



## **WIPO Arbitration and Mediation Center**

### **ADMINISTRATIVE PANEL DECISION**

**Peter Frampton v. Frampton Enterprises, Inc.**

**Case No. D2002-0141**

#### **1. The Parties**

The Complainant is Peter Frampton, a resident of the State of Ohio, United States of America.

The Respondent is Frampton Enterprises at 13217 114th Street, Largo, Florida 33778-1928, United States of America.

#### **2. The Domain Name and Registrar**

The Contested Domain Name is <peterframpton.com>.

The Registrar is Network Solutions, Inc. (NSI), located at 505 Huntmar Drive, Herndon, Virginia 20170, United States of America.

#### **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 ICANN 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 March 5, 2002, and in hard-copy form on February 12, 2002 with Annexes A-I and the appropriate payment.

The Complainant's attorney stated that on February 7, 2002, he served a copy of the Complaint itself together with a copy of the cover sheet, on the Respondent by certified, first class mail.

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 person panel.

After receiving the original Complaint, the Center, in accordance with paragraph 5 of the Supplemental Rules, determined whether the Complaint fully complied with the formal requirements of the Rules and the Supplemental Rules. In that regard, on February 15, 2002, the Center requested confirmation from the Registrar of information set forth in the Complaint relative to the contested 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 ICANN Policy applies to the contested domain name, (b) the current status of that domain name, and (c) 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.

On February 21, 2002, the Registrar provided its Response to the Center through which the Registrar provided contact information pertinent to the contested domain name from its WHOIS database, confirmed that NSI is the registrar of that name, stated that the language of the registration agreement is English, and stated that the domain name was then in an "active" status. The Registrar also informed the Center that the Respondent, through its registration agreement, 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 of the domain name.

On March 5, 2002, 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, both in e-mail and hard-copy form, to the Respondent (with the latter method forwarding a copy of all the annexes as well). 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 March 5, 2002, under paragraph 4(c) of the ICANN Policy, this administrative proceeding is deemed to have commenced on that date.

Having reviewed the Complaint 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 March 25, 2002 to file its Response with the Center and serve a copy of the Response on the Complainant.

The Respondent submitted its Response to the Center, via e-mail, on March 11, 2002, the receipt of which the Center acknowledged to the parties in an e-mail letter dated March 19, 2002.

Accordingly, pursuant to the Rules and Supplemental Rules, by e-mail letter dated March 26, 2002, the Center contacted the undersigned, Mr. Peter L. Michaelson, Esq., requesting his service as a sole panelist for this dispute. Subsequently, on that date, 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 March 27, 2002, 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 April 10, 2002.

On April 1, 2002, the Respondent directly sent the Panel, via e-mail, an additional submission, which upon its receipt the Panel so notified and submitted a copy thereof to the Center. In an e-mail dated April 4, 2002, the Center reminded the parties of Paragraph 8 of the Rules which prohibits any party from engaging in any unilateral communication with the Panel.

Due to various serious time conflicts which constitute extraordinary circumstances, the Panel extended the due date of its decision one week to April 17, 2002, and, by an e-mail message dated April 9, 2002, the Center so notified the parties.

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

The language of this proceeding is English.

#### **4. Factual Background**

A copy of the WHOIS registration record for the contested domain name appears in Annex A to the Complaint. As indicated on this record, the Respondent registered this name with NSI on July 25, 1997.

The Complainant filed an application on August 9, 2001 with the United States Patent and Trademark Office (PTO) on August 9, 2001 to register the mark "PETER FRAMPTON". The Panel takes judicial notice, from the web-accessible Trademark Electronic Search System (TESS) provided by the PTO, that this application, assigned serial number 76/299,170, was subsequently registered, as follows:

PETER FRAMPTON (block letters)  
US registration 2,534,297; registered January 29, 2002

This mark was registered for use in connection with: "Entertainment services, namely live performances by a musical performer; audio recordings and production; and recording studio services" in international class 41. This mark claims first use and first use in inter-state commerce dates of December 31, 1971.

