Celebrity in Cyberspace: A Personality Rights Paradigm for Personal Domain Name Disputes

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Abstract

When the Oscar-winning actress Julia Roberts fought for control of the <juliaroberts.com> domain name, what was her aim? Did she want to reap economic benefits from the name? Probably not, as she has not used the name since it was transferred to her. Or did she want to prevent others from using it on either an unjust enrichment or a privacy basis? Was she, in fact, protecting a trademark interest in her name? Personal domain name disputes, particularly those in the <name.com> space, implicate unique aspects of an individual’s persona in cyberspace. Nevertheless, most of the legal rules developed for these disputes are based on trademark law. Although a number of individuals have successfully used these rules in practice, the focus on trademark law has led to inconsistent and often arbitrary results. This Article suggests that if personal names merit legal protection in cyberspace, it should be under an appropriate set of legal rules, rather than through further expansion of trademarks. This Article develops a new framework for personal domain name disputes based on the theories underlying the right of publicity.

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tort. Unlike trademark law, this tort is aimed at the protection of individual names and likenesses. It has not been utilized much in cyberspace largely because of time, cost, and jurisdictional disadvantages of litigation as opposed to the quicker and cheaper, but trademark-based, Uniform Domain Name Dispute Resolution Policy (UDRP). This Article suggests the creation of a new Personal Domain Name Dispute Resolution Policy (PDRP) that combines the procedural advantages of the UDRP with the theory underlying the right of publicity tort.

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I. Introduction

When Julia Roberts, the popular Oscar-winning actress, brought proceedings for control of the domain name <juliaroberts.com>, just what was her beef? Was she concerned that the registrant of the domain name would be unjustly enriched by its use? Or was she rather concerned about unauthorized content that might appear on the associated website? Or both? She was successful in her complaint against Russell Boyd, the registrant, in an arbitration under the Uniform Domain Name Dispute Resolution Policy (UDRP). But what, theoretically, was the justification for her success? The justification is actually found in trademark law. The UDRP was implemented to protect trademark holders against the activities of bad faith cybersquatters—those who register domain names speculatively to profit from selling the names to "rightful" trademark owners.


2. See id. § 6 (finding that complainant had common law trademark rights in her name).

3. The UDRP is a private dispute resolution procedure for domain name disputes that is administered by the Internet Corporation for Assigned Names and Numbers (ICANN). See generally ICANN, UNIFORM DOMAIN NAME DISPUTE RESOLUTION POLICY (1999), available at http://www.icann.org/en/udrp/udrp-policy-24oct99.htm [hereinafter UDRP].

4. See Roberts, 2000 WL 33674395, § 6 ("[T]he name ‘Julia Roberts’ has sufficient secondary association with Complainant that common law trademark rights do exist under United States trademark law."). The UDRP is premised on protection of trademark interests, so individuals bringing actions with respect to personal names under the UDRP must establish trademark rights in those names in order to bring a successful complaint. See P. Landon Moreland and Colby Springer, Celebrity Domain Names: ICANN Arbitration Pitfalls and Pragmatic Advice, 17 SANTA CLARA COMPUTER & HIGH TECH L.J. 385, 389 (2001) ("The first potential pitfall in obtaining a favorable judgment under the UDRP is a celebrity’s failure to establish recognized trademark rights in his or her personal or professional name.").

5. 2 ANNE GILSON LALONDE, GILSON ON TRADEMARKS § 7A.06 (2008) ("Cybersquatters register trademarks in Internet domain names with no intention of developing a viable web site but instead to hold the name for resale to either the trademark owner or a third party.").

The UDRP is a global online dispute resolution procedure,\(^7\) incorporated into domain name registration agreements by reference.\(^8\) Domain name registrants are contractually bound to submit to an online arbitration if a third party complains about their registration or use of the domain name.\(^9\) Complaints are premised on the complainant’s assertion of trademark rights corresponding with the relevant domain name.\(^10\) The advantages of the UDRP over litigation are that it is inexpensive and fast compared to litigation,\(^11\) and its reach is effectively global because relevant parties are bound to it by contract.

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7. Notably, disputes involve domain names in the <.com>, <.net>, and <.org> domain spaces as well as some others. For a discussion of these disputes, see the introductory notes to the UDRP, available at http://www.icann.org/en/udrp/udrp-policy-24oct99.htm. The full text of the UDRP is also available at this website.

8. UDRP, supra note 3, ¶ 1. The UDRP is structured as follows:

This Uniform Domain Name Dispute Resolution Policy (the "Policy") has been adopted by the Internet Corporation for Assigned Names and Numbers ("ICANN"), is incorporated by reference into your Registration Agreement, and sets forth the terms and conditions in connection with a dispute between you and any party other than us (the registrar) over the registration and use of an Internet domain name registered by you.

9. See id. ¶ 4(a) (outlining the structure of a domain name complaint). The UDRP states that:

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; and (ii) you have no rights or legitimate interests in respect of the domain name; and (iii) your domain name has been registered and is being used in bad faith.

Id. (emphasis added).

10. See id. ¶ 4(a) (outlining the structure of a domain name complaint). The UDRP states that:

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Id. (emphasis added).

11. See Lipton, supra note 6, at 1372 (noting that the UDRP is a private, international, and relatively inexpensive option allowing complainants to resolve disputes over domain names). Lipton further notes:

The UDRP does not oust the jurisdiction of national courts . . . [The] dispute is managed by arbitrators licensed by one of the organizations charged with hearing disputes under the UDRP. It involves the receipt of a complaint and a response by the registrant. The arbitrator or panel then provides a decision and resolution based on this material. There are generally no in-person hearings. The only orders that can be made under the UDRP are orders for cancellation of a disputed name or for transfer of a domain name to the complainant.

Id.; see also Jessica Litman, The DNS Wars: Trademarks and the Internet Domain Name System, 4 J. SMALL & EMERGING BUS. L. 149, 155 (2000) (noting the often prohibitive cost of trademark infringement and dilution litigation in early domain name disputes); Moreland & Springer, supra note 4, at 386 ("Prior to the establishment of ICANN Arbitration, recovery of celebrity domain names was an expensive and potentially lengthy process.").
wherever they may physically reside. Thus, it has been the avenue of choice for most domain name complainants.

The problem is that not all disputed domain names correspond with trademarks. Personal names, for example, may or may not be trademarked, depending on the circumstances. UDRP arbitrators often have little guidance as to whether a particular name really operates as a trademark, despite regularly being required to make such determinations. This has led to inconsistent and arbitrary results in practice. Why, for example, should Julia Roberts and Tom Cruise be regarded as having trademarks in their personal names when the same is not true for Bruce Springsteen or the late Anna Nicole Smith? Why


It appears to be an established principle from cases such as Jeanette Winterson, Julia Roberts, and Sade that in the case of very well known celebrities, their names can acquire a distinctive secondary meaning giving rise to rights equating to unregistered trade marks, notwithstanding the non-registerability of the name itself. It should be noted that no evidence has been given of the name "Bruce Springsteen" having acquired a secondary meaning; in other words a recognition that the name should be associated with activities beyond the primary activities of Mr. Springsteen as a composer, performer and recorder of popular music. In the view of this Panel, it is by no means clear from the UDRP that it was intended to protect proper names of this nature.

Id.

15. See Smith v. DNS Research Inc., National Arbitration Forum Claim No. FA03120000220007, 2004 WL 2358216 (Feb. 21, 2004) (Davis, Arb.), available at http://www.adrforum.com/domains/decisions/220007.htm (finding that the evidence submitted by Anna Nicole Smith was not sufficient to establish common law trademark rights in her name). The Panel stated:

[I]t is unlikely that the evidence submitted here by Complainant of her career, in and of itself, is sufficient to establish common law trademark rights in the name, which is a requirement for Complainant to prevail on this aspect of the case. While the UDRP does not require a registered trademark for protection of a trademark from a confusingly identical domain name, the mere fact of having a successful career as an actress, singer or TV program star does not provide exclusive rights to the use of a name under the trademark laws. The cases require a clear showing of high commercial value and significant recognition of the name as solely that of the
should Senator Hillary Clinton’s name be recognized as a trademark when the same is not true for other politicians such as Kathleen Kennedy Townsend? The reliance on the UDRP to resolve personal domain name disputes raises two related issues. The first is that the UDRP inadvertently encourages the expansion of trademark law into questionable areas—for example, situations where an individual’s name is not operating as a source indicator for products or services (i.e., as a trademark or service mark). The second issue is that reliance on trademark-focused regulations for personal domain name disputes appears in practice to have stalled the development of legal rules more appropriately tailored for these disputes.

This Article suggests that these problems could be addressed by creating a new Personal Domain Name Dispute Resolution Policy (PDRP). This new procedure could retain the time, cost, and jurisdictional benefits of the UDRP, but be based on a theoretical model more focused on protecting individual personas than trademark law. The obvious set of legal rules that protects individual names and likenesses against unauthorized commercial use is the right of publicity—or "personality rights"—tort. Marrying the substance of the right of publicity tort with the procedural benefits of the UDRP is suggested

performer. The Humphrey Bogart case cited by the Complainant is a prime example of the type of case that would be expected to prevail, since virtually no one familiar with the movie industry would fail to recognize his name as that of a famous movie star. The Panel does not believe Complainant’s name has yet reached that level of fame.

Id.


18. 1 GILSON LALONDE, supra note 5, § 2.16[1] (2008) ("The right of publicity . . . is the right of an individual to control the commercial use of his or her name, likeness, signature, or other personal characteristics."). The United States is the only country that has created a specific right of publicity tort. Other jurisdictions may protect similar rights in other ways. See, e.g., Trade Practices Act, 1974, § 52 (Austl.) (prohibiting misleading and deceptive conduct in commerce). In the United Kingdom, privacy laws have been utilized to create a right similar to the right of publicity in practice. See, e.g., Douglas & Others v. Hello! Ltd., (2001) Q.B. 967 (U.K.) (discussing compensation for unauthorized publication of photographs of the wedding of Michael Douglas and Catherine Zeta-Jones on a privacy basis despite the absence of a right of publicity in the United Kingdom).
in this Article as a possible way forward. It would remove the focus from trademark law, thereby avoiding undesirable extensions of trademark law into areas where personal names are not truly functioning as trademarks. It would also facilitate the development of a new jurisprudence focused on identifying and enforcing emerging social norms in relation to the protection of personal names online, whilst balancing these norms against the need to avoid chilling speech in cyberspace. Initially, a new PDRP should ideally be limited in operation to <name.com> versions of an individual’s name, as opposed to, say <name.net>, <name.org>, or <namesucks.com>. This is because the <name.com> version of an individual’s name is likely the most closely associated with the individual’s "authorized" online persona. In other words, it is the domain name that most closely approximates an individual’s persona in the domain space.

One might argue that developing a PDRP along these lines is unnecessary because: (a) it would overpropertize personal names online and hence chill free speech; (b) domain name regulation is irrelevant because sophisticated search

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20. Some might argue that this was the intent of the <.name> domain space. However, that particular domain space has not grown in practice in this way, and most personal domain name disputes revolve around <.com> versions of an individual complainant’s name. See arbitrations cited supra note 19 and accompanying text (describing a few such <.com> disputes).
engines have taken the place of intuitive domain names as an Internet searching tool, and (c) personality rights jurisprudence is not an appropriate substantive fit for personal domain name disputes. The first and second concerns may be rebutted, and the third may be qualified. With respect to the overpropertization concern, the suggested PDRP in fact does little more in practice than is currently done by the UDRP with respect to propertizing personal names. However, it does so in a more consistent and appropriate manner—by developing a jurisprudence that is specific to interests in individual personas as opposed to trademarks. It therefore removes from the trademark arena those disputes that are not really about trademarks, while facilitating the development of a more nuanced personality-rights based jurisprudence. Further, the limitation of the PDRP, at least initially, to <name.com> domains should limit its impact on free speech.

While it is unquestionable that sophisticated search engine technology has a significant role to play in locating information online, the fact that personal domain name disputes are still routinely arbitrated suggests that their control remains an important issue in cyberspace. There are a variety of reasons for this. Even sophisticated search engines use algorithms that prioritize domain names in search results. Additionally, domain names have an important referential function. In other words, if I want to recommend a given website to a friend or colleague, I will likely refer to it by its domain name, and not by the

21. See Eric Goldman, Deregulating Relevancy in Internet Trademark Law, 54 EMORY L.J. 507, 548 (2005) (suggesting that increasing sophistication of search engines will portend the death of Internet domain names as search tools).


23. See arbitrations cited supra note 19 and accompanying text (listing just a few personal domain name disputes).

search steps I took to find it. An intuitive domain name is therefore still extremely important even in the age of sophisticated search engine technology.

With respect to concerns about basing a PDRP on American personality rights jurisprudence because of its somewhat controversial history and practical application, some comment should be made here. While the right of publicity tort has been criticized for lack of a clear theoretical basis or focus, it is the only obvious model of a legal remedy based intimately on protecting various aspects of an individual’s persona that may be important in the domain space. Other countries’ laws might protect some aspects of individual privacy, or unfair competition related to unauthorized use of an individual’s persona. However, the American right of publicity tort is the only area of law that attempts to draw together the various disparate threads of protecting an individual persona.

Some have argued that the right of publicity should be more like trademark law, thus arguably removing the impetus to treat personal names differently from trademarks in the domain space. However, even if personality rights jurisprudence ultimately comes to be more like trademark law, it still will not be trademark law. It will develop in a way that focuses on the protection of personas rather than marks. This will likely result in at least some deviations from trademark law. Thus, a PDRP based on even a trademark-like personality rights jurisprudence would be preferable to the current incoherent application of trademark jurisprudence to personal domain name disputes. In any event, if all this Article does is alert readers to the possibility of different practical and theoretical models for balancing competing interests in personal names in the domain space, it will have made a useful contribution to the debate on Internet governance.

25. See, e.g., Alice Haemmerli, Whose Who? The Case for a Kantian Right of Publicity, 49 DUKE L.J. 383, 389 (1999) ("The timing is propitious for an overhaul of the right of publicity. Existing doctrine remains in a state of disarray that leaves room for wrongs without remedies, despite its characterization as a field of ‘settled’ law, with a ‘self-evident’ philosophical basis.").


28. Of course, some would say that is precisely what is wrong with it—it tries to cover too much under the same umbrella. See, e.g., Stacey Dogan & Mark Lemley, What the Right of Publicity Can Learn from Trademark Law, 58 STAN. L. REV. 1161, 1162 (2006) (arguing that the right of publicity has no clear theoretical foundation, making it difficult for courts to place limits on the right).

29. See id. at 1220 ("The best justifications for a right of publicity are trademark-based justifications . . . ").
To this end, Part II categorizes different classes of personal domain name disputes. It focuses respectively on disputes involving celebrities, politicians and public figures, and private individuals. It also identifies the limitations of trademark-based rules in these disputes. Part III identifies ways in which personality rights jurisprudence is a better, or at least more "honest" substantive fit for these disputes, albeit with inherent practical and theoretical limitations. Part IV presents a framework for a new PDRP that draws on the substance of the personality rights tort, while maintaining the procedural and cost benefits of the UDRP. Part V presents conclusions about ways in which a new PDRP would facilitate the evolution of a personality rights based jurisprudence in cyberspace, while removing disputes that are not really about trademarks from the reach of trademark law.

II. Personal Domain Name Disputes and Trademark Law

A. Categorizing Personal Domain Name Disputes

Different classes of individuals have differing concerns about the use of their names in cyberspace. From past judicial and arbitral decisions, it seems that the major classes of disputes involving personal domain names can be divided into three categories respectively involving: (a) celebrities’ names, (b) politicians’ and public figures’ names, and (c) private individuals’ names. These categories, perhaps unsurprisingly, match the categories of persona protected historically by the right of publicity tort. The tort focuses on rights in personas and has developed rules, admittedly somewhat disharmonized, that at least begin to cater to the different needs of these different classes of people, and to balance those needs against competing societal interests in free speech. The right of publicity is not perfect, but could be used, with some tweaking,

30. See Graeme Dinwoodie & Mark Janis, Trademarks and Unfair Competition: Law and Policy 813 (2004) ("Most states have recognized either statutory or common law rights of publicity. In the remaining jurisdictions, right of publicity claims have not been asserted in recent reported decisions . . . ."); 1 Gilson Lalonde, supra note 5, § 2.16[1] ("The publicity right is still developing and the courts are far from unanimous in defining its scope."); Haemmerli, supra note 25, at 389 ("Existing practice [under the right of publicity] is . . . confused, with fifty state regimes protecting differing aspects of identity, for varied terms, and with disparate remedies.").

31. It is equally arguable that some other body of law from another jurisdiction, such as privacy rights jurisprudence from Europe, or "misleading and deceptive conduct" jurisprudence in Australia, could be used as the substantive basis for a PDRP. The American law is chosen here because it appears to deal the most directly with the kinds of disputes that are arising in the <name.com> space. This may be because much of the celebrity industry is based in the United States, notably California, and many of these disputes involve celebrity names.
as the basis for an efficient online arbitration mechanism for personal domain name disputes.

1. Celebrities’ Names

The most prominent category of disputes involving personal names in the domain space revolves around celebrities’ names—the names of people who are famous for their commercial activities in fields such as music, television, movies, and sports. These people probably have the most commercially valuable personal names in the sense that they trade to a large extent on their names and likenesses for their livelihood. However, this kind of trading on a personal name does not automatically mean that the name functions as a trademark. Trademarks are defined in the Lanham Act to include "any word,


36. However, there is some dispute about the extent to which they trade on those names in a "trademark sense." For a general critique of this point in the domain name context, see Anthony Verna, www.whatsina.name, 14 SECON HALL J. SPORTS & ENT. L. 153 (2004).
name, symbol, or device, or any combination thereof . . . used by a person . . . to identify and distinguish his or her goods . . . from those manufactured or sold by others and to indicate the source of the goods . . . .

A celebrity will not theoretically have a trademark or service mark in her name simply by virtue of being famous. There must be products or services associated with her name, and her name must be used to distinguish her products or services from those sold by others. Nevertheless, celebrities have generally relied on the trademark-focused UDRP to bring complaints about unauthorized uses of their names in the domain space. This is largely because the UDRP is the simplest and most cost-effective procedural avenue for them.

37. 15 U.S.C. § 1127 (2006). "Service marks" are similarly defined in the same section as follows:

The term "service mark" means any word, name, symbol, or device, or any combination thereof—(1) used by a person, or (2) which a person has a bona fide intention to use in commerce and applies to register on the principal register established by this chapter, to identify and distinguish the services of one person, including a unique service, from the services of others and to indicate the source of the services, even if that source is unknown. Titles, character names, and other distinctive features of radio or television programs may be registered as service marks notwithstanding that they, or the programs, may advertise the goods of the sponsor.


[A] complainant may show that his or her personal name has taken on such a cachet that it has become a trademark, but that to succeed in doing so the complainant will have to show that the name has actually been used in trade or commerce. It will instantly be seen that this is a considerable hurdle to vault and that the reason why some cases have failed to establish trademark rights in a personal name is that the evidence has shown only that the name is famous and not that it has been used in trade or commerce.

39. See id. § 6 ("The name in question should be actually used in trade or commerce to establish unregistered trademark rights. Merely having a famous name (such as a businessman, or religious leader) is not necessarily sufficient to show unregistered trademark rights.").

40. See Sarah Sheffield, Comment, "Celebritysquatting": The Ubiquity of Celebrity Culture and the Unique Problem It Presents for Domain Name Ownership, 15 VILL. SPORTS & ENT. L.J. 409, 421 (2008) ("As the law currently stands [related to domain name disputes], celebrities overwhelmingly prefer mediation to litigation, although mediation produces mixed results for celebrities seeking a domain name.").

41. Costs of judicial proceedings can be prohibitive for private individuals. See Litman, supra note 11, at 155 (noting the often prohibitive cost of trademark infringement and dilution litigation in early domain name disputes); Moreland & Springer, supra note 4, at 386 ("Prior to
even though it was never intended that the UDRP would inadvertently create a situation where personal names are recognized as trademarks in an expansive and unprincipled way. While many UDRP arbitrators have accepted trademark claims in personal names, some have not. It is difficult to ascertain a principled distinction between the different approaches.

While it is possible that a "Julia Roberts movie" might be regarded as a product involving a "Julia Roberts" trademark, this seems unlikely. Audiences may go to see a movie because Julia Roberts stars in it, or they may associate a certain quality of performance with Ms. Roberts, but they are unlikely to regard Ms. Roberts as the source of the movie in a trademark sense. The movie studio that produced the film is more likely to be regarded as the source of the movie. It is possible that Ms. Roberts’s name is a trademark or service mark when she offers her performance services to movie producers and movie studios. However, this does not seem to be the basis on which UDRP arbitrators

the establishment of ICANN Arbitration, recovery of celebrity domain names was an expensive and potentially lengthy process.


decided that she had trademark rights in her name. There was very little discussion of the point in the Roberts arbitration, other than the arbitrators acknowledging that a mark does not have to be registered to attract the protection of the UDRP. There is a suggestion in the Roberts arbitration, and in other UDRP decisions involving personal names, that the name of an author of a creative work, such as the author of a book, may be regarded as a trademark. However, even if this test for trademark status is correct, an actor in a film is not the film’s author. Under this analysis, it would be more likely that the writer or director of the film was its author—and therefore it would be more sensible to regard their names as trademarks in the context of the film.

Celebrities may have valid reasons for asserting some control over their personal names in the domain space, particularly in the <name.com> space which is probably viewed by most Internet users as the likely site for a celebrity’s authorized online presence. Celebrities may want to control this domain for their own commercial motives—which seems reasonable, particularly if this is in line with current Internet usage norms. For example,

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45. See id. (noting that other decisions have cited English law as justification for the proposition that "common law trademark rights exist in an author’s name"). The Panel further noted that "[t]he Policy does not require that the Complainant should have rights in a registered trademark or service mark. It is sufficient that the Complainant should satisfy the Administrative Panel that she has rights in common law trademark or sufficient rights to ground an action for passing off." Id.

