctive singing voice); *Tom Waits v Frito-Lay Inc*, 978 F 2d 1093 (1992) (right of publicity action involving Tom Waits’ distinctive singing voice); *Rogers v Grimaldi*, 875 F 2d 994 (1988) (right of publicity action involving Ginger Rogers’ name); Michael Carrier, *Cabining Intellectual Property Through a Property Paradigm*, 54 DUKE L J 1, 141-142 (2004) (“Celebrities play a central role in discourse today ... In a world of increasing fragmentation, references to celebrities are essential for dialogue on issues such as culture and values ... By putting alternative conceptions of celebrity off limits, the right of publicity ... threatens to suppress expression and to give celebrities the power to censor alternative versions of their images that are, for example, iconoclastic or irreverent.”); McKenna, *supra* note \_\_\_, at 226 (conceiving of the right of publicity as being focused “entirely on the economic value of a celebrity’s identity”); Madow, *supra* note \_\_\_ (critiquing the right of publicity in the celebrity context).

<sup>216</sup> Rielly, *supra* note \_\_\_, at 1169-1172 (discussing the application of the right of publicity to political figures); *New York Magazine v The Metropolitan Transit Authority and the City of New York*, 987 F Supp 254 (1997), *aff’d in part, vacated in part*, *New York Magazine v The Metropolitan Transit Authority and the City of New York*, 136 F.3d 123 (1998) (on Mayor Rudolph Giuliani’s rights of privacy and publicity); Charles Harder and Henry L Self III, *Schwarzenegger vs. Bobbleheads: The Case for Schwarzenegger*, 45 SANTA CLARA L REV 557 (2005); William Gallagher, *Strategic Intellectual Property Litigation, the Right of Publicity, and the Attenuation of Free Speech: Lessons from the Schwarzenegger Bobblehead Doll War (and Peace)*, 45 SANTA CLARA L REV 581 (2005); David Welkowitz and Tyler Ochoa, *The Terminator as Eraser: How Arnold Schwarzenegger Used the Right of Publicity to Terminate Non-Defamatory Political Speech*, 45 SANTA CLARA L REV 651 (2005); Jacqueline Lipton, *Who Owns Hillary.com? Political Speech and the First Amendment in Cyberspace*, 49 BOSTON COLLEGE L REV 55 (2008).

<sup>217</sup> *Rosa Parks v LaFace Records*, 329 F 3d 437 (2003) (involving publicity rights of Rosa Parks in the context of a song title using her name in relation to a hip hop recording that had nothing in particular to do with her or her work); *Martin Luther King Jr, Center for Social Change Inc v American Heritage*

private individuals,<sup>218</sup> not to mention “lesser celebrities”.<sup>219</sup> It would clearly cover cybersquatting because it prevents the use of another’s name or likeness for an unauthorized commercial profit.<sup>220</sup> Thus, it would cover all cybersquatting involving a personal name regardless of the trademarkability of the name.<sup>221</sup>

One might argue that the deficiencies of the UDRP here could be remedied easily enough by simply including a personal name as a protected interest under the UDRP alongside a trademark. This would prohibit all cybersquatting involving any personal name regardless of whether or not the name in question operated as a trademark.<sup>222</sup>

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*Products*, 694 F 2d 674 (11<sup>th</sup> Cir. 1993) (the estate of Martin Luther King Jr sought an injunction to prevent the defendant from selling plastic busts of Dr King).

<sup>218</sup> *Kevin Trudeau v George Lanoue*, 2006 U.S. Dist. LEXIS 7956 (2006) (in which a right of publicity claim was made, amongst other unfair competition claims, in a dispute involving a domain name corresponding with the plaintiff’s personal name); *Paul Wright v Domain Source Inc.*, 2002 U.S. Dist. LEXIS 16024 (2002) (plaintiff brought a claim under § 17525 of the Californian Business and Professions Code, which is a cyberspace analog to right of publicity law in some respects as it protects personal names in the domain space against certain unauthorized uses).

<sup>219</sup> In other words, it would cover situations where people like Bruce Springsteen and Anna Nicole Smith had trouble convincing UDRP arbitrators that they held trademark interests in their personal names. See *Bruce Springsteen v Jeff Burgar and Bruce Springsteen Club*, WIPO Case No. D2000-1532, Jan. 25, 2001, ¶ 6 (available at <http://arbiter.wipo.int/domains/decisions/html/2000/d2000-1532.html>) (“It appears to be an established principle from cases such as Jeanette Winterson, Julia Roberts, and Sade that in the case of very well known celebrities, their names can acquire a distinctive secondary meaning giving rise to rights equating to unregistered trade marks, notwithstanding the non-registerability of the name itself. It should be noted that no evidence has been given of the name “Bruce Springsteen” having acquired a secondary meaning; in other words a recognition that the name should be associated with activities beyond the primary activities of Mr. Springsteen as a composer, performer and recorder of popular music. In the view of this Panel, it is by no means clear from the UDRP that it was intended to protect proper names of this nature.”); *Anna Nicole Smith v DNS Research Inc*, National Arbitration Forum Claim No FA0312000220007, Feb 21, 2004 (available at <http://www.adr-forum.com/domains/decisions/220007.htm>), last viewed on October 25, 2007 (“it is unlikely that the evidence submitted here by the Complainant of her career, in and of itself, is sufficient to establish common law trademark rights in the name, which is a requirement for Complainant to prevail on this aspect of the case. While the UDRP does not require a *registered* trademark for protection of a trademark from a confusingly identical domain name, the mere fact of having a successful career as an actress, singer or TV program star does not provide exclusive rights to the use of a name under the trademark laws.”).

<sup>220</sup> Kwall, *First Amendment*, *supra* note \_\_\_, 47 (“The right of publicity is a legal theory which enables individuals to protect themselves from unauthorized, commercial appropriations of their personas.”); Carrier, *supra* note \_\_\_, 22-23 (“The right of publicity prevents the appropriation of an individual’s name or likeness for commercial advantage.”); Konsky, *supra* note \_\_\_, 347 (“The right of publicity prohibits commercial use of a person’s name or likeness without the person’s consent.”); GILSON LALONDE, *supra* note \_\_\_, at § 2.16[1] (“The right of publicity ... is the right of an individual to control the commercial use of his or her name, likeness, signature, or other personal characteristics.”)

<sup>221</sup> Of course, § 1129 of the Lanham Act would also cover the same conduct. However, that involves litigation as opposed to inexpensive online arbitration, so a PDRP would be an improvement over the Lanham Act for personal domain name disputes.

<sup>222</sup> See discussion in Jacqueline Lipton, *Who Owns Hillary.com? Political Speech and the First Amendment in Cyberspace*, 49 BOSTON COLLEGE L REV 55 (2008).

Nevertheless, the UDRP for the most part is still geared at protecting marks in cyberspace against unauthorized commercial uses likely to confuse consumers as to source or origin of goods or services.<sup>223</sup> In other words, it is still focused on aspects of trademark law that are not necessarily well suited to addressing concerns about unauthorized commercial uses of personal names. Thus, even adding a personal name as a protected interest under the existing UDRP would likely lead to inconsistent and arbitrary results as UDRP arbitrators attempted to apply trademark-like tests to personal name disputes.

Additionally, the UDRP is not particularly appropriate for the second class of personal domain name conflicts: that is, situations in which the registrant does not want to *sell* the name for a profit, but rather wants to *use* it herself for some reason. These situations really boil down into two sub-categories which can overlap: commerce and commentary. Some unauthorized uses of a personal domain name will be commercial and some will be for commentary purposes – whether it be idolatry, parody or criticism, or a combination. Additionally, it is possible for a website to contain elements of commerce and elements of commentary simultaneously. A fan website may charge a fee for joining a relevant fan club, online chat group or the like. It may equally sell unauthorized celebrity merchandise. A website critical of a particular person may sell or advocate the sale of merchandise or information supporting a view critical of that person or her views.<sup>224</sup> Even a parody website may advocate the sale of merchandise critical of the person or institution being parodied.<sup>225</sup> These kinds of cases raise difficult questions of balancing interests in an individual's persona against the First Amendment. Personality rights law is the body of law that has historically dealt with this balance. Trademark law has dealt with a similar balance relating to protecting free speech against trademark interests.<sup>226</sup> However, the interests of a trademark holder are somewhat

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<sup>223</sup> See, for example, UDRP, para 4(b) (“the following circumstances, in particular but without limitation, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith: (i) circumstances indicating that you have registered or you have acquired 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 of that complainant, for valuable consideration in excess of your documented out-of-pocket costs directly related to the domain name; or (ii) you have registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that you have engaged in a pattern of such conduct; or (iii) you have registered the domain name primarily for the purpose of disrupting the business of a competitor; or (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.”)

<sup>224</sup> See, for example, *Lamparello v Falwell*, 420 F.3d 309 (2005) (gripesite contained links to amazon.com webpage selling a book critical of the Reverend Jerry Falwell's views on homosexuality).

<sup>225</sup> *People for the Ethical Treatment of Animals v Doughney*, 113 F.Supp.2d 915 (2000); *aff'd* 263 F.3d 359 (2001) (parody site linking to websites where fur and animal products antithetical to plaintiff's views were available for sale).

<sup>226</sup> For a general discussion of these issues, see also Jacqueline Lipton, *Commerce versus Commentary: Gripe Sites, Parody and the First Amendment in Cyberspace*, 84 WASH U L REV 1327

different to those of an individual in her persona – and the appropriate body of rules should be applied in each case. Rights in individual personas flow from both theories of personhood and theories of property,<sup>227</sup> while trademark rights are focused purely on commercial source identifiers.<sup>228</sup>

## 2. Case Study 1: Unauthorized Celebrity Websites

Two examples might be useful to illustrate ways in which a personality rights framework for personal domain name disputes might differ from a trademark-focused model. Two obvious cases might be: (a) a celebrity concerned about an unauthorized fan website utilizing her personal name as a domain name; and, (b) a politician concerned about a website that uses her personal name as a domain name and contains messages critical of her, or her views. These examples have been chosen because they both implicate First Amendment concerns. However, the first example may additionally implicate commercial values much more than the second example. Each example deals with ways in which a personality rights framework might balance the complainant's rights in her persona against First Amendment concerns.

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(2006); Margreth Barrett, *Domain Names, Trademarks and the First Amendment: Searching for Meaningful Boundaries*, 39 CONNECTICUT LAW REVIEW 973 (2007).

<sup>227</sup> On theories of the right of publicity with a focus on personhood and individual autonomy, see Haemmerli, *supra* note \_\_\_\_\_. On the property theory basis for the right of publicity, see Dogan and Lemley, *Right of Publicity*, *supra* note \_\_\_\_, 1181-1183 (critique of Lockean labor theory justifications for personality rights as property); McKenna, *supra* note \_\_\_\_, 247 (“It might be true that identity is sufficiently similar to other objects the law regards as property and therefore deserves at least some of the sticks in the traditional bundle of property rights. But far too few courts and commentators have offered a theory as to why any of the traditional property justifications lead to that conclusion.”); 251-267 (critique of Lockean labor theory justifications for property rights in personal identity); Alice Haemmerli, *Whose Who? The Case for a Kantian Right of Publicity*, 49 DUKE L J 343, 388 (“Both proponents and critics of the right of publicity generally perceive it as a property claim grounded in Lockean labor theory.”), 407-8 (1999) (noting dual property and privacy justifications for right of publicity actions), 412 (“To the extent that commentators specifically address publicity rights, they tend to do so within this property context, and to use Lockean labor theories of property to explain the assertion of a property right in identity or persona.”); Kwall, *Fame*, *supra* note \_\_\_\_, 15 (“This Article ... contends that a property-based conception for publicity rights is the natural outgrowth of our cultural norms as well as our theoretical conceptions of property.”); David Westfall and David Landau, *Publicity Rights as Property Rights*, 23 CARDOZO ARTS AND ENT LJ 71 (2005) (examining property basis for rights of publicity); Rielly, *supra* note \_\_\_\_, 1165-9 (describing development of a property rights rationale for the right of publicity). See also Diane Zimmerman and Melissa Jacoby, *Foreclosing on Fame: Exploring the Uncharted Boundaries of the Right Of Publicity*, 77 N.Y.U. L. REV. 1322 (2002).

