

True Blue Productions Inc. v. Hoffman, 73 USPQ2d 1512 (WIPO 2004)

73 USPQ2D 1512
True Blue Productions Inc. v. Hoffman
World Intellectual Property Organization

No. D2004-0930
Decided December 22, 2004

Headnotes

TRADEMARKS AND UNFAIR TRADE PRACTICES

[1] Infringement; conflicts between marks — Likelihood of confusion —Particular marks — Confusion likely (§335.0304.03)

Infringement; conflicts between marks — Willful (§335.11)

REMEDIES

Non-monetary and injunctive — Equitable relief — Seizure; forfeiture (§505.0703)

Complainant in Internet domain name dispute resolution proceeding has established

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that respondent engaged in cybersquatting by registering “fatactress.com” domain name, even though complainant's “Fat Actress” mark is not registered, since Uniform Domain Name Dispute Resolution Policy of Internet Corporation for Assigned Names and Numbers applies to any domain name that is identical or confusingly similar to trademark “in which the complainant has rights,” and record supports complainant's claim that it holds common law rights in mark, since disputed domain name sufficiently resembles complainant's mark so as to cause confusion, since respondent has no legitimate rights or interests in “fatactress.com,” and since respondent's opportunistic exploitation of complainant's mark to confuse Internet users and substantially increase number of visitors to Web sites having no connection to complainant evidences bad-faith registration and use of domain name.

Case History and Disposition

Administrative proceeding pursuant to Uniform Domain Name Dispute Resolution Policy of Internet Corporation for Assigned Names and Numbers, in which complainant True Blue Productions Inc. alleges cybersquatting by respondent Chris Hoffman. Panelist directs transfer of disputed domain name, “fatactress.com,” to complainant.

Attorneys:

Goldman & Kagon Law Corp., Los Angeles, Calif., for complainant.

Christ Hoffman, Pacific Palisades, Calif., for respondent.

Opinion Text

Opinion By:

Michaelson, panelist.

1. The Parties

The Complainant is True Blue Productions, Inc., Los Angeles, California of United States of America, represented by Goldman & Kagon Law Corporation, United States of America.

The Respondent is Chris Hoffman, Pacific Palisades, California, of United States of America.

2. The Domain Name and Registrar

The disputed domain name <fatactress.com> is registered with Go Daddy Software (“GoDaddy”).

3. Procedural History

The Complaint was brought pursuant to the Uniform Domain Name Dispute Resolution Policy (the “Policy”), which was adopted by the Internet Corporation for Assigned Names and Numbers (ICANN) on August 26, 1999, and approved on October 24, 1999, and in accordance with the Rules for Uniform Domain Name Dispute Resolution Policy (the “Rules”) as approved on October 24, 1999, and by the World Intellectual Property Organization Supplemental Rules for Uniform Domain Name Dispute Resolution Policy in effect as of December 1, 1999 (the “Supplemental Rules”).

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) in e-mail form on November 5, 2004, and in hard copy form on November 11, 2004, along with Annexes 1-12.

Pursuant to Paragraph 4(d) of the Policy, the Complainant selected the Center as the ICANN-approved administrative dispute resolution service provider to administer this proceeding. Through the Complaint, the Complainant requested a single member panel.

After receiving the Complaint, the Center, in accordance with Paragraph 5 of the Supplemental Rules, determined whether that Complaint fully complied with the formal requirements of the Rules and

the Supplemental Rules. In that regard, on November 8, 2004, the Center requested confirmation from the Registrar of information set forth in the Complaint relative to the disputed domain name; specifically, contact and registrant information for that domain name, as well as whether the Registrar received a copy of the Complaint from the Complainant. The Center also requested the Registrar to specify: (a) whether the Policy applies to each disputed domain name, (b) whether the registrant has submitted, in its registration agreement, to the jurisdiction at the location of the principal office of the registrar for court adjudication of disputes concerning or arising from the use of the domain name, (c) the language of the registration agreement, and (d) whether the domain name will remain “locked” during the proceeding.