46. See id. ("A recent decision citing English law found that common law trademark rights exist in an author’s name."); see also Clinton v. Dinoia, National Arbitration Forum Claim No. FA0502000414641, 2005 WL 853535, § 7 (Mar. 18, 2005) (Atkinson, Arb.), available at http://www.adrforum.com/domains/decisions/414641.htm (finding that Senator Clinton did have an unregistered trademark right in her name in connection with both her political activities and her career as an author of a number of books sold in commerce).

47. Verna, supra note 36, at 162–63. Verna argues:

If an author has trademark rights in his or her name, then it must come from the rather singular nature of a novel. Yes, there are editors in the writing process, however, editors do relatively little work compared to the author. A movie, on the other hand, has many other people involved in the process . . . . Looking at the credits of any major motion picture, there are writers, assistant directors, and people who need to operate the microphone and the camera. There may be more than one scriptwriter. The actors and actresses are just a small part of the motion picture.

Id.

48. Some people would disagree even with this analysis because of the collective, creative nature of a motion picture. See supra note 47 and accompanying text (noting the singular nature of a novel and the collaborative nature of a motion picture).
Tyra Banks’s management company, Bankable Inc., appears to have registered the domain name <tyrabanks.com> precisely for this purpose.\(^{49}\) It is an official website authorized and operated by Ms. Banks, including details about her and her career.\(^{50}\) Another example is <parishilton.com>, which appears to be an authorized website for Paris Hilton, including details of her proposed public appearances and her recently released album.\(^{51}\)

Celebrities may also want to control relevant domain names to prevent unjust enrichment. In other words, celebrities who may not necessarily want to make commercial profits themselves from using a domain name may nevertheless wish to prevent others from profiting from their name online. If we are at least initially limiting the scope of a PDRP to <name.com> domain names, this seems reasonable. It seems sensible to allow a presumption that celebrities’ rights in the <name.com> version of their name extend to preventing others from using the name to make an unauthorized commercial profit from Internet users who are actually seeking the authorized website of the relevant celebrity.\(^{52}\) This would likely be the result in applying the right of publicity to a <name.com> case where the registrant was making an unauthorized commercial use of the domain name.\(^{53}\)


\(^{52}\) At least this would be the inference drawn from a parallel to applications of trademark principles in the domain space where a presumption seems to have arisen that <trademark.com> versions of domain names rightfully belong to the trademark holder. See Jacqueline Lipton, Commerce Versus Commentary: Gripe Sites, Parody and the First Amendment in Cyberspace, 84 WASH. U. L. REV. 1327, 1359–60 (2006) ("Here, the arbitrator seems to be suggesting a presumption that the use of a .com gTLD [generic top level domain] corresponding to a trademark will be in bad faith . . . .").

\(^{53}\) In fact, a right of publicity action may well support such an action in relation to some other iterations of the name in the domain space, such as <name.net> and <name.org>. However, these actions are seldom taken in current practice because of the costs and jurisdictional issues involved in litigation, as contrasted with a UDRP arbitration. See infra Part III.B.1 (discussing why most disputes involving personal domain names have been brought under the faster and less expensive UDRP). This Article suggests initially restricting the operation of a PDRP based on the right of publicity to <name.com> names largely as a trial run to see how arbitrators reflect emerging social norms in decisions respecting the <name.com> space. If there was a later perceived need to expand or otherwise alter the scope of the PDRP, this could be achieved later in light of developments in <name.com> cases.
Alternatively, a celebrity might want to control a <name.com> domain name to avoid any authorized web content about her. In other words, some celebrities may wish to control <name.com> versions of their names to telegraph to the public that they have not authorized any web content. Thus, Internet users will find nothing relating to the celebrity under the <name.com> name, and they will be aware that any web content they find under other iterations of the celebrity’s name is likely to be unauthorized content. In some ways, this analogizes to a kind of privacy protection allowing the celebrity to communicate to the public her desire not to exploit her own image online, and perhaps implicitly request privacy considerations from others. An example of this is found in the Julia Roberts UDRP arbitration. After successfully obtaining a transfer of the <juliaroberts.com> domain name, Ms. Roberts has not utilized the name for an official website. This result does not necessarily chill speech about celebrities online. Many other domain names are available for fans and critics who want to communicate about their idols. Search engines will also help Internet users find unauthorized content about individuals posted under less intuitive domain names.

The interests identified above in both commercial control of <name.com> names and in privacy protections of a celebrity persona match the emphases of the right of publicity tort much more than does trademark law. The right of publicity tort has been explained variously on the basis of economic property rights in an individual’s name or likeness, a need to prevent free riding or

54. Various justifications have been put forward for a property basis for personality rights, and have equally been criticized over the years. See Dogan & Lemley, supra note 28, 1181–83 (critiquing Lockean labor theory justifications for personality rights as property); Mark McKenna, The Right of Publicity and Autonomous Self-Definition, 67 U. Pitt. L. Rev. 225, 247, 251–67 (2005) (noting that courts avoid important questions by labeling identity as property and criticizing Lockean labor theory justifications for property rights in personal identity). McKenna also notes the following:

It might be true that identity is sufficiently similar to other objects the law regards as property and therefore deserves at least some of the sticks in the traditional bundle of property rights. But far too few courts and commentators have offered a theory as to why any of the traditional property justifications lead to that conclusion.

Id.; see also Haemmerli, supra note 25, at 388 ("Both proponents and critics of the right of publicity generally perceive it as a property claim grounded in Lockean labor theory."); id. at 407–08 (noting dual property and privacy justifications for right of publicity actions); id. at 412 ("To the extent that commentators specifically address publicity rights, they tend to do so within this property context, and to use Lockean labor theories of property to explain the assertion of a property right in identity or persona."); Roberta Kwally, Fame, 73 Ind. L.J. 1, 15 (1997) (arguing "that a property-based conception for publicity rights is the natural outgrowth of our cultural norms as well as our theoretical conceptions of property"); Eileen Rielly, Note, The Right of Publicity for Political Figures: Martin Luther King, Jr., Center for Social Change, Inc. v. American Heritage Products, 46 U. Pitt. L. Rev. 1161, 1165–69 (1985) (describing
unjust enrichment,\textsuperscript{55} and the need to protect a person’s privacy from unauthorized commercial interference.\textsuperscript{56} Personality rights jurisprudence has also dealt extensively with issues of balancing the public’s interest in free speech about a celebrity with the celebrity’s interest in controlling her public persona.\textsuperscript{57} Although these are difficult issues that have not been definitively resolved even within the right of publicity, this body of law has at least started to address these concerns and develop responses to them. Trademark law, on
the other hand, even the trademark laws focused on preventing cybersquatting, are not geared towards such balancing of interests. They are aimed predominantly at protecting valuable trademarks against unauthorized commercial uses. Where trademark cases have dealt with free speech, the inquiry has focused on balancing the integrity of commercial source indicators against First Amendment concerns, rather than on balancing the integrity of individual personas against the First Amendment. Personality rights jurisprudence has developed responses to questions about balancing First Amendment concerns against rights in individual personas. Thus, the personality rights tort is better suited to personal domain name disputes than trademark law in most cases.

2. Politicians’ and Public Figures’ Names

Politicians and other public figures may also have concerns about the use of their personal names in domain names. These concerns may differ in some ways from those of celebrities, and may be valid to the extent that they do not unduly interfere with freedom of expression in the political process. Again,

58. See, e.g., 15 U.S.C. § 1114 (2006) (establishing infringement of a registered trademark by the creation of consumer confusion as to source of goods or services); id. § 1125(a) (demarcating infringement of an unregistered mark); id. § 1125(c) (delineating trademark dilution through tarnishment or blurring); id. § 1125(d) (addressing cybersquatting in relation to domain names corresponding with trademarks). But see id. § 1129(1) (providing for the protection of personal names against cyberpiracy without requiring the plaintiff to establish a trademark in her personal name to succeed on a claim under the provision). Note that these examples are outside the UDRP.

59. See Mattel, Inc. v. MCA Records, Inc., 296 F.3d 894, 900–01 (9th Cir. 2002) (balancing expressive interests of popular singers in using the "Barbie" trademark in their "Barbie Girl" song). It is worth noting that some cases have dealt with the balance of free speech against trademark claims and right of publicity claims in the alternative. See generally Rogers v. Grimaldi, 875 F.2d 994 (2d Cir. 1989) (dealing with the use of Ginger Rogers’s personal name in a movie title for a movie about two cabaret performers who imitated Ginger Rogers and Fred Astaire).

60. See supra note 57 and accompanying text (citing to a number of such responses).

61. See N.Y. Magazine v. Metro. Transit Auth., 987 F. Supp. 254, 265 (S.D.N.Y. 1997) (balancing Mayor Rudolph Giuliani’s rights of privacy and publicity against First Amendment interests), aff’d in part, vacated in part, 136 F.3d 123 (2d Cir. 1998); Riel, supra note 54, at 1172–74 (describing need to balance First Amendment interests in political debate against the publicity rights of politicians and public figures); see also Wilson v. Brown, 73 N.Y.S.2d 587, 590 (N.Y. Sup. Ct. 1947) (refusing to grant an injunction that would restrict the defendants from using plaintiff’s name on a dance card). In Wilson, the court stated:

One who takes an office, whether it is in government or in outside organizations, must be deemed to have agreed to any reasonable public use of, or reference to, his name . . . . Persons who accept high positions ought not to be so tender about the
trademark law is not a good fit for balancing competing interests in such names. Even if some famous celebrities, such as authors, have trademarks in their names, politicians are less likely to hold such trademarks. Most politicians do not use their names as source indicators as trademark law requires. Rather, they use their names to raise public awareness about particular issues and, in the case of politicians, often in the context of a political campaign. These names often have a temporal quality that is particularly significant to the democratic process. If, for example, electors are voting on a particular issue, a given domain name might be extremely valuable in the lead-up to an election and much less valuable thereafter—both in the hands of the person whose name it is and in the hands of others.

62. Of course, where a politician is also an author, she may assert trademark rights in her name under this analysis. See, e.g., Clinton v. Dinoia, National Arbitration Forum Claim No. FA0502000414641, 2005 WL 853535 (Mar. 18, 2005) (Atkinson, Arb.), available at http://www.adrforum.com/domains/decisions/414641.htm (finding that Senator Clinton had an unregistered trademark right in her personal name in connection with both her political activities and her career as an author of a number of books sold in commerce).

63. Jacqueline Lipton, Who Owns “Hillary.com”? Political Speech and the First Amendment in Cyberspace, 49 B.C. L. REV. 55, 58 (2008) (“Many politicians’ names may not even attain a common law trademark status if used in a purely political, as opposed to commercial, context.”); SECOND WIPO INTERNET DOMAIN NAME PROCESS, WORLD INTELLECTUAL PROP. ORG., THE RECOGNITION OF RIGHTS AND THE USE OF NAMES IN THE INTERNET DOMAIN NAME SYSTEM ¶ 188 (2001), available at http://www.wipo.int/amc/en/processes/process2/report/html/report.html [hereinafter WIPO REPORT] (“[T]he names of political figures, religious leaders, scientists and historical persons may never have been used in commerce and, thus, are unlikely to have trademarks associated with them.”). However, some politicians have been regarded as having commercial trademark rights in their personal names in relation to certain commercial activities. See, e.g., Clinton v. Dinoia, National Arbitration Forum Claim No. FA0502000414641, 2005 WL 853535 (Mar. 18, 2005) (Atkinson, Arb.), available at http://www.adrforum.com/domains/decisions/414641.htm (finding that Senator Clinton had an unregistered trademark right in her personal name in connection with both her political activities and her career as an author of a number of books sold in commerce).

64. See 15 U.S.C. § 1127 (2006) (including in the definitions of both “trademark” and “service mark” the requirement that such marks indicate their source).

65. That is not to say that celebrities do not also get involved in public interest issues—it is just more typical of politicians in their day to day activities.

66. There can also obviously be temporal aspects to a celebrity’s fame. However, the temporal issues can be more pronounced and more important in the lead-up to an election where election day is effectively the deadline for a politician to get her message across to the electorate. The temporal issues in politics are also much more significant to the operation of
The kind of balancing exercise needed to protect a politician’s interests in her personal identity against the need of the public to engage in discourse about her will be different from balancing speech and commerce under trademark law. The First Amendment is likely to be more seriously implicated in the political context than in the commercial context. This is yet another area in which personality rights jurisprudence may be helpful because of its developed focus on protecting different classes of individuals against improper use of their personas. The right of publicity has already developed rules for protecting politicians and public figures against certain unauthorized intrusions, while at the same time promoting society’s interests in free speech where these interests should override a public figure’s desire not to have her name or likeness used in a certain way.

representative democracy than temporal issues relating to a celebrity’s fame which are likely to have more to do with the creation and waning of public interest in cultural commodities at any given point in time.


68. See Parks v. LaFace Records, 329 F.3d 437, 459–60 (6th Cir. 2003) (discussing publicity rights of Rosa Parks in the context of a song title using her name in relation to a hip hop recording that had nothing in particular to do with her or her work); N.Y. Magazine, 987 F. Supp. at 268 (discussing then New York City Mayor Rudolph Giuliani’s public image in relation to an advertising campaign on city buses), aff’d in part, vacated in part, 136 F.3d 123 (2d Cir. 1998); Martin Luther King Jr., Ctr. for Soc. Change Inc. v. Am. Heritage Prods., Inc., 694 F.2d 674, 683 (11th Cir. 1983) (granting an injunction to prevent the defendant from selling plastic busts of Dr. King).

69. See N.Y. Magazine, 987 F. Supp. at 266 ("[A]s a highly visible public figure Giuliani’s interest in his privacy is very limited. One who chooses to be the Mayor of the ‘Big Apple’ must expect that he will be the subject of all kinds of public comments, even in advertisements."). Of course publicity rights jurisprudence is not perfect in the political context. It is disharmonized common law that has not yet had an international reach. See DINWOODIE & JANIS, supra note 30, at 813 ("Most states have recognized either statutory or common law rights of publicity. In the remaining jurisdictions, right of publicity claims have not been asserted in recent reported decisions . . . ."); 1 GILSON LALONDE, supra note 5, § 2.16[1] ("The publicity right is still developing and the courts are far from unanimous in defining its scope."); Haemerli, supra note 25, at 389 ("Existing practice [under the right of publicity] is . . . confused, with fifty state regimes protecting differing aspects of identity, for varied terms, and with disparate remedies."); see also WIPO REPORT, supra note 63, ¶ 173 (discussing the diversity of interests). The Report provides:

Because of the diversity of interests affected by the treatment of personal names, the legal principles and policies that can be deployed to protect personal names are similarly diverse and vary, as might be expected, from country to country. These legal principles and policies include the right to publicity or the right to control the commercial use of one’s identity, recognized in many States of the United States of America; the tort of unfair competition; the tort of passing-off (conceptually
Politicians and public figures will naturally have some concerns about unauthorized uses of <name.com> domains that mirror those of celebrities. An obvious example is cybersquatting. A cybersquatter may well register either a celebrity’s name or a politician’s name in the hopes of making a commercial profit from its transfer. There may be situations in which cybersquatting is more serious for a politician than a celebrity in terms of practical consequences of failing to secure control of a given name. For example, in the lead-up to an election, a politician will likely have a strong desire to control a domain name relating to her personal name, particularly the <name.com> version, as the Internet has become a very important tool for communicating with the electorate and also for political fundraising.70

Like celebrities, politicians and public figures will also have concerns about situations where a domain name registrant is not cybersquatting on a given name, but rather wants to use the name herself for some expressive or commercial purpose. Where the purpose is purely commercial, the right of publicity would presumably proscribe the conduct on the basis that the tort prohibits unauthorized commercial exploitations of a person’s name or likeness.71 Where the purpose is expressive, more difficult First Amendment concerns will arise.

An opposing party or candidate may be highly motivated to register a politician’s name as a domain name in order to criticize the politician on the

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71. See 1 GILOSM LALONDE, supra note 5, § 2.16[1] (“The right of publicity . . . is the right of an individual to control the commercial use of his or her name, likeness, signature, or other personal characteristics.”).
associated website. Because of the importance of free speech in the political process, these uses of a <name.com> domain name raise important competing aspects of the need for the electorate to communicate effectively about politicians. On the one hand, if all political speech is to be protected, regardless of content or forum, then anyone should arguably be entitled to register and use such a name for any expressive purpose. On the other hand, if there is a social norm that <name.com> domains will resolve to websites authorized by relevant politicians, it could be misleading to allow even purely expressive unauthorized messages about a politician under those domain names. Internet users could be misled in these cases as to the identity of the speaker, and it could make it more difficult for Internet users to find authorized messages by the politicians in question.

There are two recent examples of this conduct in Montana. One involves Bob Keenan, a Republican candidate who ran for the United States Senate. The domain name <bobkeenan.com> has been registered by the Montana Democratic Party and hosts a website critical of Keenan’s past policies and practices. The second example involves a Democratic candidate for Montana Secretary of State, Linda McCulloch. The Montana Republican State Central Committee has registered the domain name <lindamcculloch.com> and is using it for a website critical of McCulloch. Given the lack of likely trademark interest in these politicians’ names, it is unlikely that trademark law would help either candidate. The conduct would not even run afoff the personal name provisions in § 1129(1)(A) of the Lanham Act, which does not require a trademark interest, because technically the registrants of the domain names are not cybersquatters—section 1129(1)(A) requires an attempt to sell a domain name for profit for liability to attach. The registrants in these scenarios are


Any person who registers a domain name that consists of the name of another living person, or a name substantially and confusingly similar thereto, without that
not attempting to sell the names. Rather they are utilizing the names to communicate messages critical of the politicians in question.\textsuperscript{76}

There is some state legislation in California that indirectly addresses such situations by prohibiting fraudulent and misleading conduct on the Internet in relation to a ballot measure.\textsuperscript{77} This would likely catch some instances of misleading Internet users by registering a domain name similar to a politician’s name, particularly in the lead-up to an election. However, this approach has not yet been picked up in other states within the United States, let alone at a more global level. In any event, it is not targeted specifically at the protection of individual names from unauthorized uses, but rather deals with ballot measures more generally.\textsuperscript{78} Thus, it would not apply outside the electoral context. There is also some Californian state legislation that deals specifically with unauthorized registrations and uses of domain names corresponding with personal names.\textsuperscript{79} This covers all personal names, whether relating to politicians or public figures or otherwise.\textsuperscript{80} However, again it only exists in California and is, therefore, probably not a realistic option to address these issues, at least in the short term.

\begin{itemize}
\item person’s consent, with the specific intent to profit from such name by selling the domain name for financial gain to that person or any third party, shall be liable in a civil action by such person.
\end{itemize}

\textit{Id.}

\textsuperscript{76} \textit{Supra} notes 72–73 and accompanying text.


\textsuperscript{78} See \textit{id.} § 18320(c)(1) (defining "Political cyberfraud"). The statute provides: "Political cyberfraud" means a knowing and willful act concerning a political Web site that is committed with the intent to deny a person access to a political Web site, deny a person the opportunity to register a domain name for a political Web site, or cause a person reasonably to believe that a political Web site has been posted by a person other than the person who posted the Web site, and would cause a reasonable person, after reading the Web site, to believe the site actually represents the views of the proponent or opponent of a ballot measure.

\textit{Id.}

\textsuperscript{79} \textit{See generally} \textsc{Cal. Bus. & Prof. Code}, §§ 17525–17526 (West 2006). California law also provides: "It is unlawful for a person, with a bad faith intent to register, traffic in, or use a domain name, that is identical or confusingly similar to the personal name of another living person or deceased personality, without regard to the goods or services of the parties." \textit{Id.} § 17525(a).

\textsuperscript{80} In fact, there is specific mention of using a domain name corresponding with an individual person’s name in bad faith to mislead electors. See \textit{id.} § 17526(j) (including, as a bad faith factor, "[t]he intent of a person alleged to be in violation of this article to mislead, deceive, or defraud voters").
Developing specific principles that deal with uses of personal names in general, and politicians’ names in particular, under a new PDRP would more directly address the kinds of situations described here. Such an approach would also have the advantage of being globally harmonized. Additionally, a PDRP would not be limited to the electoral context, but would cover all politicians and public figures attempting to use their names to promulgate messages on the Internet, regardless of whether an election was looming at a given time. Importantly, it would take disputes about free speech in the political process away from trademark policy by avoiding UDRP complaints involving politicians’ names. The development of online jurisprudence related to free speech in the political process should not be decided by focusing on trademark principles where the conflict in question is not about balancing commercial trademarks against the First Amendment.  

3. Private Individuals’ Names

Private individuals’ names are different than those of celebrities or politicians in the issues they raise in the domain space. These names are perhaps less important in the context of this discussion than celebrities’ and public figures’ names. There are significantly fewer disputed situations involving unauthorized registration and use of private individuals’ names on the Internet. A number of disputes involving private individuals’ names actually do relate to trademark uses of those names where a name has acquired secondary meaning as being synonymous with the relevant person’s business.

81. Nevertheless, disputes about politicians’ names in domain names have been brought under the UDRP in the past and the focus has been on establishing trademark interests—or lack thereof—in a relevant politician’s name, rather than on the balance of speech interests in the political context. See, e.g., Clinton v. Dinoia, National Arbitration Forum Claim No. FA0502000414641, 2005 WL 853535 (Mar. 18, 2005) (Atkinson, Arb.), available at http://www.adrforum.com/domains/decisions/414641.htm (finding that Senator Clinton had an unregistered trademark right in her personal name in connection with both her political activities and her career as an author of a number of books sold in commerce); Townsend v. Birt, WIPO Arbitration and Mediation Center Case No. D2002-0030, 2002 WL 827005, § 7 (Apr. 11, 2002) (Donahey, Davis & Sellers, Arbs.), available at http://www.wipo.int/amc/en/domains/decisions/html/2002/d2002-0030.html (finding that an individual politician in a state gubernatorial race did not hold trademark rights in her personal name).