<sup>228</sup> Traditional trademark law has generally been premised on two interconnected aims: (a) to protect the public when purchasing a product or service to ensure that the purchasers get what they think they are paying for in terms of goods or services from a particular source; and, (b) to ensure that those who invest in developing goodwill in a particular mark are protected against unfair misappropriations of that goodwill. See GRAEME DINWOODIE and MARK JANIS, TRADEMARKS AND UNFAIR COMPETITION, 563-566 (2004) (citing S. Rep. No. 1333, 79<sup>th</sup> Cong., 2d Sess. 3 (1946)); Stacey Dogan and Mark Lemley, *Trademarks and Consumer Search Costs on the Internet*, 41 HOUSTON LAW REVIEW 777, 786 (2004) (noting the benefits to both consumers and producers of consumers having access to ‘truthful information about the source of products and services’).

In the first case, the trademark-focused laws would obviously not help the celebrity at all unless she could establish a trademark interest in her personal name.<sup>229</sup> Assuming she could establish such an interest, she would have to establish that the website in question was confusing consumers for a trademark infringement action,<sup>230</sup> was dilutive of her name in commerce for a dilution action,<sup>231</sup> or was registered and used in bad faith for an ACPA action<sup>232</sup> or a UDRP arbitration. This is putting to one side an action under the personal name provisions of the Lanham Act on the basis that they only prohibit bad faith intents to sell the relevant domain name,<sup>233</sup> and not unauthorized uses of the name *per se*.

An unauthorized fan website is probably not confusing to consumers provided that it is not passing itself off as an authorized fan website. Thus, a disclaimer might cure any confusion and mitigate against the likelihood of a successful trademark infringement action.<sup>234</sup> If no commercial activity is conducted on the website, it is not likely to be “in commerce” for the purposes of a dilution action.<sup>235</sup> However, if there are commercial activities, such as charging membership fees or engaging in advertising, could an unauthorized fan site be said to be dilutive of a celebrity persona as a mark? Even if there is some commercial activity, it is possible that the use of the domain name could be excused under the new “commentary” defense to dilution inserted into the Lanham Act in 2006.<sup>236</sup> Obviously, the fan site creates some “noise” around the celebrity’s name, but

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<sup>229</sup> Obviously, 15 U.S.C. § 1129(1) applies in the absence of a trademark interest as discussed above. However, it only prohibits cybersquatting and does not cover any other unauthorized uses of a domain name corresponding with a person’s name.

<sup>230</sup> 15 U.S.C. §§ 1114 (infringement of registered trademarks); 1125(a) (infringement of unregistered trademarks).

<sup>231</sup> 15 U.S.C. § 1125(c).

<sup>232</sup> 15 U.S.C. § 1125(d).

<sup>233</sup> 15 U.S.C. § 1129(1).

<sup>234</sup> *Bridgestone Firestone v Myers*, WIPO Case No, D2000-0190, July 6, 2000, (available at <http://www.wipo.int/amc/en/domains/decisions/html/2000/d2000-0190.html>) (“In the cybersquatting cases, the domain names in question generally were www.trademark.com domain names, which prevented the trademark holder from utilizing the customary commercial domain name for its “official” site . . . . Here, however, the domain name registrant has not usurped the <.com> domain, but has utilized only the <.net> domain, has posted disclaimers on the website homepage, and has included criticism or commentary on the site so that a reasonably prudent Internet user can tell that the site is not the trademark holder’s “official” site.”); Haemmerli, *supra* note \_\_\_, at 400 (noting a non-Internet setting that the use of a highly visible disclaimer on a film might negate likelihood of confusion); but see also *Planned Parenthood Federation of America Inc v Bucci*, 42 U.S.P.Q. 2d 1430, pp 39-40 (S.D.N.Y. 1997) (defendant’s use of *plannedparenthood.com* domain name for messages critical of the Planned Parenthood organization would likely confuse consumers as to the source of various services provided by the plaintiff regardless of the use of a disclaimer).

<sup>235</sup> 15 U.S.C. § 1125(c)(3)(C).

<sup>236</sup> 15 U.S.C. § 1125(c)(3)(A)(ii) (excusing identifying the plaintiff for the purposes of parody, criticism and commentary from the scope of a trademark dilution action).

such noise may be reinforcing the celebrity's identity, rather than blurring or detracting from it.<sup>237</sup> Additionally, a celebrity's name is unlikely to meet the definition of "famous mark".<sup>238</sup> Thus, a dilution action may not be successful in this case. Further, if the domain name has been registered not in bad faith but for the purposes of legitimate fan related commentary, the provisions of § 1125(d)(1)(A) of the Lanham Act are unlikely to be satisfied in terms of a traditional cybersquatting action.<sup>239</sup>

Would the right of publicity give a different result here and, just as importantly, should it? One might argue that because trademark laws carry these inherent limitations, partly to balance them against First Amendment concerns, the same should be true of personality rights law. Otherwise, individual names and likenesses will be over-propertized and this result will chill free expression on the Internet. However, it is important not to consider rights in personal names with too much emphasis on trademark law. Personality rights clearly implicate a number of concerns similar to trademark law.<sup>240</sup> However, they also protect other aspects of an individual's personality, such as the right to keep certain aspects of a persona out of the public domain. Thus, while trademark jurisprudence may in some ways inform the development of personality rights jurisprudence, trademarks are not the same as personality rights.<sup>241</sup>

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<sup>237</sup> See McKenna, *supra* note \_\_\_\_, at 269-270 ("Landes and Posner argue that overgrazing on identity leads to "face wearout," a reduction in the value of one's persona due to declining interest in the person as her persona is increasingly used. Their argument is at odds with the well-known maxim that "all publicity is good publicity," though both sentiments are oversimplifications of the phenomenon of fame. Publicity tends to feed off of itself and, as a result, many uses actually increase the value of a celebrity's identity, whatever the character of those uses. But additional publicity will increase the value of an individual's identity only until a certain point, after which interest may wane, along with the value of the identity. In other words, early additional uses may create "network effects" that increase the value of an identity, but at some point the number of uses will lead consumers to tire of the identity and it no longer will capture their attention. In most cases, consumers lose interest in particular cultural objects simply because something has come along that better defines them at that point in time. The point of tedium, however, may be accelerated, at least in terms of chronological time, as a result of overexposure. Some celebrities have more enduring cultural significance than others and, as a result, almost every aspect of an identity's long-term value will vary from individual to individual: the rate at which value is added by early uses, the point at which additional uses begin to erode value and the value of the persona at that point, and the rate at which the value will decline beyond the wearout point.")

<sup>238</sup> 15 U.S.C. § 1125(c)(2)(A) now defines "famous mark" as follows: "[A] mark is famous if it is widely recognized by the general consuming public of the United States as a designation of source of the goods or services of the mark's owner. In determining whether a mark possesses the requisite degree of recognition, the court may consider all relevant factors, including the following: (i) The duration, extent, and geographic reach of advertising and publicity of the mark, whether advertised or publicized by the owner or third parties. (ii) The amount, volume, and geographic extent of sales of goods or services offered under the mark. (iii) The extent of actual recognition of the mark...."

<sup>239</sup> The same will be true of an attempt to satisfy the bad faith requirements of the UDRP: see UDRP, clause 4(b).

<sup>240</sup> For a detailed discussion of the similarities between trademark law and the right of publicity, see Dogan and Lemley, *Right of Publicity*, *supra* note \_\_\_\_.

<sup>241</sup> Dogan and Lemley, *Right of Publicity*, *supra* note \_\_\_\_, at 1211 (noting differences between personality rights and trademarks, including the fact that there is no "use in commerce" or secondary meaning requirement for complainants under the right of publicity).

The right of publicity tort does not require the complainant to establish trademark-like incidents in her personal name or likeness.<sup>242</sup> This is clearly an advantage for complainants over the UDRP. However, the commercial use requirement could be a problem here in the same way that it could be a problem in a trademark-based action. If the view is taken that all Internet conduct is commercial because of the nature of the Internet,<sup>243</sup> the commercial use requirement is automatically satisfied. If not, it may be that the nature of the activities on the website could satisfy the commercial use requirement only if the registrant was advertising,<sup>244</sup> or selling products or services on the relevant website. This may well be as it should be. A purely expressive website, even in the <name.com> space, should perhaps be protected speech where there is no unfair or unauthorized commercial gain being made from someone else's persona.

On the other hand, the right of publicity protects individuals from being thrust into the limelight against their wishes<sup>245</sup> – this is the privacy aspect of the right, usually applied more to private individuals than celebrities on the basis that the latter are presumably expecting, and even overtly seeking, the limelight.<sup>246</sup> While the privacy-based aspects of the right of publicity are usually geared towards private individuals, and even then at public *commercial* uses of a private individual's persona,<sup>247</sup> there may be some scope to argue that celebrities should have some privacy rights in relation to at least

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<sup>242</sup> *id.*

<sup>243</sup> *Planned Parenthood Federation of America Inc v Bucci*, 42 U.S.P.Q. 2d 1430, page 11 (S.D.N.Y. 1997) (“Internet users constitute a national, even international, audience, who must use interstate telephone lines to access defendant's web site on the Internet. The nature of the Internet indicates that establishing a typical home page on the Internet, for access to all users, would satisfy the Lanham Act's "in commerce" requirement.”). But note that this reasoning relates to the Lanham Act's “in commerce” requirement in particular and may not automatically apply to the right of publicity. An example of a similar judicial interpretation that everything on the Internet is automatically “in commerce” outside the trademark context is found in *American Libraries Association v Pataki*, 969 F. Supp. 160, 45 (S.D.N.Y. 1997) (“In addition, many of those users who are communicating for private, noncommercial purposes are nonetheless participants in interstate commerce by virtue of their Internet consumption. Many users obtain access to the Internet by means of an on-line service provider, such as America Online, which charges a fee for its services. "Internet service providers," including plaintiffs Panix, Echo, and NYC NET, also offer Internet access for a monthly or hourly fee. Patrons of storefront "computer coffee shops," such as New York's own CyberCafe, similarly pay for their access to the Internet, in addition to partaking of food and beverages sold by the cafe. Dial-in bulletin board systems often charge a fee for access.”)

<sup>244</sup> See, for example, *Tom Cruise v Alberta Hot Rods*, WIPO Case No D2006-0560, 5 July, 2006, para. 4 (available at <http://www.wipo.int/amc/en/domains/decisions/html/2006/d2006-0560.html>) (the relevant website included links to services and products that were not connected with the complainant).

<sup>245</sup> See Dogan and Lemley, *Right of Publicity*, *supra* note \_\_\_\_, at 1167.

<sup>246</sup> *id.*

<sup>247</sup> See, for example, *Tellado v Time-Life Books, Inc*, 643 F Supp 904 (D.N.J. 1986) (involving the unauthorized use of a Vietnam war veteran's photo on promotional materials for a series of books about the Vietnam war).

<name.com> versions of their names online. There have been cases where the right to publicity has prevented public uses of likenesses of private individuals even where there is no direct economic harm to the plaintiff and where the plaintiff's concern is with moral privacy-related objections to the use of the image, rather than economic benefits.<sup>248</sup>

Although one might argue that celebrities should not be entitled to bring such actions because of their admittedly public personas, the nature of the Internet brings a new scope and scale to the idea of unauthorized public distribution.<sup>249</sup> Whereas a plaintiff in the past may have been concerned about emotional distress or loss of privacy in relation to an unauthorized billboard advertisement in one or more specific geographical locations, today's plaintiff may face a complete loss of privacy in the face of the whole world.<sup>250</sup> Thus, even a celebrity may be entitled to some control of Internet content about her on this basis, particularly if that control is initially limited to the <name.com> space which is likely the most closely associated with the idea of the celebrity's authorized online persona. A PDRP based on a personality rights framework might justify this result. Decisions under the PRDP based on balancing the rights of a given celebrity in her persona against the registrant's free speech entitlements would create a more nuanced jurisprudence for these situations in cyberspace. Such a jurisprudence might ultimately inform the development of personality rights in cyberspace more generally: that is, perhaps in other domain spaces, or with respect to the use of unauthorized celebrity images on websites that do not use the complainant's name in the domain space at all. In any event, it is the right of publicity, rather than trademark law, that most appropriately deals with these questions.

