



## DECISION

MPL Communications, Limited et al v 1WebAddress.com  
Claim Number: FA0104000097092

### **PARTIES**

The Complainant is **MPL Communications, Limited et al**, London, United Kingdom (“Complainant”) represented by **Howard H. Weller**, of **RubinBaum LLP**. The Respondent is **1WebAddress.com**, Siesta Key, FL, USA (“Respondent”).

### **REGISTRAR AND DISPUTED DOMAIN NAME**

The domain name at issue is "**epaulmccartney.com**" registered with **Network Solutions, Inc.** (NSI).

### **PANEL**

The undersigned certifies that he has acted independently and impartially and to the best of his knowledge, has no known conflict in serving as Panelist in this proceeding.

Mr. Peter L. Michaelson, Esq., as Panelist.

### **PROCEDURAL HISTORY**

The Complaint was brought pursuant to the Uniform Domain Name Dispute Resolution Policy (“Policy”), available at <http://www.icann.org/services/udrp/udrp-policy-24oct99.htm>, 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 ICANN Rules for Uniform Domain Name Dispute Resolution Policy (“Rules”) as approved on October 24, 1999, as supplemented by the National Arbitration Forum Supplemental Rules for Uniform Domain Name Dispute Resolution Policy then in effect (“Supplemental Rules”).

The Complainant submitted a Complaint to the National Arbitration Forum (“the Forum”) electronically on April 20, 2001; the Forum received a hard copy of the Complaint on April 20, 2001 together with Annexes A-N. Through the Complaint, the Complainant elected to have the dispute heard before a single panelist.

On April 23, 2001, NSI confirmed by e-mail to the Forum that the contested domain name "**epaulmccartney.com**" is registered with Network Solutions, Inc., that the Respondent is the current registrant of the name and that the contested domain name is in "active" status. NSI has also verified that Respondent is bound by the NSI version 5.0 registration agreement and has thereby agreed to resolve domain-name disputes brought by third parties in accordance with the Policy.

On April 23, 2001, a Notification of Complaint and Commencement of Administrative Proceeding (the "Commencement Notification"), setting a deadline of May 14, 2001 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@epaulmccartney.com by e-mail.

A timely response, together with Annexes A-H, was received and determined to be complete on May 14, 2001.

On May 22, 2001, pursuant to Complainant's request to have the dispute decided by a single-member Panel, the Forum appointed Mr. Peter L. Michaelson, Esq. as Panelist.

## **RELIEF SOUGHT**

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

## **PARTIES' CONTENTIONS**

### **A. Complainant**

#### **1. Confusing similarity/identity**

The Complainant contends that the contested domain name is identical or at least confusingly similar to the Complainant's "Paul McCartney" marks, therefore satisfying the confusing similarity requirement in paragraph 4(a) of the Policy.

Specifically, the Complaint avers that the prefix "e" which merely signifies "electronic" (as in "e-mail" or "E-Trade") is insufficient to distinguish the contested domain name from the Complainant's marks.

Further, the Complainant states that it is the owner of the registered trademark "PAUL McCARTNEY" in the United Kingdom and in the United States. The Complainant avers that the "Paul McCartney" name, through its considerable usage, has acquired distinctiveness and has achieved a high degree of secondary meaning with a single source such that that name, as a mark, deserves considerable protection.

#### **2. Legitimacy**

The Complainant contends that the Respondent has no rights or legitimate interests in the contested domain name.

First, the Complainant states that at no time has it assigned, granted, licensed, sold, authorized or otherwise agreed to the Respondent's use of the mark "PAUL McCARTNEY". In that regard, the Complainant contends that the Respondent cannot be said to have legitimately chosen the contested domain name unless it was seeking to create an impression of an association with the Complainant. Since there is no such authorized association, Respondent's interests in the domain name cannot be said to be legitimate.

Furthermore, the Complainant contends that the Respondent is not using, nor has it demonstrated that it is preparing to use, the domain name in connection with a *bona fide* offering of services. Hence, the Complainant concludes that the absence of any use signifies that the Respondent lacks legitimate interests in this domain name.

In addition, the Complainant contends that the Respondent has not acquired any trademark usage of the "PAUL McCARTNEY" mark, nor is it making a legitimate noncommercial or fair use of the domain name without intent for commercial gain or to tarnish the trademark at issue. In that regard, the Complainant contends that the Respondent's intent, as made clear from its own website, is to auction the contested domain name to the highest bidder. Hence, the Complainant concludes that this action is clearly inconsistent with the Respondent holding any legitimate interests in the contested domain name.

Hence, the Complainant concludes that the Respondent cannot demonstrate any rights or legitimate interests in the contested domain name pursuant to paragraph 4(a) of the Policy.

### 3. Bad Faith

The Complainant contends that, for each of several reasons, the Respondent registered and is using the contested domain name in bad faith.

First, the Complainant contends that, in violation of paragraph 4(b)(i) of the Policy, the Respondent primarily registered the contested domain name for the purpose of selling or otherwise transferring it to the Complainant for valuable consideration ostensibly in excess of the costs of registration. In particular, the Complainant states that the Respondent is offering the contested domain name for sale on its home page. Together with the other iterations of the name "PAUL McCARTNEY" that have been registered as domain names by the principal of the Respondent, Mark Elsis, the Respondent is holding the contested domain name hostage in exchange for that which cannot be calculated with a price tag -- Paul McCartney's endorsement of Elsis' environmental causes. Toward this

end, the Complainant avers that Elsis has placed ever-changing conditions on the transfer of each of these domain names (including the contested domain name), such as demanding a meeting with Paul McCartney to urge him to read certain of Elsis' essays and demanding a personal signature by Paul McCartney on the NSI Registrant Name Change Form. Indeed, initially, Elsis suggested that "the fair market value" be paid for each of the domain names.