82. See generally Trudeau v. Lanoue, No. 04 C 7165, 2006 WL 516579 (N.D. Ill. Mar. 2, 2006); Schmidheiny v. Weber, 285 F. Supp. 2d 613 (E.D. Pa. 2003); Wright v. Domain Source, Inc., No. 02 C 2525, 2002 WL 1998287 (N.D. Ill. Aug. 27, 2002). These cases involved personal names used in conjunction with businesses conducted by the complainant. They are some of the few cases on record involving the names of private individuals.

83. See 1 GILSON LALONDE, supra note 5, § 2.03[4][d] (“Just as with descriptive terms,
activities.\textsuperscript{84} Thus, trademark-focused laws, including the UDRP, will, in fact, be appropriate avenues for dispute resolution in many of these cases.

Where a private individual’s name is not a trademark in the commercial context, it is unlikely to raise many conflicts in the \texttt{<name.com>} space. There is much less profit to be made by cybersquatting on non-famous names, and little reason to set up gripe sites or parody sites about private individuals. However, one obvious example of where such a situation might arise would be the case where more than one person shares the same personal name.\textsuperscript{85} This situation is analogous to the case where more than one company legitimately shares the same or similar trademarks in different product or geographic markets.\textsuperscript{86} In the absence of some kind of domain trademark or trade name that consists of a personal name (first name, surname, or both) is entitled to legal protection only if it attains secondary meaning.

\textsuperscript{84} Many businesses, in fact, use their chief officers’ names as business names and trademarks, for instance, The Trump Organization (owned by Donald Trump). See TrumpOrganization.com, www.trump.com (last visited Oct. 5, 2008) (on file with the Washington and Lee Law Review). Of course, because of his participation in the television show "The Apprentice," it is possible that Trump’s name also functions as a celebrity name. Nevertheless, due to his business activities (and perhaps also his authorship of several books), Trump’s name is likely a trademark. Trump has also registered a variety of permutations of his personal name as registered marks with respect to particular goods and services. See Trademark Electronic Search System, http://tess2.uspto.gov/bin/gate.exe? f=tess&state=l24i8r.1.1 (last visited Oct. 5, 2008) (providing a list of trademark registrations associated with "Trump") (on file with the Washington and Lee Law Review).

\textsuperscript{85} Ultimately, this was what happened in the \texttt{<paulwright.com>} dispute. Wright v. Domain Source, Inc., No. 02 C 2525, 2002 WL 1998287 (N.D. Ill. Aug. 27, 2002). Although the plaintiff was successful in an action to have the domain name \texttt{<paulwright.com>} transferred back to him by a defendant cybersquatter, the order was conditioned on no third party having acquired bona fide rights in the name. \textit{Id.} at *5. The defendant had already transferred the domain name before the court order went into effect so the plaintiff likely never regained control of the name. \textit{Id.} at *1.

\textsuperscript{86} See Nat’l Ass’n for Healthcare Comm’n’s, Inc. v. Cent. Ark. Area Agency on Aging, Inc., 257 F.3d 732, 738 (8th Cir. 2001) (granting injunction against federal trademark owner in order to allow user of the same mark to use it in established six county area in California); Dawn Donut Co. v. Hart’s Food Stores, Inc., 267 F.2d 358, 360 (2d Cir. 1959) (holding that there was no likelihood of confusion in a case where plaintiff and defendant used similar marks in different product markets and different jurisdictions); David Barrett, \textit{The Future of the Concurrent Use of Trademarks Doctrine in the Information Age}, 23 Hastings Comm. & Ent. L.J. 687, 689–91 (2001) (examining American legislative history of the "concurrent use" doctrine in trademark law, which allows different trademark holders to use similar marks in different geographic areas); Litman, \textit{supra} note 11, at 152 ("Out here in meat space, we can have a whole bunch of different owners of Acme as a trademark—the last time I counted there were more than a hundred different trademark registrations . . . . On the Internet, only one person can own acme.com."); Stuart Weinstein, \textit{The Cyberpiracy Prevention Act: Reconciling Real Space Sectoral and Geographic Distinctions in the Use of Internet Domain Names Under the Lanham Act}, 9 U. Miami Bus. L. Rev. 145, 158 (2001) ("[A]n entity may use an identical mark as another, as long as he does not use that mark within the same sector or industry. As
name sharing strategy, it may be that the "first come, first served" rule has to apply here. More relevant to this discussion would be the admittedly less usual case where someone registered one or more domain names relating to private individuals’ names either in the hope of extracting money from those individuals for transfer of the names, or, perhaps more likely, extracting money for offering web hosting services under the names. The first iteration of this conduct—the pure sale motive—sounds like cybersquatting, but probably is not covered by trademark law because private, non-commercial personal names will generally not be trademarked. It may be covered in the United States by § 1129(1)(A) of the Lanham Act, which does not require a trademark with geographical protection of a user’s mark, the scope of protection is determined as an evidentiary matter, looking at the likelihood of consumer confusion.”; cf. Jacqueline Lipton, *A Winning Solution for YouTube and Utube? Corresponding Trademarks and Domain Name Sharing*, 21 HARV. J.L. & TECH. 509, 549 (2008) (suggesting a domain name sharing mechanism for situations where two legitimate trademark holders are asserting rights in the same domain name simultaneously).

87. See Goldman, supra note 21, at 546 ("[S]ome domain names resolve to a ‘gateway page’ (also referred to as a ‘shared page’ or ‘intermediate page’) for the sole purpose of allowing multiple trademark owners or licensees to ‘share’ the domain name through links on the page to their respective sites."); Lipton, supra note 86, at 549 (suggesting a domain name sharing mechanism for situations where two legitimate trademark holders are asserting rights in the same domain name simultaneously).

88. See Litman, supra note 11, at 151 ("Network Solutions registered .com domain names on a first-come first-served basis, just as all the Internet domain names had always been allocated."); see also Stephen Moccaldi, *Do Any Viable Solutions Exist to Prevent The Exploitation of Trademarks Used as Internet Domain Names?*, 21 SUFFOLK TRANSNAT'L L. REV. 179, 182–83 (1997) (discussing a first-come, first-served basis). Moccaldi asserts:

Network Solutions, Inc. (NSI), a United States business, controls the registration of internet domain names worldwide. Under the original registration policy, NSI simply registered domain names on a first-come, first-served basis with no requirement that the registrant actually intend to use the name in commerce. The method enabled domain name pirates to register famous trademarks as domain names without ever using them in commerce. Many pirates registered popular names and auctioned them off to the highest bidder. Trademark holders filed suits against the pirates for trademark infringement, and against NSI for contributory infringement.

Id.


90. See 1 GILSON LALONDE, supra note 5, § 2.03[4][d] ("Just as with descriptive terms, a trademark or trade name that consists of a personal name (first name, surname, or both) is entitled to legal protection only if it attains secondary meaning.").
in a personal name to support a cybersquatting action. The second iteration may or may not be Cybersquatting depending on whether the registrant would be prepared to release the name to the relevant person without receiving a profit in the event that the person in question did not want to accept the web hosting services. If the registrant is only holding the name in the hope of selling web hosting services and is prepared to give it up if the relevant person does not agree, then it will not likely amount to cybersquatting. However, if the registrant seeks a profit to transfer the name, it will likely amount to cybersquatting and would be covered by § 1129(1)(A) of the Lanham Act.

B. Shortcomings of The Existing Legal Framework

Before turning to ways in which the substance of the personality rights tort might usefully inform the development of a new PDRP, it is worth briefly surveying the shortcomings of the current trademark-focused options, in particular the UDRP. It may seem counter-intuitive to say that the UDRP has shortcomings in the personal domain name dispute context, as a number of celebrities and some politicians have used it successfully to gain control of relevant domain names. Ironically, the very success of personal domain name

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92. One permutation of this conduct that is occurring with increasing frequency, with respect to personal names and other names, involves an individual registering his own name as a domain name and then accidentally letting the registration lapse. Some online businesses quickly register lapsed domain names of all kinds and then try to extort money from selling the names back to the original registrants or to someone else with an interest in the name. See Wright, 2002 WL 1998287, at *1 (recounting how the defendant registered the plaintiff’s domain name—paulwright.com—when the plaintiff accidentally let it lapse and then attempted to resell it to the plaintiff for almost $2,000). This is basically a new form of cybersquatting that differs from traditional cybersquatting only in terms of timing. Traditional cybersquatters registered domain names in a more anticipatory way: that is, the cybersquatter would estimate what domain names would likely be valuable to “rightful owners” in the future and would register those names in the hope of extorting money for their transfer. This new permutation relates to names that have been valuable to someone in the past, and the cybersquatter hopes that that person, or someone else with a competing interest in the name, will pay significant sums for transfer of the name, after its original registration has lapsed. This conduct will be caught by the anti-cybersquatting legislation assuming that the second registrant—the cybersquatter—has no legitimate interest in the name other than seeking to make a profit from its sale back to the original owner or perhaps to someone else with an interest in the name.

complaints under the trademark-focused UDRP may evidence a problem with the current system. The major problem with the UDRP in this context is that it requires complainants to establish trademark rights in their personal names. The question as to whether a particular name has acquired such a meaning can be quite a difficult one and has generally been left to the courts within domestic trademark systems.

Asking UDRP arbitrators to resolve these questions raises several concerns. For one thing, UDRP arbitrators, unlike courts, will generally not have the benefit of detailed judicial precedent on the question of secondary meaning in front of them when making a decision. In any event, they are not

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94. See UDRP, supra note 3, ¶ 4(a) (detailing the requirement that complainants establish trademark rights in their own names). The UDRP provides:

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; and,

(ii) you have no rights or legitimate interests in respect of the domain name; and,

(iii) your domain name has been registered and is being used in bad faith.

Id. (emphasis added).

95. See 1 GILSON LALONDE, supra note 5, § 2.03[4][d] ("Just as with descriptive terms, a trademark or trade name that consists of a personal name (first name, surname, or both) is entitled to legal protection only if it attains secondary meaning.").

96. See id. (discussing various cases where courts have examined personal names for secondary meanings).

97. Although complainants under the UDRP are required to assert legitimate trademark interests, the proceedings do not require registered trademark interests, or detailed discussions of the nature of a complainant’s alleged trademark interest. The Julia Roberts arbitration is a good example of how little time is often spent on the trademarkability question with respect to a personal name. The arbitration panel in the Roberts case stated:

A recent decision citing English law found that common law trademark rights exist in an author’s name. The Policy does not require that the Complainant should have rights in a registered trademark or service mark. It is sufficient that the Complainant should satisfy the Administrative Panel that she has rights in common law trademark or sufficient rights to ground an action for passing off.

bound by judicial precedent. This has led to inconsistent, and often arbitrary or superficial, reasoning in personal domain name arbitrations.\(^98\) Secondly, the fact that the UDRP is the easiest and most cost effective avenue for domain name disputes results in most personal domain name disputes being directed to UDRP arbitrators, rather than courts.\(^99\) This compounds the difficulties for UDRP arbitrators because of the sheer volume of disputes in the personal name area they need to adjudicate without the benefit of much detailed judicial precedent on the trademarkability question.

This Part considers the development of trademark practice from the early days of the domain name system through to the adoption of the UDRP. Its aim is to illustrate how we arrived at a situation where the UDRP is, by default, the best available avenue for personal domain name disputes, despite its shortcomings. Parts III and IV then focus on how an online dispute resolution mechanism based largely on the substance of the right of publicity tort could improve matters.

1. Trademark Infringement

In the early days of the domain name system, litigants turned to existing trademark law—trademark infringement and dilution actions—to protect their valuable source-identifiers in cyberspace.\(^100\) The trademark infringement action protects a trademark holder against an unauthorized use of the mark in commerce that is likely to confuse consumers as to the source of a particular product or service.\(^101\) It was applied successfully in early domain name cases involving trademarks on the basis that unauthorized registration and use of

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\(^98\) Why, for example, should Julia Roberts and Tom Cruise be regarded as having trademark interests in their personal names when the same is not necessarily true for Bruce Springsteen or the late Anna Nicole Smith? Why should Hillary Clinton be recognized as a trademark when the same is not true for other politicians such as Kathleen Kennedy Townsend? See supra notes 12–17 and accompanying text (questioning the disparate treatment of each of the above celebrities’ UDRP claims).

\(^99\) Moreland & Springer, supra note 4, at 386 ("Prior to the establishment of ICANN Arbitration, recovery of celebrity domain names was an expensive and potentially lengthy process.").

\(^100\) See 15 U.S.C. § 1114 (2006) (providing a civil action for the infringement of registered trademarks); id. § 1125(a) (providing a civil action for the infringement of unregistered trademarks).

\(^101\) See 2 GILSON LALONDE, supra note 5, § 5.01 (noting that the general aim of trademark law is to prevent consumer confusion about the source of products or services).
domain names corresponding with someone else’s trademark would likely confuse consumers.102

There are only a few instances with disputes involving personal names.103 Perhaps personal name litigants did not feel that they could support a trademark infringement action because of concerns that they might not be able to establish a trademark interest in their names. It may also have been that the cost of judicial proceedings in trademark law was prohibitive for private individuals,104 even those most likely to be able to establish trademark interests in their own names. This is probably the reason why most disputes involving personal domain names have been brought under the faster and less expensive UDRP.105 Trademark based actions can also raise jurisdictional concerns that do not arise under the UDRP.106 The actor Kevin Spacey, for example, failed to establish personal jurisdiction over a defendant in litigation for control of the domain name <kevinspacey.com>.107 He then went on to successfully obtain control of the name in a UDRP proceeding.108

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102. See Brookfield Commc’ns, Inc. v. W. Coast Entm’t. Corp., 174 F.3d 1036, 1053–65 (9th Cir. 1999) (holding that the use of the "moviebuff.com" domain name by one video library was likely to confuse customers of one of its competitors where each had some association with an iteration of the term "Movie Buff" in its trademark); Planned Parenthood Fed’n of Am., Inc. v. Bucci, 42 U.S.P.Q.2d 1430, 1435 (S.D.N.Y. 1997) (holding that defendant’s use of the <plannedparenthood.com> domain name for messages critical of the Planned Parenthood organization was likely to confuse consumers as to the source of various services provided by the plaintiff).


104. See Litman, supra note 11, at 155 (noting the often prohibitive cost of trademark infringement and dilution litigation in early domain name disputes); Moreland & Springer, supra note 4, at 386 (“Prior to the establishment of ICANN Arbitration, recovery of celebrity domain names was an expensive and potentially lengthy process.”).

105. See Moreland & Springer, supra note 4, at 386 (“ICANN Arbitration provides an inexpensive and extremely quick means of determining domain name. In addition, celebrities have come to enjoy a very high success rate in arbitration.”).


Even in situations where the complainant is able to bear the cost of trademark litigation and can establish a trademark interest in her name, she must still satisfy the "consumer confusion" element of a trademark infringement action. Consumer confusion is the key to a successful trademark infringement suit. Many situations involving personal domain names will not involve consumer confusion in the trademark sense. It may be that a person is making unauthorized commercial use of a domain name, but it is clear that the registrant does not represent the person whose name is used in the domain name. This could happen where the registrant is simply using the name as a "draw" to attract unrelated commercial customers.

There would still be an open question in the celebrity cases at least as to whether the misleading use of the mark was "in commerce" in the sense required by trademark law. If the domain name registrant was not actually using the unauthorized website for commercial purposes in the sense of selling any goods or services, the use of the name purely to attract Internet users may not be sufficiently "in commerce" to support a trademark infringement action.

name <kevinspacey.com> from respondent to Kevin Spacey).

109. See 2 GILSON LALONDE, supra note 5, § 5.01 (noting that the general aim of trademark law is to prevent consumer confusion about the source of products or services).

110. See id. (noting trademark law's focus on the prevention of consumer confusion).

111. There may be an argument that the right of publicity should not prohibit such conduct. However, if there is something significant about protecting the integrity of individual personas online, theories of personhood as well as property would come into play, and they might support an argument for a right of publicity action, even if such an action would not arise under trademark law. For a discussion of personhood theories as a basis for the right of publicity, see generally Haemmerli, supra note 25, and McKenna, supra note 54.

112. Such conduct could amount to trademark infringement under the "initial interest confusion" doctrine or perhaps to trademark dilution. However, both of these approaches to domain name disputes under domestic trademark principles have come under attack for over-extending the boundaries of trademark law in cyberspace. For a discussion of initial interest confusion, see Lastowka, supra note 22, at 35–36. Lastowka provides:

With respect to search engines . . . a . . . significant expansion of trademark law is the doctrine of initial interest confusion. Traditionally, and not surprisingly, most courts have focused analysis of consumer confusion on the time period proximate to consumer purchases. The doctrine of initial interest confusion shifts the focus of confusion analysis to a time prior to the time of purchase. Initial interest confusion can be found to exist even if that confusion was not present at the time of purchase.

Id.; see also Goldman, supra note 21, at 559 ("[Initial interest confusion] lacks a rigorous definition, a clear policy justification, and a uniform standard for analyzing claims. With its doctrinal flexibility, [it] has become the tool of choice for plaintiffs to shut down junior users who have not actually engaged in misappropriative uses."); Jennifer Rothman, Initial Interest Confusion: Standing at the Crossroads of Trademark Law, 27 CARDOZO L. REV. 105, 121–50 (2005) (offering a broad critique of the initial interest confusion doctrine). For a discussion of dilution, see infra Part II.B.2.
There is some case law in the domain name context suggesting that any unauthorized use of a trademark as a domain name could be sufficiently "in commerce" for a trademark infringement action on the basis that the Internet by its nature is a global commercial communications medium. On this reasoning, any use of a trademarked personal name in a domain name could potentially give rise to a trademark infringement action. However, it remains to be seen whether future courts would follow this line of reasoning.

Of course, right of publicity jurisprudence also has an "in commerce" requirement which may or may not be interpreted in the same way as trademark law’s "in commerce" requirement in cyberspace. Whether or not this requirement is interpreted in the same way for the right of publicity, there is a good argument that unauthorized non-commercial uses of even a <name.com> domain name should not be proscribed under a new PDRP. These uses may well, for the most part, be purely expressive uses that are protected by the First Amendment.

113. See Planned Parenthood Fed’n of Am., Inc. v. Bucci, 42 U.S.P.Q.2d 1430, 1434 (S.D.N.Y. 1997) ("Internet users constitute a national, even international, audience, who must use interstate telephone lines to access defendant’s web site . . . . The nature of the Internet indicates that establishing a typical home page on the Internet, for access to all users, would satisfy the Lanham Act’s ‘in commerce’ requirement."). In American Libraries Association v. Pataki, 969 F. Supp. 160, 173 (S.D.N.Y. 1997), the court asserted:

   In addition, many of those users who are communicating for private, noncommercial purposes are nonetheless participants in interstate commerce by virtue of their Internet consumption. Many users obtain access to the Internet by means of an on-line service provider, such as America Online, which charges a fee for its services. "Internet service providers," including plaintiffs Panix, Echo, and NYC NET, also offer Internet access for a monthly or hourly fee. Patrons of storefront "computer coffee shops," such as New York’s own CyberCafe, similarly pay for their access to the Internet, in addition to partaking of food and beverages sold by the cafe. Dial-in bulletin board systems often charge a fee for access.

Id.

114. See Lastowka, supra note 22, at 64 ("[I]t is not clear how Bucci had used the Planned Parenthood mark in commerce, given that he was not selling anything. Those who advocate for an expansion of trademark use often criticize Bucci for this reason.").

115. See 1 GILSON LALONDE, supra note 5, § 2.16[1] ("The right of publicity . . . is the right of an individual to control the commercial use of his or her name, likeness, signature, or other personal characteristics.") (emphasis added).

116. The balance of First Amendment rights against personality rights in personal domain names is considered further in Part IV.
2. Trademark Dilution

Trademark dilution also has limited application to personal domain name disputes because of its requirement of a trademark interest in the personal name, and because of the time, cost and jurisdictional problems often associated with litigation. Dilution differs from trademark infringement in that it is not focused on the prevention of consumer confusion and, therefore, does not require a showing of consumer confusion on the part of the plaintiff.\textsuperscript{117} Rather, it protects famous marks\textsuperscript{118} from blurring\textsuperscript{119} or tarnishment.\textsuperscript{120} Dilution at the federal level is designed to prevent people from creating "noise" around a mark that might have the effect of lessening the strength of the mark in terms of its capacity to identify the plaintiff’s goods or services.\textsuperscript{121} Thus, a dilution action could prevent the sale of Sony potato chips as potentially dilutive of the

\textsuperscript{117} See 15 U.S.C. § 1125(c)(1) (2006) (providing injunctive relief to victims of trademark dilution without requiring a showing of consumer confusion). Section 1125(c)(1) applies only to names or marks that are "distinctive" and can only be employed when the defendant has used the name in commerce. \textit{Id.} Most personal domain name disputes probably will not satisfy these requirements.

\textsuperscript{118} See \textit{id.} § 1125(c)(2)(A) (defining "famous mark").

[A] mark is famous if it is widely recognized by the general consuming public of the United States as a designation of source of the goods or services of the mark’s owner. In determining whether a mark possesses the requisite degree of recognition, the court may consider all relevant factors, including the following: (i) The duration, extent, and geographic reach of advertising and publicity of the mark, whether advertised or publicized by the owner or third parties; (ii) The amount, volume, and geographic extent of sales of goods or services offered under the mark; (iii) The extent of actual recognition of the mark . . . .

\textit{Id.}

\textsuperscript{119} See \textit{id.} § 1125(c)(2)(B) (defining "blurring" as an "association arising from the similarity between a mark or trade name and a famous mark that impairs the distinctiveness of the famous mark").

\textsuperscript{120} See \textit{id.} § 1125(c)(2)(C) (defining "tarnishment" of a famous mark as an "association arising from the similarity between a mark or trade name and a famous mark that harms the reputation of the famous mark").