For more than thirty years, the Complainant has been internationally known as one of the most successful and critically acclaimed artists in popular music. Since 1967, the Complainant has made continuous use of the mark "PETER FRAMPTON" in commerce in connection with numerous musical recordings, including eighteen solo albums and at least seven albums recorded under the names "The Herd" and "Humble Pie," released by major record labels. This is indicated in a copy of "Discography", which appears in Annex B to the Complaint, and was provided from the Complainant's

web site at <frampton.com>. The Complainant's 1976 album "Frampton Comes Alive" has sold over sixteen million copies since its release, making it the world's best-selling live album. This is indicated in a copy of the Complainant's biography which appears, in the Complaint, as Annex C. In 1976, *Rolling Stone* magazine named the Complainant "Artist of the Year." *Id.* During his career, the Complainant has recorded and collaborated with such noted artists as Mick Jagger, Stevie Wonder, and David Bowie. *Id.*

In addition to his recordings, the Complainant has toured extensively throughout virtually the entire world including North America, South America, Europe, Asia and Australia to perform live concerts and promote his musical recordings. *Id.* The Complainant just completed a North American tour that included thirty-five dates in amphitheaters throughout the United States. Annex D to the Complaint contains a copy of the Complainant's "Live Dates" for July-August, 2001 -- provided from the Complainant's web site and accessible at specifically <www.frampton.com/live.html>.

The Complainant has also used the mark "PETER FRAMPTON" in connection with the promotion and sale of videos, CD-ROMs, DVDs, concert tickets for live performances, advertising and promotion, clothing, including, but not limited to, t-shirts, baseball caps, as well as musical equipment, and other merchandise. Examples of the Complainant's use of the mark "PETER FRAMPTON" in connection with various goods offered by the Complainant appear in Annex E to the Complaint. The Complainant has continuously and without interruption used the mark "PETER FRAMPTON" throughout the world for more than thirty years.

On March 15, 2001, the Complainant, through his counsel, sent a letter to the Respondent demanding that the Respondent cease and desist from using the contested domain name and requesting that the Respondent transfer that name to the Complainant. The Complainant has provided a copy of this letter in Annex H to the Complaint.

In response to the Complainant's letter, the Respondent sent a letter dated March 23, 2001 to the Complainant's counsel in which the Respondent indicated that he would only transfer the contested domain name to the Complainant on the condition that the Complainant agree to participate in a joint business proposition with the Respondent. The Complaint contains a copy of the Respondent's letter in Annex I.

Specifically, in its March 23, 2001 letter, the Respondent suggested: "My solution is that we work together since we are both Framptons with Equal Rights?" (sic). The Respondent further proposed that the Complainant transfer the Complainant's <frampton.com> web site along with "reasonable" consideration, in addition to "creating a mutual agreement for marketing rights/web site content approval between both of us marketed on my new: Frampton.com/ web site." *Id.* The Respondent continued, in its letter, by asking "why can't we produce a Frampton alliance by working together and creating an unlimited business opportunity for both of us. We do look a lot like we could be related." *Id.* The Respondent's president, Lyle Frampton, concluded his letter by stating "who is better to market Peter Frampton merchandise than another Frampton[?]"

A hard-copy print-out of the home page of the Respondent's web site as of February 26, 2001 appears in Annex F to the Complaint. That home page contained the following text:

Frampton Enterprises, Inc.

Entertainment!/Income Opportunities!/Shopping!  
@ WWW.PETERFRAMPTON.COM  
A Monster Business Development Opportunity!  
Unlimited Income Potential!  
“A New Life” You Must See This!  
FRAMPTON4U@AOL.COM”>  
Please! Send: Your Full Name/Address/ Phone #/ Your Resume in Text Only!  
Then Call (ASAP)  
Mr. Frampton  
(727)584-0395  
For Your Lifetime Career Opportunity Interview!  
Now Hiring for Key Corporate Regional / Filed Manager Positions in USA.

The Respondent's home page also contained two stylized "PETER FRAMPTON" logos (the stylized “Peter Frampton” logo and the “Frampton On-Line Shopping” logo) from the Complainant's web site but without the Complainant's permission.