Second, the Complainant contends that the Respondent has engaged in a calculated attempt to foreclose the Complainant from using its own mark as a domain name, in contravention of paragraph 4(b)(ii) of the Policy. In support of its contention, the Complainant points to the fact that, apart from the contested domain name, Elsis has also registered three other iterations of the mark "PAUL MCCARTNEY", hence reflecting bad faith registration.

Further, the Complainant contends that the Respondent's actions in willfully misappropriating the name of the Complainant, in which the Complainant has exclusive rights, is nothing more than the speculation of the contested domain name with no specific use in mind other than to hold the name hostage for sale or other future profit, thus evincing bad faith use.

In addition, the Complainant contends that the Respondent, by curtailing the Complainant's and Paul McCartney's right to exploit the value of the name and trademark "PAUL McCARTNEY" on the Internet, is disrupting the business of both the Complainant, MPL, and Paul McCartney and will continue to do so as long as the Respondent retains the contested domain name.

Moreover, the Complainant contends that Respondent's bad faith is also evidenced by the fact that the Respondent has engaged in a pattern and practice of registering hundreds of domain names that are confusingly similar to names and marks of famous celebrities through which the Respondent trades on the value of those names and marks to further its own causes. Specifically, the Complainant contends that, as with Complainant here, these other legitimate mark owners are similarly being urged to read various of Elsis' essays on the environment as a condition for the transfer of each of the corresponding domain names to its rightful celebrity owner. The Complainant contends that, in the process, these rightful celebrity owners are also being prevented from utilizing their names, in the context of these domain names, on the Internet. Hence, the Complainant concludes that this pattern of conduct also constitutes bad faith registration and use in contravention of paragraph 4(b)(ii) of the Policy.

Finally, the Complainant contends that bad faith can also be inferred from Respondent's conduct as the Respondent was clearly on constructive, if not actual, notice of another's rights in the "PAUL McCARTNEY" mark and name. In that regard, the Complainant points to the panel decision in *J. Crew Int'l., Inc. v. crew.com*, D2000-0054 (WIPO Apr. 20, 2000) as delineating four factors that, in the context of speculative registration (as here), reflect abusive domain name registration: (1) the respondent has no demonstrable

plan to use the domain name for a bona fide purpose prior to registration or acquisition of the domain name; (2) the respondent had constructive or actual notice of another's rights in a trademark corresponding to the domain name prior to registration or acquisition of the domain name; (3) the respondent engages in a pattern of conduct involving speculative registration of domain names; and (4) the domain name registration prevents the trademark holder from having a domain name that corresponds to its registered mark. The Complainant contends that each of these factors is met by the facts here, hence warranting a finding of bad faith registration.

## B. Respondent

### 1. Confusing similarity/identity

The Respondent does not dispute that the contested domain name is either identical or confusingly similar to the McCartney marks.

In that regard, the Respondent admits that Elsis has intentionally registered numerous celebrity names as domain names, of which the contested domain name is one.

### 2. Legitimacy

The Respondent contends that its use of the contested domain name is legitimate inasmuch as it constitutes noncommercial and fair use without intent for commercial gain or to tarnish the "Paul McCartney" marks.

Specifically, the Respondent, while acknowledging, in the Response, that it registered domain names of over 365 "environmentally conscious celebrities", contends that it did so to establish fan sites for these celebrities through which the Respondent promotes the celebrity along with "loving environmental and humanitarian causes".

In that regard, in the Response, the Respondent argues that its "Paul McCartney" home page (copies of which appear in hard copy form in Annex F to the Complaint) is indeed a legitimate fan site and particularly one which supports celebrities known to have environmental and humanitarian interests.

In support of its view, the Respondent points to various elements of the home page, as indicative of a fan site, to wit: a large photo of McCartney; situated above the photo, a banner about the Respondent's petition to honor McCartney with an international holiday every October 9<sup>th</sup>; along a left column, a biography of McCartney and links to other websites (presumably established by the Respondent) for each of the other members of The Beatles; a photo gallery of McCartney; and news concerning both McCartney and The Beatles. The Respondent states that the home page also reflects a favorite song poll, tour dates and a message board where fans are allowed to express their greetings, opinions and read what others are saying. The home page, as the Panel notes, also

contains a link to the other 365 celebrity websites accessible through the celebrity-based domain names that the Respondent registered. Furthermore, the Respondent notes that the home page it created for McCartney also contains a public address where fans can send postal mail to McCartney.

Further, the Respondent states that should fans send postal mail to McCartney, that as part of their "own personal message" they "please ask him to read 'Rainforests' " -- which is an environmental essay authored by the Respondent.

Lastly, the Respondent states that it has not financially profited from any of the 365 celebrity websites it maintains (through the celebrity domain names it has registered) by stating, in its Response:

"We make no money from them (we did receive less then 400.00 total from our affiliates amazon.com and cdnow.com last year, this is 1.00 per site). We promote only the celebrity along with loving environmental and humanitarian causes. We of course have never tried to sell one, matter of fact, dozens of times we have been offered from hundreds to thousands of dollars for a celebrity domain name over the last 3 plus years, and we kindly declined."

Hence, the Respondent contends that its use of the contested domain name satisfies paragraph 4(c)(iii) of the Policy.

### 3. Bad Faith

The Respondent, particularly Elsis, contends that it neither registered nor uses the contested domain name in bad faith.