\textsuperscript{121} See 2 \textsc{Gilson Lalonde}, \textit{supra} note 5, § 5A.01[1] (discussing federal dilution law). Gilson Lalonde provides:

Federal dilution law protects famous trademarks from unauthorized uses that are likely to impair their distinctiveness or harm their reputation. It enables owners of those marks to maintain their value as source indicators and as symbols of good will. While the law benefits only famous trademarks, it adds a potent weapon against the whittling away of the hard-to-measure distinctive quality of those marks.

\textit{Id.; see also} Lemley, \textit{supra} note 22, at 1698–99 ("Dilution laws are directed against the possibility that the unique nature of a mark will be destroyed by companies who trade on the renown of the mark by selling unrelated goods, such as Kodak pianos or Buick aspirin.").
Sony corporation’s marks for audio-visual and electronic equipment. 122 There is a non-commercial use exception from trademark dilution liability. 123 Additionally, under revisions to the Lanham Act in 2006, there is an expanded fair use defense that contemplates various forms of commentary on a trademark holder as a defense to the action. 124

Trademark dilution actions were used successfully by trademark holders in the early days of the domain name system. 125 These actions were particularly effective in cases involving cybersquatters. 126 This is because the use of someone else’s trademark in a domain name for no particular purpose other than to sell the name to the trademark holder—or perhaps to a competitor of the trademark holder—could be said to be creating noise around the mark in the dilution sense. Early courts held that a domain name corresponding to a trademark is integral to a business’s ability to engage in commerce on the Internet such that cybersquatting on such a name would be prohibited as interfering with this ability. 127

However, a dilution action requires that the plaintiff establish not only a trademark interest, but also that she holds a famous mark. 128 Despite the fact that it has historically been reasonably easy in practice for commercial plaintiffs to establish that their mark is sufficiently famous to bring a dilution action, 129 this may not be the case with respect to personal names. Personal

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122. See Lemley, supra note 22, at 1698 (explaining that dilution laws prohibit individuals or business entities from using famous trademarks to sell unrelated goods at the expense of the trademark owner).


124. See id. § 1125(c)(3)(A)(ii) (excluding "parodying, criticizing, or commenting upon the famous mark owner or [the owner’s] goods or services" from actionable conduct under federal dilution law).

125. See, e.g., Panavision Int’l, L.P. v. Toeppen, 141 F.3d 1316, 1327 (9th Cir. 1998) (finding trademark dilution in an action against cybersquatter who was not using the name for any purpose other than attempting to sell it to the corresponding trademark holder).

126. For an example of a successful action, see id.

127. See id. at 1327 ("We reject [defendant’s] premise that a domain name is nothing more than an address. A significant purpose of a domain name is to identify the entity that owns the web site. . . . [Defendant’s] use of Panavision.com also puts Panavision’s name and reputation at his mercy.").

128. See 15 U.S.C. § 1125(c)(1) (2006) (requiring a plaintiff in a federal dilution action to establish that she holds a famous mark); id. § 1125(c)(2)(A) (defining "famous mark").

129. See Lemley, supra note 22, at 1698–99 ("[C]ourts applying the state and federal dilution statutes have been quite willing to conclude that a local favorite, or a rather obscure company, is famous within the meaning of the Act. . . . Worse, many courts seem willing to find dilution without even inquiring into the fame of the mark."). However, since the enactment of
names are often not trademarks at all, even with respect to some rather well-known celebrities. Recent amendments to the federal dilution statute may make it more difficult for individuals, even famous individuals, to establish that their personal names operate as famous marks. The new definition of "famous mark" inserted into the Lanham Act in October 2006 contemplates the notion of a famous mark in very consumer-oriented terms with respect to the source of goods or services. Many famous individuals’ names will not, in fact, operate in this way. Thus, it may be more difficult, in theory at least, for a plaintiff to establish trademark dilution with respect to a personal name than even to establish trademark infringement. Celebrities to one side, presumably most politicians, public figures, and private individuals will not be able to show marks at all, or at least marks with sufficient fame, to bring a successful dilution action. This, coupled with the costs of litigation, makes a trademark dilution action an inappropriate and unlikely avenue for the future resolution of personal domain name disputes.

130. See Smith v. DNS Research, Inc., National Arbitration Forum Claim No. FA0312000220007, 2004 WL 2358216 (Feb. 21, 2004) (Davis, Arb.), available at http://www.adrforum.com/domains/decisions/220007.htm ("[T]he mere fact of having a successful career as an actress, singer or TV program star does not provide exclusive rights to the use of a name under the trademark laws."); Springsteen v. Burgar, WIPO Arbitration and Mediation Center Case No. D2000-1532, 2001 WL 1705212, § 6 (Jan. 25, 2001) (Harris & Froomkin, Arbs.), available at http://www.wipo.int/amc/en/domains/decisions/html/2000/d2000-1532.html ("It appears to be an established principle . . . [that] . . . [celebrities'] names can acquire a distinctive secondary meaning giving rise to rights equating to unregistered trade marks (sic) . . . [but] it is by no means clear from the UDRP that it was intended to protect proper names of this nature."); Sumner v. Urvan, WIPO Arbitration and Mediation Center Case No. D2000-0596, 2000 WL 33939204, ¶ 6.5 (July 24, 2000) (Christie, Arb.), available at http://www.wipo.int/amc/en/domains/decisions/html/2000/d2000-0596.html ("In the opinion of this Administrative Panel, it is doubtful whether the Uniform Policy is applicable to this dispute. Although it is accepted that the Complainant is world famous under the name STING, it does not follow that he has rights in STING as a trademark or service mark."); see also Moreland & Springer, supra note 4, at 390–92 (comparing UDRP arbitrations where celebrities have not been able to establish trademark rights in their personal names).

131. See supra note 129 and accompanying text (discussing the possible effects of the TDRA).

3. The Anti-Cybersquatting Consumer Protection Act, and California’s Business and Professions Code

The Anti-Cybersquatting Consumer Protection Act (ACPA) was enacted in 1999 to address some of the specific concerns of trademark holders in relation to cybersquatting.133 It is focused on protecting trademarks in cyberspace, although it does make some specific provision for personal names—the only law to have done so in the Internet context.134 The ACPA inserted two new provisions into the Lanham Act—one directed at the prevention of cybersquatting with respect to trademarks135 and the other directed at the prevention of cybersquatting with respect to personal names.136 Both provisions prohibit the registration of a domain name with a bad faith profit motive where there is no other legitimate purpose for using the name.137 Again, the trademark-focused provision is of limited use to personal name holders because many personal names will not be trademarks.138 However, the personal name provision139 is available to people who are concerned about cybersquatters registering their names as domain names.140 This should provide


135. See id. § 1125(d) (prohibiting the bad faith usage, registration, or trafficking of domain names which infringe on another’s trademark rights).

136. See id. § 1129(1)(a) (creating a cause of action for any famous individual against "[a]ny person who registers a domain name that consists of the [famous person’s] name . . . without that person’s consent, with the specific intent to profit from such name" by selling the domain name).

137. Registering, trafficking, or using a domain name in bad faith for a profit are prohibited by id. § 1125(d)(1)(A)(ii), while id. § 1129(1)(A) contemplates an attempted sale of the name in bad faith.

138. See 1 GILSON LALONDE, supra note 5, § 2.03[4][d] ("Just as with descriptive terms, a trademark or trade name that consists of a personal name (first name, surname, or both) is entitled to legal protection only if it attains secondary meaning.").

139. See supra note 136 and accompanying text (defining the personal name provision).

some comfort to those concerned about having to pay exorbitant sums of money for return of a name that should "rightfully" be theirs. However, interestingly, the provision has not been utilized much in practice, particularly in comparison with the UDRP. This is probably because the UDRP is faster and cheaper, even though it is premised on the existence of a trademark interest.

One significant limitation of the ACPA is that it does not cover situations where the registrant is not a cybersquatter but is using a domain name for some other purpose which may be commercial, or may be expressive, or may be a combination of both. Some registrants of <name.com> names will use them to attract commercial customers, through advertising, for example. If they can make more money by doing this than by selling the name, they will not be a


The Panel finds that the protection of an individual politician’s name, no matter how famous, is outside the scope of the Policy since it is not connected with commercial exploitation as set out in the Second WIPO Report. This does not mean that Complainant is without remedy. The ACPA contains express provisions protecting the rights in personal names. Complainant is free to pursue her claims in that forum. And, as mentioned, the committee may have rights in the marks that are sufficiently commercial as to entitle the committee to protection under the Policy.

Id.

141. See Moreland & Springer, supra note 4, at 386 (noting the high success rate of celebrities in personal domain name disputes under the UDRP); id. at 394 ("A plethora of disputes involving personal names have been submitted to ICANN Arbitration.").

142. See id. at 385 ("ICANN Arbitration provides an inexpensive and extremely quick means of recovering a domain name.").

143. See Miriam Claire Beezy, Good Marksmanship, 29 L.A. LAW. 20, 24 (2006) (discussing how some cybersquatters may avoid trademark infringement liability). Beezy provides:

[T]he distinction between cybersquatter and cybergriper—that is, the difference between bad faith registration and the use of a domain name that incorporates another’s mark and permissible registration and use, albeit unauthorized, of another’s mark—will become difficult to discern. Relying on First Amendment or fair use defenses, sophisticated cybersquatters are certain to create visually impressive gripe sites in a manipulative attempt to blur the line between free speech and trademark infringement.

Id.

144. See Jacqueline Lipton, Clickfarming: The New Cybersquatting?, 12 J. INTERNET L. 1, 12 (2008) (examining the extent to which current regulations cover situations in which "the use of a domain name corresponding to another person’s trademark or personal name [is used by another person] to gain advertising revenues through click-on advertisements").
Unauthorized uses of personal domain names for purely expressive purposes raise more difficult policy questions. Should there be an overriding presumption that <name.com> names in particular "rightfully" belong to people with corresponding names, regardless of the use a registrant is making of the domain name? Such a presumption may well trample on First Amendment concerns where the registrant’s use of the name is purely expressive.

Issues of First Amendment rights versus the rights of trademark holders have arisen already in trademark disputes that do not involve personal names. For example, some UDRP arbitrators have suggested that legitimate commentary about a trademark holder should be protected on the Internet. This might include allowing an unauthorized use of a domain name that corresponds in some way with a registered trademark for, say, a gripe site about the trademark holder. However, judges and arbitrators in the trademark context have not generally accepted that commentators should be allowed to utilize the most intuitive domain name corresponding to the trademark—that is, the <trademark.com> version of the name. They have been relegated to "lesser" forms of the domain name, such as those using a different generic Top

145. See 15 U.S.C. § 1129(1)(A) (2006) (including as cybersquatters only those "with the specific intent to profit from [another’s] name by selling the domain name for financial gain to that person or any third party}).

146. See Bridgestone Firestone, Inc. v. Myers, WIPO Arbitration and Mediation Center Case No. D2000-0190, 2000 WL 33674384, § 6 (July 6, 2000) (Haviland, Arb.), available at http://www.wipo.int/amc/en/domains/decisions/html/2000/d2000-0190.html ("[T]he exercise of free speech for criticism and commentary . . . demonstrates a right or legitimate interest in the domain name under Paragraph 4(c)(iii). The Internet is above all a framework for global communication, and the right to free speech should be one of the foundations of Internet law.").

147. See id. (declining to find bad faith registration, an essential element of a UDRP claim, when defendant registered the domain name <bridgestone-firestone.net> for the purpose of complaining about the complainant’s products and policies). There is some judicial authority suggesting the same thing. For example, see Bosley v. Kremer, 403 F.3d 672, 679–80 (9th Cir. 2005), where the court provided:

Kremer is not Bosley’s competitor; he is their critic. His use of the Bosley mark is not in connection with a sale of goods or services—it is in connection with the expression of his opinion about Bosley’s goods and services. The dangers that the Lanham Act was designed to address are simply not at issue in this case. The Lanham Act . . . does not prohibit all unauthorized uses of a trademark . . . . Any harm to Bosley arises not from a competitor’s sale of a similar product under Bosley’s mark, but from Kremer’s criticism of their services. Bosley cannot use the Lanham Act either as a shield from Kremer’s criticism or as a sword to shut Kremer up.

148. See Bridgestone Firestone, Inc., 2000 WL 33674384, § 6 (explaining that the use of a <trademark.com> domain name by a third party is more likely to make him or her liable for cybersquatting than would the use of a <trademark.net> domain name).
Level Domain (gTLD) such as <.org> or <.net>, or those using a "qualifier" at the end of the domain, such as <trademarksucks.com>. There perhaps is, or should be, a presumption that well-known people such as celebrities and public figures do have rights to the <name.com> versions of their names if this is an identifiable Internet usage norm. If this presumption is correct, the ACPA will not assist with its development or enforcement because of its focus on cybersquatting, as opposed to web commentary.

Interestingly, one state—California—has experimented with legislation directed at personal name cybersquatting. Section 17525(a) of California's Business and Professions Code provides that:

It is unlawful for a person, with a bad faith intent to register, traffic in, or use a domain name, that is identical or confusingly similar to the personal name of another living person or deceased personality, without regard to the goods or services of the parties.

This legislation is broader than § 1129(1)(A) of the Lanham Act in that it contemplates deceased as well as living persons and that it contains a list of "bad faith factors" that includes an intention on the part of the registrant to "mislead, deceive, or defraud voters." This may be relevant to situations where a politician is complaining about unauthorized use of her name in a corresponding domain name, at least if the use of the name is misleading or fraudulent in some way. However, it is an open question as to whether the

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149. See id. (noting the federal cases in which domain names consisting of a trademark followed by a pejorative qualifier, e.g., <trademarksucks.com>, have been found not to violate cybersquatting laws). However, some arbitrators have held that even domain names employing pejorative qualifiers should be in the control of the trademark holder rather than anyone else. See, e.g., Société Air France v. Virtual Dates, Inc., WIPO Arbitration and Mediation Center Case No. D2005-0168, 2005 WL 5143242, ¶ 7 (May 24, 2005) (Wallberg & Le Stanc, Arbs.), available at http://www.wipo.int/amc/en/domains/decisions/html/2005/d2005-0168.html (deciding that the <airfrancesucks.com> domain name should be transferred to the trademark holder and ought not be controlled by a gripe site operator).


152. Id. § 17525(a).

153. Id. § 17526(j).

154. On this point, see CAL. ELEC. CODE § 18320 (West 2008), which prohibits certain activities described as "political cyberfraud." This legislation, although not specifically targeted at personal name protection, may have the same results in practice as the Business and Professions Code with respect to some uses of politicians' names in the lead-up to elections. For a more general discussion of the operation of both Californian statutes in the political domain name context, see Lipton, supra note 63, at 60–84, in which Lipton discusses the shortcomings of current domain name law in the political context.
legislation would, or indeed should, cover pure political gripe sites, such as the
<bobkeenan.com> and <lindamcculloch.com> examples described in Part
II.A.2. This is because a legitimate criticism of a politician may not be
regarded as misleading, deceiving or defrauding voters, provided it is clear
from the context that these websites are not endorsed by the politician in
question. On the other hand, if the view is taken that using a <name.com>
domain name for a website other than that authorized by the person in question
is automatically a misleading use of the name because Internet users would
expect the domain name to resolve to an authorized website, then the section
might have some application.

4. The Uniform Domain Name Dispute Resolution Policy

This brings us back to the most popular avenue for personal domain name
disputes—<sup>155</sup>—the UDRP—which was adopted at the same time that the ACPA
was enacted. The UDRP is global in scope because of its incorporation into
relevant domain name registration agreements.<sup>156</sup> It thus does away with some
of the jurisdictional problems inherent in both trademark- and personality
rights-based litigation.<sup>157</sup> Again, the UDRP is aimed at preventing

<sup>155</sup> See Beezy, supra note 143, at 23–24 (noting high success rate of celebrities in
personal domain name proceedings under the UDRP and surveying some of the recent
decisions); Moreland & Springer, supra note 4, at 394 (“A plethora of disputes involving
personal names have been submitted to ICANN Arbitration.”).

<sup>156</sup> See UDRP, supra note 3, at Note 2 (“This policy has been adopted by all accredited
domain-name registrars for domain names ending in .com, .net, and .org. It has also been
adopted by certain managers of country-code top-level domains (e.g., .nu, .tv, .ws).”). The
UDRP further states:

This Uniform Domain Name Dispute Resolution Policy (the "Policy") has been
adopted by the Internet Corporation for Assigned Names and Numbers ("ICANN"),
is incorporated by reference into your Registration Agreement, and sets forth the
terms and conditions in connection with a dispute between you and any party other
than us (the registrar) over the registration and use of an Internet domain name
registered by you.

<sup>Id. ¶ 1.</sup>

<sup>157</sup> See, e.g., Wright v. Domain Source, Inc., No. 02 C 2525, 2002 WL 1998287, at *2–4
(N.D. Ill. Aug. 27, 2002) (discussing jurisdictional issues raised in complaint against
cybersquatter’s registration of <paulwright.com> domain name).

The movie actor Kevin Spacey was also initially unsuccessful in a cybersquatting claim
against the registrant of <kevinspacey.com> on jurisdictional grounds, but later succeeded
under a UDRP proceeding. McCarthy, supra note 107. For completeness, it should also be
noted that the ACPA contains some in rem provisions to simplify jurisdictional issues for
offended trademark owner to "file an in rem civil action against a domain name in the judicial
The two major hurdles for personal domain name complainants under the UDRP are that: (a) a trademark must be established in the personal name, and (b) the UDRP will only apply to cybersquatting. The UDRP contains a specific defense for domain name registrants "making a legitimate noncommercial or fair use of the domain name." It has not been clear what will constitute "fair use" in this context, although noncommercial use should be relatively easy to identify in practice. Further, it is unclear whether the UDRP is intended to cover personality rights in individual names. A World Intellectual Property Organization ("WIPO") Report on the subject specifically suggested that these rights are not covered under the UDRP. However, some UDRP arbitrators have felt that in the absence of any specific prohibition on the protection of such rights, they are covered by the UDRP. Thus, to the extent that complainants are specifically basing claims on personality interests rather than trademark rights, there is some confusion as to whether they should be successful in the absence of a trademark right.

158. See UDRP, supra note 3, ¶ 4(a) ("You are required to submit to a mandatory administrative proceeding in the event that a third party (a ‘complainant’) asserts to the applicable Provider . . . that (i) your domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights . . . .").

159. See Beezy, supra note 143, at 24–25 ("[T]he distinction between cybersquatter and cybergriper—that is, the difference between bad faith registration and the use of a domain name that incorporates another’s mark and permissible registration and use, albeit unauthorized, of another’s mark—will become difficult to discern."); Moreland & Springer, supra note 4, at 390–92 (noting that the UDRP will not assist a complainant where a domain name registrant is using a domain name for commentary or otherwise to refer to the complainant in a legitimate manner).

160. UDRP, supra note 3, ¶ 4(c)(iii).

161. See Moreland & Springer, supra note 4, at 394–95 (citing WIPO report to the effect that personality rights were never intended to be covered by the UDRP).

162. See WIPO REPORT, supra note 63, ¶ 199 ("Persons who have gained eminence and respect, but who have not profited from their reputation in commerce, may not avail themselves of the UDRP to protect their personal names against parasitic registrations.").

163. See id. ¶¶ 181–84 (surveying decisions in which UDRP arbitrators have ordered transfers of domain names based on personal names); Spacey v. Alta. Hot Rods, National Arbitration Forum Claim No. FA02050000114437, 2002 WL 1832705 (Aug. 1, 2002) (Meyerson, Buchele & Harris Arbs.), available at http://www.adrforum.com/domains/decisions/114437.htm ("Respondent has argued that . . . ‘personality’ disputes are outside the scope of the Policy. . . . Because the Policy does not purport to exclude the category of disputes involving personality rights, we join the many other Panels that have recognized that the Policy does, indeed, protect such interests.").

164. See, e.g., Spacey, 2002 WL 1832705 (deciding that the text of the UDRP is not ambiguous as to personality rights and refusing to exclude personality rights from the Policy on
The current application of the UDRP to personal domain name disputes is certainly confused in terms of the scope of the policy over personal names. Some arbitrators are more prepared to recognize protectable interests in personal names than others, usually on the basis of an unregistered trademark right. Julia Roberts and Tom Cruise were found to have trademark interests in their personal names, but a majority panel of UDRP arbitrators felt that Bruce Springsteen did not likely have such rights. A UDRP arbitrator also held that the late Anna Nicole Smith was not sufficiently famous to assert a trademark interest in her personal name. In the political context, "Hillary Clinton" has been recognized as a trademark under the UDRP, but the same was not true for the Maryland gubernatorial candidate, and former lieutenant governor, Kathleen Kennedy Townsend.


166. See Springsteen v. Burgar, WIPO Arbitration and Mediation Center Case No. D2000-1532, 2001 WL 1705212, § 6 (Jan. 25, 2001) (Harris & Froomkin, Arbs.), available at http://www.wipo.int/amc/en/domains/decisions/html/2000/d2000-1532.html ("It should be noted that no evidence has been given of the name Bruce Springsteen having acquired a second meaning. . . . In the view of this Panel, it is by no means clear from the UDRP that it was intended to protect proper names of this nature.").

167. See Smith v. DNS Research, Inc., National Arbitration Forum Claim No. FA0312000220007, 2004 WL 2358216 (Feb. 21, 2004) (Davis, Arb.), available at http://www.adrforum.com/domains/decisions/220007.htm ("The cases require a clear showing of high commercial value and significant recognition of the name as solely that of the performer. . . . The Panel does not believe Complainant’s name has yet reached that level of fame.").