Subsequently, on November 8, 2004, the Registrar provided its response to the Center through which the Registrar specified name and contact information pertinent to the disputed domain name, to the extent present in

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its WhoIS database, confirmed that GoDaddy is the registrar of that name, stated that: it had not received a copy of the Complaint, the Policy applied to the disputed domain name, the language of the underlying registration agreement for the name is English and the name was then held in a “locked” status. The Registrar also informed the Center that the Respondent, through the registration agreements, had submitted to the jurisdiction at the location of the principal office of the Registrar for court adjudication of disputes concerning or arising from the use the disputed domain name.

On November 12, 2004, the Center informed the Complainant’s counsel, by e-mail, of an administrative deficiency in the Complaint and requested counsel to file an amendment to the Complaint. Subsequently on the same day, the Complainant’s counsel filed an amendment to the Complaint by facsimile and e-mail. Hereinafter, for simplicity, the Complaint together with its amendment will simply be collectively referred to as the “Complaint”.

On November 15, 2004, the Center notified the Respondent of the filing of the Complaint, including an indication that the Center was forwarding a complete copy of the Complaint, by courier and e-mail (the latter without the Exhibits), to the Respondent. Specifically, the Center separately provided its

notice along with the Complaint, by e-mail, to the Respondent's domain name registrant, technical, administrative and zone contacts as set forth in the WhoIS record for the disputed domain name. In addition and also on November 15, 2004, the Center forwarded a copy of the Complaint (without the annexes) to the Registrar. The Complaint, and its accompanying documents, and all subsequent communications associated therewith were provided in the preferred manners and to the addresses as mandated by paragraphs 2(a), 2(b) and 4(a) of the Rules.

Hence, the notification to the Respondent having occurred on November 15, 2004, under Paragraph 4(c) of the Policy, this administrative proceeding is deemed to have commenced on that date.

Having reviewed the Complaint and all preceding and succeeding correspondence between the Center and the Registrar, in detail, the Panel agrees with the determination of the Center that the Complaint and its handling met the requirements of the Rules and the Supplemental Rules.

The Respondent was then provided with a 20 calendar day period, expiring on December 5, 2004, to file its Response with the Center and serve a copy of the Response on the Complainant.

As of December 6, 2004, the Center had not received a substantive Response to the Complaint from the Respondent; hence, the Center, in an e-mail letter dated December 6, 2004, notified the Complainant and Respondent of the default of the Respondent.

Accordingly, pursuant to the Rules and Supplemental Rules, by e-mail letter dated December 7, 2004, the Center contacted the undersigned, Mr. Peter L. Michaelson, requesting his service as a Sole Panelist for this dispute. Subsequently, on the same day, Mr. Michaelson accepted and returned, by facsimile to the Center, a fully executed Statement of Acceptance and Declaration of Impartiality and Independence. The Center, through an e-mail letter dated December 8, 2004, notified the parties of the appointment of Mr. Michaelson as sole panelist.

Based on the deadline set forth in Paragraph 15 of the Rules, a decision was to be issued by the Panel to the Center on or before December 22, 2004.

This dispute concerns one domain name, specifically: <fatactress.com>.

The language of this proceeding is English.

4. Factual Background

A copy of the WhoIS registration record for the disputed domain name appears in Annex 1 to the Complaint. As indicated on that record, the Respondent registered this name on July 22, 2004.

A. The mark “FAT ACTRESS” and the Parties Activities

A television series entitled “Fat Actress” was written and created by the Complainant and will be initially broadcast in March 2005, on the Showtime Networks, Inc. premium programming service. Seven episodes have been produced and star Kirstie Alley (who is the sole shareholder and president of the Complainant) as a fictitious version of herself. Ms. Alley’s association with, creation of and acting in “Fat Actress” is well known throughout the United States and international

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public. In that regard, the Complainant has provided copies of various media articles in Annex 3 to the Complaint. Specifically, the earliest of those new articles dated July 21, 2004 — one day before the Respondent registered the disputed domain name — first publicly announced the Complainant’s television series, by stating, inter alia:

“Showtime has greenlighted ‘Fat Actress’ episode, half-hour hybrid comedy/reality series starring two-time Emmy winner Kirstie Alley that was inspired by Alley’s real life, it was announced by Robert Greenblatt, President of Entertainment for Showtime Networks, Inc. Taking her life experiences and recreating them in the extreme, Alley plays a fictional version of herself — a successful television and movie star whose weight has become the subject of every tabloid imaginable as well as the bane of her existence as she tries to find work and true love in an unforgiving Hollywood. This irreverent series, which will be co-created and executive produced by Alley Brands Hampton (‘Seventh Heaven’), will be unscripted, with each episode emanating from a story outline and the actors largely improvising the dialogue. ‘Fat Actress’ will begin production in September in Los Angeles and will air on Showtime in 2005....”