In that regard, the Respondent contends that its use of the contested domain name does not deceive Internet users into believing that McCartney is affiliated with, sponsors or endorses any of the Respondent's causes. In that regard, the Respondent states that all it is asking is that McCartney's fans "ask Paul to read Rainforests".

Furthermore, the Respondent contends that its use of the contested domain name could not reflect bad faith inasmuch as, while it requested McCartney to read "Rainforests", all the Respondent required, as of December 1999 as a condition for transferring the contested domain name to McCartney at no charge, was an NSI transfer agreement completed and personally signed by McCartney -- which thusfar McCartney has failed to provide. The Respondent states that it imposes the same conditions for a no-charge transfer, of any of the other celebrity domain names it registered, to the corresponding celebrity.

The Respondent also counters the Complainant's assertion that the Respondent's McCartney website is causing irreparable harm to McCartney's reputation and good will

inasmuch as that site, as Elsis states, "show[s] only the highest esteem I myself hold for Paul McCartney".

Hence, the Respondent contends that its actions do not reflect bad faith use and registration under paragraph 4(a)(iii) of the Policy.

## **FINDINGS**

Upon consideration of the record before it, the Panel makes the following findings.

The Complainant, MPL Communications, Limited is the exclusive owner of the rights to the common law and registered trademarks of Sir Paul McCartney ("McCartney"). McCartney, who formed MPL, is one of the most well-known and recognizable celebrities in the world. He is an internationally renowned musician and recording artist and was a member of The Beatles -- one of the most famous and successful musical recording and performing groups of all time.

A copy of the WHOIS registration record for the contested domain name appears in Annex K to the Complaint. As indicated on that record, the Respondent registered the contested domain name with NSI on July 14, 1999.

The Complainant currently owns the following valid and subsisting United States trademark registration on which this dispute is based. The Complainant has provided a copy, in Annex A to the Complaint, of the corresponding record for this mark in the web-accessible TARR database provided by the United States Patent and Trademark Office (PTO).

mark: PAUL McCARTNEY (block letters)

US registration 2,407,693; registered November 28, 2000

This trademark was registered for use in connection with:

"Musical sound recordings; pre-recorded phonograph records, compact discs, magnetic tapes, magnetic disc, video tapes and discs, all featuring music; and cinematographic films featuring vocal and musical performances" all in international class 9;

"Printed matter, namely, sheet music, music folios, concert and tour brochures; series of fiction books, series of non-fiction books on a variety of topics; series of books featuring art and series of books featuring poetry" all in international class 16;

"Articles of outerclothing and underclothing, namely, t-shirts, sweatshirts, waistcoats, jackets, dressing gowns, bathrobes, hats and caps" all in international class 25; and

"Entertainment services, namely, live musical performances; cultural

activities, namely live artistic and visual arts performances; recording studio services; production of music, television programs, motion picture films, music for motion picture films, and audio and video recordings" all in international class 41.

This mark claims priority based on United Kingdom trademark application 2174686, filed August 12, 1998, now registration 2174686 filed August 12, 1998 and expiring August 12, 2008 -- which the Complainant also owns. This mark covers various similar services, to those recited above, in class 41. The Complainant also owns United Kingdom trademark registration 2023922 filed June 14, 1995 and expiring June 14, 2005 for similar and other goods to those recited above in classes 9, 16 and 25. For simplicity, these marks will be collectively referred to as the "McCartney" marks.

McCartney enjoys an exceedingly valuable reputation and goodwill of enormous and inestimable value as a result of: (a) extensive sales and advertising of hundreds of musical compositions and recordings bearing his name; (b) fame and acclaim surrounding the musical services of The Beatles and of McCartney individually, and popularity of the motion pictures in which McCartney has appeared; (c) widespread public recognition of the name PAUL McCARTNEY and association of that name with McCartney; and (d) high quality and nature of McCartney's musical compositions, musical recordings and musical services. In 1997, and in recognition and in honor of his accomplishments, McCartney received a knighthood from Queen Elizabeth II. In 1999, McCartney was inducted into the Rock & Roll Hall of Fame as a solo artist. This tremendous goodwill, which has come to be associated with the unique and distinctive features of McCartney and his work, has accorded substantial monetary value to the exclusive right of the Complainant to exploit the name and trademark PAUL McCARTNEY.

Through McCartney's efforts and professional activities, the substantial use of his name, the hugely successful sales of goods and services bearing his name, and the world-wide publicity that he has received and continues to receive, the PAUL McCARTNEY name and trademark have become highly distinctive and, as such, have acquired considerable secondary meaning and are widely recognized throughout the United States and the world by millions of music fans and consumers alike. As a result, the McCartney name and trademark have become famous.

In that regard, over the course of the last four decades, McCartney's name has been prominently displayed on record albums, tape cassettes, compact discs and associated packaging and all manner of commercial advertisements, promotional signs and brochures. The McCartney name has also been featured in books, newspapers, magazine articles, radio and television news reports, entertainment programming, motion pictures and music videos and in numerous other ways since the 1960s.

The Respondent's website, "1WebAddress.com", is operated by an individual named Mr. Mark Elsis ("Elsis"), an environmentalist who is also in the business of selling domain names for profit. Elsis also operates LOVEARTH.net and a variety of other websites including "celebrity-websites.com" that specifically target celebrities. Elsis, either individually or d/b/a LOVEARTH.net, owns hundreds of celebrity domain names (among the thousands of other domain names he owns), including three other iterations of McCartney's name in addition to the contested domain name; namely: "paul-mccartney.com", "paul-mccartney.net" and "sirpaulmccartney.com" (for simplicity, all four McCartney-based domain names will be collectively referred to hereinbelow as the "PAUL McCARTNEY domain names").