Although one could attempt some factual distinctions, it appears that Roberts, Cruise, Springsteen and the late Anna Nicole Smith are all basically entertainers who do not sell products or services under their names in a trademark sense, unless you consider their names to be marks for the movies or television shows they appear in, or the songs they perform.\textsuperscript{170} If the marks work in this way, it is not clear why Bruce Springsteen would not be a mark in the same way as Julia Roberts and Tom Cruise. A UDRP arbitrator recognized a trademark interest in Hillary Clinton’s name partly on the basis that she had authored books under her name.\textsuperscript{171} If this is the basis for a trademark interest in a personal name, shouldn’t “Bruce Springsteen” also be a trademark as the writer and performer of songs? If the test for trademarkability relates to whether a person has written a song or book or appeared in a movie, then would this not lead to peculiar results? For example, would all politicians and public figures have to write an autobiography in order to achieve protected trademark status for their personal names under the UDRP? What about merchandising to establish trademark rights?\textsuperscript{172} At the time of this writing, Senator Barack Obama was selling a series of "Obama 2008" merchandise on his campaign website,\textsuperscript{173} as was Senator Hillary Clinton with respect to her own presidential bid.\textsuperscript{174} Would the use of the Senators’ respective names on t-shirts, blankets, and keyrings amount to a trademark use?\textsuperscript{175}

\begin{itemize}
\item \textsuperscript{170} See Verna, supra note 36, at 170–71 (questioning why certain famous personalities are able to establish trademark rights in their personal names for UDRP purposes while others are not).
\item \textsuperscript{171} See Clinton, 2005 WL 853535 (deciding that Senator Clinton has an unregistered trademark right in her personal name in connection with both her political activities and her career as an author of a number of books sold in commerce).
\item \textsuperscript{172} See Stacey Dogan & Mark Lemley, The Merchandising Right: Fragile Theory or Fait Accompli? 54 EMORY L.J. 461, 464–65 (2005) [hereinafter Dogan & Lemley, Merchandising Right] (describing the merchandising right as the protected use of a trademark not as a source indicator but as a desirable feature of a product); Dogan & Lemley, supra note 28, at 1175–78 (discussing the merchandising right in trademark law).
\item \textsuperscript{175} In Senator Obama’s case, it should be noted that he has already authored two books. Thus, Senator Obama arguably already has trademark rights in his personal name. \textit{ Cf.} Clinton v. Dinoia, National Arbitration Forum Claim No. FA0502000414641, 2005 WL 853535 (Mar. 18, 2005) (Atkinson, Arb.), \textit{available at} http://www.adrforum.com/domains/decisions/414641.htm (granting Senator Clinton an unregistered trademark right in her personal name partly in connection with her career as an author of a number of books sold in commerce). 
\end{itemize}
Obviously rules relating to the protection of trademark interests are not automatically geared towards protecting personal names, although they may cover personal names in some cases.\textsuperscript{176} Creating a new PDRP that replaces the UDRP’s trademark focus with a personality rights model would help here. It would lead to more predictable results, and to the development of a more nuanced jurisprudence geared to balancing the integrity of individual personas against other interests such as free speech. It would remove the need for arbitrators to explain why certain individuals should have trademark rights in their personal names while others would not. In so doing, it would prevent an inappropriate expansion of trademark law into the personal name context in cyberspace.

\section*{III. Personality Rights}

\subsection*{A. The Right of Publicity and Personal Name Disputes}

The right of publicity has been described as "the right of an individual to control the commercial use of his or her name, likeness, signature, or other personal characteristics."\textsuperscript{177} It derives originally from the right of privacy.\textsuperscript{178} Admittedly, this genesis has caused some confusion about the scope of the modern day tort, which covers both privacy and some property-like aspects of an individual’s persona.\textsuperscript{179} Over the years, the right has developed in different

\\textsuperscript{176}. The obvious case is where the personal name is, in fact, used as a trademark in a business context. See, e.g., Trudeau v. Lanoue, No. 04 C 7165, 2006 WL 516579, at *1 (N.D. Ill. Mar. 2, 2006) (discussing Mr. Kevin Trudeau’s name as a domain name); Schmidheiny v. Weber, 285 F. Supp. 2d 613, 628 (E.D. Pa. 2003) (ordering the transfer of the domain name <schmidheiny.com> to Stephan Schmidheiny).

\textsuperscript{177}. 1 GILSON LALONDE, supra note 5, § 2.16[1].

\textsuperscript{178}. Id. § 2.16[5]; see also id. § 2.16[1][a] ("[S]ome courts view the right of publicity as a direct descendant of the right of privacy."); Haemmerli, supra note 25, at 406 ("It is worth asking . . . why the doctrinal confusion is so extreme. One reason is that . . . [the right of publicity] may have taken a wrong turn forty-six years ago, when Second Circuit Judge Jerome Frank severed the right of publicity from the right of privacy."); Madow, supra note 55, at 167 ("As Thomas McCarthy tells the story, the right of publicity was ‘carved out of the general right of privacy’—‘like Eve from Adam’s rib’ . . . [T]his simile is . . . misleading. The right of publicity was created not so much from the right of privacy as from frustration with it." (quoting J. THOMAS MCCARTHY, THE RIGHTS OF PUBLICITY AND PRIVACY § 5:61 (2nd ed. 2006))).

\textsuperscript{179}. See Haemmerli, supra note 25, at 407–08 (discussing the development of the right of publicity). Haemmerli states that:

The doctrine . . . developed in a schizoid manner: publicity rights were purely economic property rights, as distinct from "personal" privacy rights (thereby enabling publicity rights to become transferable and descendible); but publicity rights, even though economic in nature, were also part of the tort of invasion of
states sometimes as a matter of common law, and sometimes under state legislation. High profile examples include situations relating to unauthorized uses of Elvis Presley’s name and likeness after his death, John Wayne’s likeness on greeting cards, Martin Luther King Jr.’s likeness on unauthorized plastic busts, Rosa Parks’s name as a song title, Arnold Schwarzenegger’s likeness as a bobblehead doll, and Rudolph Giuliani’s likeness on an advertisement run on city buses in New York City.

privacy, thereby implying that they should be viewed as a species of personal privacy rights, and as such nonassignable and nondescendible.

Id.; see also Dogan & Lemley, supra note 28, at 1208–09 (noting that privacy-based justifications for right of publicity are legitimate and are different from the economic trademark rationale for publicity rights).

180. Kentucky, for example, has a common law basis for the right of publicity. See Dinwoodie & Janis, supra note 30, at 823–27, for a discussion of Kentucky’s long-standing recognition of invasion of privacy as an actionable tort under the state’s common law.

181. See, e.g., IND. CODE ANN. § 32-36-1-7 (West 2002) (“As used in this chapter, ‘right of publicity’ means a personality’s property interest in the personality’s: name; voice; signature; photograph; image; likeness; distinctive appearance; gestures; or mannerisms.”).


183. See Madow, supra note 55, at 141–45 (discussing the objections of John Wayne’s children to the use of John Wayne’s picture on a greeting card sold mostly in gay bookstores as offensive to his conservative macho image).

184. See Martin Luther King, Jr., Ctr. for Soc. Change, Inc. v. Am. Heritage Prods., 694 F.2d 674, 675–76 (11th Cir. 1993) (involving a suit on behalf of the estate of Martin Luther King, Jr. which sought an injunction to prevent the defendant from selling plastic busts of Dr. King).

185. See Parks v. LaFace Records, 329 F.3d 437, 441–43 (6th Cir. 2003) (involving publicity rights of Rosa Parks in the context of a song title using her name in relation to a hip-hop recording that had nothing in particular to do with her or her work).

186. See William T. Gallagher, Strategic Intellectual Property Litigation, the Right of Publicity, and the Attenuation of Free Speech: Lessons from the Schwarzenegger Bobblehead Doll War (and Peace), 45 SANTA CLARA L. REV. 581, 583 (2005) (arguing that the bobblehead producers would have prevailed, based upon the First Amendment, had the case gone to trial and asserting that the plaintiff’s theory of the case was "legally unsustainable because it presumed that the plaintiff had an almost absolute right to control the use of Schwarzenegger image"); Charles J. Harder & Henry L. Self III, Schwarzenegger vs. Bobbleheads: The Case for Schwarzenegger, 45 SANTA CLARA L. REV. 557, 558 (2005) (arguing that any politician has as much right as any other person to control "the commercial use of his name, image and identity"); David S. Welkowitz & Tyler T. Ochoa, The Terminator As Eraser: How Arnold Schwarzenegger Used the Right of Publicity to Terminate Non-Defamatory Political Speech, 45 SANTA CLARA L. REV. 651, 652 (2005) (arguing that basic flaws in the current analysis of celebrity right of publicity actions led to the suppression of free speech in the Schwarzenegger case).

Because the right is arguably based both on aspects of property theory and aspects of personhood, it is uniquely able to protect individual personas in ways that more purely economically based laws—such as trademark law—cannot. Most importantly, it protects aspects of an individual’s persona regardless of commercial trademark rights in the person’s name. It can thus protect personas of celebrities, public figures, and private individuals against unauthorized commercial exploitations. Past practices have demonstrated that the combination of interests people want to protect in their names online corresponds to the same mixture of morally and economically based protections derived from the right of publicity. A PDRP based on personality rights theory can draw on the policy justifications underpinning protection of an individual’s persona against unauthorized use. This would include protections of an individual’s online privacy and support the notion that individuals should have some economic control of at least the <name.com> versions of their personal names.

Metropolitan Transit Authority refused to run advertisements on city buses that used the slogan "Possibly the only good thing in New York Rudy hasn’t taken credit for"), aff’d in part, vacated in part, 136 F.3d 123 (2nd Cir. 1998). Mayor Giuliani ultimately failed in his appeal on free speech grounds. See N.Y. Magazine v. Metro. Transit Auth., 136 F.3d 123, 131 (2nd Cir. 1998) ("[P]rotecting the right to express skeptical attitudes toward the government ranks among the First Amendment’s most important functions."). The right of publicity tort has been also extended to "lookalikes" and "soundalikes" of famous people. See generally Waits v. Frito-Lay, Inc., 978 F.2d 1093 (9th Cir. 1992) (discussing the imitation of Tom Waits’s distinctive singing voice in an advertising campaign); White v. Samsung Elecs. Am., Inc., 971 F.2d 1395 (9th Cir. 1992) (addressing the use of a Vanna White lookalike robot in a television commercial); Midler v. Ford Motor Co., 849 F.2d 460 (9th Cir. 1988) (discussing the imitation of Bette Midler’s singing voice in an advertising campaign).

188. See supra note 54 and accompanying text (discussing numerous commentators’ views on the relationship between the right of publicity and property theory).

189. See supra note 56 and accompanying text (discussing numerous commentators’ views on the relationship between the right of publicity and aspects of personhood and privacy).

190. These interests include both economic rights, to control the value of personas in cyberspace (e.g., Prince threatening legal action against unauthorized fan sites’ exploitation of images and information about him) as well as individual privacy rights (e.g., the desires of some celebrities to prevent anyone using a <name.com> version of their personal name, such as Julia Roberts and Tom Cruise).

191. See 1 Gilson Lalonde, supra note 5, § 2.16[5] (noting different courts’ approaches to treating the right of publicity either as a property-based or a privacy-based right); Kwall, supra note 54, at 36–37 ("The author has argued elsewhere that ‘the unauthorized use of an individual’s persona potentially poses the maximum harm when the persona is being appropriated . . . for an objectionable purpose. . . .’ [S]ome celebrities still might want to pursue the limelight . . . , other celebrities, particularly those with strong moral philosophies, might not.” (quoting Roberta Rosenthal Kwall, The Right of Publicity vs. The First Amendment: A Property and Liability Rule Analysis, 70 Ind. L.J. 47, 70 (1994))); supra note 179 and accompanying text (discussing the right of publicity).
Another advantage of personality rights theory is that it can effectively address situations that fall somewhere in between privacy, defamation, copyright, and trademark law. Consider, for example, a case where a person manufactures and sells an unauthorized coffee mug bearing a photograph of Britney Spears. It may be difficult for Ms. Spears to bring an invasion of privacy action when her persona has been developed largely for public consumption. In other words, it is hard to claim invasion of privacy for something that she herself has put into public view—her image and likeness—unless the image on the coffee mug was taken in an unauthorized private context: for example, by a photographer using a telephoto lens to shoot her in the privacy of her own home. Further, if the coffee mug does not suggest anything defamatory about Ms. Spears, there will be no remedy in defamation law. Copyright also will be an unlikely avenue for Ms. Spears unless she can bring a copyright infringement action with respect to the photograph in question. She does not hold a copyright interest in her own person, although she may own the copyright in a particular photograph.

Trademark law, as we know, is also potentially problematic here. Trademark law protects source indicators of products and services to prevent consumer confusion and to encourage investment in developing those products.

192. See Madow, supra note 55, at 168–69 ("Claims of . . . emotional injury [under privacy law] were not nearly as convincing when they came from celebrities . . . . [H]ow could a movie star or professional athlete, who had deliberately . . . sought the limelight, complain of embarrassment or hurt feelings when an advertiser or merchantiser simply gave his face some additional publicity?").

193. See id. (discussing the unconvincing nature of celebrities’ claims of emotional injury under privacy law); Dogan & Lemley, supra note 28, at 1171 (noting that privacy actions were not generally much use to celebrities because they were regarded as having purposely sought out the limelight so there was no obvious invasion of privacy); Kwall, supra note 54, at 36 ("Some courts . . . hold that celebrities cannot maintain right-of-privacy actions, although this view is not universal.").

194. For a summary of the genesis of privacy rights based on media intrusion into personal space, see Madow, supra note 55, at 167–70.

195. Kwall, supra note 54, at 36 ("Another significant disadvantage [for celebrities protecting their personality rights] derives from the law of defamation, under which celebrities enjoy less protection than other citizens. Defendants in defamation actions involving . . . public figures must meet the higher, ‘actual malice’ standard of liability . . . .").

196. Copyright generally subsists in the author of an original work, which would typically include a photographer in the case of a photograph, or the person who hired the photographer to take the photograph under the "works for hire" doctrine. See 17 U.S.C. § 201(a) (2000) ("Copyright in a work protected under this title vests initially in the author or authors of the work."); id. § 201(b) ("In the case of a work made for hire, the . . . person for whom the work was prepared is considered the author . . . , and, unless the parties have expressly agreed otherwise in a written instrument signed by them, owns all of the rights comprised in the copyright.").
and services. Thus, if Ms. Spears could establish trademark rights in her image and could establish that the coffee mugs in question were confusing consumers as to source, origin, or affiliation with her, she may be able to establish a trademark infringement claim. Alternatively, if she could establish a trademark in her image and could establish also that the coffee mugs were blurring or tarnishing the mark in the marketplace, she may be able to sustain a claim in trademark dilution. However, it is not clear whether Ms. Spears actually has a trademark in her name or image.

Even if Ms. Spears could establish a trademark interest in her likeness, would it be sufficiently connected to the sale of merchandise, like coffee mugs, to support a successful trademark infringement action? It would seem more likely that any mark that did exist would relate to concerts and to music products, not to the merchandising of coffee mugs and associated products. While there are some trademark cases that accept trademark infringement in the merchandising context, this use of trademark law has been criticized as straying from the basis of trademark infringement law in protecting marks per se rather than marks used as trademarks.

197. See 2 Gilson Lalonde, supra note 5, § 5.01 (noting that the general aim of trademark law is to prevent consumer confusion about the source of products or services); see also Dinwoodie & Janis, supra note 30, at 16–17 (“[T]wo primary justifications have traditionally been offered in support of trademark protection: to ‘protect the public so that . . . it will get the product which it asks for,’ and to ensure that ‘the owner of a trade-mark . . . is protected in his investment from its misappropriation by pirates and cheats.’” (quoting S. Rep. No. 79-1333, at 3 (1946)).

198. See 15 U.S.C. § 1125(c) (2006) (creating a right in the owner of a famous mark that is distinctive to file suit to enjoin the use of a mark or trade name in commerce by another person because it is likely to cause dilution by blurring or dilution by tarnishment of the famous mark).

199. A search of the United States Patent and Trademark Office’s Trademarks Database as of November 11, 2007 shows that Britney Spears has, in fact, registered her name as a trademark for various products and services. However, the mere fact of registration does not prove that a trademark is valid. See Dinwoodie & Janis, supra note 30, at 315 (“Trademark registration . . . does not create rights; it only confirms the existence of rights.”).

200. A search of the United States Patent and Trademark Office’s Trademarks Database as of November 11, 2007 shows that Britney Spears has registered her name as a mark for a variety of products including arts and craft kits, desk organizers and backpacks. However, there does not appear to be a registration specifically for coffee mugs.

201. For a detailed critique of the merchandising right in trademark law, see generally Dogan & Lemley, Merchandising Right, supra note 172.

202. In fact, there is currently a significant debate as to whether “trademark use” by a defendant is an essential element of a trademark infringement action in the United States. See Dinwoodie & Janis, Confusion over Use, supra note 22, at 1602–08 (rejecting the theory that the user of an unauthorized trademark is only liable when it uses the plaintiff’s trademark as a “mark” and arguing that the theory’s use in courts’ analyses will result in insufficient market regulation); Dinwoodie & Janis, Lessons, supra note 22, at 1704–05 (arguing that the Lanham Act does not impose a trademark use requirement, that trademark use theory would still fail to
Of course, there is also a possibility of a trademark dilution action, but, again, Ms. Spears would have to establish the existence of a trademark right in her image to begin with, as well as establishing that the use of the picture on the coffee mug blurred or tarnished her mark in some way. By increasing circulation of her image in the marketplace, it may actually enhance the value of her mark rather than blurring or tarnishing it. Additionally, the dilution action is limited to "famous marks," and the name of a famous person is not necessarily a famous mark.

People other than sports and entertainment celebrities may have greater difficulties with trademark focused laws. A politician, public figure, or private individual may have more trouble establishing trademark rights in her name or create sufficient oversight of search engine results or advertising sales practices, and that offline analogies should not be used to direct the outcomes of trademark disputes over online practices); Dogan & Lemley, supra note 22, at 1670–73 (discussing the emergence of the trademark use doctrine and arguing that it is required in order to quash suits brought against defendants who have not attempted to promote their own products or services using the protected mark); Lastowka, supra note 22, at 45–47 (discussing three recent cases in the federal courts, which all concluded that the commercial sale of a search term in the "pop-up" context does not amount to trademark use).

203. See Madow, supra note 55, at 168–69 (discussing the unconvincing nature of celebrities’ claims of emotional injury under privacy law). There is also some debate about whether increased circulation of a name or image actually increases or rather decreases the value of the celebrity identity:

Landes and Posner argue that overgrazing on identity leads to "face wearout," a reduction in the value of one’s persona due to declining interest in the person as her persona is increasingly used. Their argument is at odds with the well-known maxim that "all publicity is good publicity," though both sentiments are oversimplifications of the phenomenon of fame. Publicity tends to feed off of itself and, as a result, many uses actually increase the value of a celebrity’s identity, whatever the character of those uses. But additional publicity will increase the value of an individual’s identity only until a certain point, after which interest may wane, along with the value of the identity. In other words, early additional uses may create "network effects" that increase the value of an identity, but at some point the number of uses will lead consumers to tire of that identity and it no longer will capture their attention. In most cases, consumers lose interest in particular cultural objects simply because something has come along that better defines them at that point in time. The point of tedium, however, may be accelerated, at least in terms of chronological time, as a result of overexposure. Some celebrities have more enduring cultural significance than others and, as a result, almost every aspect of an identity’s long-term value will vary from individual to individual: the rate at which value is added by early uses, the point at which additional uses begin to erode value and the value of the persona at that point, and the rate at which the value will decline beyond the wearout point.

McKenna, supra note 54, at 269–70.

Thus, if the above hypothetical involved Rudolph Giuliani coffee mugs, rather than Britney Spears coffee mugs, Giuliani may have much more trouble establishing a trademark interest in his name or likeness, simply because he does not sell any goods or services in connection with his name or likeness in the trademark sense.

These are the kinds of situations where personality rights jurisprudence may be helpful. Personality rights cover celebrity personas. However, they have also been used by politicians, public figures, and private individuals to provide remedies against unauthorized commercial uses of their personas. Although generally regarded as an "economic" tort protecting against commercial harm on the basis of a property-like right in a famous person's identity, it has also been recognized as having "moral"

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205. See WIPO REPORT, supra note 63, ¶ 188 ("[T]he names of political figures, religious leaders, scientists and historical persons may never have been used in commerce and, thus, are unlikely to have trademarks associated with them.").

206. See 1 GILSON LALONDE, supra note 5, § 2.16[1][b] ("The right of publicity is generally available only to celebrities, the Luciano Pavarottis, the John McEnroes, the Robert Redfords. Cases involving unknowns are usually brought under the older right of privacy.").


208. See supra notes 184–85 and accompanying text (discussing personality rights as applied to Rosa Parks and Martin Luther King Jr.).

209. See Tellado v. Time-Life Books, Inc., 643 F. Supp. 904, 905–08 (D.N.J. 1986) (involving the unauthorized use of image of private individual plaintiff taken during Vietnam war for advertising materials relating to a book); 1 GILSON LALONDE, supra note 5, § 2.16[1][a] ("The first successful right of privacy action . . . was designed to enable a non-public figure to retain his anonymity. The courts . . . enjoin[ed] the unauthorized commercial use of the plaintiff’s name and likeness, and they awarded general damages for injury to individual feelings, much as is done for libel and slander."); see also Kwall, supra note 57, at 96–100 (discussing Tellado v. Time-Life Books, Inc. and the different implications for the plaintiff’s suit had the photo been used in the book or in the promotional materials).