Kirstie Alley became a household name playing ‘Rebecca Howe’ on the television series ‘Cheers’ for which she won both a Golden Globe and an Emmy award. Her flair for comedy translated to the big screen in movies like Woody Allen’s ‘Deconstructing Harry’, ‘Look Who’s Talking’ and ‘Look Who’s Talking Too’. In 1997, Alley returned to television to produce and star in the sitcom ‘Veronica’s Closet’ which ran for three seasons.”

The Respondent uses the disputed domain name to re-direct Internet users to the Respondent’s website at “plannedchildhood.org” which identifies itself by a label “unborn babies poisoned by rocket launches” that appears in the upper left-hand corner of hard-copy printouts of its web pages. These web pages are devoted to a negative portrayal of abortion, pornography, birth control, planned parenthood, and Hollywood movies. The Respondent’s website omits any mention of the mark “FAT ACTRESS”. A hard-copy printout of these web pages appears in Annex 5 to the Complaint.

The Respondent owns the domain name <plannedchildhood.org>. A copy of the corresponding registration record for that name, taken from the Registrar’s WhoIS database, appears in Annex 6 to the Complaint.

The Complainant and the Complainant’s counsel have made numerous attempts to contact the Respondent via voice-mail and e-mail at the contact number/address specified in the registration record for the disputed domain name. Furthermore, the Complainant’s counsel sent the Respondent, by postal mail, a cease and desist letter dated October 29, 2004, (a copy of that letter appears in Annex 7) which demanded that the Respondent transfer the disputed domain name to the Complainant. Despite those efforts, the Respondent failed to respond to the Complainant or its counsel.

5. Parties’ Contentions

A. Complainant

(i) Identical or Confusingly Similar

The Complainant contends that the disputed domain name is identical or confusingly similar to the Complainant’s mark “FAT ACTRESS” ostensibly for the reason that domain name includes the

Complainant's mark.

The Complainant contends that it has developed common law trademark rights in the mark "FAT ACTRESS" throughout the US and for use in conjunction with the Complainant's upcoming television series starring "Kirstie Alley" with those rights commencing on July 21, 2004 — that date being the Complainant's first public announcement of that series.

Hence, the Complainant inferentially concludes that it has satisfied the confusing similarity/identity requirement in Paragraph 4(a)(i) of the Policy.

(ii) Rights or Legitimate Interests

The Complainant contends that the Respondent has no rights or legitimate interests in the disputed domain name pursuant to Paragraph 4(a)(ii) of the Policy.

Specifically, the Complainant states that at no time after it registered the disputed domain name did the Respondent establish a website

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directly resolvable through that name, let alone take any bona fide steps to offer goods or services through such a site. Instead, the Respondent used that name to redirect Internet users to its website at "www.plannedchildhood.org" which negatively portrays various subjects, including abortion, pornography, birth control and planned parenthood. The Complainant notes that the Respondent registered the disputed domain name exactly one day after the Complainant's earliest public announcement on July 21, 2004, of its upcoming "Fat Actress" television series.

(iii) Registered and Used in Bad Faith

The Complainant contends that the Respondent has registered and is now using the disputed domain name in bad faith, hence in violation of paragraph 4(a)(iii) of the Policy.

