



November 15, 2016

Successfully Managing the Intellectual Property of Celebrity Estates

NEWSLETTER

An Entertainment Industry Organization

The President's Corner

Celebrities, musicians, songwriters, authors, inventors, photographers, and artists spend their lives creating, building, exploiting and protecting their personal intellectual property rights, such as copyrights, trademarks, personality rights, and patents; which can generate sizeable income streams during such individual's lifetime and generate cash flow for years to come.

Death is inevitable for everyone, however, a deceased individual's copyrights, trademarks, personality rights, and patents often serve as such individual's legacy for generations. Whether it's the estate of Leonard Cohen, Harper Lee, Muhammad Ali, Lemmy Kilmister, Jackie Collins, Glenn Frey, Prince, Leon Russell or David Bowie, the delegation to whom personal intellectual property rights are transferred to after death, either via a will or intestacy, can dictate how well these post-mortem rights are managed and exploited.

Tonight, it is a privilege to have with us experts to discuss the nuances of these valuable post-mortem personal intellectual property rights and what considerations need to be taken into account for the continued monetization, maintenance, management and use of such property rights.

Messrs. Frackman, Halloran, Strauss and White, on behalf of the California Copyright Conference and myself, we thank you each for your time and insight this evening.

J. Charley Londoño, Esq.
Vice President, California Copyright Conference (2016-2017)

P.S. Also, please join us next month for the CCC's annual holiday party where we will honor our good friend and respected industry mensch, attorney and entrepreneur, Steve Winogradsky, as he officially retires. More details to follow, however, this celebration of the holidays and Steve's career will take place on Tuesday, December 6 at the Catalina Bar & Grill (6725 Sunset Blvd in Hollywood), festivities start at 7pm. Tickets to this "you don't want to miss" event can be purchased at theccc.org. See you there!

A Brief History of the Right of Publicity

by Jonathan Faber

The Right of Publicity can be defined as the right to control the commercial use of one's identity. That definition raises a number of questions, of course, as well it should. What does control mean? Are there limitations on that control? Can it be used as a spear for censorship by a famous personality? What is a commercial use? Are there exceptions to commercial use? What does identity encompass?

A Helicopter View of the Right of Publicity

The elements typically comprising the Right of Publicity are referred to as "name, image and likeness." This trifecta varies from state to state. According to Indiana's statute, the Right of Publicity refers to the property interest inherent in an individual's "name, voice, signature, photograph, image, likeness, distinctive appearance, gestures or mannerisms." Clearly, Indiana, as but one jurisdiction, takes a more expansive view of what comprises the Right of Publicity. The author of this article (and administrator of www.RightofPublicity.com) was responsible for passage of Indiana's current Right of Publicity statute in 2012, which was signed into law by then-Governor Mitch Daniels, and has contributed to legislative efforts throughout the United States.

The majority view is that the Right of Publicity extends to every individual, not just those who are famous. But as a practical matter, Right of Publicity disputes usually involve celebrities, since it is they who possess the names and images that help hype advertisements and sell products.

The Right of Publicity as Part of the Intellectual Property Family

The Right of Publicity is often confused with its more recognized cousins in the intellectual property family, copyright and trademark. However, the historical origins of copyright, trademark and the Right of Publicity demonstrate distinct policy, rationales for the interests that each is designed to protect.

The Right of Publicity has little to do with copyright. Copyright applies to the bundle of rights one acquires in “original works of authorship fixed in any tangible medium of expression,” according to 17 U.S.C. Section 102 (a), so the exclusive rights held by a copyright owner apply to the work itself. This can get complicated, as Right of Publicity and copyright considerations can simultaneously be implicated in a single usage. An advertisement featuring a celebrity’s picture may require authorization from the photographer for the copyright use, and from the celebrity for the Right of Publicity use. Because these are wholly distinct claims with independent parties charged with standing to assert them, federal copyright laws generally will not preempt a state-based, Right of Publicity claim.

There are, however, some noteworthy similarities between the Right of Publicity and trademark law. Theoretically, the Right of Publicity is of the same genus as unfair competition and, more precisely, the doctrine of misappropriation—two hallmarks of trademark law, as reflected in the Lanham Act. Like a trademark, the Right of Publicity can function as a quality assurance to a consumer, especially if a celebrity, or his or her estate, maintains self-imposed quality standards and exercises discretion in licensing publicity rights. Also, proprietors of both trademark and publicity rights seek to prevent others from reaping unjust rewards by appropriation of the mark or celebrity’s fame.

Given these occasional parallels, overlap is inevitable. In *Motown Record Corp. v. Hormel & Co.*, for example, trademark laws were used to protect the “persona” of the legendary music group, the Supremes. 657 F. Supp. 1236 C.D. Cal. 1987. But as a general proposition, the Right of Publicity stands apart from both trademark and copyright law, as a distinct body of law, with its own underlying principles and history of precedent.

Landmark Cases Addressing the Right of Publicity

The Supreme Court of the United States has reviewed the Right of Publicity only once, in the seminal case of *Zacchini v. Scripps-Howard Broadcasting*. *Zacchini* involved a famous “human cannonball” who objected to his entire 15-second performance being televised on the local news. The value of his act depended on the public’s desire to witness the event, so televising the event detracted from the demand of people willing to pay to see his act.

The Court recognized *Zacchini*’s Right of Publicity and rejected the Broadcasting Company’s First and Fourteenth Amendment defenses. In so doing, the Court noted that the decision was not merely to ensure compensation for the performer; rather, it was to provide “an economic incentive for him to make the investment required to produce a performance of interest to the public.” 433 U.S. 562, 576 (1977). Thus, in language reminiscent of the policies supporting copyright and patent laws, Justice White solidified the foundation of the Right of Publicity.

The most famous Right of Publicity cases are the so-called “impersonator” cases. *Midler v. Ford Motor Co.* 849 F.2d 460 (9th Cir. 1989) and *Waits v. Frito-Lay, Inc.* 978 F.2d 1093 (9th Cir. 1992) involved similar fact patterns in that both Bette Midler and Tom Waits declined to lend their distinctive voices to advertising jingles for two prominent manufacturers. Undeterred, the advertisers in each case simply found sound-alike performers who could duplicate the vocal timbre and styling of Bette Midler and Tom Waits. Both Midler and Waits prevailed on Right of Publicity claims which yielded \$400,000 for Midler and \$2,500,000 for Waits several years later.

In another famous impersonator case, *White v. Samsung Electronics America, Inc.*, Samsung utilized a robot that looked and acted like Vanna White of “Wheel of Fortune” fame. 971 F.2d 1395 (9th Cir. 1992). This usage was an infringement because Samsung had deliberately pawned the image and popularity of White and because White was readily identifiable from the context of the use. She was awarded \$403,000.