210. See Dogan & Lemley, supra note 28, 1172–74 (noting growth in the view that the right of publicity is an economic right); Haemmerli, supra note 25, at 392 ("The right of publicity is traditionally formulated as the right to exploit the commercial value of personal identity."); Konsky, supra note 55, at 349 ("[M]ost courts and commentators now ground the right of publicity in property rationales."); Kwall, supra note 54, at 15 ("[A] property-based conception for publicity rights is the natural outgrowth of our cultural norms as well as our theoretical conceptions of property."); McKenna, supra note 54, at 226 ("Because the right of publicity has focused entirely on the economic value of a celebrity’s identity, courts considering claims have no basis to differentiate among the variety of ways in which others might exploit
The key moral harm that has been protected by the right of publicity is more like a privacy protection than a property protection. The obvious example is where unauthorized commercial use is made of an individual’s name or likeness in circumstances in which that individual wants to maintain the privacy of her image, rather than control commercial profits derived from her image. Another advantage of a right of publicity framework is that courts have already engaged in balancing exercises between personality rights and the First Amendment in a variety of contexts. Such jurisprudence is more relevant to the personal domain name dispute context than that relating to the balance between trademark interests and the First Amendment.

Questions have arisen under the right of publicity as to whether purely expressive conduct by the defendant, not necessarily resulting in a commercial profit, should be compensable. Rogers v. Grimaldi, for example, is a case in which the expressive speech elements of the defendant’s use of the plaintiff’s name and likeness were not compensable under trademark law or under the...
right of publicity.\textsuperscript{214} In that case, the defendant had used the title "Ginger and Fred" in a film about a cabaret act that impersonated Ginger Rogers and Fred Astaire.\textsuperscript{215} The court held that the defendants had used no more of Ms. Rogers’s identity than was necessary for expressive artistic purposes.\textsuperscript{216} Ms. Rogers was therefore unsuccessful on her claims in both trademark law and publicity rights.

In the Internet context, one analog to the Rogers facts might be the use of a personal domain name resolving to a website that commented on the person in question. The commentary could be a fan website, a parody, or a website critical of the person. Assuming the domain name registrant did not receive any commercial profit from the use of the domain name, the right of publicity may not provide any compensation to the plaintiff. However, if the registrant was attempting to make a profit from the name either by selling the name itself—that is, cybersquatting—or by using the name to attract customers to the website for commercial purposes, a right of publicity claim would more likely be successful.

\textbf{B. Does a Personality Rights Framework Improve on the Current Situation?}

\textit{1. Personality Rights vs. the UDRP}

Despite the theoretical suitability of personality rights law for personal domain name disputes, most disputes are currently brought under the UDRP.\textsuperscript{217}
There are a number of reasons why this has been the case, relating to cost, timing, and general accessibility for individual complainants as compared with litigation under either trademark or right of publicity law. Judicial proceedings will be more costly, more time-intensive, and more resource-intensive than online arbitration. Compared even with federal trademark law, the right of publicity has a number of procedural disadvantages. For one thing, it is state law that is not harmonized nationally within the United States, let alone globally. This potentially causes conflicts of law issues, including problems of asserting jurisdiction over an out-of-state defendant, as well as choice of law issues.

Apart from these problems with litigation, it is likely that complainants are simply more focused on the UDRP for any domain name dispute than on the right of publicity. When complainants and their legal counsel think of personal

§ 17525, which is a cyberspace analog to right of publicity law in some respects as it protects personal names in the domain space against certain unauthorized uses); Beezy, supra note 143, at 23–24 (noting high success rate of celebrities in personal domain name proceedings under the UDRP and surveying some of the recent decisions); Moreland & Springer, supra note 4, at 386 (noting high success rate of celebrities in personal domain name disputes under the UDRP) (citing STATISTICAL SUMMARY OF PROCEEDINGS UNDER UNIFORM DOMAIN NAME DISPUTE RESOLUTION POLICY, http://www.icann.org/udrp/proceedings-stat.htm); id. at 394 (“A plethora of disputes involving personal names have been submitted to ICANN Arbitration.”).

218. See Moreland & Springer, supra note 4, at 395 (“ICANN Arbitration offers celebrities and their lawyers a quick, cost effective and usually successful means to recover domain names registered by third parties that incorporate the celebrity’s name.”).

219. Id.

220. See Rogers v Grimaldi, 875 F.2d 994, 1002–05 (2d Cir. 1988) (discussing problems of applying Oregon’s right of publicity law in a New York forum); 1 GILSON LALONDE, supra note 5, § 2.16[1] (“The publicity right is still developing and the courts are far from unanimous in defining its scope. Precedent (or the lack of it) in the selected forum may thus dictate reliance on trademark rights and unfair competition claims to the exclusion of, or in addition to, the publicity right.”); Haemmerli, supra note 25, at 389 (“Existing practice [under the right of publicity] is . . . confused, with fifty state regimes protecting differing aspects of identity, for varied terms, and with disparate remedies.”).

221. This has been an issue with respect to personal domain name disputes in the past. See Wright v. Domain Source, Inc., No. 02 C 2525, 2002 WL 1998287, at *2–4 (N.D. Ill. Aug. 27, 2002) (discussing jurisdictional issues raised in complaint against cybersquatter’s registration of <paulwright.com> domain name). The movie actor Kevin Spacey was also initially unsuccessful in a cybersquatting claim against the registrant of <kevinspacey.com> on jurisdictional grounds, but later succeeded under a UDRP proceeding. See Spacey v. Zuccarini, National Arbitration Forum Claim No. FA0103000096937, 2001 WL 1708365 (May 8, 2001) (Yachnin, Arb.), available at http://www.adrforum.com/domains/decisions/96937.htm (transferring the domain name <kevinspacey.com> to Kevin Spacey after the arbitrator determined Mr. Spacey had satisfied all three elements required under the ICANN Policy). See generally McCarthy, supra note 107.

222. See, e.g., Grimaldi, 875 F.2d at 1002–05 (discussing problems with applying Oregon’s right of publicity law in a New York forum).
domain name disputes, they probably instinctively categorize them as "domain name disputes," rather than "personal name disputes," and thus focus on the set of rules geared towards resolving the former. In many ways, this is a problem of classification. If one classifies a given dispute as a "domain name dispute" rather than as a "dispute to protect the integrity of an individual’s persona," one will tend to think of domain name-focused rules, rather than personal identity rules.

This Article identifies advantages in marrying the substance of the personality rights tort with the procedural advantages of the UDRP to arrive at the best solutions regardless of whether the dispute is classified as being primarily "about domain names" or "about personality." Under a new PDRP, one could achieve the time and cost benefits of the UDRP, but with a clearer focus on the aspects of an individual’s persona that should be protected in the domain space as a substantive policy matter. One could also avoid undesirable expansions of trademark law into matters involving personal names that do not really operate as trademarks, as well as minimize inconsistencies in arbitrations about which personal names should be accepted as trademarks.

In substance, what would a personality rights-based PDRP do differently than the UDRP? Take, at a broad level of generality, two classes of conduct that concern potential personal domain name complainants. The first is comprised of cybersquatting situations where a registrant has registered or used a domain name corresponding with the plaintiff’s personal name with the intent to sell it for a profit. The second is comprised of situations where a registrant does not want to sell the domain name, but wants to use it for commercial or commentary purposes. With respect to the first class—cybersquatting—a personality rights framework improves on the UDRP in several ways. It does not require the complainant to establish a trademark interest in her personal name. Thus, it applies as equally to extremely famous celebrities as to

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223. Of course, there are some legislative provisions that could be categorized as aimed at both domain name disputes and personal names. See, e.g., 15 U.S.C. § 1129(1)(A) (2006) (“Any person who registers a domain name that consists of the name of another living person, or a name substantially and confusingly similar thereto, without that person’s consent, with the specific intent to profit . . . by selling the domain name for financial gain . . . , shall be liable in a civil action . . . .”). However, these laws require expensive domestic litigation as opposed to inexpensive online arbitration.

224. Of course, infringement under legislative provisions such as 15 U.S.C. § 1129(1)(A) does not require establishment of a trademark in a personal name, but it does require often expensive litigation.

225. The right of publicity has its most obvious applications in the case of celebrity
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politicians, public figures, and private individuals, not to mention "lesser celebrities." It clearly would cover cybersquatting because it prevents the use of another’s name or likeness for an unauthorized commercial profit.

persons. See Waits v. Frito-Lay, Inc., 978 F.2d 1093, 1096–98 (9th Cir. 1992) (deciding a right of publicity action regarding Tom Waits's distinctive singing voice); Rogers v. Grimaldi, 875 F.2d 994, 996–97 (2nd Cir. 1988) (adjudicating a right of publicity action regarding Ginger Rogers's name); Midler v. Ford Motor Co., 849 F.2d 460, 461–62 (9th Cir. 1988) (assessing a right of publicity action regarding Bette Midler’s distinctive singing voice); 1 Gilson Lalonde, supra note 5, § 2.16[1] ("The right of publicity, a developing common law right of great value to the celebrity . . . ."); Michael A. Carrier, Cabining Intellectual Property Through a Property Paradigm, 54 Duke L.J. 1, 141–42 (2004) ("[R]eferences to celebrities are essential for dialogue on issues such as culture and values . . . . By putting alternative conceptions of celebrity off limits, the right of publicity . . . threatens to suppress expression and to give celebrities the power to censor alternative versions of their images that are . . . iconoclastic or irreverent."); Dogan & Lemley, supra note 28, at 1164 (conceiving right of publicity in terms of protecting celebrities’ names and likenesses); Madow, supra note 55, at 178–238 (critiquing the right of publicity in the celebrity context); McKenna, supra note 54, at 226 (conceiving of the right of publicity as being focused "entirely on the economic value of a celebrity’s identity").

227. See supra notes 184–85 and accompanying text (discussing the right of publicity as it applied to Rosa Parks and Martin Luther King, Jr.).

228. See Trudeau v. Lanoue, No. 04 C 7165, 2006 WL 516579, at *2–4 (N.D. Ill. Mar. 2, 2006) (addressing a suit where the plaintiff argued a right of publicity claim, amongst other unfair competition claims, in a dispute involving a domain name corresponding with the plaintiff’s personal name); Wright v. Domain Source, Inc., No. 02 C 2525, 2002 WL 1998287, at *6 (N.D. Ill. Aug. 27, 2002) (addressing a claim brought by the plaintiff under Cal. Bus. & Prof. Code § 17525, which is a cyberspace analog to right of publicity law in some respects as it protects personal names in the domain space against certain unauthorized uses).

229. In other words, it would cover situations in which people like Bruce Springsteen and Anna Nicole Smith had trouble convincing UDRP arbitrators that they held trademark interests in their personal names. See Smith v. DNS Research, Inc., National Arbitration Forum Claim No. FA0312000220007, 2004 WL 2358216 (Feb. 21, 2004) (Davis, Arb.), available at http://www.adrforum.com/domains/decisions/220007.htm ("[I]t is unlikely that the evidence . . . of [Ms. Smith’s] career, in and of itself, is sufficient to establish common law trademark rights . . . . [T]he mere fact of having a successful career as an actress, singer or TV program star does not provide exclusive rights to the use of a name . . . ."); Springsteen v. Burgar, WIPO Arbitration and Mediation Center Case No. D2000-1532, 2001 WL 1705212, § 6 (Jan. 25, 2001) (Harris & Froomkin, Arbs.), available at http://www.wipo.int/ami/en/domains/decisions/2000/d2000-1532.html ("[I]n the case of very well known celebrities, their names can acquire a distinctive secondary meaning . . . . [N]o evidence has been given of . . . ‘Bruce Springsteen’ having acquired a secondary meaning . . . . [I]t is by no means clear from the UDRP that it was intended to protect proper names of this nature.").

230. See 1 Gilson Lalonde, supra note 5, § 2.16[1] ("The right of publicity . . . is the right of an individual to control the commercial use of his or her name, likeness, signature, or other personal characteristics."); Carrier, supra note 225, at 22–23 ("The right of publicity prevents
Thus, it would cover all cybersquatting involving a personal name regardless of the trademarkability of the name.\textsuperscript{231}

One might argue that the deficiencies of the UDRP here could be remedied easily enough by simply including a personal name as a protected interest under the UDRP alongside a trademark. This would prohibit all cybersquatting involving any personal name regardless of whether or not the name in question operated as a trademark.\textsuperscript{232} Nevertheless, the UDRP for the most part is still geared at protecting marks in cyberspace against unauthorized commercial uses likely to confuse consumers as to the source or origin of goods or services.\textsuperscript{233} In other words, it is still focused on aspects of trademark law that are not necessarily well suited to addressing concerns about unauthorized commercial uses of personal names. Thus, even adding a personal name as a protected interest under the existing UDRP would likely lead to inconsistent

the appropriation of an individual’s name or likeness for commercial advantage."); Konsky, \textit{supra} note 55, at 347 ("The right of publicity prohibits commercial use of a person’s name or likeness without the person’s consent."); Kwall, \textit{supra} note 57, at 47 ("The right of publicity is a legal theory which enables individuals to protect themselves from unauthorized, commercial appropriations of their personas.").

\textsuperscript{231} Of course, § 1129 of the Lanham Act would also cover the same conduct. \textit{See} 15 U.S.C. § 1129 (2006) (stating that anyone registering a domain name of another with the intent to profit "shall be liable in a civil action"). However, that involves litigation as opposed to inexpensive online arbitration, so a PDRP would be an improvement over the Lanham Act for personal domain name disputes. \textit{See infra} Part IV.D (discussing remedies available under PDRP).

\textsuperscript{232} \textit{See} Lipton, \textit{supra} note 63, at 69 (discussing the possibility of adding personal names as a protected interest under the UDRP and noting the practical difficulties of protecting personal names on an international level).

\textsuperscript{233} \textit{See, e.g.}, UDRP, \textit{supra} note 3, ¶ 4(b) (limiting a finding of bad faith registration and use of a domain name). On bad faith, the UDRP provides:

\textit{[T]he following circumstances, in particular but without limitation, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith: (i) circumstances indicating that you have registered or you have acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of your documented out-of-pocket costs directly related to the domain name; or (ii) you have registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that you have engaged in a pattern of such conduct; or (iii) you have registered the domain name primarily for the purpose of disrupting the business of a competitor; or (iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your web site or other on-line location, by creating a likelihood of confusion with the complainant’s mark as to the source, sponsorship, affiliation, or endorsement of your web site or location or of a product or service on your web site or location.}

\textit{Id.}
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and arbitrary results as UDRP arbitrators attempted to apply trademark-like tests to personal name disputes.234

Additionally, the UDRP is not particularly appropriate for the second class of personal domain name conflicts: that is, situations in which the registrant does not want to sell the name for a profit, but rather wants to use it herself for some reason. These situations really boil down into two sub-categories which can overlap: commerce and commentary. Some unauthorized uses of a personal domain name will be commercial and some will be for commentary purposes—whether it be idolatry, parody or criticism, or a combination. Additionally, it is possible for a website to contain elements of commerce and elements of commentary simultaneously.235 A fan website may charge a fee for joining a relevant fan club, online chat group or the like. It may equally sell unauthorized celebrity merchandise. A website critical of a particular person may sell or advocate the sale of merchandise or information supporting a view critical of that person or her views.236 Even a parody website may advocate the sale of merchandise critical of the person or institution being parodied.237

These kinds of cases raise difficult questions of balancing interests in an individual’s persona against the First Amendment. Personality rights law is the body of law that has historically dealt with this balance. Trademark law has dealt with a similar balance relating to protecting free speech against trademark interests.238 However, the interests of a trademark holder are somewhat different than those of an individual in her persona, and the appropriate body of

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234. See Lipton, supra note 63, at 69 ("On the global scale, there are more names and presumably more people, and even potentially famous people, with the same or similar names. Additionally, different legal systems may well take different attitudes to the protection of personal names in the domain space." (citations omitted)); see also infra Part IV.E (discussing the concerns raised when personal names are employed in an unauthorized way for political and commercial purposes).

235. See, e.g., People for the Ethical Treatment of Animals, Inc. v. Doughney, 113 F. Supp. 2d 915, 917–18 (E.D. Va. 2000) (discussing a parody site of PETA linking to websites where fur and animal products antithetical to plaintiff’s views were available for sale), aff’d, 263 F.3d 359 (4th Cir. 2001).


237. See, e.g., People for the Ethical Treatment of Animals, 113 F. Supp. 2d at 917–18 (concerning parody site linking to websites where fur and animal products antithetical to plaintiff’s views were available for sale), aff’d, 263 F.3d 359 (4th Cir. 2001).

238. See generally Margreth Barrett, Domain Names, Trademarks and the First Amendment: Searching for Meaningful Boundaries, 39 CONN. L. REV. 973 (2007) (discussing the proper role of trademark rights on the Internet versus free speech protections); Lipton, supra note 52 (discussing the possible problems in the extension of trademark protections into the Internet, resulting in infringement upon free speech).
rules should be applied in each case. Rights in individual personas flow from both theories of personhood and theories of property, while trademark rights are focused purely on commercial source identifiers.

2. Case Study 1: Unauthorized Celebrity Websites

Two examples might be useful to illustrate ways in which a personality rights framework for personal domain name disputes could differ from a trademark-focused model. They are: (a) a celebrity concerned about an unauthorized fan website utilizing her personal name as a domain name; and (b) a politician concerned about a website that uses her personal name as a domain name and contains messages critical of her, or her views. These examples have been chosen because they both implicate First Amendment concerns. However, the first example may additionally implicate commercial values much more than the second example. Each example deals with ways in which a personality rights framework might balance the complainant’s rights in her persona against First Amendment concerns.

In the first case, the trademark-focused laws would obviously not help the celebrity at all unless she could establish a trademark interest in her personal name. Assuming she could establish such an interest, she would have to establish that the website in question was confusing consumers for a trademark infringement action, was dilutive of her name in commerce for a dilution

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239. See Haemmerli, supra note 25, at 413 ("A concept of autonomy taken from idealist philosophy, however, can provide a rationale for a property interest in individual identity.").

240. See supra note 54 and accompanying text (tracing the origins of rights in individual personas back to theories of property rights).

241. See DINWOODIE & JANIS, supra note 30, at 563–66 (noting that dilution protection under the Lanham Act focuses on protecting commercial source identifiers to protect both consumers and producers) (citing 15 U.S.C. §§ 1125(c), 1127 (2000)); see also Stacey Dogan & Mark Lemley, Trademarks and Consumer Search Costs on the Internet, 41 HOUS. L. REV. 777, 786 (2004) ("Both consumers and producers, these courts point out, benefit from having access to truthful information about the source of products and services."). Traditional trademark law has generally been premised on two interconnected aims: (a) to protect the public when purchasing a product or service to ensure that the purchasers get what they think they are paying for in terms of goods or services from a particular source, and (b) to ensure that those who invest in developing goodwill in a particular mark are protected against unfair misappropriations of that goodwill. Id. at 786–87.

242. See 15 U.S.C. § 1114 (2006) (dictating the remedies available when a trademark interest is violated). But see id. § 1129(1) (allowing for remedies through a civil action when an unauthorized person registers a domain name without any trademark interest). Remedies only exist under 15 U.S.C. § 1129(1), however, if the unauthorized registrant "sell[s] the domain name for financial gain." Id.

243. See id. § 1114 ("Any person who shall, without the consent of the registrant (a) use in
action, or was registered and used in bad faith for an ACPA action or a UDRP arbitration. This is putting to one side an action under the personal name provisions of the Lanham Act on the basis that they only prohibit bad faith intents to sell the relevant domain name, and not unauthorized uses of the name per se.

An unauthorized fan website is probably not confusing to consumers provided that it is not passing itself off as an authorized fan website. Thus, a disclaimer might cure any confusion and mitigate against the likelihood of a successful trademark infringement action. If no commercial activity is conducted on the website, it is not likely to be "in commerce" for the purposes of a dilution action. However, if there are commercial activities, such as

_in commerce any reproduction . . . of a registered mark . . . in connection with such use is likely to cause confusion . . . shall be liable in a civil action."); see also id. § 1125(a) (holding liable in a civil action anyone using unregistered trademarks in a false or misleading way).

244. See id. § 1125(c)(1) ("[T]he owner of a famous mark that is distinctive . . . shall be entitled to an injunction against another person who . . . commences use of a mark or trade name in commerce that is likely to cause dilution by blurring or dilution by tarnishment.").

245. See id. § 1125(d)(1)(A) ("A person shall be liable in a civil action by the owner of a mark . . . if . . . that person (i) has a bad faith intent to profit from that mark; including a personal name which is protected as a mark under this section.").

246. See UDRP, supra note 3, ¶ 4(a) (allowing for an administrative proceeding only when a domain name identical or confusingly similar to a person’s name is used in bad faith without a right to do so).

247. See 15 U.S.C. § 1129(1) (2006) (prohibiting explicitly the act of registering a domain name "that consists of the name of another living person" and then selling the name but not identifying any prohibited unauthorized uses).


In the cybersquatting cases, the domain names in question generally were <www.trademark.com> domain names, which prevented the trademark holder from utilizing the customary commercial domain name for its "official" site . . . . Here, however, the domain name registrant has not usurped the <.com> domain, but has utilized only the <.net> domain, has posted disclaimers on the website homepage, and has included criticism or commentary on the site so that a reasonably prudent Internet user can tell that the site is not the trademark holder’s "official site."

Id.; see also Haemmerli, supra note 25, at 400 (noting that in a non-Internet setting that the use of a highly visible disclaimer on a film might negate likelihood of confusion). But see Planned Parenthood Fed’n of Am., Inc. v. Bucci, 42 U.S.P.Q.2d 1430, 1439 (S.D.N.Y. 1997) ("Any ensuing confusion resulting from defendant’s use of plaintiff’s mark as his domain name and home page address is likely to be destructive to the image that plaintiff, the senior user of the mark, has established." (citing MGM-Pathe Commc’n Co. v. Pink Panther, 774 F. Supp. 869, 876 (S.D.N.Y. 1991))).

charging membership fees or engaging in advertising, could an unauthorized fan site be said to be dilutive of a celebrity persona as a mark? Even if there is some commercial activity, it is possible that the use of the domain name could be excused under the new "commentary" defense to dilution inserted into the Lanham Act in 2006. Clearly, the fan site creates some "noise" around the celebrity’s name, but such noise may be reinforcing the celebrity’s identity, rather than blurring or detracting from it. Additionally, a celebrity’s name is unlikely to meet the definition of "famous mark." Thus, a dilution action may not be successful in this case. Further, if the domain name has been registered not in bad faith but for the purposes of legitimate fan-related commentary, the provisions of § 1125(d)(1)(A) of the Lanham Act are unlikely to be satisfied in terms of a traditional cybersquatting action.