Specifically, the Complainant states that in *Women on Waves Foundation v. Chris Hoffman*, WIPO

Case No. D2000-1608 (January 29, 2001); *America Online, Inc. v. Chris Hoffman*, WIPO Case No. D2001-1184 (November 19, 2001); *New York City Police Foundation, Inc. v. Chris Hoffman*, Case No. FA286046 (Nat. Arb. Forum July 29, 2004); and *Douglas Forrester v. Chris Hoffman d/b/a Planned Childhood, Inc.*, Case No. FA170644 (Nat. Arb. Forum September 3, 2003) the administrative panel in each case found that the respondent (who is same as that in the present dispute) registered a domain name that was confusingly similar to a trademark and used its domain name to re-direct Internet users intent on seeking the website of the owner of the mark to one of the Respondent’s own websites, specifically “www.partialbirthabortions.com”, “www.goblessyourself.com”, “www.plannedchildhood.org” or “www.plannedchildhood.com” which exposed that user to content that negatively portrayed abortion, pornography, birth control, planned parenthood, and Hollywood movies. In each instance, the panel found that the Respondent was using its corresponding domain name(s) to purposely confuse those users to the ultimate detriment of the complainant therein. Hence, in each instance the panel found bad faith use and registration and ordered the disputed domain name(s) transferred to the corresponding complainant. The Complainant particularly points to the *America Online* case, *cited supra*, in which the Respondent registered the disputed domain names therein, all of which included the term “AOL”, just hours after the public announcement of the merger of AOL and Time Warner — which involves essentially the same conduct on the part of the same Respondent as that which occurred here with respect to the July 21, 2004 public announcement of the series “Fat Actress”.

B. Respondent

The Respondent failed to file any Response to the allegations raised in the Complaint.

6. Discussion and Findings

In view of the lack of a Response filed by the Respondent as required under Paragraph 5 of the Rules, this proceeding has proceeded by way of default. Hence, under paragraphs 5(e), 14(a) and 15(a) of the Rules, the Panel is directed to decide this administrative proceeding on the basis of the Complainant’s undisputed representations. In that regard and apart from judging this proceeding through mere default of the Respondent, the Panel makes the following specific findings.

A. Identical or Confusingly Similar

Though the Complainant's mark "FAT ACTRESS" is unregistered, the Complainant predicates its case not on a registered mark but rather on common law rights it has acquired through use of its mark "FAT ACTRESS" in commerce and specifically in connection with the upcoming television series by the same name. This use started one day prior to the Respondent's registration of the disputed domain name.

[1] Regarding any distinction in coverage between registered and unregistered marks, paragraph 4(a) of the Policy simply recites: "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*" [emphasis added]. Nowhere does the Policy contain a restriction that specifically limits its reach to only registered marks. Therefore, given the apparent inclusive nature of the Policy, whether the Complainant has rights to an unregistered mark and hence a protectable interest under the Policy, lies with national trademark law that governs the Respondent's actions that are the subject of the Complaint. Under American

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law, rights accrue in unregistered, so-called "common law", marks as a result of usage, though limited by geographic and product/service markets in which the mark is used. As evidence of this, one need turn no further than to §43 of the Lanham Act (15 U.S.C. §1125(a)) which states, in pertinent part: "Any person who, on or in connection with any goods or services, or any container for goods, uses in commerce *any word, term, name, symbol, or device, or any combination thereof ... (A) is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person ... shall be liable in a civil action by any person who believes that he or she is or is likely to be damaged by such act.*" [emphasis added].

Consequently, numerous panels including this one, when faced with unregistered marks, have upheld