### 3. Case Study 2: Unauthorized Political Websites

With respect to the second hypothetical raised above – a website critical of a politician under a <name.com> domain – trademark focused laws are again a poor fit.<sup>251</sup> They are not aimed at balancing a politician's rights in her persona against the public interest in free speech. Most politicians do not have, or should not be regarded as having, trademarks in their personal names. The balance of their interests in their names against the public's right to comment about them should not be a part of trademark law. However, it might be determined effectively by personality rights principles.

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<sup>248</sup> *id.*; Kwall, *First Amendment*, *supra* note \_\_\_\_, at 96-100 (discussion of *Tellado v Time-Life Books, Inc.*, 643 F Supp 904 (D.N.J. 1986) – a publicity rights case involving emotional distress to the plaintiff, rather than economic loss).

<sup>249</sup> See DANIEL SOLOVE, *THE FUTURE OF REPUTATION: GOSSIP, RUMOR, AND PRIVACY ON THE INTERNET*, 33 (2007) (“The Internet ... makes gossip a permanent reputational stain, one that never fades. It is available around the world, and with Google it can be readily found in less than a second.”)

<sup>250</sup> *id.*

<sup>251</sup> Other than potentially provisions such as 15 U.S.C. § 1129(1) that do not require a trademark interest, although this provision is limited to cybersquatting so would not be relevant in a situation where the domain name registrant did not want to ultimately sell the name for a profit.

Even in a situation where a politician can establish trademark rights in her name, a trademark infringement action is an unlikely candidate for resolving issues about unauthorized political commentary. There will likely be no consumer confusion in such cases. It is possible that a court liberally applying the initial interest confusion doctrine<sup>252</sup> would find confusion here in the sense that the Internet user is initially confused by use of the <name.com> domain name and ends up on a website she did not desire to access.<sup>253</sup> However, the initial interest confusion test is not universally accepted in trademark law.<sup>254</sup> Even in cases where a court was prepared to adopt the doctrine, the case of a political criticism website could be distinguished from prior initial interest confusion cases on the basis that the prior cases have generally had something to do with competing commercial activity, rather than purely expressive content.<sup>255</sup>

Trademark dilution will also not be an appropriate fit for these situations. The point of trademark dilution is to protect famous commercial marks from losing their distinctiveness in the marketplace,<sup>256</sup> and not to protect politicians against undesired commentary.<sup>257</sup> Even where politicians can establish trademarks in their names for infringement purposes, they would have to establish a “famous mark” for dilution purposes.<sup>258</sup> This would be difficult even for well-known politicians.<sup>259</sup> Even if sufficient fame could be shown, the complainant politician would still have to satisfy the

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<sup>252</sup> Lastowka, *supra* note \_\_\_, 35-36 (“With respect to search engines ... a ... significant expansion of trademark law is the doctrine of initial interest confusion. Traditionally, and not surprisingly, most courts have focused analysis of consumer confusion on the time period proximate to consumer purchases. The doctrine of initial interest confusion shifts the focus of confusion analysis to a time prior to the time of purchase. Initial interest confusion can be found to exist even if that confusion was not present at the time of purchase.”); see also Jennifer Rothman, *Initial Interest Confusion: Standing at the Crossroads of Trademark Law*, 27 CARDOZO L REV 105 (2005); Goldman, *supra* note \_\_\_, 559 (“[Initial interest confusion] lacks a rigorous definition, a clear policy justification, and a uniform standard for analyzing claims. With its doctrinal flexibility, [it] has become the tool of choice for plaintiffs to shut down junior users who have not actually engaged in misappropriative uses.”)

<sup>253</sup> See, for example, *Planned Parenthood Federation of America Inc v Bucci*, 42 U.S.P.Q. 2d 1430 (S.D.N.Y. 1997) (in which court held that even the use of a disclaimer on the relevant website would not detract from such confusion).

<sup>254</sup> Lastowka, *supra* note \_\_\_, at 36 (“Though not all federal circuits have endorsed the doctrine of initial interest confusion and the Supreme Court has yet to consider a case applying it, many courts have accepted and applied the doctrine.”)

<sup>255</sup> See, for example, survey of relevant cases in Lastowka, *supra* note \_\_\_, at 36.

<sup>256</sup> GILSON LALONDE, *supra* note \_\_\_, § 5A.01[1] (“Federal dilution law protects famous trademarks from unauthorized uses that are likely to impair their distinctiveness or harm their reputation.”)

<sup>257</sup> In fact, the recently adopted 15 U.S.C. § 1125(c)(3)(A)(ii) provides an express “commentary” defense to a dilution action.

<sup>258</sup> In particular, the new definition of “famous mark” for dilution purposes contemplates fame with respect to the sale of goods or services: 15 U.S.C. § 1125(c)(2)(A). This is not the kind of interest usually associated with politicians’ names.

<sup>259</sup> *id.*

“blurring or tarnishment”<sup>260</sup> and “in commerce”<sup>261</sup> requirements. Additionally, there is now a new “commentary” defense to dilution that may become relevant in these situations.<sup>262</sup> Blurring could be difficult to establish here as a website critical of a politician is not likely to blur the distinctive power of the politician’s name as a mark, but rather reinforces the politician’s identity, while criticizing her. Internet users accessing either <bobkeenan.com> or <lindamcculloch.com> would have a clear and accurate idea of the respective personal identities of Bob Keenan and Linda McCulloch. They would simply be exposed to views critical of Keenan and McCulloch.

Tarnishment may be a possibility in such cases, but, again, the registrant’s conduct may be tarnishing the politician’s personal reputation, but would be unlikely to be tarnishing the politician’s name in a trademark sense. Criticizing a politician’s views on a particular issue will not interfere with the integrity of the politician’s name as a mark in connection with the sale of goods or services, such as books and campaign merchandise. It will rather impact on the way in which people regard the politician and her suitability for office. Such criticism may even increase sales of books written by the relevant politician by people interested in learning more about the politician’s views spurred on by the criticisms of the politician. Finally, there is the issue of whether purely expressive content is “in commerce” for dilution purposes.<sup>263</sup> A commentary website, such as the <bobkeenan.com> and <lindamcculloch.com> examples do not appear to have any commercial application. Thus, unless all Internet conduct is regarded as commercial, pure political gripesites will likely not satisfy the threshold for trademark dilution. Even if the conduct is regarded as being “in commerce”, it may still be excused under the new “commentary” defense to a dilution action.<sup>264</sup> This is not surprising, because trademark dilution was never intended to cover political commentary.

The ACPA and the UDRP will not help much with this balance because of their focus on commercial bad faith cybersquatting. Sections 1125(d) and 1129(1)(A) of the Lanham Act each assume that the defendant’s purpose in registering a relevant domain name is to make a bad faith commercial profit. A registrant who has registered a politician’s name as a domain name for expressive purposes is unlikely to satisfy the test set out in either section. Section 1125(d) will not apply unless the politician has a trademark in her name. The UDRP would likely excuse commentary about a politician under a corresponding domain name, even a <name.com> name, as a legitimate use of the name.<sup>265</sup> In any event, it will not apply to a politician if her name does not operate as a trademark.<sup>266</sup> The same may be said of California’s Business and Professions Code,

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<sup>260</sup> 15 U.S.C. § 1125(c)(2)(B) (dilution by blurring); § 1125(c)(2)(C) (dilution by tarnishment).

<sup>261</sup> 15 U.S.C. § 1125(c)(3)(C).

<sup>262</sup> 15 U.S.C. § 1125(c)(3)(A)(ii).

<sup>263</sup> 15 U.S.C. § 1125(c)(3)(C).

<sup>264</sup> 15 U.S.C. § 1125(c)(3)(A)(ii).

<sup>265</sup> UDRP, para. 4(c)(iii).

<sup>266</sup> UDRP, para. 4(a)(i).

although there is little case law or commentary available on that legislation to date. Even though the key provision in § 17525(a) contemplates bad faith registrations of domain names without regard to goods or services of the parties, several of the bad faith factors relate to trademark-like concepts.<sup>267</sup> The provision that does contemplate misleading voters as a bad faith factor does not make it clear whether a political commentary site would be excused as not misleading voters as to source or affiliation of the website.<sup>268</sup>

Again, all of this may well be as it should be. It may be that there should be no law giving a politician any rights against a registrant of a corresponding domain name, even a <name.com> name, where the registrant's purpose is political commentary. However, there may be room for a presumption online that <name.com> names, even in the political context, would be expected by Internet users to resolve to officially sanctioned websites, and that any other use of those names is misleading. Could a personality rights model resolve this dilemma? For one thing, it would obviously protect any politician's or public figure's identity regardless of a trademark interest. However, it would only protect them from unauthorized commercial conduct and not necessarily against undesired critical commentary. Thus, like with the previous case study, if the defendant's conduct was purely expressive, rather than commercial, the right of publicity may not provide results any different to those currently provided under trademark focused rules.

Again, if the defendant's conduct did contain commercial elements – either because the Internet is regarded as a global commercial communications medium,<sup>269</sup> or because the website engages in some kind of commerce such as advertising books that criticize the politician<sup>270</sup> – then the politician might have more luck. As a general matter,

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<sup>267</sup> See, for example, Cal. Business and Professions Code, §§ 17526(a) (relating to trademark rights in a given domain name); 17526(c) (use of domain name in relation to the bona fide offering of goods or services); see discussion in Jacqueline Lipton, *Who Owns Hillary.com? Political Speech and the First Amendment in Cyberspace*, 49 BOSTON COLLEGE L REV 55 (2008).

<sup>268</sup> Cal. Business and Professions Code, § 17526(j) (providing as a bad faith factor "The intent of a person alleged to be in violation of this article to mislead, deceive, or defraud voters.")

<sup>269</sup> *Planned Parenthood Federation of America Inc v Bucci*, 42 U.S.P.Q. 2d 1430, page 11 (S.D.N.Y. 1997) ("Internet users constitute a national, even international, audience, who must use interstate telephone lines to access defendant's web site on the Internet. The nature of the Internet indicates that establishing a typical home page on the Internet, for access to all users, would satisfy the Lanham Act's "in commerce" requirement."). See also *American Libraries Association v Pataki*, 969 F. Supp. 160, 45 (S.D.N.Y. 1997) ("In addition, many of those users who are communicating for private, noncommercial purposes are nonetheless participants in interstate commerce by virtue of their Internet consumption. Many users obtain access to the Internet by means of an on-line service provider, such as America Online, which charges a fee for its services. "Internet service providers," including plaintiffs Panix, Echo, and NYC NET, also offer Internet access for a monthly or hourly fee. Patrons of storefront "computer coffee shops," such as New York's own CyberCafe, similarly pay for their access to the Internet, in addition to partaking of food and beverages sold by the cafe. Dial-in bulletin board systems often charge a fee for access.")