Would the right of publicity give a different result here and, just as importantly, should it? One might argue that because trademark laws carry these inherent limitations, partly to balance them against First Amendment concerns, the same should be true of personality rights law. Otherwise, individual names and likenesses will be overpropertized and this result will chill free expression on the Internet. However, it is important not to consider rights in personal names with too much emphasis on trademark law. Personality rights clearly implicate a number of concerns similar to trademark law. However, they also protect other aspects of an individual’s personality, such as the right to keep certain aspects of a persona out of the public domain. Thus, while trademark jurisprudence may in some ways inform the

250. See id. § 1125(c)(3)(A)(ii) (excusing identifying the plaintiff for the purposes of parody, criticism, and commentary from the scope of a trademark dilution action).

251. See supra note 203 and accompanying text (discussing the pros and cons of creating noise around a celebrity’s name).


253. See id. § 1125(d)(1)(A) (dictating that under cyberpiracy prevention only those people that use a protected mark with a bad faith intent to profit will be liable in a civil action). The same will be true of an attempt to satisfy the bad faith requirements of the UDRP. See UDRP, supra note 3, ¶ 4(a)(iii) (stating bad faith as a requirement in order to be found liable in an administrative proceeding).

254. See Dogan & Lemley, supra note 28, at 1190 ("The structure and content of trademark law provide a theoretical justification for a bounded right of publicity." (citations omitted)).

255. See id. at 1190–1208 (discussing the similarities between trademark law and the right of publicity).

256. See id. at 1168 (noting that a privacy right "would redress the harms that private individuals suffered from invasions of their privacy").
development of personality rights jurisprudence, trademarks are not the same as personality rights.257

The right of publicity tort does not require the complainant to establish trademark-like incidents in her personal name or likeness.258 This is clearly an advantage for complainants over the UDRP. However, the commercial use requirement could be a problem here in the same way that it could be a problem in a trademark-based action. If the view is taken that all Internet conduct is commercial because of the nature of the Internet, the commercial use requirement is automatically satisfied.259 If not, it may be that the nature of the activities on the website could satisfy the commercial use requirement only if the registrant was advertising or selling products or services on the relevant website.260 This may well be as it should be. A purely expressive website,

257. See id. at 1211 (identifying a specific difference between personality rights and trademarks—there is no "use in commerce" or secondary meaning requirement for complainants under the right of publicity).

258. See id. (stating that trademark requirements "make little sense in the context of personal likeness").

259. See Planned Parenthood Fed’n of Am., Inc. v. Bucci, 42 U.S.P.Q.2d 1430, 1434 (S.D.N.Y. 1997) (finding use of a mark on the Internet to be an "in commerce" use). The court provided:

Internet users constitute a national, even international, audience, who must use interstate telephone lines to access defendant’s web site on the Internet. The nature of the Internet indicates that establishing a typical home page on the Internet, for access to all users, would satisfy the Lanham Act’s "in commerce" requirement. Id. (citing Intermatic v. Toeppen, 947 F. Supp. 1227, 1239 (N.D. Ill. 1996)); see also Am. Libraries Ass’n v. Pataki, 969 F. Supp. 160, 173 (S.D.N.Y. 1997) (finding, in a case outside the trademark context, that everything on the Internet is automatically in commerce). The American Libraries Association court provided:

In addition, many of those users who are communicating for private, noncommercial purposes are nonetheless participants in interstate commerce by virtue of their Internet consumption. Many users obtain access to the Internet by means of an on-line service provider, such as America Online, which charges a fee for its services. "Internet service providers," including plaintiffs Panix, Echo, and NYC NET, also offer Internet access for a monthly or hourly fee. Patrons of storefront "computer coffee shops," such as New York’s own CyberCafe, similarly pay for their access to the Internet, in addition to partaking of food and beverages sold by the café. Dial-in bulletin board systems often charge a fee for access.

Id. Note, however, that the context in which "in commerce" is used in Bucci and American Libraries Association relates to the Lanham Act and the Commerce Clause respectively, and those interpretations might not apply to the right of publicity.

even in the <name.com> space, should perhaps be protected speech where there is no unfair or unauthorized commercial gain being made from someone else’s persona. 261

On the other hand, the right of publicity protects individuals from being thrust into the limelight against their wishes. 262 This is the privacy aspect of the right, usually applied more to private individuals than celebrities on the basis that the latter are presumably expecting, and even overtly seeking, the limelight. 263 While the privacy-based aspects of the right of publicity are usually geared towards private individuals, and even then at public commercial uses of a private individual’s persona, 264 there may be some scope to argue that celebrities should have some privacy rights in relation to at least <name.com> versions of their names online. There have been cases where the right of publicity has prevented public uses of likenesses of private individuals even where there is no direct economic harm to the plaintiff and where the plaintiff’s concern is with moral privacy-related objections to the use of the image, rather than economic benefits. 265

Although one might argue that celebrities should not be entitled to bring such actions because of their admittedly public personas, the nature of the Internet brings a new scope and scale to the idea of unauthorized public distribution. 266 Whereas a plaintiff in the past may have been concerned about emotional distress or loss of privacy in relation to an unauthorized billboard advertisement in one or more specific geographical locations, today’s plaintiff

261. See Dogan & Lemley, supra note 28, at 1191 (arguing that applying a trademark analogy is desirable because it would provide a reason to protect publicity rights). But see supra notes 256–57 and accompanying text (discussing the importance of protecting the privacy rights of private individuals).

262. See Dogan & Lemley, supra note 28, at 1167 (“The privacy phase . . . involved the court’s recognition . . . of the right of individuals to limit the use of their names or likenesses by commercial actors. Most privacy cases involved noncelebrities.”).

263. See id. at 1171 (noting that the mere production of a celebrity’s photograph or image is not protected by publicity rights because “the celebrities had actively sought out their fame and could not be offended by its furtherance”).

264. See Tellado v. Time-Life Books, Inc., 643 F. Supp. 904, 910 (D.N.J. 1986) (finding that the defendant’s use of the plaintiff’s photo to advertise a book was a commercial use of the plaintiff’s likeness even though damage was not monetary).

265. See id. (discussing a situation when the right to publicity was implicated when no economic harm befell the plaintiff); see also Kwall, supra note 57, at 96–100 (criticizing the Tellado decision because granting damages would not appropriately remedy the emotional distress that the plaintiff had suffered).

266. See Daniel Solove, The Future of Reputation: Gossip, Rumor, and Privacy on the Internet 33 (2007) (“The Internet . . . makes gossip a permanent reputational stain, one that never fades. It is available around the world, and with Google it can be readily found in less than a second.”).
may face a complete loss of privacy in the face of the whole world. Thus, even a celebrity may be entitled to some control of Internet content about her on this basis, particularly if that control is initially limited to the <name.com> space, which is likely most closely associated with the idea of the celebrity’s authorized online persona. A PDRP based on a personality rights framework might justify this result. Decisions under the PRDP based on balancing the rights of a given celebrity in her persona against the registrant’s free speech entitlements would create a more nuanced jurisprudence for these situations in cyberspace.

3. Case Study 2: Unauthorized Political Websites

With respect to the second hypothetical raised above—a website critical of a politician under a <name.com> domain—trademark-focused laws are again a poor fit. They are not aimed at balancing a politician’s rights in her persona against the public interest in free speech. Most politicians do not have, or should not be regarded as having, trademarks in their personal names. The balance of their interests in their names against the public’s right to comment about them should not be a part of trademark law. It might be determined more effectively by personality rights principles.

Even in a situation where a politician can establish trademark rights in her name, a trademark infringement action is an unlikely candidate for resolving issues about unauthorized political commentary. There will likely be no consumer confusion in such cases. It is possible that a court liberally applying the initial interest confusion doctrine would find confusion here in the sense that the Internet user is initially confused by use of the <name.com> domain name and ends up on a website she did not desire to access.

267. See id. at 35 (“In a world where it is difficult to separate the true from the false, rumor and defamation can readily spread, and the Internet can be used as a powerful tool to launch malicious attacks on people and ideas.”).


269. See supra notes 203, 250 and accompanying text (discussing the contention that all publicity is good publicity and the commentary exception in the Lanham Act).

270. See Dogan & Lemley, supra note 28, at 1191–97 (focusing on consumer confusion when discussing what qualifies as confusion under the Lanham Act).

271. See supra note 112 and accompanying text (explaining how the doctrine of interest confusion shifts the focus to the time in which the user accesses the website).

272. See, e.g., Planned Parenthood Fed’n of Am., Inc. v. Bucci, 42 U.S.P.Q.2d 1430, 1441 (S.D.N.Y. 1997) (finding that even the use of a disclaimer on the relevant website would not
However, the initial interest confusion test is not universally accepted in trademark law.273 Even in cases where a court was prepared to adopt the doctrine, the case of a political criticism website could be distinguished from prior initial interest confusion cases on the basis that the prior cases have generally had something to do with competing commercial activity, rather than purely expressive content.274

Trademark dilution will also not be an appropriate fit for these situations. The point of trademark dilution is to protect famous commercial marks from losing their distinctiveness in the marketplace275 and not to protect politicians against undesired commentary.276 Even where politicians can establish trademarks in their names for infringement purposes, they would have to establish a "famous mark" for dilution purposes.277 This would be difficult even for well-known politicians.278 Even if sufficient fame could be shown, the politician would still have to satisfy the "blurring or tarnishment"279 and "in commerce"280 requirements. Additionally, there is now a new "commentary" defense to dilution that may become relevant in these situations.281

273. Lastowka, supra note 22, at 36 ("Though not all federal circuits have endorsed the doctrine of initial interest confusion and the Supreme Court has yet to consider a case applying it, many courts have accepted and applied the doctrine.").

274. See id. ("Traditionally, and not surprisingly, most courts have focused analysis on consumer confusion on the time period proximate to the consumer purchases.").

275. 2 GILSON LALONDE, supra note 5, § 5A.01[1] ("Federal dilution law protects famous trademarks from unauthorized uses that are likely to impair their distinctiveness or harm their reputation."); see also supra notes 117–24 and accompanying text (discussing the purpose of dilution application at the federal level).


277. In particular, the new definition of "famous mark" for dilution purposes contemplates fame with respect to the sale of goods or services. See id. § 1125(c)(1) ("Subject to the principles of equity, the owner of a famous mark that is distinctive, inherently or through acquired distinctiveness, shall be entitled to an injunction."). This is not the kind of interest usually associated with politicians’ names.

278. See id. § 1125(c)(2)(A) (making it difficult for politicians to establish a famous mark by contemplating fame with respect to commercial activities).

279. See id. § 1125(c)(2)(B) ("[D]ilution by blurring’ is association arising from the similarity between a mark or trade name and a famous mark that impairs the distinctiveness of the famous mark."); id. § 1125(c)(2)(C) ("[D]ilution by tarnishment’ is association arising from the similarity between a mark or trade name and a famous mark that harms the reputation of the famous mark.").

280. See id. § 1125(c)(3)(C) (stating that "any noncommercial use of the mark" is not actionable in a dilution action).

281. See id. § 1125(c)(3)(A)(ii) (excluding from liability in a dilution action "identifying and parodying, criticizing, or commenting upon the famous mark owner or the goods or services
could be difficult to establish here as a website critical of a politician is not likely to blur the distinctive power of the politician’s name as a mark, but rather reinforces the politician’s identity while criticizing her.

Tarnishment may be a possibility in such cases, but, again, the registrant’s conduct may be tarnishing the politician’s personal reputation, but would be unlikely to be tarnishing the politician’s name in a trademark sense. Criticizing a politician’s views on a particular issue will not interfere with the integrity of the politician’s name as a mark in connection with the sale of goods or services, such as books and campaign merchandise. It will rather impact the way in which people regard the politician and her suitability for office. Such criticism may even increase sales of books written by the relevant politician by people interested in learning more about the politician’s views spurred on by the criticisms of the politician.\textsuperscript{282} Finally, there is the issue of whether purely expressive content is "in commerce" for dilution purposes. Commentary websites, such as the <bobkeenan.com> and <lindamcculloch.com> examples, do not appear to have any commercial application. Thus, unless all Internet conduct is regarded as commercial, pure political gripesites will likely not satisfy the threshold for trademark dilution. Even if the conduct is regarded as being "in commerce," it may still be excused under the new "commentary" defense to a dilution action.\textsuperscript{283} This is not surprising, because trademark dilution was never intended to cover political commentary.\textsuperscript{284}

The ACPA and the UDRP will not help much with this balance because of their focus on commercial bad faith cybersquatting. Sections 1125(d) and 1129(1)(A) of the Lanham Act each assume that the defendant’s purpose in registering a relevant domain name is to make a bad faith commercial profit.\textsuperscript{285} A registrant who has registered a politician’s name as a domain name for expressive purposes is unlikely to satisfy the test set out in either section. Additionally, § 1125(d) will not apply unless the politician has a trademark in her name.\textsuperscript{286} The UDRP would likely excuse commentary about a politician of the famous mark owner”).

\textsuperscript{282} See id. § 1125(c)(2)(C) (focusing punishment on the "tarnishment of a famous mark" and not punishing an act influencing public opinion about a politician).

\textsuperscript{283} See id. § 1125(c)(3)(A)(ii) (providing the commentary defense).

\textsuperscript{284} Dogan & Lemley, supra note 28, at 1194 ("[D]ilution properly understood is targeted at reducing consumer search costs.").

\textsuperscript{285} See 15 U.S.C. § 1125(d)(1)(A)(i) (2006) (stating that a person shall be held liable by the owner of a mark if the person "has a bad faith intent to profit from that mark, including a personal name which is protected as a mark under this section"); id. § 1129(1)(A) (holding liable anyone registering as a domain name the name of another "with the specific intent to profit from such name by selling the domain name for financial gain").

\textsuperscript{286} See id. § 1125(d)(1)(A) ("A person shall be liable in a civil action by the owner of a
under a corresponding domain name, even a <name.com> name, as a legitimate use of the name. In any event, it will not technically apply to a politician if her name does not operate as a trademark. The same may be said of California’s Business and Professions Code, although there is little case law or commentary available on that legislation to date. Even though the key provision in § 17525(a) contemplates bad faith registrations of domain names without regard to goods or services of the parties, several of the bad faith factors relate to trademark-like concepts. The provision that does contemplate misleading voters as a bad faith factor does not make it clear whether a political commentary site would be excused as not misleading voters as to source or affiliation of the website.

Again, all of this may well be as it should be. It may be that there should be no law giving a politician any rights against a registrant of a corresponding domain name, even a <name.com> name, where the registrant’s purpose is political commentary. However, there may be room for a presumption that <name.com> names, even in the political context, would be expected by Internet users to refer to officially sanctioned websites, and that any other use of those names is misleading. Could a personality rights model resolve this dilemma? For one thing, it would obviously protect any politician’s or public figure’s identity regardless of a trademark interest. However, it would only protect them from unauthorized commercial conduct and not necessarily against undesired critical commentary. Thus, as with the previous case study, if the defendant’s conduct was purely expressive, rather than commercial, the right of publicity may not provide results any different from those currently provided under trademark focused rules.

mark, including a personal name which is protected as a mark under this section.

287. See UDRP, supra note 3, ¶ 4(c)(iii) (“You are making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.”).

288. See id. ¶ 4(a)(i) (mandating that the domain name must be “identical or confusingly similar to a trademark or service mark in which the complainant has rights”).

289. See CAL. BUS. & PROF. CODE § 17525(a) (West 2006) (“It is unlawful for a person, with a bad faith intent to register, traffic in, or use a domain name.”).

290. See, e.g., id. § 17526(a) (relating to trademark rights in a given domain name); id. § 17526(c) (relating to use of domain name in relation to the bona fide offering of goods and services); see also Lipton, supra note 63, at 84–88 (discussing the questions concerning the California code’s bad faith requirement and whether that renders the code useless against political cybersquatting).

291. See CAL. BUS. & PROF. CODE § 17526(j) (West 2006) (providing as a bad faith factor “[t]he intent of a person alleged to be in violation of this article to mislead, deceive, or defraud voters”).
Again, if the defendant’s conduct did contain commercial elements, either because the Internet is regarded as a global commercial communications medium,\textsuperscript{292} or because the website engages in some kind of commerce, such as advertising books that criticize the politician,\textsuperscript{293} then the politician might have more luck. As a general matter, unauthorized commercial use may be more difficult to establish in the case of a political commentary website than an unauthorized fan website. This is because the iterations of unauthorized fan conduct are more likely, in practice, to have a commercial aspect than is a pure political commentary website. Celebrities names are more likely to attract online customers than political names and may thus be more desirable to those seeking to make commercial profits from use of corresponding domain names.\textsuperscript{294}

Overall, a personality rights based framework for personal domain name disputes that allowed unauthorized expressive uses of \textlt{name.com}\textgreater names, while prohibiting unauthorized commercial uses, might achieve a better theoretical focus than the current UDRP. It would remove the requirement that a complainant establish trademark rights in her personal name, or establish cybersquatting, as opposed to other kinds of commercial profit motives by the registrant. At the same time, it would not unduly chill speech because it would preserve the right to engage in purely expressive conduct about an individual, and, if limited in the first instance to \textlt{name.com}\textgreater names, would preserve other iterations of a relevant name in the domain space for both expressive and commercial conduct. To some extent, these results are similar to those currently found in practice in some trademark-based litigation. However, the use of a personality rights model would lead to greater consistency on the question of what is being protected—a name rather than a mark—and why—because we care about both the personhood and proprietary aspects of an individual’s persona.\textsuperscript{295}

\textsuperscript{292} See supra note 113 and accompanying text (discussing cases in which courts labeled use of the Internet as inherently commercial).

\textsuperscript{293} See People for the Ethical Treatment of Animals, Inc. v. Doughney, 113 F. Supp. 2d 915, 919 (E.D. Va. 2000) (finding that a parody website of PETA linking to websites selling items offensive to PETA was in commerce and connected with distribution of services), aff’d, 263 F.3d 359 (4th Cir. 2001).


\textsuperscript{295} See supra notes 54, 56 and accompanying text (discussing numerous commentators’ views on the personhood and property theories behind the right of publicity).
IV. Crafting a New Personal Domain Name Dispute Resolution Policy (PDRP)

A. Basic Structure and Scope of a PDRP

Obviously, the right of publicity can be applied to some personal domain name cases now.\(^{296}\) Even after the implementation of a new PDRP, this would continue to be the case, as contractual arbitration procedures will not oust the jurisdiction of domestic courts.\(^{297}\) Thus, even if a PDRP was limited to <name.com> disputes, conflicts about personal domain names in other domain spaces could arguably be litigated under right of publicity laws in relevant jurisdictions.\(^{298}\) The main problem with the right of publicity in domestic law is that it raises jurisdictional and cost problems that are largely avoided or minimized by using an inexpensive and efficient online dispute resolution procedure. Thus, merging the substance of the right of publicity with the procedural advantages of the UDRP in a new PDRP would be a useful innovation in domain name dispute resolution policy and practice.

This Article has suggested that most relevant disputes arise in <name.com> cases,\(^{299}\) and that initially a new PDRP should be limited to these cases until a clearer jurisprudence about the protection of personas in cyberspace emerges. This approach also goes some way towards alleviating concerns about the potential chilling effect on free speech of any new procedure for personal domain name dispute resolution. There may be some question as to whether a PDRP should automatically apply to registrations in the newer <.name> gTLD, although there are already other protections for that gTLD that might assist people in the protection of their personal names.\(^{300}\) Thus, a new

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296. See, e.g., Trudeau v. Lanoue, No. 04 C 7165, 2006 WL 516579, at *2–4 (N.D. Ill. March 2, 2006) (asserting a right of publicity claim, amongst other claims, in a dispute involving a domain name corresponding with the plaintiff’s personal name); Wright v. Domain Source, Inc., No. 02 C 2525, 2002 WL 1998287, at *5 (N.D. Ill. Aug. 27, 2002) (finding that the defendant’s use of the plaintiff’s domain name violated the plaintiff’s right of publicity).

297. See UDRP, supra note 3, ¶ 4(k) (“The mandatory administrative proceeding requirements set forth in Paragraph 4 shall not prevent either you or the complainant from submitting the dispute to a court of competent jurisdiction for independent resolution before such mandatory administrative proceeding is commenced or after such proceeding is concluded.”).

298. And of course <name.com> disputes could be litigated in domestic courts under right of publicity laws as well. See supra note 296 and accompanying text (discussing two recent cases in which <name.com> disputes were litigated in domestic courts under right of publicity laws).

299. See supra note 19 and accompanying text (discussing several arbitrations that dealt with <name.com> disputes).

300. See Lipton, supra note 6, at 1420–21 (describing domain name "watch" service and
PDRP should, at least initially, only be incorporated by reference into domain name registration agreements for <.com> domain names. It could later be extended or modified if the need arose.

A new PDRP could be drafted in terms similar to the UDRP. It could adopt the UDRP’s basic structure and general terms, including representations and warranties made by the registrant, orders that could be made by arbitrators, and procedural matters such as how to lodge communications relating to a dispute. As with the UDRP, a person who has registered a <name.com> domain name would be required to submit to a mandatory arbitration proceeding if a complainant with the relevant personal name established the matters set forth in the policy. Again, as with the UDRP, an administrative proceeding under the PDRP would not prevent either party from taking the dispute to a relevant court. The idea would be to streamline

"defensive registration" service, which may act as protections for the gTLD). "Watch” service allows an individual to be notified if anyone else attempts to register a given domain name without having to register it herself. Id. at 1421. "Defensive registration” service allows a person with a legitimate interest in a domain name to register it without having to actively use it in order to maintain the registration. Id.