A “Frampton On-Line Shopping” banner on the Respondent's home page directed users to a portion of the Complainant's web site on which the Complainant offers merchandise for sale.

Shortly after Complainant's Counsel first contacted the Respondent, the Respondent modified its web site and removed the logos that resembled those on the Complainant's web site. In that regard, the Complainant has provided in, Annex G to the Complaint, a copy of the Respondent's home page as it appeared on July 31, 2001.

The Respondent's web site, as shown in Annex F, encouraged Internet users to contact “Mr. Frampton” at a certain telephone number linked to the Respondent, or to contact the Respondent via e-mail using the e-mail address “Frampton4U@aol.com.”

The Respondent has placed links from the Respondent's web site to sites where the Complainant's musical recordings and videos can be purchased, along with text that reads “Peter Frampton Music / Videos!”. Further, the Respondent placed numerous links on its web site to music-related vendors, including “Collector's Choice Music,” and “www.Route101Guitars.com.” *Id.*

The Respondent also included on its web site a figure playing guitar, which is the instrument played by the Complainant. In that regard, see Annexes E and F to the Complaint.

## **5. Parties' Contentions**

### **A. Complainant**

#### **i. Similarity**

The Complainant contends that the contested domain name is identical to the Complainant's mark “PETER FRAMPTON”.

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

#### **ii. Legitimacy**

The Complainant contends that, for several reasons, that the Respondent has no rights or legitimate interests in the contested domain name pursuant to paragraph 4(a)(ii) of the Policy.

First, the Complainant avers that the Respondent has not, at any time, used or made any demonstrable preparations to use the contested domain name in connection with a bona fide offering of goods or services. The Complainant contends that the Respondent has used the domain name, which includes the Complainant's name, to attract Internet users to the Respondent's web site for the purpose of promoting goods and services unrelated to those offered by the Complainant, hence not constituting a bona fide offering of goods or services (citing to *Madonna Ciccone, p/k/a Madonna v. Dan Parisi and Madonna.com* WIPO Case No. D2000-0847, October 12, 2000).

Second, the Complainant avers that the Respondent has never been known, commonly or otherwise, by the contested domain name or any name corresponding to it. In that regard, the Complainant states that the Respondent's name is "Frampton Enterprises, Inc". The Complainant also states that the Respondent's president claims that his full name is "Lyle Peter Frampton", but the Respondent has presented no evidence of the truth of that claim. Lastly, the Complainant contends that the Respondent or its president has never been commonly known by the name "Peter Frampton."

Thus, the Complainant concludes that the Respondent has no rights or legitimate interests in the contested domain name pursuant to paragraph 4(a)(ii) of the Policy.

### **iii. Bad Faith**

The Complainant contends that, also for various reasons, the Respondent has registered and is now using the contested domain name in bad faith.

First, the Complainant contends that by registering and using <peterframpton.com>, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to the Respondent's web site, through which the Respondent sells goods and services, by creating a likelihood of confusion with the Complainant's mark.

Specifically, view of the information on the Respondent's home page indicating Respondent's offerings in the musical field, a field with which the Complainant has long been associated for over thirty years, the Complainant contends that the Respondent registered the contested domain name for the purpose of promoting its own business (i.e., a "Monster Business Development Opportunity") and related employment opportunities at the expense of the Complainant's reputation.

In that regard, the Complainant contends that not only did the Respondent register the contested domain name, containing the Complainant's mark, for the purpose of promoting its own "business development opportunities," but also the Respondent copied two stylized "PETER FRAMPTON" logos from the Complainant's web site, and posted such logos onto Respondent's own web site without the Complainant's permission, hence violating the Complainant's trademark and copyright interests.

Further, the Complainant contends that the Respondent, by using the "Frampton On-Line Shopping" banner to divert users to a portion of the Complainant's web site on which Complainant offers merchandise for sale, strengthens an impression in the mind of Internet users that the Complainant was somehow affiliated with or endorsed the Respondent's activities when that is not the case in fact.

