



NATIONAL
ARBITRATION
FORUM

DECISION

Carlos Santana v. Domain Sales a/k/a ##### This Domain Name is For Sale

Claim Number: FA0312000222189

PARTIES

Complainant is **Carlos Santana**, San Rafael, CA ("Complainant") represented by **Eric W. Doney**, Esq., of **Donahue Gallagher Woods LLP**, 591 Redwood Highway, Suite 1200, Mill Valley, CA 94941. Respondent is **Domain Sales a/k/a ##### This Domain is For Sale #####**, WEI 35-B, Da-Dong, Jung-gu 100-180, Korea 283-4937 ("Respondent").

REGISTRAR AND DISPUTED DOMAIN NAME

The domain name at issue is <**carlossantana.com**>, registered with **Iholdings.com, Inc.** d/b/a **Dotregistrar.com**.

PANEL

The undersigned certify that they have acted independently and impartially and to the best of their knowledge have no known conflict in serving as Panelists in this proceeding.

Estella Gold, Esq., Presiding Panelist, and Hon. Paul A. Dorf (ret.) and Peter L. Michaelson, Esq. as Panelists.

PROCEDURAL HISTORY

Complainant submitted a Complaint to the National Arbitration Forum (the "Forum") electronically on December 26, 2003; the Forum received a hard copy of the Complaint, together with Exhibits A-M, on December 29, 2003.

On January 2, 2004, Iholdings.com, Inc. d/b/a Dotregistrar.com confirmed by e-mail to the Forum that the domain name <**carlossantana.com**> is registered with Iholdings.com, Inc. d/b/a Dotregistrar.com and that Respondent is the current registrant of the name. Iholdings.com, Inc. d/b/a Dotregistrar.com has verified that Respondent is bound by the Iholdings.com, Inc. d/b/a Dotregistrar.com registration agreement and has thereby agreed to resolve domain-name disputes brought by third parties in accordance with ICANN's Uniform Domain Name Dispute Resolution Policy (the "Policy").

On January 7, 2004, a Notification of Complaint and Commencement of Administrative Proceeding (the "Commencement Notification"), setting a deadline of January 27, 2004 by which Respondent could file a Response to the Complaint, was transmitted to Respondent via e-mail, post and fax, to all entities and persons listed on Respondent's registration as technical, administrative and billing contacts, and to postmaster@carlossantana.com by e-mail.

Having received no Response from Respondent, using the same contact details and methods as were used for the Commencement Notification, the Forum transmitted to the parties a Notification of Respondent Default.

On February 12, 2004, pursuant to Complainant's request to have the dispute decided by a three-member Panel, the Forum appointed Estella Gold, Esq. as Presiding Panelist, and Hon. Paul A. Dorf (ret.) and Peter L. Michaelson, Esq. as Panelists.

Having reviewed the communications records, the Administrative Panel (the "Panel") finds that the Forum has discharged its responsibility under Paragraph 2(a) of the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules") "to employ reasonably available means calculated to achieve actual notice to Respondent." Therefore, the Panel may issue its decision based on the documents submitted and in accordance with the ICANN Policy, ICANN Rules, the Forum's Supplemental Rules and any rules and principles of law that the Panel deems applicable, without the benefit of any Response from Respondent.

RELIEF SOUGHT

Complainant requests that the disputed domain name be transferred from Respondent to Complainant.

PARTIES' CONTENTIONS

A. Complainant makes the following assertions:

1. Respondent's <carlossantana.com> domain name is identical to Complainant's CARLOS SANTANA mark.
2. Respondent does not have any rights or legitimate interests in the <carlossantana.com> domain name.
3. Respondent registered and used the <carlossantana.com> domain name in bad faith.

B. Respondent failed to submit a Response in this proceeding.

FINDINGS

Complainant, who was inducted into the Rock and Roll Hall of Fame in 1998, is prominently known worldwide for musical talents and abilities. Since 1969, Complainant has utilized the birth name and mark, CARLOS SANTANA, to promote

and sell 37 commercial music albums. Additionally, Complainant has contributed his talents to 45 commercial releases by other artists, as well as having appeared in eight motion pictures. All told, Complainant has sold over 42.5 million record albums in the United States under the CARLOS SANTANA mark.