Numerous other noteworthy Right of Publicity cases have come down over the years. *Carson v. Here's Johnny Portable Toilets* (698 F.2d 831, 6th Cir. 1983) and *Motschenbacher v. R.J. Reynolds Tobacco Co.* (498 F.2d 921, 9th Cir. 1974) are significant in that neither case involved the name or image of the famous individual implicated in the case. The former of these cases involved the well-known “Here’s Johnny” introduction of Johnny Carson on the “Tonight Show” in an advertisement. The latter involved an advertising use of a distinctive race car that was identifiable as belonging to a specific driver. In each case, the companies were infringing because of the unequivocal association that the public could make between the phrase and the car, and the famous individuals associated therewith.

In January of 1999, Dustin Hoffman asserted his Right of Publicity against a magazine publisher, but the use did not involve an advertisement, *per se*. In *Hoffman v. Capital Cities/ABC, Inc., Los Angeles Magazine* created a feature photo spread by using a variety of celebrity images from famous movie still shots without authorization from the celebrities. 33 F.Supp. 2d 867 (C.D. Cal. 1999). The magazine digitally manipulated the images so it appeared that the celebrities were wearing modern designer clothing. For example, Dustin Hoffman’s character in *Tootsie* was dressed in a Richard Tyler gown and Ralph Lauren heels. Though there was no overt suggestion that Hoffman endorsed the article or the designers in which he was depicted, Hoffman was awarded \$3,270,000 for the violation of his publicity rights. This amount consisted of \$1.5 million in compensatory damages, \$1.5 million in punitive damages, and \$270,000 in attorney fees. The case was overturned on First Amendment grounds on appeal.

As the verdicts in these cases reveal, infringing a celebrity’s Right of Publicity can be a costly error. For this reason, the use of a celebrity’s name, image or likeness in any commercial endeavor should be carefully scrutinized to ensure compliance with the applicable publicity laws (as well as possible trademark considerations since certain aspects of a celebrity’s persona also can qualify for trademark protection).

The World is not Enough: Licensed to Sell

Despite the financial wealth and adulation that often (but not always) accompany fame, celebrity status carries a hefty price tag. Benedict (Baruch) Spinoza, writing more than 300 years ago, identified this trade-off: “Fame has also this great drawback, that if we pursue it we must direct our lives in such a way as to please the fancy of men, avoiding what they dislike and seeking what is pleasing to them.” (1632.1677; from *Tractatus de Intellectus Emendatione*).

Recognition of this dilemma underscores the policies supporting the Right of Publicity. Celebrities typically invest considerable energy in nurturing their public image, and few can argue that it would be anything but unfair for a business to siphon the celebrity’s success into their advertising or products to increase sales, without compensating the celebrity for the heightened profits, profile or recognition of the product or company.

The idea of nurturing and marketing one’s public image is nothing new, as some of the greatest achievers in history have increased the value of their namesakes through controversy, theatrics and sensationalism. Niccolò Paganini, perhaps the greatest violinist to ever live, understood how to market an image. At his sold-out concerts throughout Europe in the 19th century, his mysterious stage persona and unparalleled virtuosity led many to conclude that he (or perhaps his attorney) had negotiated a deal with the devil. Paganini fueled the controversy by wearing black costumes, which, in addition to his gaunt countenance and long hair, created the spectral appearance of a wraith floating across the stage.

Paganini’s compositions — witness the *24 Caprices* — require a technical finesse to which performers painstakingly aspire. As if to mock the difficulty of his compositions, during the finale of his concerts, Paganini intentionally increased the tension on his strings to cause them to break one by one during his performance, and he would seamlessly finish the work on a single string. The German genius Louis Spohr, after attending a Paganini performance in 1830, said that “...in his compositions and performance there is a strange mixture of the highest genius, childishness and tastelessness, so that one feels alternately attracted and repelled.” Arnold Whittall, *Romantic Music* 45 (1987). The same could be said of many of today’s beloved personalities.

If the manipulation of one’s image in order to increase revenue streams is nothing new, the advent of publicity laws in the 20th century at least ensure that the profits derived from these valuable personas are more equitably channeled. Indeed, publicity laws

have led to results that the achievers and celebrities of previous ages, could merely wish for, as *The Wall Street Journal* recently explored in a special Millennium edition: “Thanks to their ability to sell tickets and raise television ratings, top stars now command contrasts and fees that make them more wealthy than the royal patrons who supported entertainers of yore.” Peter Gumber, “Fame and Fortune,” *The Wall Street Journal*, Jan. 11, 1999 at R34).

The policies supporting Right of Publicity laws are not simply about ensuring that a celebrity or celebrity estate gets paid. It is also about the right to control how a celebrity is commercialized, or if he or she will be used at all. As Vince Lombardi Jr. has said: “Nothing anyone can do is going to enhance my father’s reputation, but they certainly can detract from it.” (Mark Hyman, *Dead Men Don’t Screw Up Ad Campaigns*, *Business Week*, March 10, 1997). Thus, the ability to control commercialization in the first place is as much a policy objective of the Right of Publicity as is providing revenue streams for the rightful recipient.

A Right is Born

As of this writing, twenty-two states recognize the Right of Publicity in some capacity via statute (Alabama, Arizona, California, Florida, Hawaii, Illinois, Indiana, Kentucky, Massachusetts, Nebraska, Nevada, New York, Ohio, Oklahoma, Pennsylvania, Rhode Island, Tennessee, Texas, Utah, Virginia, Washington and Wisconsin). According to the ABA’s *Right of Publicity: Analysis, Valuation and the Law*, thirty-eight states have some form of common law precedent on the books as well; however, note that the majority view appears to be that the right exists in every state that has not explicitly rejected such interests. The American Law Institute’s *Third Restatement of Unfair Competition* (1995) §46 also recognizes the Right of Publicity as a distinct and viable legal theory. However, the parameters of the right vary from state to state, depending on the provisions of any given statute.

New York was the first state to enact a publicity law with the New York Civil Right Law in 1903. This statute prohibits the use of the name, portrait, or picture of any living person without prior consent for “advertising purposes” or “for the purposes of trade.” In the early part of the 20th century, with little precedent for publicity rights, New York viewed publicity rights through the filter of personal rights.

New York’s limiting viewpoint was addressed by Judge Jerome Frank in *Haelan Laboratories, Inc. v. Topps Chewing Gum, Inc.* 202 F.2d 866 (2nd Cir. 1953). In his decision, Judge Frank distinguished the “right of publicity” from the “right of privacy” by focusing on the economic interests involved, rather than the personal interests characteristic of the right of privacy. *Haelan* is also cited as the first articulation of these interests as the “Right of Publicity.”

Though New York still does not recognize a post-mortem Right of Publicity, New York is increasingly in the minority in failing to recognize the right beyond the death of the individual. New York has been considering amending its position via a bill that has been in front of the New York legislature over the last few legislative sessions. The Motion Picture Association, historically opposed to expansion of the Right of Publicity, has reportedly approved the latest draft in front of the legislature. That the right is of a proprietary nature appears to be an accepted principle as states enacting Right of Publicity legislation in recent years consistently provide for postmortem rights.