<sup>270</sup> See, for example, *Lamparello v Falwell*, 420 F 3d 309 (2005) (gripesite contained links to amazon.com webpage selling a book critical of the Reverend Jerry Falwell's views on homosexuality). However, note that in this case, the plaintiff was unsuccessful in establishing any form of trademark infringement or dilution despite this conduct of the plaintiff. This factor was more successful in the

unauthorized commercial use may be more difficult to establish in the case of a political commentary website than an unauthorized fan website. This is because the iterations of unauthorized fan conduct are more likely to have a commercial aspect in practice than a pure political commentary website. Celebrities names are more likely to attract online customers than political names and may thus be more desirable to those seeking to make commercial profits from use of corresponding domain names.<sup>271</sup>

Overall, a personality rights based framework for personal domain name disputes that allowed unauthorized expressive uses of <name.com> names, while prohibiting unauthorized commercial uses, might achieve a better theoretical focus than the current UDRP. It would remove the requirement for a complainant to establish trademark rights in her personal name, or to establish cybersquatting, as opposed to other kinds of commercial profit motives by the registrant. At the same time, it would not unduly chill speech because it would preserve the right to engage in purely expressive conduct about an individual, and, if limited in the first instance to <name.com> names, would preserve other iterations of a relevant name in the domain space for both expressive and commercial conduct. To some extent, these results are similar to those currently found in practice in some trademark-based litigation. However, the use of a personality rights model would lead to greater consistency on the question of what is being protected (a name rather than a mark), and why (because we care about both the personhood and proprietary aspects of an individual's persona).<sup>272</sup>

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trademark context in *People for the Ethical Treatment of Animals v Doughney*, 113 F Supp 2d 915 (2000); *aff'd* 263 F.3d 359 (2001) (parody site linking to websites where fur and animal products antithetical to plaintiff's views were available for sale).

<sup>271</sup> An obvious example is found in *Tom Cruise v Alberta Hot Rods*, WIPO Case No D2006-0560, 5 July, 2006, ¶ 4 (available at <http://www.wipo.int/amc/en/domains/decisions/html/2006/d2006-0560.html>) (respondent had used tomcruise.com domain name to draw custom to a website that advertised products and services unrelated to the well-known actor Tom Cruise).

<sup>272</sup> On theories of the right of publicity with a focus on personhood and individual autonomy, see Haemmerli, *supra* note \_\_\_\_\_. On the property theory basis for the right of publicity, see Dogan and Lemley, *Right of Publicity*, *supra* note \_\_\_\_, 1181-1183 (critique of Lockean labor theory justifications for personality rights as property); McKenna, *supra* note \_\_\_\_, 247 ("It might be true that identity is sufficiently similar to other objects the law regards as property and therefore deserves at least some of the sticks in the traditional bundle of property rights. But far too few courts and commentators have offered a theory as to why any of the traditional property justifications lead to that conclusion."); 251-267 (critique of Lockean labor theory justifications for property rights in personal identity); Alice Haemmerli, *Whose Who? The Case for a Kantian Right of Publicity*, 49 DUKE L J 343, 388 ("Both proponents and critics of the right of publicity generally perceive it as a property claim grounded in Lockean labor theory."), 407-8 (1999) (noting dual property and privacy justifications for right of publicity actions), 412 ("To the extent that commentators specifically address publicity rights, they tend to do so within this property context, and to use Lockean labor theories of property to explain the assertion of a property right in identity or persona."); Kwall, *Fame*, *supra* note \_\_\_\_, 15 ("This Article ... contends that a property-based conception for publicity rights is the natural outgrowth of our cultural norms as well as our theoretical conceptions of property."); David Westfall and David Landau, *Publicity Rights as Property Rights*, 23 CARDOZO ARTS AND ENT LJ 71 (2005) (examining property basis for rights of publicity); Rielly, *supra* note \_\_\_\_, 1165-9 (describing development of a property rights rationale for the right of publicity). See also Diane Zimmerman and Melissa Jacoby, *Foreclosing on Fame: Exploring the Uncharted Boundaries of the Right Of Publicity*, 77 N.Y.U. L. REV. 1322 (2002).

### III. CRAFTING A NEW PERSONAL DOMAIN NAME DISPUTE RESOLUTION POLICY (“PDRP”)

#### A. BASIC STRUCTURE AND SCOPE OF A PDRP

Obviously, the right of publicity can be applied to some personal domain name cases now.<sup>273</sup> Even after the implementation of a new PDRP, this would continue to be the case, as contractual arbitration procedures will not oust the jurisdiction of domestic courts.<sup>274</sup> Thus, even if a PDRP was limited to <name.com> disputes, conflicts about personal domain names in other domain spaces could arguably be litigated under right of publicity laws in relevant jurisdictions.<sup>275</sup> The main problem with the right of publicity in domestic law is that it raises jurisdictional and cost problems that are largely avoided or minimized by using an inexpensive and efficient online dispute resolution procedure. Thus, merging the substance of the right of publicity with the procedural advantages of the UDRP in a new PDRP would be a useful innovation in domain name dispute resolution policy and practice.

This article has suggested that most relevant disputes arise in <name.com> cases,<sup>276</sup> and that initially a new PDRP should be limited to these cases until a clearer

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<sup>273</sup> It has, in fact, been argued in several domain name cases involving personal domain names to date: *Kevin Trudeau v George Lanoue*, 2006 U.S. Dist. LEXIS 7956 (2006) (in which a right of publicity claim was made, amongst other unfair competition claims, in a dispute involving a domain name corresponding with the plaintiff’s personal name); *Paul Wright v Domain Source Inc.*, 2002 U.S. Dist. LEXIS 16024 (2002) (plaintiff brought a claim under § 17525 of the Californian Business and Professions Code, which is a cyberspace analog to right of publicity law in some respects as it protects personal names in the domain space against certain unauthorized uses).

<sup>274</sup> This is expressly recognized currently in paragraph 4(k) of the UDRP: “The mandatory administrative proceeding requirements set forth in Paragraph 4 shall not prevent either you or the complainant from submitting the dispute to a court of competent jurisdiction for independent resolution before such mandatory administrative proceeding is commenced or after such proceeding is concluded.”

<sup>275</sup> And of course <name.com> disputes could be litigated in domestic courts under right of publicity laws as well.

<sup>276</sup> See, for example, *Julia Fiona Roberts v Russell Boyd*, WIPO Case No. D2000-0210, 30 May, 2000 (available at <http://www.wipo.int/amc/en/domains/decisions/html/2000/d2000-0210.html>) (involving juliaroberts.com domain name); *Tom Cruise v Alberta Hot Rods*, WIPO Case No D2006-0560, 5 July, 2006 (available at <http://www.wipo.int/amc/en/domains/decisions/html/2006/d2006-0560.html>) (involving tomcruise.com domain name); *Kevin Spacey v Alberta Hot Rods*, National Arbitration Forum Claim No 114437, August 1, 2002 (available at <http://www.arb-forum.com/domains/decisions/114437.htm>) (involving the domain name kevinspacey.com); *Anna Nicole Smith v DNS Research Inc*, Claim No. FA0312000220007, National Arbitration Forum, Feb 21, 2004 (available at: <http://www.adrforum.com/domains/decisions/220007.htm>) (involving annanicolesmith.com domain name); *Bjorn Borg v Miguel Garcia*, WIPO Case No. D2007-0591, June 21, 2007 (available at: <http://www.wipo.int/amc/en/domains/decisions/html/2007/d2007-0591.html>) (involving the domain name bjornborg.com); *Hillary Rodham Clinton v Michele Dinoia*, National Arbitration Forum Claim No FA0502000414641, March 18, 2005 (full text available at <http://www.arb-forum.com/domains/decisions/414641.htm>) (involving hillaryclinton.com domain name); *Bruce*

jurisprudence about the protection of personas in cyberspace emerges. This approach also goes some way towards alleviating concerns about the potential chilling effect on free speech of any new procedure for personal domain name dispute resolution. There may be some question as to whether a PDRP should automatically apply to registrations in the newer <.name> gTLD, although there are already other protections for that gTLD that might assist people in the protection of their personal names there.<sup>277</sup> Thus, a new PDRP should, at least initially, only be incorporated by reference into domain name registration agreements for <.com> domain names. It could later be extended or modified if the need arose.

A new PDRP could be drafted in terms very similar to the UDRP. It could adopt the UDRP's basic structure and general terms, including representations and warranties made by the registrant,<sup>278</sup> orders that could be made by arbitrators,<sup>279</sup> and procedural matters such as how to lodge communications relating to a dispute.<sup>280</sup> As with the UDRP, a person who has registered a <name.com> domain name<sup>281</sup> would be required to submit to a mandatory arbitration proceeding if a complainant with the relevant personal name established the matters set forth in the policy. Again, as with the UDRP, an administrative proceeding under the PDRP would not prevent either party from taking the dispute to a relevant court.<sup>282</sup> The idea would be to streamline disputes in a more

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*Springsteen v Jeff Burgar*, WIPO Case No D2000-1532, Jan 25, 2001 (available at <http://www.wipo.int/amc/en/domains/decisions/html/2000/d2000-1532.html>).

<sup>277</sup> Jacqueline Lipton, *Beyond Cybersquatting*: *supra* note \_\_\_, at 1420-1421 (describing domain name "watch" service and "defensive registration" service; the former allows individuals to be notified if anyone else attempts to register a given domain name without having to register it herself, while the latter allows a person with a legitimate interest in a domain name to register it without having to actively use it in order to maintain the registration).

<sup>278</sup> UDRP, para. 2 ("By applying to register a domain name, or by asking us to maintain or renew a domain name registration, you hereby represent and warrant to us that (a) the statements that you made in your Registration Agreement are complete and accurate; (b) to your knowledge, the registration of the domain name will not infringe upon or otherwise violate the rights of any third party; (c) you are not registering the domain name for an unlawful purpose; and (d) you will not knowingly use the domain name in violation of any applicable laws or regulations. It is your responsibility to determine whether your domain name registration infringes or violates someone else's rights.")

<sup>279</sup> UDRP, para. 4(i) ("The remedies available to a complainant pursuant to any proceeding before an Administrative Panel shall be limited to requiring the cancellation of your domain name or the transfer of your domain name registration to the complainant."). For a more detailed discussion of proposed PDRP remedies, see Part III.D *infra*.

<sup>280</sup> See Rules for Uniform Domain Name Dispute Resolution Policy, available at <http://www.icann.org/udrp/udrp-rules-24oct99.htm>, last viewed on November 23, 2007.

<sup>281</sup> And perhaps ultimately some other iterations of the name if there was ever a need to extend the policy more broadly.

<sup>282</sup> UDRP, para 4(k) ("The mandatory administrative proceeding requirements set forth in Paragraph 4 shall not prevent either you or the complainant from submitting the dispute to a court of competent jurisdiction for independent resolution before such mandatory administrative proceeding is commenced or after such proceeding is concluded. If an Administrative Panel decides that your domain name registration should be canceled or transferred, we will wait ten (10) business days (as observed in the location of our

accessible forum than is currently available in court proceedings due to cost and jurisdiction issues. The new PDRP may also fill some gaps in the legal systems of some jurisdictions that do not have specific protections for personal names or identities outside of trademark law.<sup>283</sup>

## B. THE BASIS OF A PDRP COMPLAINT

To establish a complaint under the new PDRP, a complainant should be required to establish that: (a) the registrant's domain name corresponds letter for letter with the complainant's personal name, (b) the registrant has no legitimate interests in the domain name, and (c) the registrant has registered or used the name for an unauthorized commercial purpose. This would be the PDRP analog to clause 4(a) of the UDRP.<sup>284</sup> Rather than establishing a trademark interest, the complainant would only have to establish what her own name is – this should be easier than establishing a trademark right in a personal name for obvious reasons. The provision should cover a complainant's *actual* personal name, as well as a name she is commonly known by. Thus, it would cover “Cher” for “Cheryl Sarkisian LaPiere” and “Madonna” for “Madonna Louise Veronica Ciccone”.<sup>285</sup> It could also potentially cover “Tyra” for “Tyra Banks” and “Trump” for “Donald Trump”.<sup>286</sup>

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principal office) after we are informed by the applicable Provider of the Administrative Panel's decision before implementing that decision. We will then implement the decision unless we have received from you during that ten (10) business day period official documentation (such as a copy of a complaint, file-stamped by the clerk of the court) that you have commenced a lawsuit against the complainant in a jurisdiction to which the complainant has submitted under Paragraph 3(b)(xiii) of the Rules of Procedure. (In general, that jurisdiction is either the location of our principal office or of your address as shown in our Whois database. See Paragraphs 1 and 3(b)(xiii) of the Rules of Procedure for details.) If we receive such documentation within the ten (10) business day period, we will not implement the Administrative Panel's decision, and we will take no further action, until we receive (i) evidence satisfactory to us of a resolution between the parties; (ii) evidence satisfactory to us that your lawsuit has been dismissed or withdrawn; or (iii) a copy of an order from such court dismissing your lawsuit or ordering that you do not have the right to continue to use your domain name.”)