In each case, Elsis desires, as his objective and as a condition to transfer of the PAUL McCARTNEY domain names to McCartney, the endorsement by McCartney of Elsis' environmental causes. Specifically, Elsis' rationale in registering the PAUL McCARTNEY domain names as well as hundreds of other celebrity names, including those listed above, is explained on Elsis' "celebrity-websites.com" home page, hard-copies of which appear in Annex D to the Complaint, which on page 1 thereof states:

"365 top level domain names have been developed into websites for most Earth Conscious Celebrities by the environmental group LOVEARTH. . . . [W]e ask that the celebrities . . . read and *understand* the most important study there is on Earth. Rainforests Biodiversity." (emphasis in original).

On page 2 of this home page, Mr. Elsis writes a letter addressed to "Dear Celebrity" which states, in relevant part, that LOVEARTH.net has registered many celebrity names:

"in order to raise the consciousness about the manmade ecological disaster of mass species extinctions that results from Rainforests Destruction. . . . It is our belief when these Eco Celebrities understand the true ramifications they will help bring this critical study to the forefront of human consciousness as fast as possible. This is something nearly impossible do to [sic] in today's corporate-owned media."

The Complainant states that the Respondent's website, "1WebAddress.com", is apparently devoted to the sale of domain names for profit. See various pages of this site provided in hard-copy form in Annex B to the Complaint. The Respondent lists thousands of domain names for sale. The Complainant has provided, in Annex C to the Complaint, a partial list of some of those domain names, including, even apart from the PAUL McCARTNEY domain names, various domain names that incorporate the names of other extremely well-known celebrities and performing musical groups, such as, e.g.: "ebobdylan.com", "ebruce springsteen.com", "eclint eastwood.com", "edavid bowie.com", "edianaross.com", "efranksinatra.com", "emelgibson.com", "ethebeatles.com", "etherollingstones.com", and "ewhitneyhouston.com".

As indicated in the web article which the Complainant has provided in hard-copy form in Annex E to the Complaint, Elsis and LOVEARTH.net are admittedly "trying to get to the top people throughout the world" in order to urge them to read Elsis' "Rainforests" essay, dealing with the destruction of the world's rainforests, in exchange for the transfer of their domain names. With respect to McCartney, the Complainant states that Elsis has attempted to obtain meetings and other forms of assurance from McCartney regarding support for Elsis' environmental causes in exchange for the transfer of all of his PAUL McCARTNEY domain names to McCartney.

One of the PAUL McCARTNEY domain names, specifically "paul-mccartney.com", when accessed, leads to a "Paul McCartney" home page on a website (which the Complainant states is unauthorized presumably from a lack of any permission either from it or McCartney to exploit the name and mark PAUL McCARTNEY granted to the Respondent) associated with Respondent's LOVEARTH website; hard copies of that home page are provided in Annex F to the Complaint.

The Complainant states that a glance at this home page makes it clear that this unauthorized website not only merely pays "lip service" to McCartney; but also that this site does not resemble a fan site. In that regard, the Complainant states the unauthorized Paul McCartney website is designed solely to accomplish Elsis' objective of promoting his environmental causes by inundating an unsuspecting McCartney fan with a variety of environmental literature totally unrelated to McCartney. In that regard, the "Paul McCartney" home page contains numerous links that redirect Internet users to various ones of Elsis' environmental websites, including the above-discussed celebrity website "celebrity-websites.com", "overpopulation.net"; "humane.net"; and "rainforest.net" which contains Elsis' "Rainforests" essay which he urges (and urges the public to urge) Complainant to read (hard copies of pages from these sites appear in Annexes G, H and I, respectively, to the Complaint).

The "Paul McCartney" home page contains links directing Internet viewers to Elsis' "gods-domains.com" home page -- a site devoted to the sale of domain names owned by Elsis. That site claims to have "[t]housands of the Highest Quality Domain Names For Sale" (hard copies of pages of this site appear in Annex J to the Complaint).

On or about July 14, 1999, the Respondent, without authorization or permission from Complainant, registered the contested domain name.

Shortly after the registration of the contested domain name (as well as others not the subject of the present proceeding), counsel for the Complainant held discussions with Elsis simultaneously on behalf of The Beatles and each of the former members of the group concerning the return of their domain names then held by Elsis. In his response to a cease and desist letter written by Mr. Howard Weller, Esq., counsel for the Complainants, on behalf of George Harrison and dated September 3, 1999 (a copy of this

letter appears in Annex B to the Response), the Respondent, by its letter dated September 16, 1999 offered to sell the domain names for "fair market value". A copy of the Respondent's letter appears in Annex L to the Complaint. The Respondent's letter suggests, in the alternative, that "a letter of endorsement and/or an audio statement on Rainforests" would accomplish the transfer of the domain names.

In addition, on May 19, 1998, Elsis registered the domain name "sir-paul-mccartney.com". This web address accessed a site of revolving pictures of McCartney and his late wife Linda; hard copies of pages from this site appear in Annex M to the Complaint. The LOVEARTH logo appeared at the bottom right corner of the website. Through this site, Internet users were able to link to a letter written by Elsis to McCartney. A copy of that letter also appears in Annex M to the Complaint. That particular letter admits that Elsis acquired numerous other PAUL McCARTNEY domain names, and urges McCartney to read about "Project Internet and consider our proposal." After discussing his Project Internet, Elsis then requests, in his letter to McCartney, that McCartney "[c]ontribute what you think is just, to create this loving sustainable Earth . . ." (emphasis in original).