The number of years that postmortem publicity rights are recognized varies dramatically from state to state. For example, Tennessee recognizes the right for 10 years after death (but the right can continue in perpetuity contingent on use), Virginia for 20 years. Florida for 40 years, Kentucky, Nevada, and Texas for 50 years, California for 70 years, and Washington for 75 years. Indiana provides recognition for the Right of Publicity for 100 years after the death of the personality, and endeavors to reach backward for the full extent of those 100 years. Oklahoma, while providing a similar 100-year term of recognition as Indiana, limits the reach-back provision to 50 years.

In 1972, through section 3344 of the California Civil Code, California extended Right of Publicity protection to living personalities. In 1995, California enacted Section 990, the postmortem publicity law, which extended the right for a term of 50 years. Senate Bill 209 was introduced in early 1999 by Senate President Pro Tempore John Burton with the help of Robyn Astaire, the widow of Fred Astaire. The bill was also sponsored by the Screen Actors Guild, as well as top Hollywood names like Arnold Schwarzenegger, Tom Cruise, Anjelica Huston and Michael Douglas, as well as by the creator of this site via

coordinated support from the clients he worked with at the time. The bill was signed into law in 1999, and Section 990 was renumbered as 3344.1 to more closely coincide with publicity rights for living persons.

One issue of particular importance to Senate Bill 209's supporters involved issues spawning from the rapid advancement of digital manipulation technology, by which existing footage of celebrities is modified to produce new, spectacular results. Advertisers can now create the impression that John Wayne actually drank Coors beer, that Fred Astaire developed his dancing technique with a Dirt Devil, that Lucille Ball shopped at Service Merchandise, and that Ed Sullivan spoke glowingly of the M-Class Mercedes. The amendment to California's law endeavored to forbid the alteration or manipulation of a deceased's name, voice, signature, photograph or likeness in a false manner that is portrayed as factual, unless the personality's heirs consent.

Conclusion

The variations between state Right of Publicity laws occasionally generate scholarly debate over whether a federal Right of Publicity statute would be beneficial. Because of the aforementioned parallels with trademark law, some have proposed that the proper place for a federal Right of Publicity statute is in the Lanham Act. But as the policies and function of Right of Publicity and trademark laws vary, this notion is problematic, if not untenable. See "Symposium: Rights of Publicity: An In-Depth Analysis of the New Legislative Proposals to Congress," 16 *Cardozo Arts & Ent. L. J.* 209, 1998.

The Patent, Trademark & Copyright Section of the American Bar Association has occasionally explored federalization of the Right of Publicity. To date at least, these types of efforts have broken down under the strain of competing interests and unresolved debate. Even without a Federal Right of Publicity statute, the state-based regime is not as unmanageable as it may appear, as there is a discernable consistency in Right of Publicity case law, even from jurisdiction to jurisdiction. It just takes some getting used to, perhaps.

Adapted from *Indiana: A Celebrity Friendly Jurisdiction*, by Jonathan Faber, published in *Res Gestae*, March 2000, Vol. 43, No. 9, and last updated July 31, 2015. Used with permission from Jonathan Faber of Luminary Group, RightOfPublicity.com

PANELIST BIOS

RUSSEL J. FRACKMAN, ESQ.

Russell Frackman is a "go-to" lawyer for the entertainment industry through his stewardship of many of the most important copyright and trademark cases to have been litigated in recent years. He is recognized as one of the nation's leading entertainment and intellectual property litigators, having successfully represented clients in a number of landmark cases in state and federal trial and appellate courts. He has represented recording artists, motion picture actors and others in intellectual property matters including right of publicity cases.

He was lead counsel for the record company plaintiffs in the District Courts and Courts of Appeals in the seminal Internet file sharing litigation, *A&M Records, Inc. v. Napster*, 239 F.3d 1004 (9th Cir. 2001), and 284 F.3d 1091 (9th Cir. 2002), *In re Aimster Copyright Litigation*, 334 F.3d 643 (7th Cir. 2003), and *Metro-Goldwyn-Mayer Studios, et al. v. Grokster, Ltd, et al.*, 545 U.S. 913 (2005).

MARK E. HALLORAN, ESQ.

Mark Halloran is an entertainment lawyer and book author. He was Business Affairs Counsel at Orion Pictures and Vice President, Motion Picture Group Business Affairs, at Universal Pictures. Since leaving Universal, Mark has operated in both the studio and independent film worlds, including as production counsel on the iconic indie film *The Usual Suspects*, and currently represents clients in the motion picture, television, music, live theatre and book publishing media. He has also acted as an expert witness in film, television and music litigation for, among others, Warner Bros., Muhammed Ali, ICM, Kevin Costner, New Line, The Orson Welles and Fred Astaire Estates, Fox and Paramount, including in the *Spiderman*, *Superman*, *Citizen Kane*, and *Watchmen* cases.

Mark has also co-authored two books on the music business, *Musician's Guide to Copyright* (U.S. Copyright Office Recommended Reading List), and the current *The Musician's Business and Legal Guide*, the fifth edition of which will be published in spring 2017. Mark also serves as Co-Chair of the USC/Beverly Hills Bar Association Institute on Entertainment Law and Business, and was a speechwriter for the late Senator Daniel Inouye of Hawai'i. The fourth edition of his latest co-authored book, *The Independent Film Producer's Survival Guide: A Business and Legal Sourcebook* is slated to be published in 2018. Mark is a graduate of UCLA, and University of California Hastings College of the Law, where he co-founded and edited the first entertainment law journal, *COMM/Ent* (Communications/Entertainment Law Journal), still recognized as one of the leading entertainment law journals in the world.

STEPHEN J. STRAUSS, ESQ.

For over 30 years, Stephen J. Strauss has specialized in domestic and international trademark, copyright, and unfair competition matters (including licensing, Internet domain name disputes, and litigation). He has prosecuted over two thousand U.S. and foreign trademark and service mark applications, and won over 60 UDRP decisions.

Mr. Strauss represents a number of internationally recognized celebrities, sports personalities, recording artists, chefs, authors and media and entertainment companies. He also represents a wide range of diverse clients including restaurants, banks and financial institutions, clothing and toy manufacturers, magazine and book publishers.

Mr. Strauss is a member of The Television Academy, the Recording Academy (NARAS), Pacific Pioneer Broadcasters, and the Visual Effects Society (a non-profit professional, honorary society representing visual effects practitioners in all areas of entertainment). He is also an Adjunct Professor and member of the Executive Board of the Biederman Entertainment & Media Law Institute and Board of Directors of the Entertainment and Intellectual Property Law Alumni Association (SWEIP) at Southwestern Law School. He lectures widely in the areas of entertainment intellectual property law and celebrity branding. He has lectured before the American Bar Association, the International Trademark Association, the USC Gould Institute of Entertainment Law and Business, the Beverly Hills Bar Association and the Association of Corporate Counsel.

THOMAS A. WHITE • CONSULTANT, RECORD AND MUSIC PUBLISHING INDUSTRIES

Thomas A. White is a consultant specializing in the rights of artists and creators, and the asset management of intellectual property.