<sup>283</sup> The United States is the only country that has created a specific right of publicity tort. Other jurisdictions may protect similar rights in other ways: for example, Trade Practices Act, § 52 in Australia (prohibiting misleading and deceptive conduct in commerce). In the United Kingdom, privacy laws have been utilized to create a right similar to the right of publicity in practice: see, for example, *Douglas and others v Hello! Ltd*, [2001] 2 All ER 289; [2001] 1 FLR 982, [2002] 1 FCR 289 (U.K.) (concerned with compensation for unauthorized publication of photographs of the Michael Douglas/Catherine Zeta-Jones wedding under on a privacy basis in the absence of a right of publicity in the United Kingdom). Note also that not all states within the United States recognize the right of publicity so the adoption of a PDRP would also help with otherwise potentially problematic conflicts issues between state laws.

<sup>284</sup> UDRP, para. 4(a) (requiring a domain name registrant to submit to mandatory arbitration under the UDRP when: (i) the registrant's domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights; and (ii) the registrant has no rights or legitimate interests in respect of the domain name; and (iii) the registrant's domain name has been registered and is being used in bad faith.”)

<sup>285</sup> This would accord with the way in which the right of publicity currently works. See, for example, Indiana Code Title 32 (Property), Art. 36 (Publicity), Chap. 1 (Rights of Publicity), § 32-36-1-3 (defining

The requirement to show that the registrant has no legitimate interests in the domain name would be necessary to cover cases where, for example, the registrant happens to have the same personal name as a complainant. In cases of competing legitimate interests in the same name, probably a “first come, first served” rule, subject to private negotiation between the parties, is preferable to a dispute resolution mechanism in which the arbitrators have little to go on as to who has the best interest in a given domain name. This accords with the way the UDRP works in the case of competing legitimate trademark interests.<sup>287</sup> It may be that ultimately domain name sharing arrangements could be developed for such situations either by private agreement between parties or facilitated through a body such as the Internet Corporation for Assigned Names and Numbers (“ICANN”).<sup>288</sup>

There is a possibility that a domain name registrant might change her personal name to match that of a given individual purely in order to register a relevant domain name. This would be the analog to a domain name registrant who registers a trademark she never intends to use in order to clothe herself with a “legitimate interest” in a corresponding domain name in order to engage in abusive conduct with respect to the name. An obvious example arose in the <madonna.com> dispute where the initial registrant of that domain name was obviously a cybersquatter and had registered a “Madonna” trademark in Tunisia in order to argue that he had a legitimate trademark

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“name” for the purposes of the statute as including “the actual or assumed name of a living or deceased natural person that is intended to identify the person”).

<sup>286</sup> It may or may not cover intentional misspellings of complainants’ names such as “Tom Kruse” for “Tom Cruise”. See, for example, *Lamparello v Falwell*, 420 F 3d 309 (2005) (involving an intentional misspelling of the Reverend Falwell’s name as a domain name). However, perhaps such names should not be covered in the first instance of the policy in the interests of avoiding the chilling of speech. This may be a little like the “look-a-like” and “sound-a-like” cases under the right of publicity in the “real world” which have been criticized for extending the right too far. See, for example, William Heberer, *The Overprotection of Celebrity: A Comment on White vs Samsung Electronics America Inc*, 22 HOFSTRA L REV 729 (1994); Steven Clay, *Starstruck: The Overextension of Celebrity Publicity Rights in State and Federal Courts*, 79 MINN L REV 485 (1994).

<sup>287</sup> See discussion in *A Winning Solution for Youtube and Utube? Corresponding Trademarks and Domain Name Sharing*, (forthcoming, HARVARD JOURNAL OF LAW AND TECHNOLOGY, 2008).

<sup>288</sup> ICANN is the body that manages the Internet domain name system: see [www.icann.org](http://www.icann.org), last viewed on November 23, 2007. The author has canvassed the possibility of domain name sharing previously in the trademark context, and the mechanics of such arrangements for personal names would work similarly, so domain sharing strategies for personal names are not discussed further here. See Jacqueline Lipton, *A Winning Solution for Youtube and Utube? Corresponding Trademarks and Domain Name Sharing*, (forthcoming, HARVARD JOURNAL OF LAW AND TECHNOLOGY, 2008).

interest in the domain name.<sup>289</sup> The name was transferred to the popular singer Madonna who herself had registered American trademark interests in the name.<sup>290</sup>

It could be that the incorporation of a “bad faith” element in the PDRP would be useful to prevent such conduct. However, this leaves open the door for arbitrators to interpret that element in line with trademark based laws involving Internet domain names.<sup>291</sup> This would not necessarily be a major problem, although it might fail to catch conduct under the new policy that ought to be prohibited under a personality rights framework. An unauthorized fan website, for example, may not be in “bad faith” in the trademark sense, but perhaps should be prohibited under the new policy if it was creating a commercial gain in the hands of the registrant by using the complainant’s name in an unauthorized manner. Thus, it would be better not to require a showing of bad faith in the PDRP, and wait and see how many situations arise where a person is prepared to go to the lengths of changing her name in order to register a domain name corresponding with someone else’s name. In actual fact, many people who speculatively register domain names corresponding with the names of well known persons register multiple names<sup>292</sup> and would obviously not be able to change their own personal name to all of those names. They could attempt to register trademarks relating to a large group of personal names, but these trademarks would be subject to invalidation if they are not being used in conjunction with the sale of goods or services as required by trademark law.<sup>293</sup>

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<sup>289</sup> *Madonna Ciccone, p/k/a Madonna v. Dan Parisi and "Madonna.com"*, WIPO Case No. D2000-0847, October 12, 200 (available at <http://www.wipo.int/amc/en/domains/decisions/html/2000/d2000-0847.html>, last viewed on November 23, 2007).

<sup>290</sup> *id.*

<sup>291</sup> For example, both ACPA and the UDRP infringements rest on bad faith conduct on the part of the domain name registrant: 15 U.S.C. §§ 1125(d)(1), 1129(1), UDRP, para. 4(a)(3), 4(b).

<sup>292</sup> *Julia Fiona Roberts v Russell Boyd*, Case No. D2000-0210, May 29, 2000, WIPO Arbitration and Mediation Center, para. 4 (full text available at <http://www.wipo.int/amc/en/domains/decisions/html/2000/d2000-0210.html>, last viewed on November 6, 2007) (“The Respondent has also registered over fifty (50) other domain names, including names incorporating other movie stars names within <madeleinstowe.com> and <alpacino.com> and a famous Russian gymnast’s name within <elenaprodunova.com>.”); *Bruce Springsteen v Jeff Burgar and Bruce Springsteen Club*, WIPO Case No. D2000-1532, Jan. 25, 2001, para 5 (available at <http://arbiter.wipo.int/domains/decisions/html/2000/d2000-1532.html>) (“Mr Burgar is the owner of around 1,500 names, and that many of those names, including the domain name at issue, take the internet user to his own site, “celebrity1000.com”. They therefore point to the fact that this constitutes bad faith under paragraphs 4(b)(ii) and (iv) of the UDRP”).

<sup>293</sup> GILSON LALONDE, *supra* note \_\_\_\_, § 1.03[7][c] (describing the trademark “use” requirement). On trademark use, see also Graeme Dinwoodie and Mark Janis, *Confusion Over Use: Contextualism in Trademark Law*, 92 IOWA L REV 1597, 1629-1638 (2007); Stacey Dogan and Mark Lemley, *Grounding Trademark Law Through Trademark Use*, 92 IOWA L REV 1669, 1690-1698 (2007). In situations involving an individual registrant’s name that happens coincidentally to correspond with a famous person’s name, there may be some problems. If such a person uses a domain name that incidentally corresponds with the name of a famous person and makes a commercial profit from doing so, should that conduct be prohibited under the new policy? In terms of its affect on Internet users, they probably *are* attracted to the website by

With respect to the unauthorized commercial use requirement, the PDRP could give examples of such uses or could leave the wording vague and allow arbitrators over time to determine what constitutes an unauthorized commercial use on a case by case basis. If the PDRP were to be drafted more comprehensively to include examples of unauthorized commercial use, these could be taken from current right of publicity statutes. For example, the Indiana statute<sup>294</sup> defines “commercial purpose” in the context of the right of publicity as: “the use of an aspect of a personality’s right of publicity ... (1) On or in connection with a product, merchandise, goods, services, or commercial activities. (2) For advertising or soliciting purchases of products, merchandise, goods, services, or for promoting commercial activities. (3) For the purpose of fundraising.”<sup>295</sup> The incorporation of such a definition would give arbitrators some clear guidance in applying the PDRP to the registrant’s activities, and may be helpful at least in the early days of such a dispute resolution policy. It would also allow disputing parties to draw to some extent on existing personality rights jurisprudence to help inform initial determinations under the PDRP. Although this test does reflect some concepts traditionally associated with trademark law, it is somewhat broader with its inclusion of uses such as the promotion of commercial activities for fundraising purposes.

### C. THE “LEGITIMATE INTEREST” DEFENSE UNDER THE PDRP

It may be a good idea for the PDRP to include a defense such as that found in clause 4(c) of the UDRP to give the registrant some guidance on how to establish a legitimate interest in a given domain name. The indicia of a legitimate interest in the UDRP largely relate to good faith uses of the domain name in commerce in connection with the registrant’s own commercial or non-commercial endeavors.<sup>296</sup> Any legitimate interest provision included in a new PDRP would have to be drafted differently because

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the connection with the famous name and then may avail themselves of some unrelated information or commercial activity as a result. This sounds like the kind of thing covered by the right of publicity even though the result may be incidental due to the similarity of two people’s names. Perhaps the PDRP would require a special provision to deal with these unusual cases, leaving some discretion to arbitrators to decide who has the better interest in the name in any given case. However, such a provision may be very difficult to draft. Alternatively, these matters might ultimately be resolved by courts applying right of publicity principles or other tort principles relating to unfair competition: GILSON LALONDE, *supra* note \_\_\_, § 7.01 (on federal unfair competition law).

<sup>294</sup> Indiana Code Title 32 (Property), Art. 36 (Publicity), Chap. 1 (Rights of Publicity).

<sup>295</sup> *id.*, § 32-26-1-2.

<sup>296</sup> UDRP, para. 4(c) which gives examples of legitimate use as including the registrant’s ability to establish that: “(i) before any notice to [the registrant] of the dispute, [the registrant’s] use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services; or (ii) [the registrant] (as an individual, business, or other organization) [has] been commonly known by the domain name, even if [she has] acquired no trademark or service mark rights; or (iii) [the registrant is] making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.”

the policy would actually prohibit some unauthorized commercial uses even if they are associated with a bona fide business plan of the registrant. The UDRP, for example, currently excuses as a legitimate use a registrant's use, or demonstrable preparation to use, a relevant domain name in connection with a bona fide offering of goods or services.<sup>297</sup> This makes sense in a trademark-based system because it amounts to two competing legitimate interests in using the mark in a domain name presumably in different areas of commerce.<sup>298</sup> For example, if the complainant has registered the trademark "Hypo" for medical syringes and I have registered the domain name <hypo.com> for a business involving the sale of practice law exam questions, and I have registered the domain name in good faith for these purposes, I should be entitled to use it.<sup>299</sup>

However, comparing this to the proposed PDRP, if the policy behind the right of publicity is to prevent anyone from making any kind of unjust profit out of another person's name or likeness, the PDRP should not permit a domain name registrant to register another person's name as a domain name even for some bona fide offerings of goods or services. In any event, it is difficult to think of a situation in which a registrant would register someone else's name as a domain name with such an intent. Why would anyone register, say, <tomcruise.com> for the sale of goods or services completely unrelated to Tom Cruise unless they wanted to use the name to attract attention to their

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<sup>297</sup> UDRP, para. 4(c)(i).