Additionally, the Complainant also contends that the Respondent intentionally used ambiguous references to the Complainant's "PETER FRAMPTON" mark for the purpose of confusing Internet users into thinking that the Complainant was somehow affiliated with the Respondent's web site. As examples, the Complainant points to the Respondent's web site encouraging Internet users to contact "Mr. Frampton" at a certain telephone number linked to Respondent, or to contact Respondent via e-mail using the e-mail address "Frampton4U@aol.com." The Complainant notes that nowhere on the Respondent's web site did the Respondent make any effort to advise Internet users that the Respondent's site was not affiliated with the Complainant. Given this, the Complainant contends, that to the contrary, the use of these ambiguous references to the "PETER FRAMPTON" mark was specifically intended by the Respondent to create the impression that the Complainant was somehow affiliated with the Respondent's site.

Further, the Complainant contends that the Respondent, in placing links from its web site to sites where Complainant's musical recordings and videos can be purchased, along with text that reads "Peter Frampton Music / Videos!", is thereby creating an appearance that the Complainant is somehow affiliated with, or endorses, the Respondent's activities. In that regard, the Complainant points to numerous links on the Respondent's web site to music-related vendors, including "Collector's Choice Music" and <www.Route101Guitars.com>, and to a figure playing guitar appearing on the Respondent's web site which is the instrument played by Complainant, and with respect to which Complainant is most associated in the public.

Given this, the Complainant concludes that the numerous references and links to music related sites by the Respondent constitutes evidence of Respondent's bad faith. In doing so, the Complainant cites to *Helen Folasade Adu p/k/a Sade v. Quantum Computer Services, Inc.* WIPO Case No. D2000-0794, September 26, 2000 in which a panel found that it was "inconsistent" for a respondent to have associated a domain name with a music category on a respondent's web site and to simultaneously deny that respondent was representing a connection between that domain name and the complainant, a famous singer.

Lastly, the Complainant contends that, in view of the demands which the Respondent makes for the Complainant to engage in a "joint business proposition" in order to secure transfer of the contested domain name, the Respondent intentionally registered that name to secure consideration beyond the Respondent's out-of-pocket costs directly related to that name. Thus, the Complainant concludes that the Respondent registered the contested domain name in bad faith, and specifically in contravention of paragraph 4(b)(i) of the Policy.

Therefore, the Complainant concludes that the Respondent's conduct in registering and using the contested domain name constitutes bad faith registration and use under paragraph 4(a)(iii) of the Policy.

## **B. Respondent**

### **i. Response**

The Panel views the following, from the Response, as being the Respondent's salient contentions.

First, the Respondent states that its president is named "Lyle Peter Frampton" and has used that name for all his life (he is 61+ years of age) and that name appears on his

legal documents. Moreover, he states that mail is regularly delivered to his residence addressed to "Lyle Peter Frampton". Further, he states that he is commonly referred to as "Mr. Frampton", "Peter Frampton" or just "Peter". In addition, he states that since 1962, the Respondent, Frampton Enterprises, Inc., has been and continues to be a licensed sales marketing development company.

Further, he states that: "The web site name of peterframpton.com/ has never been offered for sale to anyone at anytime for any reason & is a private domain name meant for the benefit of 3 children & grand children. It is intended to remain a peterframpton family domain name forever! "

As to the merchandise offered through its web site, the Respondent contends: "Only the absolute finest & largest sales marketing companies in the world & major brand name merchandise companies have chosen the peterframpton.com/ site & are listed in alphabetic order as a registered affiliate business sales associate mutual agreement. They all have been marketing on this site for over five years."

The Respondent also states that, as to the Complainant: "The Singer Peter Frampton, Personal products & sales merchandise has never appeared & does not appear for sale with any of the other sales companies represented on this site during all five years." Given this, the Complainant takes the position that the contested domain name merely identifies the Respondent's president, as the web site owner, and does not depend on or have anything to do with the Complainant for any "support or gain and no recognition (other than similarity by birth) has no other interest in him."

## **ii. Respondent's additional submission dated April 1, 2002**

In its additional submission of April 1, 2002, the Respondent reiterates its contention that "Lyle Peter Frampton" is the name of its president and has been his name since his birth now over 61 years ago.