Mr. White is based in Beverly Hills, provides litigation consulting and expert witness services, and is a (non-attorney) member of the Planning Committee of the USC Institute on Entertainment Law and Business.

for more information and upcoming events, visit theccc.org or follow us!



SAVE THE DATE: CCC 2016 Holiday Party honoring Steve Winogradsky | Tuesday, December 6th at the Catalina Bar & Grill



BuchalterNemer
A Professional Law Corporation

Successfully Managing the Intellectual Property of Celebrity Estates



Celebrity Trademark Rights (1)



- Trademark Registration and Protection for
 - Names
 - Likeness
 - Signature
 - Feature
 - Voice

Int. Cl.: 41

Prior U.S. Cls.: 100, 101 and 107

Reg. No. 2,600,739

United States Patent and Trademark Office

Registered July 30, 2002

**SERVICE MARK
PRINCIPAL REGISTER**

STEVIE WONDER

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FOR: ENTERTAINMENT SERVICES IN THE NATURE OF LIVE MUSICAL PERFORMANCES; ENTERTAINMENT SERVICES, NAMELY, PROVIDING TELEVISION AND RADIO PROGRAMS IN THE FIELD OF MUSIC AND ENTERTAINMENT VIA A GLOBAL COMPUTER NETWORK; CULTURAL ACTIVITIES, NAMELY, LIVE ARTISTIC AND VISUAL ARTS PERFORMANCES; AUDIO AND VIDEOTAPE RECORDING PRODUCTION; MOTION PICTURE FILM PRODUCTION; PRODUC-

TION AND DISTRIBUTION OF ENTERTAINMENT AND MUSIC PROGRAMS FOR RADIO, TELEVISION, CABLE, SATELLITE, PAY-PER-VIEW, INTERACTIVE MEDIA, HOME VIDEO MARKETS; MULTIMEDIA PRODUCTION SERVICES IN THE FIELD OF MUSIC AND ENTERTAINMENT; RECORDING STUDIOS; MOTION PICTURE SONG PRODUCTION; AND FAN CLUBS, IN CLASS 41 (U.S. CLS. 100, 101 AND 107).

FIRST USE 0-0-1962; IN COMMERCE 0-0-1962.

SER. NO. 76-245,860, FILED 4-23-2001.

RICHARD WHITE, EXAMINING ATTORNEY

Int. Cl.: 41

Prior U.S. Cls.: 100, 101 and 107

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Registered Sep. 2, 2008

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FIRST USE 8-0-2007; IN COMMERCE 8-0-2007.

OWNER OF U.S. REG. NOS. 2,600,739 AND 2,604,279.

THE NAME STEVIE WONDER IDENTIFIES A LIVING INDIVIDUAL WHOSE CONSENT IS OF RECORD.

THE MARK CONSISTS OF THE WORDING STEVIE WONDER IN BRAILLE CODE AND THE CORRESPONDING RAISED DOTS.

SER. NO. 77-344,790, FILED 12-5-2007.

ELLEN BURNS, EXAMINING ATTORNEY

Int. Cl.: 41

Prior U.S. Cls.: 100, 101 and 107

United States Patent and Trademark Office

Reg. No. 3,257,796

Registered July 3, 2007

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FOR: ENTERTAINMENT SERVICES COMPRIS-
ING DRAMATIC PERFORMANCES BY AN ACTOR
IN MOVIES AND ON TELEVISION, IN CLASS 41
(U.S. CLS. 100, 101 AND 107).

FIRST USE 7-1-1948; IN COMMERCE 7-1-1948.

THE MARK CONSISTS OF STANDARD CHAR-
ACTERS WITHOUT CLAIM TO ANY PARTICULAR
FONT, STYLE, SIZE, OR COLOR.

THE NAME "PAUL NEWMAN" IDENTIFIES A
LIVING INDIVIDUAL WHOSE CONSENT IS OF
RECORD.

SER. NO. 78-698,168, FILED 8-23-2005.

AMOS T. MATTHEWS, JR., EXAMINING ATTOR-
NEY

Int. Cl.: 30

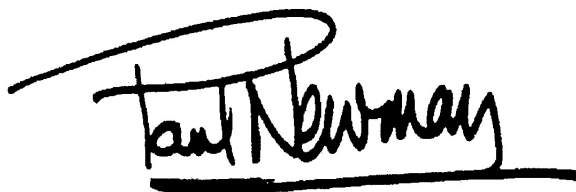
Prior U.S. Cl.: 46

United States Patent and Trademark Office

Reg. No. 3,236,035

Registered May 1, 2007

**TRADEMARK
PRINCIPAL REGISTER**



NO LIMIT LLC (CONNECTICUT LTD LIAB CO)
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FOR: SALAD DRESSINGS AND SPAGHETTI
SAUCES. IN CLASS 30 (U.S. CL. 46).

FIRST USE 2-4-2000; IN COMMERCE 4-15-2000.

OWNER OF U.S. REG. NOS. 1,280,046, 3,168,139
AND OTHERS.

THE NAME(S), PORTRAIT(S), AND/OR SIGNA-
TURE(S) SHOWN IN THE MARK IDENTIFIES
PAUL NEWMAN, WHOSE CONSENT(S) TO REGIS-
TER IS SUBMITTED.

THE MARK CONSISTS OF SIGNATURE OF
PAUL NEWMAN.

SER. NO. 78-703,385, FILED 8-30-2005.

AMOS T. MATTHEWS, JR., EXAMINING ATTOR-
NEY

Int. Cls.: 30, 31 and 32

Prior U.S. Cls.: 1, 45, 46 and 48

Reg. No. 3,145,005

United States Patent and Trademark Office Registered Sep. 19, 2006

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SPICY TOMATO SAUCE, SALSA AND BREAKFAST
CEREAL, IN CLASS 30 (U.S. CL. 46).

FIRST USE 11-0-1982; IN COMMERCE 11-0-1982.

FOR: UNPOPPED POPCORN, IN CLASS 31 (U.S.
CLS. 1 AND 46).

FIRST USE 11-0-1982; IN COMMERCE 9-0-1984.

FOR: LEMONADE AND FRUIT JUICE DRINKS,
IN CLASS 32 (U.S. CLS. 45, 46 AND 48).

FIRST USE 11-0-1982; IN COMMERCE 5-0-1983.

OWNER OF U.S. REG. NOS. 1,280,046, 1,581,795
AND OTHERS.

THE NAME(S), PORTRAIT(S), AND/OR SIGNA-
TURE(S) SHOWN IN THE MARK IDENTIFIES

PAUL NEWMAN, WHOSE CONSENT(S) TO REGIS-
TER IS SUBMITTED.

THE COLORS TAN/FLESH TONE, BLUE, WHITE,
BLACK AND YELLOW ARE CLAIMED AS A FEAT-
URE OF THE MARK.

THE COLORS TAN/FLESH TONE AND BLACK
APPEAR IN THE FACE, THE COLORS WHITE AND
BLUE APPEAR IN THE EYES, THE COLOR WHITE
APPEARS IN THE TEETH, AND THE COLORS
BLACK, WHITE AND YELLOW APPEAR IN THE
HAIR.