<sup>298</sup> The issues arising in relation to two competing trademark interests with one corresponding domain name are taken up in more detail in Jacqueline Lipton, *A Winning Solution for Youtube and Utube? Corresponding Trademarks and Domain Name Sharing*, (forthcoming, HARVARD JOURNAL OF LAW AND TECHNOLOGY, 2008).

<sup>299</sup> If such a case was brought under domestic trademark law, I may have some difficulties under the "initial interest confusion" doctrine. The medical supply company might argue in a court proceeding for trademark infringement that, even though consumers are not confused about the source of the products when they get to my website, I am potentially diverting custom from them by attracting consumers to my website by using a similar online address. It may be that consumers who assume that <hypo.com> is the website of the medical supply company would accidentally access my website and then cease looking for the other company on the basis that it is too difficult to find. Regardless of what view a court would take of this argument under domestic trademark law, the UDRP currently has no "initial interest confusion" doctrine built into it in this sense and seems to allow as a defense that the registrant was using, or planning to use, the relevant domain name in a bona fide trademark manner. On the initial interest doctrine in trademark law generally, see Lastowka, *supra* note \_\_\_, 35-36 ("With respect to search engines ... a ... significant expansion of trademark law is the doctrine of initial interest confusion. Traditionally, and not surprisingly, most courts have focused analysis of consumer confusion on the time period proximate to consumer purchases. The doctrine of initial interest confusion shifts the focus of confusion analysis to a time prior to the time of purchase. Initial interest confusion can be found to exist even if that confusion was not present at the time of purchase."); see also Jennifer Rothman, *Initial Interest Confusion: Standing at the Crossroads of Trademark Law*, 27 CARDOZO L REV 105 (2005); Goldman, *supra* note \_\_\_, 559 ("[Initial interest confusion] lacks a rigorous definition, a clear policy justification, and a uniform standard for analyzing claims. With its doctrinal flexibility, [it] has become the tool of choice for plaintiffs to shut down junior users who have not actually engaged in misappropriative uses.")

own goods, services, or advertising?<sup>300</sup> This would hardly be in good faith if we accept that individuals have a right to prevent an unauthorized commercial profit being made from their online persona in certain cases, such as with respect to <name.com> versions of their personal names. Even if Tom Cruise himself has no intention of using <tomcruise.com> to sell particular goods or services, the unauthorized registrant has interfered with his ability to control his persona in commerce which may be prohibited under a personality rights framework.

There may be conflicts between the UDRP and the new PDRP where a personal name truly is a trademark, as when an individual runs a business under her own name. In such a case, it is arguable that trademark-based laws should apply with respect to the trademarked version of the name. Of course, this happens routinely in judicial proceedings under trademark law. In such cases, courts have the power to determine trademark-based claims and right of publicity claims in the alternative.<sup>301</sup> It may be that the new PDRP should include some provision for joining UDRP proceedings with PDRP proceedings in such situations, allowing one arbitrator or panel to hear the entire dispute and decide whether the name in question is really being used by the registrant in a trademark sense or in a personal sense. If PDRP claims are to be at least initially limited to <.com> registration agreements, a procedure for joining PDRP and UDRP disputes would only have to be developed and incorporated into those agreements. There would be no need to incorporate a joining procedure into other registration agreements, such as <.net> and <.org> registrations, into which only the UDRP would be incorporated.

There may also be situations in which a domain name registrant simply happens to have the same name as a complainant and has registered the domain name for her own personal use: for example, to set up her own webpage. These situations may actually be more difficult than they seem as a matter of policy. It may be that a complainant is actually harmed in a right of publicity sense even where the registrant herself has a legitimate interest in the name by virtue of having a similar name to the complainant. As the right of publicity has no consumer confusion requirement, it may be that simply using the complainant's name in a domain name on a personal website might contravene the right in some cases, particularly if the website contains some unrelated commercial advertising. One way to deal with these situations would be to leave the "hard cases" to the courts and hope for resolution that way. In terms of the drafting of the new PDRP, though, it should suffice to excuse, as a legitimate interest, the conduct of a person who has been commonly known by the relevant name and is only using the name for her own personal website.

#### D. REMEDIES UNDER THE PDRP

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<sup>300</sup> This appears to have been the strategy utilized by the domain name registrant of tomcruise.com under discussion in *Tom Cruise v Alberta Hot Rods*, WIPO Case No D2006-0560, 5 July, 2006 (available at <http://www.wipo.int/amc/en/domains/decisions/html/2006/d2006-0560.html>).

<sup>301</sup> See, for example, *Kevin Trudeau v George Lanoue*, 2006 U.S. Dist. LEXIS 7956 (2006); *Rogers v Grimaldi*, 875 F 2d 994 (1988).

Like, the UDRP, the PDRP would be limited in terms of possible remedies to a cancellation or transfer order over the relevant domain name.<sup>302</sup> Thus, a successful complainant could either have the registration of the domain name cancelled altogether, or could have the name transferred to her. In most personal domain name disputes under the UDRP to date, the registrant has sought a transfer,<sup>303</sup> even where she does not intend to use the name herself, presumably in order to maintain control over the most intuitive version of her online persona – the <name.com> version of her name.

Because of these limitations on remedies, the proposed PDRP may actually have less of a potential chilling effect on online speech, if any, than the threat of litigation under the right of publicity. Although the usual remedy in a right of publicity action is an injunction,<sup>304</sup> which, in the domain name case, may be tantamount to a cancellation or transfer order under the PDRP, courts can award other remedies for infringement of personality rights. These include damages based on injury to a plaintiff's feelings,<sup>305</sup> damages based on unjust enrichment,<sup>306</sup> and accounts of profits.<sup>307</sup> Additionally, even an injunction may be tailored to a given case more broadly than a mere transfer or cancellation order: for example, it may prohibit the defendant from engaging in any commerce online utilizing the name or likeness of a plaintiff, regardless of the domain name used by the defendant.

Given the broad range of potential remedies under the right of publicity, a domain name registrant may be more deterred from engaging in unauthorized online use of a personal domain name than she would be if most personal domain name disputes were arbitrated under a PDRP. One might argue that the threat of personality rights litigation is available for personal domain name disputes today, and it does not appear to be chilling online conduct involving unauthorized uses of individual's names in the <.com> domain space. However, this may be a temporary situation. If, for example, the trend in UDRP arbitration changes, and UDRP arbitrators become less prepared to accept

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<sup>302</sup> See UDRP, para. 4(i) (“The remedies available to a complainant pursuant to any proceeding before an Administrative Panel shall be limited to requiring the cancellation of your domain name or the transfer of your domain name registration to the complainant.”)

<sup>303</sup> See, for example, *Julia Fiona Roberts v Russell Boyd* Case No. D2000-0210, May 29, 2000, WIPO Arbitration and Mediation Center (full text available at <http://www.wipo.int/amc/en/domains/decisions/html/2000/d2000-0210.html>, last viewed on November 6, 2007); *Tom Cruise v Alberta Hot Rods*, WIPO Case No D2006-0560, 5 July, 2006 (available at <http://www.wipo.int/amc/en/domains/decisions/html/2006/d2006-0560.html>).

<sup>304</sup> GILSON LALONDE, *supra* note \_\_\_, ¶2.16[6] (“Upon proof of a violation of the right of publicity the courts almost always grant injunctive relief. Since the primary purpose of the right of publicity is to prevent the unauthorized use of a person's name and likeness, an injunction may be perfectly tailored to prevent further violation.”)

<sup>305</sup> *id.*

<sup>306</sup> *id.*

<sup>307</sup> *id.*

trademark rights in individual's names, then right of publicity litigation may become a much more realistic prospect. It may in fact be the case that right of publicity actions have not been brought more often in domain name disputes simply because many people have not thought of it yet. It is possible that such actions will become more common in the future. There have already been some right of publicity actions involving personal domain names in recent years.<sup>308</sup>

If right of publicity disputes gain popularity in the personal domain name context, the development of a PDRP would be a welcome addition for both complainants and domain name registrants. It would be quicker, easier and cheaper for both parties. It would also provide the most appropriate remedy in such cases – a transfer or cancellation order - and may deter complainants from seeking additional remedies in judicial proceedings. If the cost is significantly less to a complainant, but the remedy is limited, the complainant may still prefer this course of action than more time consuming and costly litigation, despite the fact that litigation may provide more valuable and varied remedies. This move towards arbitration with its more limited remedies may thus create less of a chilling effect on online speech than would personality rights litigation.

### E. POLITICIANS' NAMES: A SPECIAL CASE?

As noted in Part II.B.3, the names of politicians in the domain space, particularly in the lead-up to an election, may pose special problems. Where a registrant has taken a politician's name and registered it as a domain name for purely expressive purposes, there are obvious First Amendment arguments that this conduct should not be proscribed. Speech critical of politicians and their policies is an essential aspect of a representative democracy.<sup>309</sup> However, it is also important that Internet users are not misled about the authorized web presence of a given politician. The question is: What is the correct presumption here? Should there be a presumption that all <name.com> domain names automatically belong to the relevant politician, so that others wishing to comment on them are to be relegated to "lesser" domain spaces such as <name.net>, or <namesucks.com>? Or are we better off with no such presumption and a "first come, first served" system in which even a critic of a politician is entitled to the <name.com> version of the name if she registers it first?

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<sup>308</sup> See, for example, *Kevin Trudeau v George Lanoue*, 2006 U.S. Dist. LEXIS 7956 (2006) (in which a right of publicity claim was made, amongst other unfair competition claims, in a dispute involving a domain name corresponding with the plaintiff's personal name); *Paul Wright v Domain Source Inc.*, 2002 U.S. Dist. LEXIS 16024 (2002) (plaintiff brought a claim under § 17525 of the Californian Business and Professions Code, which is a cyberspace analog to right of publicity law in some respects as it protects personal names in the domain space against certain unauthorized uses).

<sup>309</sup> See discussion in Jacqueline Lipton, *Who Owns Hillary.com? Political Speech and the First Amendment in Cyberspace*, 49 BOSTON COLLEGE L REV 55 (2008); Matthew Coleman, *Domain Name Piracy and Privacy: Do Federal Election Regulations Offer a Solution?*, 19 YALE L & POL'Y REV 235, 263 (2000) ("[W]idespread use of a new and inexpensive communications medium has the potential to lead to unprecedented citizen participation in politics...").

Any personality rights framework for dispute resolution will only assist individuals, including politicians, against unauthorized *commercial* conduct.<sup>310</sup> Thus, where the conduct complained of is purely expressive with no commercial elements, the right of publicity will not assist the politician. On this view, a PDRP based on the right of publicity should also not assist the politician, unless all conduct on the Internet is regarded as “commercial”<sup>311</sup> - which may well not be an accurate reflection of the law.<sup>312</sup> If the view is taken that a personality rights based PDRP only prohibits commercial conduct, then *some* conduct involving a <name.com> version of politician’s name will be prohibited and other conduct will not.

The example of the <kerryedwards.com> domain name from the 2004 American presidential election, for example, may have been a candidate for protection under a PDRP as suggested here. An individual called Mr Kerry Edwards did have a legitimate interest in the name in the sense that it was his personal name. However, he was also using the name for a commercial purpose during the electoral race by attempting to auction it to the highest bidder.<sup>313</sup> An arbitrator under the PDRP would have needed to decide whether Mr Kerry Edwards’ legitimate interest in his personal name outweighed his conduct that clearly sought to profit from Senator John Kerry’s and Senator John Edward’s respective names. In actual fact, it is likely that Senators Kerry and Edwards would have had no luck even under the PDRP contemplated in this Article. For one thing, Mr Kerry Edwards did have a legitimate interest in the name by virtue of his personal name, and for another thing, <kerryedwards.com> does not correspond letter for letter with the name of either senator. It is assumed here that, at least initially, the PDRP should be narrowly confined to names that exactly match a complainant’s personal name in the <.com> space to avoid chilling effects on speech. If the facts were different and

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<sup>310</sup> GILSON LALONDE, *supra* note \_\_\_, § 2.16[1] (“The right of publicity ... is the right of an individual to control the commercial use of his or her name, likeness, signature, or other personal characteristics.”)