The Respondent also questions why the Complainant is making this claim for the contested domain name some five years after the Complainant registered a domain name, different from the contested domain name, for his own web site. Further, the Respondent questions why the Complainant is now claiming "his name is more important than others with a similar name & refuses to recognize anyone else with human legal rights on the internet even though he was the last one on record to file?"

## **6. Discussion and Findings**

### **i. Similarity**

The Panel finds that confusion would likely arise as a result of the Respondents' current use of the contested domain name. Further, the Panel can conceive of no situation where confusion would not likely arise when and if any third-party not affiliated with the Complainant, to which the Respondent were to transfer the contested domain name, were to use that name with a web site offering goods identical and/or similar to those provided by the Complainant under his name and mark "PETER FRAMPTON".

Such confusion would undoubtedly cause Internet users intending to access the Complainant's web site, but who reach a web site 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, e.g., *MPL Communications, Limited and MPL Communications, Inc. v. LOVEARTH.net* FA 97086, Nat. Arb. Forum, June 4, 2001; *MPL Communications, Limited et al v. IWebAddress.com*, FA 97092, Nat. Arb. Forum, June 4, 2001; *American Home Products Corp. v. Malgioglio*, WIPO Case No. D2000-1602, February 19, 2001; *Surface Protection Indus., Inc. v. The Webposters*, WIPO Case No. D2000-1613, February 5, 2001; *Dollar Financial Group, Inc. v. VQM NET* FA 96101, Nat. Arb. Forum, January 25, 2001; *eBAY Inc. v. 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; and *The Pep Boys Manny, Moe and Jack of California v. E-Commerce Today, Ltd.*, AF-0145 , eResolution, May 3, 2000.

In view of the Complainant's substantial, long-running and publicized activities in the field of music and performing arts stretching back since 1967 and continuing to the present, the name "Peter Frampton" 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 that name as signifying a specific, unique, and widely recognized source of, inter alia, music and entertainment services. See, the *MPL Communications* FA 97086 and FA 97092 decisions, cited *supra*.

Even apart from the rights inherent in his US trademark registration, the Complainant owns common law rights in his name and mark that predate, by three decades, the Respondent's registration in 1997 of the contested domain name: common law rights under which the Complainant can 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 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., *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. Naughtya 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* 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 Nos. D2000-0014 and 2000-0015, March 11, 2000.

Also, of particular importance here, 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, September 11, 2000; *Marino, Jr. v. Video Images Productions, Inc.* WIPO Case No. D2000-0598, August 2, 2000 and *Roberts v. Boyd* WIPO Case No. D2000-0210, May 29, 2000.

Given this, the Panel believes that if a complainant (here certainly being 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. See the *MPL Communications* FA 97086 and FA 97092 decisions, cited *supra*.

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*, WIPO Case No. D2000-1532, January 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 the Complainant. No showing in any other field need be made or is required. See the *MPL Communications* FA 97086 and FA 97092 decisions, cited *supra*.

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

## ii. Illegitimacy

Based on its federal trademark registration as well as its common law rights, the Complainant has acquired exclusive rights to use its "PETER FRAMPTON" mark in conjunction with the goods and services which the Complainant has been providing under that mark since 1967 for more than three decades. Furthermore, by virtue of having registered this mark, the US PTO has implicitly recognized that the "PETER FRAMPTON" 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 "PETER FRAMPTON" mark under which the Complainant provides his services and has been doing so for over 30 years. The Complainant has never authorized the Respondent to utilize the "PETER FRAMPTON" mark in conjunction with the specific goods and services which the Complainant provides under that mark, nor does the Complainant have any relationship or association whatsoever with the Respondent.

Hence, any use to which the Respondent were to put the "PETER FRAMPTON" mark, in connection with the goods or services presently provided by the Complainant as well as those set forth in the Complainant's registration would directly violate the exclusive trademark rights now residing in the Complainant, both in terms of its common law and federal. See, e.g., the *MPL Communications* FA 97086 and FA 97092 decisions, cited *supra*; *America Online, Inc. v. Xianfeng Fu* WIPO Case No. D2000-1374, December 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*.