THE MARK CONSISTS OF ARTISTIC RENDER-
ING OF THE FACE OF PAUL NEWMAN.

SEC. 2(F).

SER. NO. 78-704,865, FILED 8-31-2005.

RON FAIRBANKS, EXAMINING ATTORNEY

Int. Cl.: 41

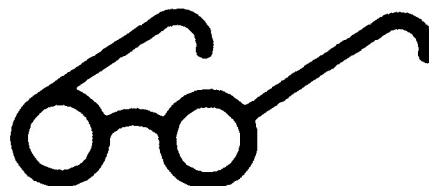
Prior U.S. Cls.: 100, 101 and 107

United States Patent and Trademark Office

Reg. No. 2,710,911

Registered Apr. 29, 2003

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CONDUCTING FILM FESTIVALS FEATURING SI-
LENT FILMS; ORGANIZING FESTIVALS FEATUR-

ING ART EXHIBITIONS; RENTAL OF FILMS, IN
CLASS 41 (U.S. CLS. 100, 101 AND 107).

FIRST USE 10-0-1998; IN COMMERCE 10-0-1998.

SER. NO. 76-365,749, FILED 1-31-2002.

AMY GEARIN, EXAMINING ATTORNEY

United States of America

United States Patent and Trademark Office

NO DRAWING-SENSORY MARK

Reg. No. 4,775,241

Registered July 21, 2015

Int. Cl.: 35

SERVICE MARK

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1801 CENTURY PARK EAST, 24TH FLR.
LOS ANGELES, CA 90067

FOR: ADVERTISING AND PROMOTING THE GOODS AND SERVICES OF OTHERS RENDERED BY LIVE ANNOUNCEMENTS AND VIA PRE-RECORDED AUDIO, VIDEO AND ELECTRONIC MEDIA, NAMELY, RADIO, TELEVISION, MOTION PICTURE FILMS, MOTION PICTURE TRAILERS, VIDEOTAPES, CD'S, THE GLOBAL COMPUTER NETWORK, COMPUTER SOFTWARE AND OTHER ELECTRONIC DISKS, NAMELY, LASER, CD-ROM, AND DVD, AT OR IN CONNECTION OR ASSOCIATION WITH SPORTING, ENTERTAINMENT AND CULTURAL EVENTS, IN CLASS 35 (U.S. CLS. 100, 101 AND 102).

FIRST USE 7-1-1997; IN COMMERCE 7-1-1997.

OWNER OF U.S. REG. NOS. 2,405,492, 2,594,218 AND OTHERS.

THE MARK CONSISTS OF A SOUND MARK COMPRISING THE SPOKEN WORDS "LET'S GET READY TO RUMBLE".

SER. NO. 86-263,410, FILED 4-25-2014.

BARNEY CHARLON, EXAMINING ATTORNEY

Uniform Dispute Resolution Policy



- Complainant must prove (by the preponderance of the evidence) three elements:
 - The domain name registered by Respondent is identical or confusingly similar to a trademark or service mark in which Complainant has rights; and
 - Respondent has no rights or legitimate interests in respect of the domain name; and
 - The domain name has been registered and is being used in bad faith
- Successful complainant obtains order canceling or transferring domain name
- Registrant or Complainant may submit the dispute to a Court of competent jurisdiction for independent resolution before or after UDRP proceeding is concluded



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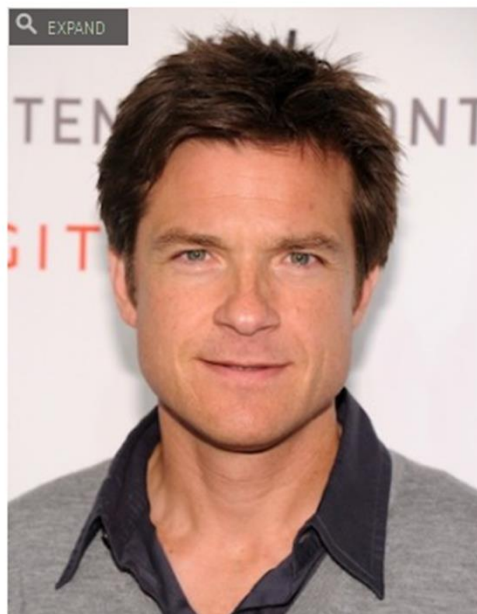
Jasonbateman.com Is a Gay Porn Site No More



Adrian Chen

Filed to: DOMAINS 8/13/10 3:56am

4,316 🔥 ★ ▼



Jasonbateman.com used to link to a **gay porn** hub. But in advance of his new movie, *The Switch*, Bateman's lawyers **made the gay porn site go away**. This is like the time our name linked to a gourmet cheese importer.

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NATIONAL ARBITRATION FORUM

DECISION

The Elizabeth Taylor Trust, Interplanet Productions Limited and The Elizabeth Taylor
Cosmetics Company v. Patrick Fitzgerald
Claim Number: FA1210001465340

PARTIES

The Complainants are **The Elizabeth Taylor Trust, Interplanet Productions Limited and The Elizabeth Taylor Cosmetics Company** (“Complainant”), represented by **Stephen J. Strauss** of **FULWIDER PATTON LLP**, California, USA. The Respondent is **Patrick Fitzgerald** (“Respondent”), represented by **Jon D. Cohen** of **Stahl Cowen Crowley Addis LLC**, Illinois, USA.

REGISTRAR AND DISPUTED DOMAIN NAME

The domain name at issue is <liztaylor.xxx>, registered with **Register.com, Inc.**

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.

Hon. Sir Ian Barker as Panelist.

PROCEDURAL HISTORY

Complainant submitted a Complaint to the National Arbitration Forum electronically on October 2, 2012; the National Arbitration Forum received payment on October 2, 2012.

On October 5, 2012, Register.com, Inc. confirmed by e-mail to the National Arbitration Forum that the <liztaylor.xxx> domain name is registered with Register.com, Inc. and that Respondent is the current registrant of the name. Register.com, Inc. has verified that Respondent is bound by the Register.com, Inc. registration agreement and has thereby agreed to resolve domain disputes brought by third parties in accordance with ICANN’s Uniform Domain Name Dispute Resolution Policy (the “Policy”).

On October 9, 2012, the Forum served the Complaint and all Annexes, including a Written Notice of the Complaint, setting a deadline of October 29, 2012 by which

Respondent could file a Response to the Complaint, via e-mail to all entities and persons listed on Respondent's registration as technical, administrative, and billing contacts, and to postmaster@liztaylor.xxx. Also on October 9, 2012, the Written Notice of the Complaint, notifying Respondent of the e-mail addresses served and the deadline for a Response, was transmitted to Respondent via post and fax, to all entities and persons listed on Respondent's registration as technical, administrative and billing contacts.

A timely Response was received and determined to be complete on October 29, 2012.

An Additional Submission from Complainant was received and determined to be compliant on November 5, 2012.