<sup>311</sup> As was suggested, at least with respect to the Lanham Act’s “in commerce” requirement in *Planned Parenthood Federation of America Inc v Bucci*, 42 U.S.P.Q. 2d 1430, page 11 (S.D.N.Y. 1997) (“Internet users constitute a national, even international, audience, who must use interstate telephone lines to access defendant’s web site on the Internet. The nature of the Internet indicates that establishing a typical home page on the Internet, for access to all users, would satisfy the Lanham Act’s “in commerce” requirement.”). See also *American Libraries Association v Pataki*, 969 F. Supp. 160, 45 (S.D.N.Y. 1997) (“In addition, many of those users who are communicating for private, noncommercial purposes are nonetheless participants in interstate commerce by virtue of their Internet consumption. Many users obtain access to the Internet by means of an on-line service provider, such as America Online, which charges a fee for its services. “Internet service providers,” including plaintiffs Panix, Echo, and NYC NET, also offer Internet access for a monthly or hourly fee. Patrons of storefront “computer coffee shops,” such as New York’s own CyberCafe, similarly pay for their access to the Internet, in addition to partaking of food and beverages sold by the cafe. Dial-in bulletin board systems often charge a fee for access.”)

<sup>312</sup> Lastowka, *supra* note \_\_\_, at 64 (“[I]t is not clear how *Bucci* had used the Planned Parenthood mark in commerce, given that he lacked any product or service. Those who advocate for an expansion of trademark use often criticize *Bucci* for this reason.”)

<sup>313</sup> See discussion in Jacqueline Lipton, *Who Owns Hillary.com? Political Speech and the First Amendment in Cyberspace*, 49 BOSTON COLLEGE L REV 55, 64-65 (2008).

the name in question was <johnkerry.com>, a registrant attempting to auction the name for profit may well have lost a PDRP proceeding.

If as a matter of policy there is a presumption that the <name.com> version of a politician's name should rightfully belong to the politician whatever the circumstances, particularly in the electoral context, then the PDRP would need to reflect that. It may be that there would need to be a special provision limited to politicians' names in the electoral context stating that the politician has the right to that name without having to establish anything other than that she is running for office and the domain name in question corresponds letter for letter with her personal name in the <.com> domain space. It may be that there should be no legitimate interest defenses for registrants in these cases, and that perhaps a temporary licensing scheme<sup>314</sup> needs to be set up to allow politicians to use (or share)<sup>315</sup> the relevant domain name during the course of the campaign where a prior registrant has a legitimate claim to the name. This may be difficult to draft and may not be worth the effort, given that politicians may prefer to attempt private negotiations with registrants in order to avoid unnecessary negative publicity.<sup>316</sup> Presumably, over time, politicians are becoming more savvy about protecting their names in the domain space and the need for such interventions may not be necessary going forwards.

There may also be First Amendment difficulties implementing a scheme prioritizing <name.com> domain names for politicians with corresponding names against all unauthorized uses, whether purely expressive or commercial, or both.<sup>317</sup> Even though the PDRP would effectively be a private system and not Congressional action, it may still incidentally attract First Amendment checks and balances if ICANN, the body adopting the procedure, was regarded as a governmental, or governmentally-controlled, organization.<sup>318</sup>

In any event, during the initial phases of the operation of a new PDRP, there are good arguments for putting aside any specific plans to protect politician's names in the

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<sup>314</sup> Jacqueline Lipton, *Beyond Cybersquatting*, *supra* note \_\_\_\_, at 1433-1435 (suggesting a temporary compulsory licensing scheme for these situations).

<sup>315</sup> On the attributes of a potential domain name sharing system, see discussion in Jacqueline Lipton, *A Winning Solution for Youtube and Utube? Corresponding Trademarks and Domain Name Sharing*, (forthcoming, HARVARD JOURNAL OF LAW AND TECHNOLOGY, 2008).

<sup>316</sup> Like UDRP proceedings, it would probably be useful if PDRP disputes were all published online for ease of reference.

<sup>317</sup> The differences between these two kinds of conduct and how they might be treated by the legal system are discussed in more detail in Jacqueline Lipton, *Who Owns Hillary.com? Political Speech and the First Amendment in Cyberspace*, 49 BOSTON COLLEGE L REV 55 (2008).

<sup>318</sup> There have certainly been cases in the past where publicly funded bodies have been subject to First Amendment constraints. See, for example, *United States v American Library Association*, 539 U.S. 194 (2003); *Mainstream Loudoun v Board of Trustees of the Loudoun Co. Library*, 2 F Supp 2d 783 (E.D. Va. 1998).

domain space that do not accord with personality rights principles. A rule that <name.com> versions of a politician's name automatically belong to a politician against all comers may not be an accurate reflection of these principles, or perhaps even of current social norms. This may differ from celebrity domain names in the sense that unauthorized registrants of <name.com> versions of celebrities' names in the domain space are perhaps more likely to be seeking commercial profit than registrants of politicians' names. In cases where an unauthorized use of a politician's name in a <name.com> domain is commercial, the PDRP would cover this without the need for any special provisions relating to politicians' names. Certainly, the PDRP as contemplated here would prevent political cybersquatting: that is, registration of a politician's name as a domain name with the intent to sell it for a profit.<sup>319</sup> It may simply not cover registrants with purely expressive motives. Politicians may also become more careful about their names in the domain space over time, and they may become better at negotiating with those who have registered their domain names before them. If, after some years of operation of the PDRP, a need is perceived to do something more specifically directed at creating clearer rules or presumptions for political domain names, such rights could be added to the PDRP at a later date.

#### F. DURATION AND DESCENDABILITY OF PERSONAL NAME RIGHTS UNDER THE PDRP

One contentious issue that arises under personality rights theory relates to the duration of those rights.<sup>320</sup> Related questions are whether the rights are transferable or descendable.<sup>321</sup> The PDRP as contemplated in this Article has presumed protection for a personal domain name during the course of the relevant person's lifetime and has not focused on issues of transferability or descendability. This is implicit in the suggestion that the PDRP should require the complainant to establish that the domain name in question corresponds letter for letter with her personal name. Once she is deceased, she can no longer establish this. Her estate may be able to establish that the name corresponds with her name, but that is not the intent of the PDRP as crafted here. The idea here has been to protect individuals against unauthorized commercial conduct with respect to their names in a domain space where perhaps an individual has not thought to register the name herself, but the public might expect her to have done so. In this sense, the rights as contemplated here spring more from personhood than from property theory.<sup>322</sup>

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<sup>319</sup> As would 15 U.S.C. § 1129(1)(A), although this has the time and cost disadvantages associated with any litigation.

<sup>320</sup> In particular, there has been some disagreement as to whether personality rights should survive a person's death: GILSON LALONDE, *supra* note \_\_\_, § 2.16[4] ("There is sharp disagreement among the courts, and even within some courts, as to whether the right of publicity is inheritable or whether it dies with the individual.") See also Kwall, *First Amendment*, *supra* note \_\_\_, 81-86.

<sup>321</sup> *id.* See also GILSON LALONDE, *supra* note \_\_\_, at § 2.16[5] (acknowledging that the right of publicity may be sold and assigned).

<sup>322</sup> On theories of the right of publicity with a focus on personhood and individual autonomy, see Haemmerli, *supra* note \_\_\_. On the property theory basis for the right of publicity, see Dogan and Lemley,

If, for example, I enter <tomcruise.com> into my web browser, I might expect to find the authorized Tom Cruise website or no content at all if Mr Cruise has not established an authorized website. However, if I were to enter the name of a deceased famous person into a web browser, such as <marlonbrando.com>, would I necessarily assume that this was an authorized website for Mr Brando? Or would I rather assume that, after his death, his estate has little interest in maintaining such a website? In actual fact, the <marlonbrando.com> domain name, along with domain names corresponding to a number of other famous deceased persons, are used for “official” websites managed by assignees of intellectual property rights in those people’s names.<sup>323</sup> However, by way of contrast, a UDRP dispute involving Albert Einstein’s name was decided against Einstein’s estate.<sup>324</sup> The decision was made largely on the grounds that an Internet user would not necessarily expect the domain name <alberteinstein.com> to resolve to a website actually run by Einstein’s estate such a lengthy period after his death.<sup>325</sup>

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*Right of Publicity*, *supra* note \_\_\_, 1181-1183 (critique of Lockean labor theory justifications for personality rights as property); McKenna, *supra* note \_\_\_, 247 (“It might be true that identity is sufficiently similar to other objects the law regards as property and therefore deserves at least some of the sticks in the traditional bundle of property rights. But far too few courts and commentators have offered a theory as to why any of the traditional property justifications lead to that conclusion.”); 251-267 (critique of Lockean labor theory justifications for property rights in personal identity); Alice Haemmerli, *Whose Who? The Case for a Kantian Right of Publicity*, 49 DUKE L J 343, 388 (“Both proponents and critics of the right of publicity generally perceive it as a property claim grounded in Lockean labor theory.”), 407-8 (1999) (noting dual property and privacy justifications for right of publicity actions), 412 (“To the extent that commentators specifically address publicity rights, they tend to do so within this property context, and to use Lockean labor theories of property to explain the assertion of a property right in identity or persona.”); Kwall, *Fame*, *supra* note \_\_\_, 15 (“This Article ... contends that a property-based conception for publicity rights is the natural outgrowth of our cultural norms as well as our theoretical conceptions of property.”); David Westfall and David Landau, *Publicity Rights as Property Rights*, 23 CARDOZO ARTS AND ENT LJ 71 (2005) (examining property basis for rights of publicity); Rielly, *supra* note \_\_\_, 1165-9 (describing development of a property rights rationale for the right of publicity). See also Diane Zimmerman and Melissa Jacoby, *Foreclosing on Fame: Exploring the Uncharted Boundaries of the Right Of Publicity*, 77 N.Y.U. L. REV. 1322 (2002).

<sup>323</sup> See also <marilynmonroe.com> and <johnwayne.com>, last viewed on November 24, 2007.

<sup>324</sup> *The Hebrew University of Jerusalem v Alberta Hot Rods*, WIPO Case No. D2002-0616, October 7, 2002, (available at <http://www.wipo.int/amc/en/domains/decisions/html/2002/d2002-0616.html>) (involving a complaint with respect to the domain name <alberteinstein.com>).

<sup>325</sup> *id.*, para (b)(III) (“There is a significant difference between the expectations of Internauts entering a domain name of a celebrity (alive or dead) who is (or was) famously associated in commerce with the supply of goods or services, on the one hand, and their expectations entering a domain name of a celebrity long since dead who was not so associated, on the other. The former expect to find a site offering goods or services associated with the celebrity’s trademark. The latter cannot reasonably have such an expectation. Albert Einstein has been dead for 47 years. He was one of the most famous people of the 20<sup>th</sup> century. The name Albert Einstein is universally associated with him. That operates to the disadvantage of Complainant in this case. Internauts entering the disputed domain name would not expect to find a site offering goods or services with which Dr. Einstein was known to have been associated during his lifetime because, on the evidence, he was not known as having any such association. Nor would they expect to find a site associated with Complainant because Complainant has not established that it has any common law trademark rights.”)

What explains the differences here? Obviously, the estates of some famous people have been extremely vigilant about protecting all relevant intellectual property rights, including personality rights.<sup>326</sup> If estates – or transferees – of intellectual property rights pertaining to famous people are vigilant about those rights and ensure registration of relevant domain names before anyone else has done so, there is no problem. There is no need for a PDRP to operate here because estates of famous people that are aggressive about protecting relevant rights will already have registered important domain names. This may explain why Einstein’s estate lost its arbitration. Perhaps the combination of the period of time since Einstein’s death and the fact that the estate had not been sufficiently vigilant to register the domain name before anyone else were sufficient factors to justify the result. On the other hand, given that the current registrants of <einstein.com> and <alberteinstein.com> do not appear to be using the names for any particular purpose,<sup>327</sup> it is arguable that the names would be better utilized by Einstein’s estate for information about Einstein and his life.