their protectable status in the United States under the Policy. In that regard, when faced with this issue, the panel in *Brooklyn Institute of Arts and Sciences v. Fantastic Sites, Inc.*, FA 95560 (Nat. Arb. Forum, November 2, 2000) held: “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, e.g., *AT&T Corp. v. Roman Abreu d/b/a Smartalk Wireless*, WIPO Case No. D2002-0605 (September 11, 2002), *Peter Frampton v. Frampton Enterprises, Inc.*, WIPO Case No. D2002-0141 (April 17, 2002); *America Online, Inc. v. John Deep d/b/a Buddy USA Inc.*, FA 96795 (Nat. Arb. Forum, May 14, 2001); *Missing Children Minnesota v. Run Yell Tell, Ltd.*, FA 95825 (Nat. Arb. Forum, November 20, 2000); *Mike Warner 2001 v. Mike Larson*, FA 95746 (Nat. Arb. Forum, November 15, 2000); *CMG Worldwide Inc. v. Naughty Page*, FA 95641 (Nat. Arb. Forum, November 8, 2000); *Home Properties v. SMSOnline*, FA 95639 (Nat. Arb. Forum, November 2, 2000); and *Bridal Rings Company v. Yemenian*, FA 95608 (Nat. Arb. Forum, October 26, 2000). Furthermore, the panel in *United States Postal Service v. Consumer Info. Org.*, FA 95757 (Nat. Arb. Forum, November 27, 2000) held: “The UDRP does not discriminate between registered and unregistered marks.” In *Exario Network Inc. v. THE DOMAIN NAME YOU HAVE ENTERED IS FOR SALE*, AF-0536, (eResolution, December 11, 2000), the panel recognized: “It is well established that a complainant need not own a registered trademark to invoke the policy. It is sufficient that a complainant have rights in an unregistered trademark.” In that regard, also see *Sand Hill Wholesale of Ohio v. Hatton*, FA 95970 (Nat. Arb. Forum, December 18, 2000), and *David Taylor Cadillac/Buick Co. v. Spider Works, Ltd.*, FA 95832 (Nat. Arb. Forum, November 30, 2000). Similarly, see *American Home Products Corp. v. Healthy Futures*, WIPO Case No. D2000-0454 (August 3, 2000); *Cho Yong Pil v. ImageLand, Inc.*, WIPO Case No. D2000-0229 (May 10, 2000); *SeekAmerica Networks, Inc. v. Tariq Masood and Solo Signs*, WIPO Case No. D2000-0131 (April 13, 2000); and *Bennett Coleman & Co. Ltd. v. Steven S Lalwani and Bennett Coleman & Co. Ltd. v. Long Distance Telephone Company*, WIPO Case No. D2000-0014 and D2000-0015 (March 11, 2000).

As a threshold matter, a question arises as to whether common law rights exist at all given that the date which the Complainant claims as the earliest date on which the mark “FAT ACTRESS” was used in commerce, i.e. July 21, 2004, was just one day prior to the date, July 22, 2004, on which the

Respondent registered the disputed domain name. Since the Respondent failed to file any response, let alone contest the Complainant's allegations of its common law trademark rights, the Panel can assess these allegations in the light most favorable to the Complainant, and, in so doing, accept all reasonable allegations and inferences in the Complaint as true. See *Douglas Forrester*, cited *supra*, itself citing to *Bayerische Motoren Werke AG v. Bavarian AG*, FA 110830 (Nat. Arb. Forum June 17, 2002) and *Desotec N.V. v. Jacobi Carbons AB* WIPO Case No. D2000-1398 (December 31, 2000).

The Panel takes judicial notice that Kirstie Alley is an extraordinarily talented and exceedingly well-regarded American actress who is very well-known across the US, if not internationally. In good measure, her renown results from her starring role in the television series "Cheers" which aired on US television for quite a number of years and has been syndicated overseas. Over the past few years, Ms.

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Alley has garnered substantial publicity and notoriety in the media owing to her personal struggles with her own weight — which, in fact, her new television series seeks to exploit in a rather comedic manner. One consequence of her fame is that her every move is captured and widely, instantly and then repeatedly disseminated by the entertainment press. The announcement of her new television series was no exception. Not only has that show received initial media coverage, that coverage continues and intensifies.

Generally speaking, this Panel would not be inclined to find a priori that a single news article featuring a marked product or service associated with a given person would be sufficient by itself and in every instance — in light of its rather limited and focused distribution and extremely short life span in the minds of its intended audience — to convey common law trademark rights to that person. In that regard, once the article were to be publicly released to its recipient community, its content would probably be forgotten within a very short time thereafter. So whatever secondary meaning, if any, would have arisen from a public perception of an association between the mark and that person, as publicized by the article, would quickly vanish, hence tending to negate the existence of any common law trademark rights. However, the present situation is far different and thus clearly justifies an exception.

Anything a celebrity does, particularly of the stature of Ms. Alley, let alone as here with an announcement of her new television series, generates enormous public interest and sustained media coverage across the US. That is simply the nature of her celebrity status. Thus, it stands to reason then that the essence of that coverage, i.e. a new television series called “Fat Actress” starring Ms. Alley will soon be aired, would likely persist in the mind of the television viewing public for quite some time.