On November 9, 2012, pursuant to Complainant's request to have the dispute decided by a single-member Panel, the National Arbitration Forum appointed Hon. Sir Ian Barker as Panelist.

Having reviewed the communications records, the Administrative Panel (the "Panel") finds that the National Arbitration Forum has discharged its responsibility under Paragraph 2(a) of the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules") *"to employ reasonably available means calculated to achieve actual notice to Respondent"* through submission of Electronic and Written Notices, as defined in Rule 1 and Rule 2.

RELIEF SOUGHT

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

PRELIMINARY ISSUE: Multiple Complainants

In the instant proceedings, there are three Complainants. Paragraph 3(a) of the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules") provides that *"[a]ny person or entity may initiate an administrative proceeding by submitting a complaint."* The National Arbitration Forum's Supplemental Rule 1(e) defines *"The Party Initiating a Complaint Concerning a Domain Name Registration"* as a *"single person or entity claiming to have rights in the domain name, or multiple persons or entities who have a sufficient nexus who can each claim to have rights to all domain names listed in the Complaint."*

In 1978, the late Dame Elizabeth Taylor, the renowned actress, assigned the rights in her name, likeness and appearance to her company, Interplanet Productions Limited

(“Interplanet”). Trademarks in the United States and elsewhere were granted for the name “Elizabeth Taylor” for cosmetic products. Some years later, Elizabeth Taylor and Interplanet licensed the “Elizabeth Taylor” name to the Elizabeth Taylor Cosmetics Company which then produced perfumes under the ‘Elizabeth Taylor’ trademark. Interplanet has now obtained similar United States trademark registrations for jewellery and headware.

On Elizabeth Taylor’s death on March 23, 2011, the Elizabeth Taylor Trust (“ETT”) succeeded to all post-mortem publicity rights not previously assigned to Interplanet, including but not limited to her voice, name, photograph and likeness. ETT filed a notice in accordance with Californian law with the California Secretary of State, claiming to be the successor-in-interest to Elizabeth Taylor’s persona and publicity rights.

In these circumstances, the Panel considers that the three complainants can demonstrate a link amongst all three of them, namely all are entities involved in the marketing and trademarking of Elizabeth Taylor’s persona. See *Vancouver Org. Comm. for the 2010 Olympic & Paralympic Games & Int’l Olympic Com. V. Marlec*, FA 66119 (Nat. Arb. Forum May 12, 2006) and *Tasty Baking Co. & Tastykake Invs. Inc. v. Quality Hosting*, FA 208584 (Nat. Arb. Forum Dec. 28, 2003) .

The Panel notes:

- (a) that the same three complainants were successful in prosecuting an earlier NAF case on June 22, 2012, viz. *The Elizabeth Taylor Trust, Interplanet Productions Ltd & The Elizabeth Taylor Cosmetic Co. v. Hope*, FA1445233 (Nat. Arb. Forum June 22, 2012) (“the *Hope* case”).
- (b) The Respondent has not made any submission concerning the fact that there are three Complainants.

Although it was probably not necessary to have filed a Complaint in the name of all three Complainants, the Panel finds there was a necessary connection amongst them and admits the Complaint in terms of NAF Supplemental Rules 1(e) and 3(a). For convenience, throughout this decision, the Complainants will be referred to as “the Complainant”.

PRELIMINARY ISSUE: Applicability of RES and CEDRP to UDRP Proceedings

While the current case was commenced under the UDRP, Complainant makes arguments relating to the Charter Eligibility Dispute Resolution Policy (“CEDRP”). The CEDRP was established for disputes relating to domain names that include the “.xxx”

top-level domain. However, cases relating to domain names that include the “.xxx” top-level domain may still be brought under the UDRP, which has occurred in the instant proceeding. The CEDRP contains a provision that allows a panel to use the requirements of that policy in the panel’s UDRP analysis.

CEDRP ¶ 8 allows a panel to use the factors under CEDRP ¶¶ 2(a) and (b) as applicable terms of legitimate rights or registration and use under the UDRP. CEDRP ¶ 2(a), “Registration or Use Inconsistent with Community Eligibility,” states that “[a] complaint under this section shall be required to show that a registered domain name in the .XXX TLD has not been registered or used in compliance with the Sponsored Community eligibility criteria as further defined in the Registry-Registrant Agreement.”

CEDRP ¶ 2(b), “Improper Sunrise A Registration,” reads as follows:

A complaint under this section shall be required to:

(i) show that a registered domain name in the .XXX TLD has not been registered in compliance with the provisions the Registry Sunrise Program as they relate to Sponsored Community Adult Trademark Rights Holders (“AT” applicants), or Sponsored Community Existing Domain Name registrants (“AD” applicants); and

(ii) be submitted to the Provider prior to September 1, 2012.

At the Panel’s discretion, the Panel may choose to find that Respondent lacks rights and legitimate interests in the disputed domain name under the UDRP based on the conditions of CEDRP ¶ 2. Additionally, the Panel may utilize the requirements of CEDRP ¶ 2 to determine bad faith registration and use under the UDRP.

Alternatively, the Panel may choose to disregard Complainant’s arguments under the CEDRP and proceed with its analysis solely under the UDRP.

The Panel sees no reason for disregarding the CEDRP, in deciding on the present Complaint. The Panel may consider the requirements of CEDRP to determine bad faith registration and use under UDRP in addition to considering the normal provisions of the UDRP.

PARTIES' CONTENTIONS

A. Complainant

The Complainant has rights in the ELIZABETH TAYLOR trade mark registered with the USPTO on March 22, 1994. The Complainant alleges that the disputed domain name is confusingly similar to the ELIZABETH TAYLOR mark and that the short form

“Liz” for the name “Elizabeth” does not negate the confusing similarity. Elizabeth Taylor was not only an award-winning actress but an internationally-recognised producer, author and business entrepreneur. The Complainant produced media articles which referred to her as “Liz Taylor”.

The Complainant filed for United States trademark applications covering the mark LIZ TAYLOR for cosmetics, fragrances, jewellery, watches, clothing and footwear in January of 2012.

The Respondent registered the disputed domain name on December 7, 2011 and has never used or developed the disputed domain name in connection with a *bona fide* offering or any goods or services.

The disputed domain name links to a website that incorporates a generic search engine with links to other third party websites selling cosmetics competing with those sold by the Complainant, as well as links to information relating to the life and career of Elizabeth Taylor.

The Complainant has established rights in the ELIZABETH TAYLOR mark through continuous use of the mark. Also, it has shown that the mark is strongly associated with Liz Taylor. See, for example, the *Hope* case, *supra*.

The Complainant has no relationship with the Respondent, nor has he been authorised by the Complainant to register and use the disputed domain name. Nor is he commonly known by that name. He is not a member of a relevant “Sponsored Community” “permitted to register .xxx domain names under CEDRP”.