LOVEARTH was founded in 1988 by Elsis and has been online since May 3, 1997 as "LOVEARTH.ORG". A copy of its environmental mission statement appears in Annex G to the Response. Elsis is the executive director of LOVEARTH.NET and the CEO of a for-profit corporation that sells only generic domain names, i.e., GODS-DOMAINS.COM, INC. Elsis states his policy, with reference to the web article appearing in Annex E to the Complaint, to be: "All celebrity sites with a full real name are only for that celebrity and are not for sale". Elsis states in the Response: "At no time have we ever tried to sell or sold a domain name celebrity's real name." Elsis further states in his response, with reference to the domain name "eGeorgeHarrison.com" which Elsis registered:

"About eGeorgeHarrison.com, it is true that this domain name was obtained under 1WebAddress.com and was listed for sale. We at first thought it would be ok and legal to sell eGeorgeHarrison.com to a George Harrison fan who would only put up a great website about George. In this new and ever changing domain dispute field of law we soon discovered that this might be illegal. Since then, we never tried to sell a celebrity name with a prefix. All of these eNames were only listed on 1WebAddress.com – which was a site we thought we were going to develop, but we didn't, as our tracking numbers will attest (exhibit G [to the Response])."

As to his actions in registering various celebrity domain names, Elsis further states in his Response:

"We decided to put all our energy into Gods-Domains.com Inc. where we sell only generic domain names. We never listed any celebrity name with or without a prefix there, or anywhere else. Instead, we started to use the eNames as fan

sites like eSting.com, eBlondie.com, e-REM.com, ePinkFloyd.com and others. Leaving them listed on this old 1WebAddress.com site was simply a very dumb oversight on our part, we were not acting in bad faith.

Don't let this one oversight on our part in any way make you think we ever tried to sell any real name .coms, we never have listed nor tried to sell one ever from Gods-Domains.com or anywhere else. By the way when eGeorgeHarrison.com (also **epaulmccartney.com** as the Respondent acknowledges) comes up for renewal we will put it in under Lovearth.net."

Elsis acknowledges having registered 365 celebrity domain names, by stating in the Response:

"Let me state right up front, I, Mark Elsis as Executive Director of Lovearth.net obtained the domain names of 365 plus Environmentally conscious celebrities to put up fan sites promoting each ecocelebrity, and if they so desired, to give them their .com domain name at no charge."

In order for any celebrity, where Elsis has registered a corresponding celebrity domain name, to obtain that name by voluntary transfer at no charge from Elsis, he requests that particular celebrity to read "Rainforests" but requires that celebrity to first complete and personally sign an NSI transfer agreement for that name.

## **DISCUSSION**

Paragraph 15(a) of the Rules for Uniform Domain Name Dispute Resolution Policy (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."

Paragraph 4(a) of the Policy requires that the 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 the Respondent is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;
- (2) the Respondent has no rights or legitimate interests in respect of the domain name;
- and
- (3) the domain name has been registered and is being used in bad faith.

### Identical and/or Confusingly Similar

This Panel can not conceive of any situation where confusion would not likely arise when and if the Respondent, or any third-party not affiliated with the Complainant to which the

Respondent were to transfer the contested domain name, were to start using that name in conjunction with goods and/or services similar to those provided by the McCartney under his name and marks.

Such confusion would undoubtedly cause Internet users intending to access the Complainant's website, but who reach a website through the contested domain name, to think that an affiliation of some sort exists between the Complainant and the Respondent or its third-party transferee, when, in fact, no such relationship would exist at all. See *American Home Products Corp. v. Malgioglio* D2000-1602 (WIPO Feb. 19, 2001); *Surface Protection Ind., Inc. v. The Webposters* D2000-1613 (WIPO Feb. 5, 2001); *Dollar Financial Group, Inc. v. VQM NET* FA 96101 (Nat. Arb. Forum Jan. 25, 2001); *eBAY Inc. v. G L Liadis Computing, Ltd.* D2000-1463 (WIPO Jan. 10, 2001); *Treeforms, Inc. v. Cayne Ind. Sales Corp.* FA 95856 (Nat. Arb. Forum Dec. 18, 2000) and *The Pep Boys Manny, Moe and Jack of California v. E-Commerce Today, Ltd.* AF-0145 (eResolution May 3, 2000).

In view of McCartney's substantial, long-running and highly publicized activities in the field of music and performing arts stretching back since the early 1960s, when The Beatles made their first debut -- of which he was a member, and continuing to the present, the name "Paul McCartney" and associated McCartney marks have become so distinctive, acquired such secondary meaning and hence fame to the point where a significant proportion of the world's population is likely to recognize the McCartney name and McCartney marks as signifying a very specific, unique, high quality and widely recognized source of, inter alia, music and entertainment services.

Even apart from the rights inherent in the US and UK trademark registrations, McCarthy owns common law rights in his name and marks of incalculable strength and value that predate, by close to four decades, the Respondent's registration in 1999 of the contested domain name; common law rights under which the Complainant can also base its claim under the Policy.

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 law, rights accrue in unregistered, so-called "common law", marks as a result of usage, though limited by geographic and product 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].