It is eminently clear to this Panel that the Respondent, by currently using the contested domain name which identically incorporates the Complainant's "PETER FRAMPTON" mark, to sell items in the exact same field of endeavor as the Complainant, i.e., music-related, is intentionally seeking to exploit user confusion by diverting Internet users away from the Complainant's site to the Respondents' web site for the latter's own benefit, i.e., by capitalizing on the celebrity reputation and fame of the Complainant's name, a name which the Respondent coincidentally shares with the Complainant, to cause user confusion. Such use, which at its heart relies on exploiting user confusion, can not and does not constitute bona fide commercial use, sufficient to legitimize any rights and interests the Respondent might have in the contested domain name. In that regard, see *Madonna Ciccone p/k/a Madonna v. Dan Parisi and Madonna.com*, cited *supra* ("use which intentionally trades on the fame of another can not constitute a 'bona fide' offering of goods or services.").

While the Panel recognizes that any individual has a right to use his(her) name in connection with a business, that right is not unfettered; instead, it is circumscribed by the prior trademark rights of others who use that name in connection with specific goods and services, as is certainly the case here.

A party alleging, under paragraph 4(c)(ii), as the Respondent purports to do here, that it is commonly known by a particular name, sufficient to show legitimate rights and interest in a domain name that contains that particular personal name (e.g. a surname), must provide adequate extrinsic proof that a corresponding group of consumers, e.g., Internet users, who are likely to access that party's web site, associates that domain name with that party rather than with the trademark owner, i.e., that domain name possesses requisite secondary meaning, or at least that party has used or is using that name sufficiently broadly such a panel can infer that such meaning exists. See *Dell Computer Corporation v. Logo Excellence* WIPO Case No. D2001-0361, May 7, 2001.

In balancing the tension between an individual's right to use his(her) personal name in connection with a business vis-à-vis the interest of a trademark owner having a mark in the same name, the Panel finds that analysis set forth by the US Court of Appeals for the Ninth Circuit in *Avery Dennison Corp. v. Sumpton* 51 U.S.P.Q.2d 1801, 1809, (9<sup>th</sup> Cir. 1999), (thought there in the context of assessing distinctiveness for purposes of trademark dilution) not only pertinent to the present facts before this Panel but also highly instructive:

“No dispute exists that 'Avery' and 'Dennison' are common surnames according to evidence presented by Appellants, respectively the 775th and 1768th most common in the United States. A long-standing principle of trademark law is the right of a person to use his or her own name in connection with a business. See *Howe Scale Co. v. Wyckoff, Seamans & Benedict*, 198 U.S. 118, 140 (1905). This principle was incorporated into the Lanham Act, which states that a mark that is 'primarily merely a surname' is not protectable unless it acquires secondary meaning. 15 U.S.C. Section 1052(e)(4), (f) (1994); *Abraham Zion Corp. v. Lebow*, 761 F.2d 93, 104 [226 USPQ 104] (2d Cir. 1985); see *L.E. Waterman Co. v. Modern Pen Co.*, 235 U.S. 88, 94 (1914) (pre-Lanham Act case stating that protection from confusion is available to the holder of a surname trademark that has acquired public recognition); *Horlick's Malted Milk Corp. v. Horluck's, Inc.*, 59 F.2d 13, 15 [13 USPQ 296] (9th Cir. 1932) (pre-Lanham Act case limiting the defendant's right to use his surname as a trademark where the name has acquired public recognition from the efforts of a competitor). Avery Dennison cannot claim that 'Avery' and 'Dennison' are inherently distinctive, but must demonstrate acquired distinctiveness through secondary meaning.”

While the “PETER FRAMPTON” mark clearly is a personal name, and one shared with the Respondent, nevertheless as a result of the Complainant's extensive use of his name since 1967 in connection with advertising and promoting his musically-related goods and services, that mark has acquired considerable secondary meaning, and consequently distinctiveness, in the Internet community, and certainly in a much larger community of the contemporary music industry and its followers, in conjunction with and as a source indicator of the goods and services which the Complainant offers.