The Complainant submits that the Respondent must have had actual knowledge of the Complainant’s rights in the trademark when he registered the disputed domain name. Moreover, he has made no demonstrable preparations to use the disputed domain name which, as noted earlier, resolves into a website providing links to other websites offering competing products. There is no *bona fide* offering of goods or services

Membership of a ‘Sponsored Community’ entitles registration of a .xxx name to those who provide adult online entertainment or who represent or provide services for such persons. The Respondent does not meet this requirement and therefore has no right or legitimate interest under CEDRP. See *Branson v. Truman*, FA1423689 (Nat. Arb. Forum Feb. 14, 2012).

The disputed domain name is being used in bad faith by the Respondent since it redirects internet users to other commercial websites and the Respondent derives

commercial benefit from click-through fees. The Respondent's passive holding of the disputed domain name constitutes evidence of bad faith) it is improbable that the Respondent was unaware of the Complainant's trademarks at the time of registration.

Moreover the Respondent's defiance of the CEDRP eligibility requirements further demonstrates bad faith.

B. Respondent

The Complainant's trademark rights are narrowly defined and limited to commercial classes for perfume and fragrances, cosmetics and jewellery, hats and caps. The disputed domain name is clearly different from the ELIZABETH TAYLOR trade name; no evidence was submitted in support of the likelihood of confusion between "Liz Taylor" and "Elizabeth Taylor". There is no association in the marketplace between the mark ELIZABETH TAYLOR and adult entertainment. On the other hand, "Liz Taylor" and "Lizz Taylor" have been used as names for actresses in adult entertainment". There are hundreds of pages and dozens of sources of photographs, descriptions, videos and other information about the adult entertainment actresses, Liz Taylor and Lizz Taylor. These persons have allowed sites to post videos of them, often indulging in sexual activity. There is no incidental or potential similarity to the appearance of these adult entertainers and the late Elizabeth Taylor.

Whilst alive, Elizabeth Taylor did not refer to herself as "Liz Taylor" and did not use the name for commercial purposes. She stated once that she hated the name Liz. Accordingly, the argument that the domain name is confusingly similar is without merit.

The Respondent has registered but has not activated the disputed domain name. He has never offered it for sale, has never been asked to sell it, nor does he intend to sell it. He has held the disputed domain name inactive and non-resolving with plans to commercialise the disputed domain name for limited use in the adult entertainment industry.

Since the filing of the Complaint, the Respondent has obtained Sponsored Community status. He requires additional time to create his website which he intends to build around the disputed domain name. He has not received any financial gain in respect of the use. Entry into the domain name field yields no connection to search pages. Users will find links to adult entertainment sites relating to the adult entertainers, Liz Taylor and Lizz Taylor.

The Respondent would agree, on request, to post a suitable disclaimer on his under-construction page. The Respondent did not register the disputed domain name in order to prevent the owner of any trademark from reflecting the mark in a

corresponding domain name. The Complainant did not seek to obtain a trademark for LIZ TAYLOR until some weeks after the Respondent had registered the disputed domain name, which has never been used for any purpose in commerce.

The Respondent is not a competitor of the Complainant. He is not in the same line of industry, there are no plans to use the disputed domain name with reference to Elizabeth Taylor deceased. He has not intentionally attempted to attract commercial internet users to the website or other online locations. Searches made using the disputed domain name address all return to existing and unrelated adult entertainment websites. There is no commercial gain. The Respondent is an entrepreneur who has developed commercial websites in the past but his primary means of income is not derived from an internet-based business. He has not had time to develop the adult entertainment website but he intends to do this within the next six months. To that end, he has become a member of a Sponsored Community and has caused enquiries to be made of the agent for the adult entertainment performer, Liz Taylor.

He has actively demonstrated preparations to use the disputed domain name in connection with a *bona fide* offering of services as a member of a Sponsored Community.

The Respondent has not acted in bad faith. The Complainant has not discharged the burden of proof in that regard. The *Hope* case is not binding. It was clear that the respondent in that case had purchased the domain name <liztaylor.com> in bad faith having no intent to develop a website related or unrelated to Elizabeth Taylor but rather with the sole intent to sell the domain name for \$2m.

The Panel's decision in *Hope*, that <liztaylor.com> was confusingly similar to the present Complainant's mark, must be discounted because of the lack of analysis arguments for and against and citation of legal standards or other indications of how the conclusion had been reached. In any respect, <liztaylor.com> is distinguishable from <liz.taylor.xxx> because a search of the former domain name would yield references to the late Dame Elizabeth Taylor but a search of the latter would yield references to the adult entertainment performer, Liz Taylor.

The Respondent is not receiving a commercial benefit through click-through fees by redirecting internet users to other commercial websites. The XXX domain was specifically created for the purpose of providing separate top-level domains for the dissemination of adult entertainment. Such a website would not attract customers seeking perfumes or hats.

The “passive holding” argument is without merit. Inactivity is merely a factor in determining if there is bad faith. There is no specific time limit for registrants to develop a website for every domain they have registered. Bad faith should not be assumed in the absence of a quick development.

The Respondent is a relative, but not wholly inexperienced, novice in the Internet industry. He has meaningful and honest intentions to develop the disputed domain name. The XXX top level domain was only made available in 2011 and many in the “sponsored community” are grappling with the best way to utilize sites for these domains. The Respondent should not be penalized because he is not capable of devoting sufficient time to building the internet site or penalized because he has another full-time job.

It is not necessary to be in a “sponsored community” prior to registering a XXX domain name. The Rules merely provide that until the registrant is in the Sponsored Community, the domain name will not resolve to one’s DNS. It will still be a valid domain registration which means it must be renewed at some point and could be transferred. However, functionality such as web-hosting, email URL forward will not work until the domain is associated with a known membership ID.

C. Complainant’s Additional Submissions

The Respondent has not contested the Complainant’s ownership of the ELIZABETH TAYLOR mark and its fame. Or that “Liz Taylor” is a name associated with the late Dame Elizabeth Taylor.

The Complainant’s mark was famous throughout the world long before the Respondent registered the disputed domain name. The Respondent’s argument that the disputed domain name is very different and not phonetically the same ignores the evidence that the media and the public have come to associate Liz Taylor with Elizabeth Taylor. That *Hope* decision is to this effect.

The Respondent admits he has not used the disputed domain name for commercial purposes. His argument is that “Liz Taylor” and “Lizz Taylor” are the assumed names of well-known pornographic actresses. It is a frequent practice for porn stars to adopt stage names, derived from or mimicking the names of celebrities. The fact that the Respondent registered and claimed “sponsored community” status after the Complaint was filed, does not constitute demonstrable preparations existing before the Complaint.

The Respondent has made no sworn statement nor provided any evidence of his enquiries relating to the adult entertainment performer, Liz Taylor. Nor did he provide any credible evidence satisfying the demonstrable preparations requirement of Policy

¶ 4(c)(i). No business plan, documentary evidence, affidavit or declaration under penalty of perjury was provided.

The lack of evidence of demonstrable preparations is sufficient to combat any claims of right or interest in a domain name. *See Christian Dior Couture & Chloe v. Zourmas*, D2008-1440 (WIPO December 22, 2008). That was a case where there was no evidence the Respondents had any authorization from the adult industry actress, Chloe Dior, to incorporate her name in a disputed domain name or to use it in any way.