Numerous panels, 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 Nov. 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., *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 Nov. 20, 2000); *Mike Warner 2001 v. Mike Larson* FA 95746 (Nat. Arb. Forum Nov. 15, 2000); *CMG Worldwide Inc. v. Naughty Page* FA 95641 (Nat. Arb. Forum Nov. 8, 2000); *Home Properties v. SMSOnline* FA 95639 (Nat. Arb. Forum Nov. 2, 2000); and *Bridal Rings Company v. Yemenian* FA 95608 (Nat. Arb. Forum Oct. 26, 2000). Furthermore, the Panel in *United States Postal Service v. Consumer Inf. Org.* FA 95757 (Nat. Arb. Forum Nov. 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, Dec. 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 Dec. 18, 2000) and *David Taylor Cadillac/Buick Co. v. Spider Works, Ltd.* FA 95832 (Nat. Arb. Forum Nov. 30, 2000). Similarly, see *American Home Products Corp. v. Healthy Futures* D2000-0454 (WIPO Aug. 3, 2000); *Cho Yong Pil v. ImageLand, Inc.* D2000-0229 (WIPO May 10, 2000); *SeekAmerica Networks, Inc. v. Tariq Masood* D2000-0131 (WIPO Apr. 13, 2000); and *Bennett Coleman & Co. Ltd. v. Steven S Lalwani and Bennett Coleman & Co. Ltd. v. Long Distance Telephone Company* D2000-0014 and 2000-0015 (WIPO Mar. 11, 2000). Also, various panels have recognized that celebrities have common law trademark rights in their names. See, e.g., *Jagger v. Hammerton* FA 95261 (Nat. Arb. Forum Sept. 11, 2000); *Marino, Jr. v. Video Images Productions, Inc.* D2000-0598 (WIPO Aug. 2, 2000) and *Roberts v. Boyd* D2000-0210 (WIPO May 29, 2000).

Given this, the Panel believes that if a complainant (here a celebrity, but, in general, by no means limited thereto) puts forth an appropriate showing of prior, continuous use in a given product and territorial market of an unregistered mark or a tradename over a sufficiently long period to evidence the acquisition of common law trademark rights, then

those rights are susceptible of protection under paragraph 4(a) of the Policy to the same extent as are those emanating from registered marks.

The Complainant here has clearly and unquestionably made such a showing, with the territorial market being the entire United States as well as all other countries that recognize trademark rights based on prior use of unregistered marks. Compare *Bruce Springsteen v. Jeff Burgar* D2000-1532 (WIPO Jan. 25, 2001) where a majority of the panel there very surprisingly, and this Panel believes rather erroneously, apparently concluded that Bruce Springsteen did not have such rights (though curiously and diametrically, it then presumed that the name was protected under the Policy hence at least implicitly recognizing its status as a common law trademark) on the basis that no showing was made of "a recognition that the name 'Bruce Springsteen' has acquired any secondary meaning", i.e., that it be "associated with activities beyond the primary activities of Mr. Springsteen as a composer, performer and recorder of popular music." "This Panel believes that that conclusion is not only completely mistaken but also and, more importantly, its underlying test wholly lacks merit for the simple reason that Bruce Springsteen's well-known activities and fame over many years, again decades, in his field of endeavor, i.e., music, are the very activities that give rise to his common law trademark rights in the first place -- as they unquestionably do here for McCartney. No showing in any other field need be made or is required.

The mere inclusion of the prefix "e" in the contested domain name, which is commonly understood to mean electronic (as in the case of, e.g., "email"), is manifestly insufficient to adequately distinguish that name, i.e., "**epaulmccartney.com**", from the name "Paul McCartney" so as to dispel any likelihood of user confusion with the McCartney name and McCartney marks. In that regard, various panels have reached very similar conclusions in other cases. Specifically, in *Inter-IKEA Systems B. V. v. Technology Education Center* D2000-0522 (WIPO Aug. 7, 2000), a panel held that the addition of "e" by a respondent to a complainant's service mark "IKEA" was insufficient to distinguish the two and hence rendered the domain name ("e-ikea.com") confusingly similar to the mark. Similarly, see *Ty Inc. v. Parvin*, D2000-0688 (WIPO Nov. 9, 2000) as to the addition of "e" as a prefix to a trademark in forming a domain name being insufficient to prevent confusion. Also, consider *National Academy of Recording Arts & Sciences, Inc. v. Las Vegas Computer Journal* FA 95168 (Nat. Arb. Forum Aug. 18, 2000) where the addition of "cyber" by the respondent to the complainant's registered mark "Grammy" in forming the domain name "'cybergrammy.com' conveyed an impression that the complainant there had a presence in cyberspace and thus was likely to cause an observer to be confused, mislead or deceived when encountering 'cybergrammy.com'." Further, in *Park Place Entertainment Corp. v. Conille* FA 95492 (Nat. Arb. Forum Oct. 6, 2000) the panel found confusingly similarity as a result of the respondent prepending the term "casino" to the complainant's mark "parislasvegas" in forming the domain name "casinoparislavegas.com". For similar results, see *America Online, Inc. v. Anson Chan* D2001-0004 (WIPO Feb. 22, 2001), *America Online Inc. v. Neticq.com LTD* D2000-1606 (WIPO Feb. 12, 2001), *America Online, Inc. v.*

*Go2North.Com, Inc.* D2000-0810 (WIPO Dec. 15, 2000), and, in accord on a finding of confusing similarity, *America Online, Inc. v. Vadim Eremeev* D2001-0003 (WIPO Feb. 15, 2001).

Apart from the above, the Respondent admits to having registered celebrity-based domain names, in fact at least 365 different domain names at that. Hence, based on that admission, the Panel will infer that Respondent intentionally registered each of these domain names, including the contested domain name, having the prefix "e" primarily, if not solely, not only for its inherent potential to confuse Internet users who encounter that name but also, and for its potential, as leverage, to "extort" value from the celebrity, i.e., that the celebrity will accede to the conditions imposed by the Respondent, regardless of what those conditions are, in order to procure the name and eliminate any further user confusion. Thus, this provides an independent basis on which the Panel finds confusing similarity between the contested domain name and the McCartney marks.