Complainant has also attained significant international prominence via live musical performances. In 2003 alone, Complainant performed for audiences in New Zealand, Australia, Germany, Italy, Japan, China, England, Switzerland, Sweden, Finland, Norway, France, Spain, and the Netherlands. Over 30 million people have been entertained around the world by Complainant and an estimated 800 million international viewers observed Complainant perform during the National Football League's Super Bowl XXXVII Pregame Show.

Besides musical recordings and live performances, Complainant also uses its CARLOS SANTANA mark in conjunction with the promotion and sale of books, clothing, various accessories and souvenirs.

Respondent registered the disputed domain name, <carlossantana.com>, on March 13, 1999. The domain's attached website directs Internet users to <clubhongkong.com>, which displays the following warning:

“NO CHILDREN ALLOWED! You must be at least 18 years old to enter! [Click here if you are 18 years old or older!](#)”

Upon entering this website, the user is confronted with a series of pornographic links, as well as a link to a domain registry that offers 667 different domain names for sale with asking prices ranging from \$1,000 to \$50,000.

DISCUSSION

Paragraph 15(a) of the Rules instructs this Panel to "decide a complaint on the basis of the statements and documents submitted in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable."

In view of Respondent's failure to submit a Response, the Panel shall decide this administrative proceeding on the basis of Complainant's undisputed representations pursuant to paragraphs 5(e), 14(a) and 15(a) of the Rules and draw such inferences it considers appropriate pursuant to paragraph 14(b) of the Rules.

Paragraph 4(a) of the Policy requires that Complainant must prove each of the following three elements to obtain an order that a domain name should be cancelled or transferred:

- (1) the domain name registered by Respondent is identical or confusingly similar to a trademark or service mark in which Complainant has rights; and
- (2) Respondent has no rights or legitimate interests in respect of the domain name; and
- (3) the domain name has been registered and is being used in bad faith.

Identical and/or Confusingly Similar

Under the Policy, a mark need not be registered by a governmental authority to be afforded protection. *See McCarthy on Trademarks and Unfair Competition*, § 25:74.2 (4th ed. 2002) (The ICANN dispute resolution policy is “broad in scope” in that “the reference to a trademark or service mark ‘in which the complainant has rights’ means that ownership of a registered mark is not required—unregistered or common law trademark or service mark rights will suffice” to support a domain name Complaint under the Policy); *see also British Broad. Corp. v. Renteria*, D2000-0050 (WIPO Mar. 23, 2000) (noting that the Policy “does not distinguish between registered and unregistered trademarks and service marks in the context of abusive registration of domain names” and applying the Policy to “unregistered trademarks and service marks”); *see also Great Plains Metromall, LLC v. Creach*, FA 97044 (Nat. Arb. Forum May 18, 2001) (finding that the Uniform Domain Name Dispute Resolution Policy does not require “that a trademark be registered by a governmental authority for such rights to exist”).

However, to be afforded protection, an identifying mark must be distinctive. A mark is defined as distinctive and capable of being protected if it either (1) is inherently distinctive or (2) has acquired distinctiveness through secondary meaning. *See Restatement (Third) of Unfair Competition* § 13, pp. 37-38, and Comment *a* (Tent. Draft No. 2, Mar. 23, 1990). Personal names, such as CARLOS SANTANA, acquire secondary meaning if a substantial segment of the public understands the designation as an indication of the source of a product or service. *See McCarthy on Trademarks and Unfair Competition*, § 13:2 (4th ed. 2002) (stating that secondary meaning grows out of long association of the name with the business, and thereby becomes the name of the business as such; is acquired when the name and the business become synonymous in the public mind; and submerges the primary meaning of the name as a word identifying a person, in favor of its meaning as a word identifying that business).

Names used in conjunction with celebrity personalities have been consistently held under the Policy to maintain common law trademark rights. *See Roberts v. Boyd*, D2000-0210 (WIPO May 29, 2000) (finding that trademark registration was not necessary and that the name “Julia Roberts” has sufficient secondary association with Complainant that common law trademark rights exist); *see also Ciccone v. Parisi & madonna.com*, D2000-0847 (WIPO Apr. 17, 2002); *see also Marino v. Video Images Prod.*, D2000-0598 (WIPO Aug. 2, 2000).