The Panel has every reason to think, and so infers, that the July 21, 2004, article, in light of its likely instantaneous and widespread dissemination as well as transposition of its contents into other media articles and outlets, more than amply functioned to implant a rather lasting association in the minds of a wide community of television watching Internet users between the upcoming television series “Fat Actress” and Kirstie Alley — which unquestionably establishes common law trademark rights commencing as of that date. That association was repeatedly reinforced by subsequent media coverage which Ms. Alley received and continues to receive in the entertainment media — as recently evidenced by a 15 minute prime-time segment on the December 19, 2004, edition of Dateline aired on the NBC Television Network which highlighted Ms. Alley and her “Fat Actress” television series. Thus, it is eminently reasonable for the Panel to find that the July 21, 2004, article established common law trademark rights, and the Panel so finds.

Having found that the Complainant acquired common law trademark rights as of July 21, 2004, the Panel finds that confusion unquestionably and inevitably arises — and in fact is so intended — as a result of the Respondent’s use of the disputed domain name as an address to re-direct Internet users, who would otherwise seek the Complainant’s website for information relating to Ms. Alley’s new television series, to the Respondent’s website, which has absolutely no connection with Ms. Alley or her television series. Moreover, the Panel can conceive of no situation where confusion would not likely arise when and if any third party not affiliated with the Complainant, and to which the Respondent were to transfer the disputed domain name, were ever to use that name with a website offering information concerning television entertainment or Ms. Alley’s television series in particular.

Such confusion would undoubtedly cause Internet users intending to access Complainant’s website, but who reach a website through the disputed domain name, to think that an affiliation of some sort exists between Complainant and Respondent, when, in fact, no such relationship would exist at all. *See,*

e.g., *Am. Family Life Assurance Company of Columbus v. defaultdata.com*, FA 123896 (Nat. Arb. Forum October 14, 2002); *AT&T Corp, cited supra*; *Pfizer Inc. v. Order Viagra Online*, WIPO Case No. D2002-0366 (July 11, 2002); *L.F.P., Inc. v. B and J Props.*, FA 109697 (Nat. Arb. Forum May 30, 2002); *Frampton, cited supra*; *Spence-Chapin Servs. to Families and Children v. Wynman*, FA 100492 (Nat. Arb. Forum December 10, 2001); *MPL Communications v. LOVEARTH. net*, FA 97086 (Nat. Arb. Forum June 4, 2001); *Meijer, Inc. v. Porksandwich Web Servs.*, FA 97186 (Nat. Arb. Forum July 6,

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2001); *MPL Communications v. IWebAddress.com*, FA 97092 (Nat. Arb. Forum June 4, 2001); *American Home Prods. Corp. v. Malgioglio*, WIPO Case No. D2000-1602 (Feb. 19, 2001); *Surface Protection Industries, Inc. v. The Webposters*, WIPO Case No. D2000-1613 (February 5, 2001); *Dollar Fin. Group, Inc. v. VQM NET*, FA 96101 (Nat. Arb. Forum January 25, 2001); *eBAY Inc. v. G L Liadis Computing, Ltd. and John L. Liadis d/b/a G L Liadis Computing Ltd.*, WIPO Case No. D2000-1463 (January 10, 2001); *Treeforms, Inc. v. Cayne Indus. Sales Corp.*, FA 95856 (Nat. Arb. Forum December 18, 2000); *see also The Pep Boys Manny, Moe and Jack of CA v. E-Commerce Today, Ltd.*, AF-0145 (eResolution May 3, 2000).

Therefore, the Panel finds that the disputed domain name <fatactress.com> sufficiently resembles the Complainant's mark as to cause confusion; hence, the Complainant has shown sufficient similarity between its mark and that name under paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

The Panel believes that the Respondent has yet to provide any basis that would legitimize any claim he has to the disputed domain name and moreover is extremely unlikely to ever be in such a position to legitimately make such a claim.

The simple reason is that the disputed domain name contains the Complainant's mark "FAT ACTRESS" under which the Complainant, specifically Ms. Alley, provides entertainment services.