As such, the Panel finds that sufficient similarity exists under paragraph 4(a)(i) of the Policy between the contested domain name and the McCartney marks.

#### Rights or Legitimate Interests

Based on its federal trademark registration (as well as its UK registrations), the Complainant has acquired exclusive rights to use its McCartney marks. Furthermore, by virtue of the registrations of these marks, as discussed above, the US PTO has implicitly recognized that the federal McCartney mark has acquired appropriate secondary meaning in the marketplace.

The Panel believes that the Respondent has yet to provide any basis that would legitimize any claim it has to the contested domain name. In fact, it is extremely unlikely that the Respondent can even make such a claim.

The simple reason is that the contested domain name includes the Complainant's "Paul McCartney" mark under which McCartney provides his services and has been doing so for close to 40 years. Neither the Complainant nor McCartney himself has ever authorized the Respondent to utilize the McCartney marks, nor does the Complainant (or McCartney) have any relationship or association whatsoever with the Respondent. Hence, any use to which the Respondent were to put the McCartney marks, in connection with the goods or services set forth in the Complainant's registrations or those related thereto would directly violate the exclusive trademark rights now residing in the Complainant, both in terms of its federal and UK rights as well as those at common law. See, e.g., *America Online, Inc. v. Xianfeng Fu* D2000-1374 (WIPO Dec. 11, 2000), and *Treeforms, Inc. v. Cayne Ind. Sales Corp.*, cited *supra*. For similar holdings specifically in connection with registration of celebrity-based domain names, see *Roberts v. Boyd*, cited *supra*.

While the Respondent claims its use of the contested domain name is solely for a fan site and particularly for McCartney whom the Respondent acknowledges is quite conscious of environmental and humanitarian causes, the Panel categorically rejects such a simplistic view.

The Panel views the purported fan site as a cleverly designed platform through which the Respondent furthers its own environmental interests by leveraging off and, in effect, misappropriating the widespread recognition and fame of the corresponding celebrity, here being Paul McCartney, to the Respondent's benefit by falsely suggesting, to Internet site visitors, an affiliation, sponsorship or connection between the celebrity and the specific causes advocated by the Respondent. If the Respondent established and were hosting a bona fide fan site (of which the present site is clearly not), then, in this Panel's mind, that site would solely be devoted to providing or exchanging information to and/or among Internet site visitors about the corresponding celebrity but, in all likelihood, would be devoid of information reflective of any cause advocated by the site operator which was not personally and specifically endorsed by that celebrity -- with such an endorsement clearly appearing on the site. The record before this Panel, and specifically the hard copies of the web pages on the Respondent's McCartney site, contains absolutely no endorsement by McCartney of any specific environmental cause advocated by the Respondent or Elsis, or of Elsis' "Rainforests" essay.

While the Respondent's use of the contested "**epaulmccartney.com**" domain name may facially appear to be noncommercial -- as the Respondent urges, i.e., in the sense of not being used in some manner to aid the Respondent in directly generating monetary revenue, the Respondent's use of the McCartney name in the contested domain name implicitly suggests, though on an entirely unauthorized basis, an affiliation, sponsorship or relationship of some sort between the Respondent's environmental causes and McCartney -- when no such connection exists at all. This use, if permitted to occur over time, will clearly weaken and tarnish the McCartney marks. Hence, this use does not constitute "legitimate noncommercial or fair use" of the contested domain name within the meaning of paragraph 4(c)(iii) of the Policy.

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

#### Registration and Use in Bad Faith

The Panel finds that the Respondent intentionally chose the contested domain name to benefit from its near identical resemblance and ensuing user confusion with respect to the Complainant's McCartney marks and continues to use that name to further that purpose. Thus, the Panel finds that the Respondent registered and uses the contested domain name in bad faith.

The Respondent was unquestionably aware, and so admits, that it was well aware of the

Complainant's name and mark "Paul McCartney" and in spite of that knowledge registered the contested domain name in an effort to avail itself, to its own benefit, of the substantial goodwill and extensive recognition in that name and mark.

A celebrity, having rights resulting through registration and/or common law, is entitled to the exclusive control and exploitation of his(her) mark in connection with the goods and services with which that celebrity is associated and provides (either directly or, e.g., via license) under that mark. The value which the Respondent received here was an implicit association, and thereby validation if not approval, by the celebrity with the Respondent's causes. While this value can not be readily quantified, there is no question, that the more widely known the celebrity is -- as is certainly the case with McCartney, the more valuable that association becomes to the party, and hence the stronger the validation becomes, to the party, here the Respondent, attempting to create it.

Clearly, having the endorsement of McCartney, even by implication, would be of considerable and inestimable value to the Respondent in furthering its environmental causes. In fact, the mere act of publicly requesting McCartney to read the Respondent's "Rainforests" essay and McCartney's public response of having considered the request -- regardless of whether he actually read the essay or not -- as a condition to retrieve the contested domain name would likely suggest to an Internet user some tacit endorsement by McCartney of the cause. Such an endorsement, particularly made by a celebrity of the stature of McCartney, would yield enormous benefit to the Respondent Elsis.