In this case, the Panel concludes that Complainant has established secondary meaning in its CARLOS SANTANA mark based on the extent of use, the quantity of musical productions and performances and the qualitative nature therein, evidenced by the induction into the Rock and Roll Hall of Fame. *See Jagger v. Hammerton*, FA 95261 (Nat. Arb. Forum Sept. 11, 2000) (Complainant held common law trademark rights in his famous name MICK JAGGER); *see also Estate of Tupac Shakur v. Shakur Info Page*, AF-0346 (eResolution Sept. 28, 2000) (finding that a “person may acquire such a reputation in his or her own name as to give rise to trademark rights in that name at common law”); *see also Garnett v. Trap Block Technologies*, FA 128073 (Nat. Arb.

Forum Nov. 21, 2002) (holding that Complainant had accrued common law rights in the KEVIN GARNETT mark).

The disputed domain name, <carlossantana.com>, is identical to Complainant's CARLOS SANTANA mark because the name incorporates the mark in its entirety and merely affixes a top-level domain, which is irrelevant under the Policy. *See Oki Data Americas, Inc. v. ASD Inc.*, D2001-0903 (WIPO Nov. 6, 2001) ("The fact that a domain name incorporates a Complainant's registered mark is sufficient to establish identical or confusing similarity for purposes of the Policy."). *See also Nikon, Inc. v. Technilab, Inc.*, D2000-1774 (WIPO Feb. 26, 2000) (holding that confusing similarity under the Policy is decided upon the inclusion of a trademark in the domain name); *Rollerblade, Inc. v. McCrady*, D2000-0429 (WIPO June 25, 2000) (finding that the top level of the domain name such as ".net" or ".com" does not affect the domain name for the purpose of determining whether it is identical or confusingly similar); and *Busy Body, Inc. v. Fitness Outlet Inc.*, D2000-0127 (WIPO Apr. 22, 2000) (finding that the addition of a top-level domain is without legal significance).

Therefore, Complainant has established Policy ¶ 4(a)(i).

Rights or Legitimate Interests

Having failed to respond to the Complaint, the Panel may deduce from such failure that Respondent lacks rights to and legitimate interests in the disputed domain name and may accept Complainant's assertions as true. *See Pavillion Agency, Inc. v. Greenhouse Agency Ltd.*, D2000-1221 (WIPO Dec. 4, 2000) (finding that Respondents' failure to respond can be construed as an admission that they have no legitimate interest in the domain names); *see also Am. Online, Inc. v. AOL Int'l*, D2000-0654 (WIPO Aug. 21, 2000) (finding no rights or legitimate interests where Respondent fails to respond); *see also Talk City, Inc. v. Robertson*, D2000-0009 (WIPO Feb. 29, 2000) ("In the absence of a response, it is appropriate to accept as true all allegations of the Complaint.").

No evidence has been advanced to suggest that Respondent is, or ever has been, commonly known by the disputed domain name pursuant to Policy ¶ 4(a)(ii). *See Tercent Inc. v. Yi*, FA 139720 (Nat. Arb. Forum Feb. 10, 2003) (finding that the WHOIS information, and its failure to imply that Respondent is commonly known by the disputed domain name, is a factor in determining that Policy ¶ 4(c)(ii) does not apply); *see also Gallup Inc. v. Amish Country Store*, FA 96209 (Nat. Arb. Forum Jan. 23, 2001) (finding that Respondent does not have rights in a domain name when Respondent is not known by the mark).

Evidence has been advanced indicating that Respondent uses the disputed domain name to market pornographic material. Such use has consistently been held to be neither a bona fide offering of goods or services pursuant to Policy ¶ 4(c)(i), nor a legitimate noncommercial or fair use pursuant to Policy ¶ 4(c)(iii). *See ABB Asea Brown Boveri Ltd. v. Quicknet*, D2003-0215 (WIPO May 26, 2003) (stating that the "use of the disputed domain name in connection with pornographic images and links tarnishes and dilutes

[Complainant's mark]" and is evidence that Respondent had no rights or legitimate interests in the disputed domain name); *see also Isleworth Land Co. v. Lost In Space, SA*, FA 117330 (Nat. Arb. Forum Sept. 27, 2002) (finding that Respondent's use of its domain name to link unsuspecting Internet traffic to an adult-oriented website, containing images of scantily clad women in provocative poses, did not constitute a bona fide offering of goods or services, nor a noncommercial or fair use); *see also McClatchy Mgmt. Servs., Inc. v. Carrington a/k/a Party Night Inc.*, FA 155902 (Nat. Arb. Forum June 2, 2003) (holding that Respondent's use of the disputed domain names to divert Internet users to a website featuring pornographic material, has been "consistently held" to be neither a bona fide offering of goods or services, nor a legitimate noncommercial or fair use).