The Panel infers from the Complaint that the Complainant has never authorized the Respondent to utilize the mark “FAT ACTRESS” or a mark confusingly similar thereto in conjunction with entertainment services, let alone a television series. Furthermore, the Complainant has no any relationship or association whatsoever with the Respondent. Hence, any use to which the Respondent were to put the mark “FAT ACTRESS” or a mark confusingly similar thereto, in connection with providing services identical or similar to that associated with the Complainant would directly violate the exclusive trademark rights now residing in the Complainant. See, e.g., *Lockheed Martin Corporation v. Deborah Teramani*, WIPO Case No. D2004-0836 (December 1, 2004); FA208576 (Nat. Arb. Forum January 27, 2004); *Leiner Health Servs. Corp. v. ESJ Nutritional Prods.*, FA 173362 (Nat. Arb. Forum September 16, 2003); and *AT&T Corp., MPL Communications, and Treeforms*, all cited *supra*.

The Respondent’s apparent intent of opportunistic use, which at its essence relies on instigating and exacerbating user confusion and hence at the very least tarnishing the Complainant’s mark and its reputation therein, can not and will not constitute bona fide commercial or fair use sufficient to legitimize any rights and interests the Respondent might have in any of the disputed domain names. See, e.g., *Register.com, Inc. v. Wolfgang Reile a/k/a RWG Internet et al* FA208576 [70 USPQ2d 1351] (Nat. Arb. Forum January 27, 2004); and *Lockheed, Leiner Health Servs. Corp.*, and *Frampton*, all cited *supra*.

Moreover, there is absolutely no evidence of record that the Respondent has ever been commonly known by the domain name. Nor, in fact, in view of the fame inherent in Ms. Alley and widespread recognition in her activities, including her new television series, could the Respondent ever likely have attained such common recognition, at least in conjunction with the entertainment services offered by the Complainant, without infringing on the exclusive trademark rights of the Complainant.

Accordingly, the Panel is not persuaded that the Respondent has any rights or legitimate interests or, based on current facts provided to the Panel, is likely to acquire any rights or legitimate interests in any of the disputed domain names under any provision of paragraph 4(c) of the Policy.

Thus, the Panel finds that the Respondent has no rights or legitimate interests in the disputed domain name within Paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

The Panel unequivocally believes that the Respondent's actions in registering and using the disputed domain name constitute bad faith registration and use.

It simply defies reason to think that the Respondent, upon learning of Ms. Alley's new television series, and appreciating the resulting widespread recognition which the mark "FAT ACTRESS" would quickly attain, had absolutely no intention of misappropriating some of that recognition for his own ends—specifically as a means of substantially increasing the number of visitors to his websites

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than he would otherwise attract. Unsuspectingly, those additional visitors, upon being re-directed to the Respondent's website, would be exposed to the Respondent's viewpoint on various issues, including, e.g., abortion, pornography, birth control, planned parenthood, and Hollywood movie — none of which has any apparent connection to Ms. Alley or her television series. The inevitable viewer confusion resulting from the re-direction clearly injures the Complainant by damaging its reputation. If the Respondent had no such intention of opportunistically exploiting the Complainant's mark to increase his own audience, then why would he have registered the disputed domain name in the first place? This Panel sees no other plausible explanation.

Given this, the Panel can not seriously entertain, however fleetingly, any notion that the Respondent was completely unaware of the Complainant's mark "FAT ACTRESS" and its reputation when the Respondent formed and registered the disputed domain name and that its registration coming only one day after the July 21, 2004 article was merely coincidental and not intended to injure the Complainant. Clearly, this was not the case and the Panel categorically dismisses any such notion as totally baseless.

Such opportunistic exploitation constitutes bad faith in and of itself under the general provision of Paragraph 4(b) of the Policy. See, e.g., *Lockheed* and *Register.com*, both cited *supra*.

Thus, the Panel concludes that the Complainant has provided sufficient proof of its allegations to

establish a case under Paragraph 4(a) of the Policy upon which the relief it now seeks can be granted.

7. Decision

Accordingly, under Paragraphs 4(i) of the Policy and 15 of the Rules, the Panel now grants the relief sought by the Complainant.

The disputed domain name, <fatactress.com>, is ordered transferred to the Complainant.

**- End of Case -
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