While paragraph 4(b)(i) of the Policy requires that a respondent register or acquire a domain name for the purpose of selling, renting or otherwise transferring it for "valuable consideration" in excess of the document out-of-pocket costs of registration, the Policy does not limit this consideration strictly to monetary form. This Panel believes that consideration can take on many different forms, only one of which is monetary, with the test being whether the consideration demanded by a respondent has value to that particular respondent beyond the direct out-of-pocket costs to that respondent of registering the domain name. See *Metallica v. Schneider* FA 95636 (Nat. Arb. Forum Oct. 18, 2000) where the panel held, with respect to a respondent registering a celebrity domain name and then offering to transfer it in exchange for various actions taken by the respondent: "The Respondent also registered and used the domain name in order to extract valuable concessions from the Complainant. ...Policy ¶ 4(b)(i) was broadly construed as to provide relief when the infringing domain name holder seeks transfer of the domain name for something valuable other than money. The Respondent offered to transfer the domain name in exchange for a meeting with the Complainant, phone calls from the Complainant, and an interview with the Complainant. Given the Complainant's fame, these encounters with the Complainant would be of great value -- certainly a value in excess of the minimal costs associated with registering and maintaining the domain name 'metallica.org'."

Substantial value, as is unquestionably the case here, can arise from a celebrity

endorsement -- of the kind the Respondent demanded from McCartney -- that overwhelmingly dwarfs the incidental dollar costs of registering a domain name. The value, to the extent it can be quantified, is proportionally if not exponentially related to the fame of the celebrity. In fact, given this situation, one can simply ask whether in the absence of any such value to a respondent, would the respondent have registered the celebrity domain name in the first place. This Panel believes that in each such instance -- and there are at least 365 of them involving this Respondent, the answer would unquestionably be no.

The Panel sees no distinction between non-monetary and monetary consideration, else if it were to restrict application of this paragraph of the Policy to the former, then doing so would create a large loophole through which unscrupulous respondents could seek shelter by merely changing the form of the consideration they sought -- a result which this Panel does not countenance and will not permit to occur.

Not the slightest doubt could possibly exist that Paul McCartney does not possess such a substantial level of international fame and name recognition that his endorsement, even if only tacit, would be of unparalleled yet inestimable value -- clearly substantially in excess of the direct costs of registration. It is just this value which the Respondent intentionally sought by registering the contested domain name and then demanding, as a condition of its transfer to the Complainant, that McCartney undertake specific acts.

No obligation is imposed on a trademark owner to do any act, support any activity or endorse or affirm any cause for any respondent in order to retrieve a domain name from that respondent that should rightfully belong to that owner. To require otherwise would permit a respondent to effectively extort action of some nature from the celebrity -- a result clearly in conflict with the Policy. While the celebrity, in his(her) sole discretion, may decide, for whatever reason (s)he has, to acquiesce to or reach a negotiated settlement with a respondent in exchange for transfer of a corresponding domain name, the decision to do so lies solely with the celebrity. That respondent has absolutely no power, nor does the Policy permit any, to compel the celebrity to do any act -- regardless of how trivial that act might appear to be -- to obtain that domain name.

Consequently, the Panel finds that the Respondent's actions here signify bad faith use and registration under paragraph 4(b)(i) of the Policy.

Furthermore, the Respondent has not just registered the contested domain name, but by its own admission, at least 365 celebrity-based domain names involving the names of many other celebrities, other than McCartney. This repetitive concerted action reflects the Respondent's resolve to further its own personal cause by using each of those domain names as leverage for demanding, in effect "extorting", valuable consideration, identical to that it sought from McCartney, from as many celebrities as possible as a condition of transferring each of their domain names back to its rightful owner. If the celebrity refused to act as the Respondent demanded, the Respondent indicated that it would

simply renew the registration and presumably continue to utilize the domain name as it had been doing (as described above with respect to McCartney). Hence, by retaining that name, the respondent would effectively prevent the celebrity from gaining that name and, under paragraph 4(b)(ii) of the Policy reflecting its mark in that name. In that regard, for similar conduct, in the context of a respondent using a domain name as leverage in attempting to extort benefits and privileges from a complainant, being viewed as bad faith, though under paragraph 4(b)(i) of the Policy, see *www. ValidSites.com Inc. v. English and Nanasca* FA 96177 (Nat. Arb. Forum Jan. 16, 2001).

Moreover, paragraph 4(b) of the Policy lists various criteria, each of which is indicative of bad faith use and registration under paragraph 4(a)(iii) of the Policy. This list is not exhaustive. Though the Panel finds that the Respondent's efforts violate paragraph 4(b)(i) and (ii) of the Policy, the Panel also finds that, even apart from these specific criteria, the Respondent's conduct here amounts to bad faith use and registration under paragraph 4(a)(iii). Specifically, the Respondent's conduct of engaging in a pattern of registering, e.g., celebrity-based, domain names that it knows or should know incorporate and infringe well known trademarks of others with a goal of forcing the corresponding trademark owners or celebrities to affirmatively act in a certain manner beneficial to the Respondent in exchange for the Respondent transferring the corresponding domain names to their rightful owners, itself constitutes bad faith use and registration under paragraph 4(a)(iii). See *Cabela's Inc. v. Cupcake Patrol* FA 95080 (Nat. Arb. Forum Aug. 29, 2000).

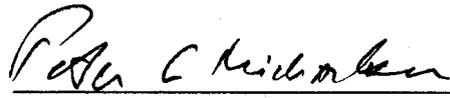
Hence, the Panel finds that the Complainant has shown a sufficient basis to establish bad faith registration and use of the contested domain name under paragraph 4(a)(iii) of the Policy.

Thus, the Panel concludes that the Complainant has provided sufficient proof of its allegations to establish a prima facie case under paragraph 4(a) of the Policy upon which the relief it now seeks can be granted.

## **DECISION**

In accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the relief sought by the Complainant is hereby **granted**.

The contested domain name, specifically "**epaulmccartney.com**", is ordered transferred to the Complainant.



PETER L. MICHAELSON, ESQ.

ARBITRATOR

Dated: June 4, 2001