The Respondent produced no evidence that Liz Taylor allowed him to use her name in any way in a disputed domain name. The claim that the site will be used only in relation to that adult entertainer is self-serving, without any supporting evidence and its accuracy is questionable. It makes no sense to wait until the website becomes active which inevitably will cause confusion when it does, given the international fame of the Complainant's trademark and Elizabeth Taylor's nickname of Liz.

The public on seeing the name on search engines will believe that the resulting website will feature the late Dame Elizabeth Taylor instead of being directed to a website featuring an adult entertainer who has chosen to adopt a version of the late Elizabeth Taylor's name. Members of the public would reasonably conclude that an XXX domain name referring to the late Dame Elizabeth Taylor could tarnish the reputation and name of the late Elizabeth Taylor. *See ABB Brown Boverie Limited v. Quicknet*, D2003-0215 (WIPO May 26, 2003), where it was said:

“The use of ABB as part of a domain name offering pornographic material certainly tarnishes the Complainant's existing mark which is also evidence of bad faith.”

FINDINGS

1. The disputed domain name is confusingly similar to a registered trademark in which the Complainant has rights.
2. The Respondent has no rights or legitimate interests to use the disputed domain name.
3. The disputed domain name was registered and is being used in bad faith.

DISCUSSION

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

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

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

DISCUSSION

Identical and/or Confusingly Similar

The Panel is in no doubt that the disputed domain name is confusingly similar to the Respondent's trademark. "Liz" is a very common abbreviation of the forename, "Elizabeth". The Complainant has produced evidence that the late Elizabeth Taylor was known, in the media at least, as "Liz" Taylor. Whether she personally liked the shortened version of her full name or not is irrelevant. It does not matter that the trademarks of the Complainant extend only to jewellery, clothing, etc. All that needs to be proved under the Policy is that a complainant has rights in a trademark and that the disputed domain name is identical or confusingly similar to that mark.

The Panel notes that the same conclusion was reached by the very experienced Panelist under the UDRP in the *Hope* case. That Panelist did not need to give extended reasons for his conclusion, as contended for by the Respondent. One would have thought that a finding that "Liz" is a common rendition of the name "Elizabeth" and that the name of Elizabeth Taylor was known worldwide inevitably meant that a finding that the disputed domain name and the trademark are confusingly similar under Policy ¶ 4(a)(i).

Accordingly, Policy ¶ 4(a)(i) of the Policy is satisfied.

Rights or Legitimate Interests

Complainant gave the Respondent no rights to reflect Complainant's trademark in a domain name. Accordingly, the onus shifts to the Respondent to show that he comes within one of the three situations contemplated by Paragraph 4(c) of the Policy.

The Respondent claims that he wishes to develop a website devoted to a porn star who calls herself "Liz Taylor" or "Lizz Taylor". When one visits the disputed domain name, the Google search shows a whole list of pornographic sites devoted to a porn star who calls herself "Liz Taylor". It seems that some actors in the "adult entertainment" industry take on names of famous actors or actresses or slight variants thereof. One speculates whether the famous people whose names are thus appropriated are happy with this phenomenon. The Respondent claims that he wishes to develop this website but because website development is not his primary occupation, he does not have time to do so. In the meantime, the domain name is inactive or diverts to this particular website.

The Respondent is required to show that he has made demonstrable preparations to offer goods and services using the disputed domain name before he had notice of the Complaint. He claims, for example, to have had some contact with an agent for the star, Liz Taylor, but there is no evidence to support this contention. Nor is there any evidence to show that he had instructed a contractor to prepare a website. Bearing in mind the onus of proof is on the Respondent, the Panel considers that proof of demonstrable preparations has not been shown as required by Paragraph 4(c)(i) of the Policy.

An additional indication of lack of demonstrable preparations before notice of the Complaint stems from the fact that only after the Complaint was filed, did the Respondent apply to join the "Sponsored Community" for persons wishing to develop XXX domain names. One wonders why, if he were so intent on promoting interest in the porn star, Liz Taylor, he did not take this step earlier. He says that it is common practice for those with XXX sites not to seek membership of a sponsored community until after the domain has been registered but then, again, there is no evidence of this.

Nor is there any evidence of a *bona fide* offering of goods and services in a legitimate non-commercial or fair use of the disputed domain name which could bring the Respondent within Paragraph 4(c)(iii) of the Policy. The Respondent uses the resolving website to provide *inter alia* hyperlinks on behalf of companies selling cosmetics in competition with the Complainant. It has often been held in UDRP cases that a Respondent must take responsibility for what is on a website. Passing responsibility on to a "parking site" operator is not good enough. Some links are to sites featuring the late Elizabeth Taylor.

Although it is correct that in some circumstances, a passive holding of a domain name may not necessarily disqualify a respondent from taking advantage of Paragraphs 4(c)(i) and (iii) of the Policy, in many cases where that defence has been successful, there has been evidence of attempts to develop the website, often accompanied by evidential declarations or production of contracts with a website designer or developer.

Under CEDRP Policy, ¶ 8, the arguments concerning the lack of legitimate interest in relation to a XXX domain name may be introduced as complementary to UDRP arguments. There is little need to resort to the CEDRP Policy in this case since the decision under the UDRP criteria is so clear. Accordingly, the Complainant has established Paragraph 4(a)(ii) of the Policy.

Registration and Use in Bad Faith

Considering all the available evidence, the Panel has no difficulty in concluding both bad faith registration and use for the following considerations.

- (a) The fame of the Academy award-winning actress, Elizabeth Taylor, over many years, is worldwide. There was much publicity when she died in March 2011, the disputed domain name was registered some months after her death. It defies belief that the Respondent had never heard of Elizabeth Taylor at the time when he registered the disputed domain name, albeit in a contracted form of her first name, but in a form which is easily recognised as relating to Elizabeth Taylor, the famous actress.
- (b) The disputed domain name clearly tarnishes the Complainant's trademark. There is no evidence that the late Dame Elizabeth Taylor was associated with pornography on the internet. Close association of her name with a pornographic site must surely tarnish the trademark bearing her name.
- (c) Some internet viewers might be confused into thinking that the domain name liztaylor.xxx related to the late Elizabeth Taylor. Some may be surprised that she might have been associated with pornography. Others may be merely curious to see whether she indeed dabbled in that particular predilection.

One can take judicial notice of the fact that the name "Elizabeth Taylor" or its shortening of "Liz Taylor" would be well-known universally. It would be certainly better known than the name "Liz Taylor" assumed by an actress in pornographic videos or downloads. Hence there is a likelihood of confusion to internet users.

- (d) The fact that the Respondent was not at the time of the Complaint a member of a Sponsored Community as envisaged by CEDRP strengthens the inference of bad faith registration and use of which all of the above are indicia.

Accordingly, Paragraph 4(a)(iii) of the Policy is satisfied.

DECISION

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

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

Hon. Sir Ian Barker, Panelist
Dated: November 20 , 2012

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