Moreover, the fact that Respondent incorporated Complainant's mark in its entirety and used the name to host material unrelated to the mark, naturally suggests that Respondent was using the name in a parasitic fashion to attract Internet users to its site, presumably for profit. Such use does not confer rights or legitimate interests in the name under the Policy. *See eBay Inc. v. Hong*, D2000-1633 (WIPO Jan. 18, 2001) (stating that the "use of complainant's entire mark in infringing domain names makes it difficult to infer a legitimate use"). *See also WeddingChannel.com Inc. v. Vasiliev a/k/a Free Domains Parking*, FA 156716 (Nat. Arb. Forum June 12, 2003) (finding that Respondent's use of the disputed domain name to redirect Internet users to websites unrelated to Complainant's mark, websites where Respondent presumably receives a referral fee for each misdirected Internet user, was not a bona fide offering of goods or services as contemplated by the Policy); and *U.S. Fran. Sys., Inc. v. Howell*, FA 152457 (Nat. Arb. Forum May 6, 2003) (holding that Respondent's use of Complainant's mark and the goodwill surrounding that mark as a means of attracting Internet users to an unrelated business was not a bona fide offering of goods or services).

Therefore, Complainant has established Policy ¶ 4(a)(ii).

Registration and Use in Bad Faith

Respondent's registration of a domain name, which is identical to Complainant's name and mark, in order to provide pornographic material unrelated to Complainant demonstrates bad faith registration and use pursuant to Policy ¶ 4(a)(iii). *See Microsoft Corp. v. Horner*, D2002-0029 (WIPO Feb. 27, 2002) (holding that Respondent's use of Complainant's mark to post pornographic photographs and to publicize hyperlinks to additional pornographic websites evidenced bad faith use and registration of the domain name); *see also Ty, Inc. v. O.Z. Names*, D2000-0370 (WIPO June 27, 2000) (finding that absent contrary evidence, linking the domain names in question to graphic, adult-oriented websites is evidence of bad faith); *Youtv, Inc. v. Alemdar*, FA 94243 (Nat. Arb. Forum Apr. 25, 2000) (finding bad faith where Respondent attracted users to his website for commercial gain and linked his website to pornographic websites); and *Wells Fargo & Co. v. Party Night Inc. & Carrington*, FA 144647 (Nat. Arb. Forum Mar. 18, 2003) (finding that Respondent's tarnishing use of the disputed domain names to redirect

Internet users to adult-oriented websites was evidence that the domain names were being used in bad faith).

Furthermore, Respondent registered and used the disputed domain name in bad faith pursuant to Policy ¶ 4(b)(iv) because it intentionally attracted Internet traffic to its website by creating a likelihood of confusion with Complainant's mark for commercial gain. *See Perot Sys. Corp. v. Perot.net*, FA 95312 (Nat. Arb. Forum Aug. 29, 2000) (finding bad faith where the domain name in question is obviously connected with Complainant's well-known marks, thus creating a likelihood of confusion strictly for commercial gain); *Am. Online, Inc. v. Fu*, D2000-1374 (WIPO Dec. 11, 2000) (finding that Respondent intentionally attempted to attract Internet users to his website for commercial gain by creating a likelihood of confusion with Complainant's mark and offering the same services as Complainant via his website); and *Scholastic Inc. v. Applied Software Solutions, Inc.*, D2000-1629 (WIPO Mar. 15, 2001) (finding bad faith under Policy ¶ 4(b)(iv) where Respondent initially used the domain name at issue to resolve to a website offering similar services as Complainant into the same market).

Therefore, Complainant has established Policy ¶ 4(a)(iii).

DECISION

Having established all three elements required under the ICANN Policy, the Panel unanimously concludes that relief shall be **GRANTED**.

Accordingly, it is Ordered that the <**carlossantana.com**> domain name be **TRANSFERRED** from Respondent to Complainant.

Estella Gold, Esq., Presiding Panelist
Dated: February 24, 2004