Given this possibility of wasteful uses of a deceased person’s name, and the fact that personality rights are transferable in at least some jurisdictions,<sup>328</sup> there is a plausible argument that the PDRP should allow for assignees and beneficiaries of personality rights to bring complaints in the name of the assignor or deceased person. If this were to be done, the PDRP as contemplated above would have to be amended to allow a complainant to show either that she has a personal name corresponding with the given domain name *or* that she controls personality rights relating to a person with such a name. This raises some practical difficulties, including the fact that if the beneficiary or transferee of the deceased lives in a jurisdiction that has no personality rights laws, or has personality rights laws that do not allow for transfer or descendability, there is little plausible basis for bringing a PDRP complaint. In other words, the complainant would not be able to show that she controlled the relevant personality rights.

Additionally, it may be difficult for arbitrators to determine the validity of a claim that a complainant controls personality rights in another person’s name. It is a simple enough task for arbitrators to accept evidence of what a complainant’s personal name actually is under the PDRP as contemplated here. It may be more difficult for them to evaluate evidence of claims about personality rights of deceased persons or persons who have allegedly transferred personality rights to others. The PDRP procedure is intended to achieve the same advantages in terms of time, cost, and procedural simplicity as the

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<sup>326</sup> See, for example, *Estate of Elvis Presley v Russen*, 513 F Supp 1339 (1981).

<sup>327</sup> As at the date of writing, they both look like cybersquatting sites perhaps disguised as legitimate sites. One has no commentary at all – just a graphic and the name “einstein.com”, while the other contains lists of services unrelated to the domain name <alberteinstein.com>. Each of these sites was last viewed on November 24, 2007.

<sup>328</sup> GILSON LALONDE, *supra* note \_\_\_\_, at § 2.16[5] (acknowledging that the right of publicity may be sold and assigned). For an example of a specific state law on the transferability of publicity rights, see Indiana Code Title 32 (Property), Art. 36 (Publicity), Chap. 1 (Rights of Publicity), § 32-36-1-16 (“The rights recognized under this chapter are property rights, freely transferable and descendible, in whole or in part ...”).

UDRP does for trademark-related claims. If arbitrators are asked to evaluate more complex questions than simply what a person claims her name actually is, this could interfere with the operation of the procedure in terms of time, cost and perhaps even predictability of outcome. These might be good reasons to leave out matters relating to transferability and descendability of personal rights in domain names until a later iteration of the PDRP if the need arises.

Other arguments against the initial inclusion of a provision allowing assignees and beneficiaries of personality rights to bring complaints under the PDRP include concerns about how long a person's image should be controlled by her estate after her death.<sup>329</sup> There may also be concerns that the transferability and descendability of rights in a persona are not universally accepted even within the United States,<sup>330</sup> so it may be a mistake to foist them on a global system for protecting personal name interests in domain names.<sup>331</sup>

Further, there may be some question as to how often these issues would arise in practice in the domain name context. As noted above, the estates of many famous people currently hold the domain names corresponding with the relevant names,<sup>332</sup> while celebrities and politicians are now getting better about aggressively fighting for control of relevant domain names during their lifetimes.<sup>333</sup> The result may be that the question of post-mortem personal domain name disputes has very minimal practical importance. If a PDRP is established now to help those who want to assert interests in relevant domain names to obtain those names, those people can presumably hold on to the names and pass them to their estates in the future as a matter of contract law. It is a simple matter for a successful complainant to transfer the domain name to anyone she wants, either during her lifetime or presumably post mortem if she executes the transfer formalities prior to her death.

#### IV. CONCLUSIONS

This Article has identified why over-reliance on trademark-focused rules, such as the UDRP, to resolve personal domain name disputes leads to inconsistent and arbitrary results. It has suggested that a personality rights model would create a better substantive

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<sup>329</sup> See, for example, discussion in Kwall, *First Amendment*, *supra* note \_\_\_, 81-86 (1994).

<sup>330</sup> See discussion in GILSON LALONDE, *supra* note \_\_\_, at §§ 2.16[4]-[5].

<sup>331</sup> Of course, the same argument could be made more generally in terms of foisting a PDRP on the global economy that is based on unharmonized American state law. However, this Article suggests that it may be less objectionable to base the PDRP on personality rights theory if some of the more contentious aspects of the theory, such as questions of duration and descendability of rights, can be avoided, at least in the initial iteration of the PDRP.

<sup>332</sup> See, for example, [www.marlonbrando.com](http://www.marlonbrando.com), [www.johnwayne.com](http://www.johnwayne.com), [www.marilynmonroe.com](http://www.marilynmonroe.com), last viewed on November 24, 2007.

<sup>333</sup> See, for example, discussion in Moreland, *supra* note \_\_\_; Beezy, *supra* note \_\_\_.

framework for dealing with these disputes. However, personality rights litigation suffers from cost and procedural disadvantages. It also exists today largely as a matter of unharmonized state law within the United States. The aim of this Article has been to suggest a new procedure for personal domain name disputes – a PDRP – that marries together the procedural and globalization advantages of the UDRP with the substantive theoretical advantages of the right of publicity. This approach achieves the best of both worlds in that it maintains the procedural benefits of the UDRP – the avenue most often chosen by complainants in personal domain name disputes today – while basing the decisions on a theory that more appropriately protects interests in an individual’s persona than trademark law.

Drafting and implementing a new PDRP would be a relatively easy and cost-effective matter. It would require the drafting and adoption of such a procedure by ICANN. Implementation would simply require the incorporation of the new PDRP by reference into <.com> registration agreements in the first instance. The drafting of the PDRP would generally mirror the drafting of the UDRP except for some changes in substance to the text of UDRP’s clause 4 relating to the matters the claimant needs to prove, and the nature and scope of the legitimate use defense available to the registrant.

The continued development of personal domain name jurisprudence based on trademark principles threatens to warp the boundaries of trademark law and to unjustifiably extend trademark practice online into areas where the alleged trademarks are mere fictions. Alternatively, it could fail to protect interests that really should be protected as a matter of tort law under the right of publicity.<sup>334</sup> In any event, the application of the trademark-based UDRP to personal domain name disputes is clearly creating inconsistent results.<sup>335</sup>

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<sup>334</sup> See, for example, *Bruce Springsteen v Jeff Burgar and Bruce Springsteen Club*, WIPO Case No. D2000-1532, Jan. 25, 2001 (available at <http://arbiter.wipo.int/domains/decisions/html/2000/d2000-1532.html>) (involving *bruce.springsteen.com* domain name); *Anna Nicole Smith v DNS Research Inc*, Claim Number FA0312000220007, Feb 21, 2004, National Arbitration Forum, full text available at <http://www.adrforum.com/domains/decisions/220007.htm>, last viewed on October 25, 2007; *The Hebrew University of Jerusalem v Alberta Hot Rods*, WIPO Case No. D2002-0616, October 7, 2002, (available at <http://www.wipo.int/amc/en/domains/decisions/html/2002/d2002-0616.html>) (involving a complaint with respect to the domain name <alberteinstein.com>).

<sup>335</sup> Why, for example, should Julia Roberts and Tom Cruise be regarded as having trademark interests in their personal names when the same is not necessarily true for Bruce Springsteen, or the late Anna Nicole Smith? Why should “Hillary Clinton” be recognized as a trademark when the same is not true for other politicians such as Kathleen Kennedy Townsend? See, for example, *Julia Fiona Roberts v Russell Boyd*, WIPO Case No. D2000-0210, 30 May, 2000 (available at <http://www.wipo.int/amc/en/domains/decisions/html/2000/d2000-0210.html>) (involving *juliaroberts.com* domain name); *Tom Cruise v Alberta Hot Rods*, WIPO Case No D2006-0560, 5 July, 2006 (available at <http://www.wipo.int/amc/en/domains/decisions/html/2006/d2006-0560.html>) (involving *tomcruise.com* domain name); *Anna Nicole Smith v DNS Research Inc*, Claim No. FA0312000220007, National Arbitration Forum, Feb 21, 2004 (available at: <http://www.adrforum.com/domains/decisions/220007.htm>) (involving *annanicolesmith.com* domain name); *Hillary Rodham Clinton v Michele Dinoia*, National Arbitration Forum Claim No FA0502000414641, March 18, 2005 (full text available at <http://www.arbforum.com/domains/decisions/414641.htm>) (involving *hillaryclinton.com* domain name); *Bruce Springsteen v Jeff Burgar*, WIPO Case No D2000-1532, Jan 25, 2001 (available at

Another important advantage of a PDRP over the UDRP with respect to personal domain name disputes is that it might refocus judicial attention on the appropriate legal principles when these disputes do end up in court. While the trademark-focused UDRP remains most people's first port of call with respect to domain name disputes, litigation also seems to be centered around the trademark-based provisions of domestic law. The *Falwell* case,<sup>336</sup> for example, was argued purely with respect to trademarks and did not raise personality rights claims at all.<sup>337</sup> The *Kathleen Kennedy Townsend* complaint<sup>338</sup> would likely have been successful if it had been litigated under § 1129(1)(A) of the Lanham Act, but was brought under the trademark-based UDRP instead.<sup>339</sup> It may be that if the cost-effective avenue of choice for complainants focuses on more appropriate issues than trademark law, litigants would think to bring judicial proceedings under more appropriate provisions of domestic law in the event that the dispute does end up in court.

This Article has demonstrated the importance of developing a mechanism specifically and appropriately tailored for personal domain name disputes. This would be a simple and easy task for ICANN in practice. If a PDRP could be adopted along the lines described here, it might well result in a more effective resolution of domain name disputes involving personal names. It might also assist more generally with appropriately nuanced developments in cyberlaw, particularly pertaining to the protection of personality rights online. Given that Internet regulators are constantly striving to balance property and property-like rights online against free speech interests, the creation of more sophisticated laws and regulations that more clearly define the scope of relevant interests is of paramount importance. Trademark law in particular is currently under a lot of pressure in cyberspace.<sup>340</sup> If we are truly concerned about identifying the boundaries of

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<http://www.wipo.int/amc/en/domains/decisions/html/2000/d2000-1532.html>); *Kathleen Kennedy Townsend v Birt*, WIPO Case No D2002-0030, April 11, 2002 (available at <http://www.wipo.int/amc/en/domains/decisions/html/2002/d2002-0030.html>).

<sup>336</sup> *Lamparello v Falwell*, 420 F 3d 309 (2005).

<sup>337</sup> This is not a criticism of the holding in the *Falwell* litigation, but merely an observation that it is interesting the entire case was argued under trademark law, rather than the right of publicity, when the case revolved around rights in a personal name.

<sup>338</sup> *Kathleen Kennedy Townsend v Birt*, WIPO Case No D2002-0030, April 11, 2002 (available at <http://www.wipo.int/amc/en/domains/decisions/html/2002/d2002-0030.html>).

<sup>339</sup> *id.* ("The Panel finds that the protection of an individual politician's name, no matter how famous, is outside the scope of the Policy since it is not connected with commercial exploitation as set out in the Second WIPO Report. This does not mean that Complainant is without remedy. The ACPA contains express provisions protecting the rights in personal names. Complainant is free to pursue her claims in that forum. And, as mentioned, the committee may have rights in the marks that are sufficiently commercial as to entitle the committee to protection under the Policy.").

<sup>340</sup> See Lastowka, *supra* note \_\_\_, Goldman, *supra* note \_\_\_, Graeme Dinwoodie and Mark Janis, *Confusion Over Use: Contextualism in Trademark Law*, 92 IOWA L REV 1597, 1629-1638 (2007); Stacey Dogan and Mark Lemley, *Grounding Trademark Law Through Trademark Use*, 92 IOWA L REV 1669, 1690-1698 (2007).

*CELEBRITY IN CYBERSPACE*

trademark law on the Internet, we must be prepared to address situations that do not really involve trademarks by more targeted and effective means. Personality rights are a more well-tailored and effective theoretical basis for resolving personal domain name disputes, if we can avoid the current procedural and jurisdictional pitfalls. A new PDRP as suggested in this Article could achieve this result in practice.