Therefore, under the analysis set forth in *Avery Dennison*, the Complainant's mark “PETER FRAMPTON”, having acquired requisite secondary meaning, is certainly protectable from confusion -- even though the term “PETER FRAMPTON” is also a personal name. The US PTO recognized that as such by registering this mark, evidently concluding that it has acquired sufficient secondary meaning and is thus distinctive such that, when used by the Complainant in conjunction with its goods and services, it is not “primarily merely a surname”.

Moreover, in view of the secondary meaning residing in the “PETER FRAMPTON” mark in favor of the Complainant, the Respondent, at the very least, would need to put forth sufficient evidence of its actual use of the contested domain name and the extent

of its use, including, e.g., advertising and promotional activities, in order for this Panel to infer that those Internet users who would most likely come into contact with that domain name would probably associate that particular name, through its having attained sufficient secondary meaning, with the Respondent rather than Complainant trademark owner. Clearly, as the notoriety of a mark increases in its given product/service market, then so will the quanta of proof which an opposing party must put forth to counter the likely consumer perception of associating a domain name that incorporates that mark with the trademark owner.

This Panel believes that, in view of the widespread, worldwide notoriety enjoyed by the "PETER FRAMPTON" mark in connection with the Complainant's goods and services particularly in view of the Complainant's continuing and substantial efforts occurring over at least the past three decades, the Respondent here faces an exceedingly difficult, if not impossible, task of showing satisfactory proof of its use of the term "PETER FRAMPTON", for use in connection with goods and services similar to those offered by the Complainant to establish that it has legitimate rights and interest in the contested domain name sufficient to justify its retention of that name. The Respondent's showing falls way short of doing so here.

While the Respondent's president himself, by his own admission, may be commonly known, among his own associates, by the name "PETER FRAMPTON" or the like, this in and of itself is clearly insufficient to establish the Respondent is "commonly known" by that name consistent with paragraph 4(c)(ii) of the Policy in order to successfully counter the rights of the Complainant trademark owner.

In light of the above findings, the Panel is not persuaded that the Respondent has any or, based on current facts provided to the Panel, is likely to acquire any rights or legitimate interests in the contested domain name under any provision of paragraph 4(c) of the Policy.

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

### **iii. Bad Faith**

The Panel firmly believes that the Respondent's actions constitute bad faith registration and use of the contested domain name.

It is inconceivable to this Panel that, when the Respondent chose and registered the contested domain name in 1997, it had not been fully aware of the Complainant's "PETER FRAMPTON" mark and particularly the widespread reputation that mark had attained as a result of the Complainant's long-term and on-going efforts, in the contemporary music field, that he had started some 30 years before, particularly given the Respondent's subsequent actions in posting a web site that offered goods directly competitive with the Complainant through the contested domain name that identically matched the Complainant's mark.

While this Panel might be more solicitous of the Respondent's position had it offered goods and services through its web site that were sufficiently disparate from those offered by the Complainant such that user confusion was not likely to occur, this is clearly not the case here.

There can be no question that the Respondent having absolutely no association, relationship or affiliation whatsoever with the Complainant, clearly chose to include the

Complainant's mark in the contested domain name with a goal of creating opportunities, to commercially benefit itself, arising out of the inevitable user confusion that would flow from concurrent use by the Complainant of its "PETER FRAMPTON" mark and by the Respondent of its contested domain name. The Panel views such opportunistic registration of the contested domain name as indicative of bad faith registration and the subsequent use of that domain name by the Respondents in an effort to attain such benefit as bad faith use, both collectively actionable under paragraph 4(b)(iv) of the Policy. See, e.g., *Novus Credit Services Inc. v. Personal*, WIPO Case No. D2000-1158, November 29, 2000 and *Guinness UDV North America v. Lewis*, cited *supra*.

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.

## **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 contested domain name, specifically <peterframpton.com>, is ordered transferred to the Complainant.

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Peter L. Michaelson, Esq.  
Sole Panelist

Dated: April 17, 2002