301. See UDRP, supra note 3, ¶ 2 (describing regulations regarding registering a domain name). The UDRP specifically states:

By applying to register a domain name, or by asking use to maintain or renew a domain name registration, you hereby represent and warrant to us that (a) the statements that you made in your Registration Agreement are complete and accurate; (b) to your knowledge, the registration of the domain name will not infringe upon or otherwise violate the rights of any third party; (c) you are not registering the domain name for an unlawful purpose; and (d) you will not knowingly use the domain name in violation of any applicable laws or regulations. It is your responsibility to determine whether your domain name registration infringes or violates someone else’s rights.

Id.

302. See id. ¶ 4(i) ("The remedies available to a complainant pursuant to any proceeding before an Administrative Panel shall be limited to requiring the cancellation of your domain name or the transfer of your domain name registration to the complainant."). For a more detailed discussion of proposed PDRP remedies, see infra Part IV.D.


304. This could ultimately be expanded to include some other iterations of the name, if there was ever a need to extend the policy more broadly.

305. The UDRP provides:

The mandatory administrative proceeding requirements set forth in Paragraph 4 shall not prevent either you or the complainant from submitting the dispute to a court of competent jurisdiction for independent resolution before such mandatory administrative proceeding is commenced or after such proceeding is concluded. If an Administrative Panel decides that your domain name registration should be
disputes in a more accessible forum than is currently available in court proceedings due to cost and jurisdiction issues.

B. The Basis of a PDRP Complaint

To establish a complaint under the new PDRP, a complainant should be required to establish that: (a) the registrant’s domain name corresponds letter for letter with the complainant’s personal name, (b) the registrant has no legitimate interests in the domain name, and (c) the registrant has registered or used the name for an unauthorized commercial purpose. This would be the PDRP analog to clause 4(a) of the UDRP.306 Rather than establishing a trademark interest, the complainant would only have to establish what her own name is—this should be easier than establishing a trademark right in a personal name for obvious reasons. The provision should cover a complainant’s actual personal name, as well as a name she is commonly known by. Thus, it would cover "Cher" for "Cheryl Sarkisian LaPiere" and "Madonna" for "Madonna Louise Veronica Ciccone."307 It could also potentially cover "Tyra" for "Tyra Banks" and "Trump" for "Donald Trump."308
The requirement to show that the registrant has no legitimate interests in the domain name would be necessary to cover cases where, for example, the registrant happens to have the same personal name as a complainant. In cases of competing legitimate interests in the same name, a "first come, first served" rule, subject to private negotiation between the parties, is probably preferable to a dispute resolution mechanism in which the arbitrators have little to go on as to who has the best interest in a given domain name. This accords with the way the UDRP works in the case of competing trademark interests.\footnote{See Lipton, supra note 86, at 514 (describing the first-come, first-served domain registration system established by ICANN).} It may be that ultimately domain name sharing arrangements could be developed for such situations either by private agreement between parties or facilitated through a body such as the Internet Corporation for Assigned Names and Numbers ("ICANN").\footnote{ICANN is the body that manages the Internet domain name system. See generally ICANN.com, http://www.icann.org (last visited Oct. 5, 2008) (on file with the Washington and Lee Law Review). The author has canvassed the possibility of domain name sharing previously in the trademark context, and the mechanics of such arrangements for personal names would work similarly. Thus, domain sharing strategies for personal names are not discussed further here. See generally Lipton, supra note 86.}

With respect to the unauthorized commercial use requirement, the PDRP could give examples of such uses or could leave the wording vague and allow arbitrators over time to determine what constitutes an unauthorized commercial use on a case by case basis. If the PDRP were to be drafted more comprehensively to include examples of unauthorized commercial use, these could be taken from current right of publicity statutes. For example, an Indiana statute defines "commercial purpose" in the context of the right of publicity as: "the use of an aspect of a personality’s right of publicity . . . (1) On or in connection with a product, merchandise, goods, services, or commercial activities. (2) For advertising or soliciting purchases of products, merchandise, goods, services, or for promoting commercial activities. (3) For the purpose of fundraising." The incorporation of such a definition would give arbitrators first instance of the policy in the interests of avoiding chilling speech. This may be a little like the "look-a-like" and "sound-a-like" cases under the right of publicity in the "real world," which have been criticized for extending the right too far. \footnote{See generally Lipton, supra note 86.} See Steven C. Clay, Note, Starstruck: The Overextension of Celebrity Publicity Rights in State and Federal Courts, 79 MINN. L. REV. 485, 487 (1994) ("[T]he right of publicity as applied in White and other cases has far outgrown the limited rationales that support it and other intellectual property protections."); William M. Heberer III, Comment, The Overprotection of Celebrity: A Comment on White v. Samsung Electronics America Inc., 22 HOFSTRA L. REV. 729, 771 (1994) (arguing that a Samsung advertisement parodying Vanna White was fair use and should have been allowable under copyright law).}
some guidance in applying the PDRP to the registrant’s activities, and may be helpful at least in the early days of such a dispute resolution policy. It would also allow disputing parties to draw to some extent on existing personality rights jurisprudence to help inform initial determinations under the PDRP. Although this test does reflect some concepts traditionally associated with trademark law, it is somewhat broader with its inclusion of uses such as the promotion of commercial activities for fundraising purposes.

C. A "Legitimate Interest" Defense Under the PDRP

It may be a good idea for the PDRP to include a defense such as that found in clause 4(c) of the UDRP to give the registrant some guidance on how to establish a legitimate interest in a given domain name. The indicia of a legitimate interest in the UDRP largely relate to good faith uses of the domain name in connection with the registrant’s own commercial or non-commercial endeavors. Any legitimate interest provision included in a new PDRP would have to be drafted differently because the policy would actually prohibit some unauthorized commercial uses even if they are associated with a bona fide business plan of the registrant. The UDRP, for example, currently excuses, as legitimate, a registrant’s use, or demonstrable preparation to use, a relevant "domain name in connection with a bona fide offering of goods or services." This makes sense in a trademark-based system because it amounts to two competing legitimate interests in using the mark in a domain name, presumably in different areas of commerce. For example, if the complainant has registered the trademark "Hypo" for medical syringes and I have registered the domain name <hypo.com> for a business involving the sale of practice law

312. The UDRP gives examples of legitimate use, including the registrant’s ability to establish that:

(i) before any notice to [the registrant] of the dispute, [the registrant’s] use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services; or
(ii) [the registrant] (as an individual, business, or other organization) [has] been commonly known by the domain name, even if [she has] acquired no trademark or service mark rights; or
(iii) [the registrant is] making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

UDRP, supra note 3, ¶ 4(c).

313. Id. ¶ 4(c)(i).

314. The issues arising in relation to two competing trademark interests with one corresponding domain name are taken up in more detail in Lipton, supra note 86.
exam questions, and I have registered the domain name in good faith for these purposes, I should be entitled to use it.315

However, comparing this to the proposed PDRP, if the policy behind the right of publicity is to prevent anyone from making any kind of unjust profit out of another person’s name or likeness, the PDRP should not permit a domain name registrant to register another person’s name as a domain name even for some bona fide offerings of goods or services. In any event, it is difficult to think of a situation in which a registrant would register someone else’s name as a domain name with such an intent. Why would anyone register <tomcruise.com> for the sale of goods or services completely unrelated to Tom Cruise, unless they wanted to use the name to attract attention to their own goods, services, or advertising? 316 This would hardly be in good faith if we accept that individuals have a right to prevent an unauthorized commercial profit being made from their online persona in certain cases, such as with respect to <name.com> versions of their personal names. Even if Tom Cruise himself has no intention of using <tomcruise.com> to sell particular goods or services, the unauthorized registrant has interfered with his ability to control his persona in commerce, which may be prohibited under a personality rights framework.317

There may be conflicts between the UDRP and the new PDRP where a personal name truly is a trademark, as when an individual runs a business under her own name. In such a case, it is arguable that trademark-based laws should

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315. If such a case was brought under domestic trademark law, I may have some difficulties under the "initial interest confusion" doctrine. The medical supply company might argue in a trademark infringement suit that, even though consumers are not confused about the source of the products when they get to my website, I am potentially diverting business from them by attracting consumers to my website by using a similar online address. It may be that consumers who assume that <hypo.com> is the website of the medical supply company would accidentally access my website and then cease looking for the other company on the basis that it is too difficult to find. Regardless of what view a court would take of this argument under domestic trademark law, the UDRP currently has no "initial interest confusion" doctrine built into it in this sense and seems to allow as a defense that the registrant was using, or planning to use, the relevant domain name in a bona fide trademark manner. See supra note 112 and accompanying text (discussing the initial interest doctrine in trademark law).


apply with respect to the trademarked version of the name. Of course, this
happens routinely in judicial proceedings under trademark law. In such cases,
courts have the power to determine trademark-based claims and right of
publicity claims in the alternative.\footnote{See generally Rogers v. Grimaldi, 875 F.2d 994 (2d Cir. 1988) (assessing the use of
Ginger Rogers’s name in a movie with which she had no involvement); Trudeau v. Lanoue, No.
04 C 7165, 2006 WL 516579, at *2–4 (N.D. Ill. Mar. 2, 2006) (discussing the use of
<trudeau.com> by a reseller to sell goods associated with Kevin Trudeau).} It may be that the new PDRP should
include some provision for joining UDRP proceedings with PDRP proceedings
in such situations, allowing one arbitrator or panel to hear the entire dispute and
decide whether the name in question is really being used by the registrant in a
trademark sense or in a personal sense. If PDRP claims are to be at least
initially limited to <.com> registration agreements, a procedure for joining
PDRP and UDRP disputes would only have to be developed and incorporated
into those agreements. There would be no need to incorporate a joining
procedure into other registration agreements, such as <.net> and <.org>
registrations, into which only the UDRP would be incorporated.

There may also be situations in which a domain name registrant simply
happens to have the same name as a complainant and has registered the domain
name for her own personal use, for example, to set up her own webpage. These
situations may actually be more difficult than they seem as a matter of policy.
It may be that a complainant is actually harmed in a right of publicity sense
even where the registrant herself has a legitimate interest in the name by virtue
of having a similar name to the complainant. As the right of publicity has no
consumer confusion requirement, it may be that simply using the complainant’s
name in a domain name on a personal website might contravene the right in
some cases, particularly if the website contains some unrelated commercial
advertising. This may be one area in which personality rights theory needs to
be pared down to meet the realities of the Internet age. In most cases, it would
probably be best to excuse, as a legitimate interest under the PDRP, the conduct
of a person who has been commonly known by the relevant name and is only
using it for her own personal website. Of course, if the registrant were not
regarded as making a commercial use of the name in question, there would be
no basis for a complaint under the PDRP in the first place.
D. Remedies Under the PDRP

Like the UDRP, the PDRP would be limited in terms of possible remedies to a cancellation or transfer order over the relevant domain name. Thus, a successful complainant could either have the registration of the domain name cancelled altogether or could have the name transferred to her. In most personal domain name disputes under the UDRP to date, the registrant has sought a transfer even where she does not intend to use the name herself, presumably in order to maintain control over the most intuitive version of her online persona—the <name.com> version of her name.

Because of these limitations on remedies, the proposed PDRP may actually have less of a potential chilling effect on online speech, if any, than the threat of litigation under the right of publicity. Although the usual remedy in a right of publicity action is an injunction, which in the domain name case may be tantamount to a cancellation or transfer order under the PDRP, courts can award other remedies for infringement of personality rights. These include damages based on injury to a plaintiff’s feelings, damages based on unjust enrichment, and accounts of profits. Additionally, even an injunction may be tailored to a given case more broadly than a mere transfer or cancellation order: For example, it may prohibit the defendant from engaging in any commerce online utilizing the name or likeness of a plaintiff, regardless of the domain name used by the defendant.

Given the broad range of potential remedies under the right of publicity, a domain name registrant may be more deterred from engaging in unauthorized online use of a personal domain name than she would be if most personal

319. See UDRP, supra note 3, ¶ 4(i) ("The remedies available to a complainant pursuant to any proceeding before an Administrative Panel shall be limited to requiring the cancellation of your domain name or the transfer of your domain name registration to the complainant.").
321. 1 GILSON LALONDE, supra note 5, § 2.16[6] ("Upon proof of a violation of the right of publicity the courts almost always grant injunctive relief. Since the primary purpose of the right of publicity is to prevent the unauthorized use of a person’s name and likeness, an injunction may be perfectly tailored to prevent further violation.").
322. Id.
323. Id.
324. Id.
325. See 3 GILSON LALONDE, supra note 5, § 14.02(1) (2008) ("[T]hough injunctive relief is an extraordinary remedy, the variety of acts that a court may prohibit or order are virtually limitless.").
domain name disputes were arbitrated under a PDRP. One might argue that the threat of personality rights litigation is available for personal domain name disputes today, and it does not appear to be chilling online conduct. However, this may be a temporary situation. If, for example, the trend in UDRP arbitration changes and UDRP arbitrators become less prepared to accept trademark rights in individuals’ names, then right of publicity litigation may become a much more realistic prospect. It may in fact be the case that right of publicity actions have not been brought more often in domain name disputes simply because many people have not thought of it yet. It is possible that such actions will become more common in the future. There have already been some right of publicity actions involving personal domain names in recent years.326

If right of publicity disputes gain popularity in the personal domain name context, the development of a PDRP would be a welcome addition for both complainants and domain name registrants. It would be quicker, easier, and cheaper for both parties. It would also provide the most appropriate remedy in such cases—a transfer or cancellation order—and may deter complainants from seeking additional remedies in judicial proceedings. If the cost is significantly less to a complainant, but the remedy is limited, the complainant may still prefer this course of action over more time consuming and costly litigation, despite the fact that litigation may provide more valuable and varied remedies. This move towards arbitration with its more limited remedies may thus create less of a chilling effect on online speech than would personality rights litigation.

E. Politicians’ Names: A Special Case?

As noted in Part III.B.3, the names of politicians in the domain space, particularly in the lead-up to an election, may pose special problems. Where a registrant has registered a politician’s name as a domain name for purely expressive purposes, there are obvious First Amendment arguments that this conduct should not be proscribed. Speech critical of politicians and their policies is an essential aspect of a representative democracy.327 However, it is

326. See supra note 296 and accompanying text (discussing two recent cases in which <name.com> disputes were litigated in domestic courts under right of publicity laws).

327. See Coleman, supra note 70, at 263 ("[W]idespread use of a new and inexpensive communications medium has the potential to lead to unprecedented citizen participation in politics . . . ."); Lipton, supra note 63, at 129 ("The electoral process is fundamental to the U.S. system of government, and the ability to disseminate and receive important information about politics and politicians in an electoral context is key to the functioning of that system.").
also important that Internet users are not misled about the authorized web presence of a given politician. The question is: What is the correct presumption here? Should there be a presumption that all <name.com> domain names automatically belong to the relevant politician, so that others wishing to comment on them are to be relegated to "lesser" domain spaces such as <name.net>, or <namesucks.com>? Or are we better off with no such presumption and a "first come, first served" system in which even a critic of a politician is entitled to the <name.com> version of the name if she registers it first?

Any personality rights framework for dispute resolution will only assist individuals, including politicians, against unauthorized commercial conduct. Thus, where the conduct complained of is purely expressive with no commercial elements, the right of publicity will not assist the politician. On this view, a PDRP based on the right of publicity should also not assist the politician, unless all conduct on the Internet is regarded as "commercial" which may well not be an accurate reflection of the law. If the view is taken that a personality rights based PDRP only prohibits commercial conduct, then some conduct involving a <name.com> version of a politician’s name will be prohibited and other conduct will not.

The example of the <kerryedwards.com> domain name from the 2004 American presidential election, for example, may have been a candidate for protection under a PDRP as suggested here. An individual called Mr. Kerry Edwards did have a legitimate interest in the name in the sense that it was his personal name. However, he was also using the name for a commercial purpose during the presidential race by attempting to auction it to the highest bidder. An arbitrator under the PDRP would have needed to decide whether Mr. Kerry Edwards’s legitimate interest in his personal name outweighed conduct that clearly sought to profit from Senator John Kerry’s and Senator John Edwards’s respective names. In actual fact, it is likely that Senators Kerry and Edwards would have had no luck even under the PDRP contemplated in this Article—Mr. Kerry Edwards did have a legitimate interest in the name by

328. 1 GILSON LALONDE, supra note 5, § 2.16[1] ("The right of publicity . . . is the right of an individual to control the commercial use of his or her name, likeness, signature, or other personal characteristics.").
329. See supra note 113 and accompanying text (discussing cases in which courts labeled use of the Internet as inherently commercial).
330. Lastowka, supra note 22, at 64 ("[I]t is not clear how Bucci had used the Planned Parenthood mark in commerce, given that he lacked any product or service. Those who advocate for an expansion of trademark use often criticize Bucci for this reason.").
331. See Lipton, supra note 63, at 64–65 (discussing the <kerryedwards.com> domain name dispute).
virtue of his personal name, and <kerryedwards.com> does not correspond letter for letter with the name of either senator. It is assumed here that, at least initially, the PDRP should be narrowly confined to names that exactly match a complainant’s personal name in the <.com> space to avoid unnecessary chilling effects on speech. If the facts were different and the name in question was <johnkerry.com>, a registrant attempting to auction the name for profit may well have lost a PDRP proceeding.

In cases where an unauthorized use of a politician’s name in a <name.com> domain is commercial, the PDRP would cover this without the need for any special provisions relating to politicians’ names. Certainly, the PDRP as contemplated here would prevent political cybersquatting: that is, registration of a politician’s name as a domain name with the intent to sell it for a profit. It may simply not cover registrants with purely expressive motives. Politicians may also become more careful about their names in the domain space over time, and they may become better at negotiating with those who have registered their domain names before them. If, after some years of operation of the PDRP a need is perceived to do something more specifically directed at creating clearer rules or presumptions for political domain names, such rights could be added to the PDRP at a later date.

F. Duration and Descendibility of Personal Name Rights Under the PDRP

One contentious issue that arises under personality rights law is the appropriate duration of those rights. Related questions are whether the rights are transferable or descendible. The PDRP as contemplated in this Article has presumed protection for a personal domain name during the course of the relevant person’s lifetime and has not focused on issues of transferability or descendibility. This is implicit in the suggestion that the PDRP should require the complainant to establish that the domain name in question corresponds

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332. Such conduct would be actionable under 15 U.S.C. § 1129(1)(A) (2006), although this has the time and cost disadvantages associated with any litigation.

333. In particular, there has been some disagreement as to whether personality rights should survive a person’s death. See 1 GILSON LALONDE, supra note 5, § 2.16[4] (“There is sharp disagreement among the courts, and even within some courts, as to whether the right of publicity is inheritable or whether it dies with the individual.”); see also Kwall, supra note 57, at 81–86 (discussing justifications for a descendible right of publicity).

334. See Kwall, supra note 57, at 81–86 (tracing expansion of the right of publicity from a right that is capable of being assigned or licensed to being descendible in some jurisdictions); see also 1 GILSON LALONDE, supra note 5, § 2.16[5] (acknowledging that the right of publicity may be sold and assigned).
letter for letter with her personal name. Once she is deceased, she can no longer establish this. Her estate may be able to establish that the name corresponds with her name, but that is not the intent of the PDRP as crafted here. The idea here has been to protect individuals against unauthorized commercial conduct with respect to their names in a domain space where perhaps an individual has not thought to register the name herself, but the public might expect her to have done so. In this sense, the rights as contemplated here spring more from personhood than from property theory.335

If, for example, I enter <tomcruise.com> into my web browser, I might expect to find the authorized Tom Cruise website or no content at all if Mr. Cruise has not established an authorized website.336 However, if I were to enter the name of a deceased famous person into a web browser, such as <marlonbrando.com>, would I necessarily assume that this was an authorized website for Mr. Brando? Or would I rather assume that, after his death, his estate has little interest in maintaining such a website? In actual fact, the <marlonbrando.com> domain name, along with domain names corresponding to a number of other famous deceased persons, are used for "official" websites managed by assignees of intellectual property rights in those people’s names.337 However, by way of contrast, a UDRP dispute involving Albert Einstein’s name was decided against Einstein’s estate.338 The decision was made largely on the grounds that an Internet user would not necessarily expect the domain name <alberteinstein.com> to resolve to a website actually run by Einstein’s estate such a lengthy period after his death.339

335. See supra notes 54, 56 and accompanying text (discussing numerous commentators’ views on the personhood and property theories behind the right of publicity).


339. Id. § 6. The opinion states:

There is a significant difference between the expectations of Internauts entering a domain name of a celebrity (alive or dead) who is (or was) famously associated in commerce with the supply of goods or services, on the one hand, and their expectations entering a domain name of a celebrity long since dead who was not so associated, on the other. The former expect to find a site offering goods or services
What explains the differences here? Obviously, the estates of some famous people have been extremely vigilant about protecting all relevant intellectual property rights, including personality rights.340 If estates of famous people or transferees of intellectual property rights pertaining to famous people are vigilant about those rights and ensure registration of relevant domain names before anyone else has done so, there is no problem. There is no need for a PDRP to operate here because estates of famous people that are aggressive about protecting relevant rights will already have registered important domain names. This may explain why Einstein’s estate lost its arbitration. Perhaps the combination of the period of time since Einstein’s death and the fact that the estate had not been sufficiently vigilant to register the domain name before anyone else were sufficient factors to justify the result. On the other hand, given that the current registrants of <einstein.com> and <alberteinstein.com> do not appear to be using the names for any particular purpose,341 it is arguable that the names would be better utilized by Einstein’s estate for information about Einstein and his life.

Given this possibility of wasteful uses of a deceased person’s name and the fact that personality rights are transferable in at least some jurisdictions,342 there is a plausible argument that the PDRP should allow for assignees and beneficiaries of personality rights to bring complaints in the name of the

associated with the celebrity’s trademark. The latter cannot reasonably have such an expectation.

Albert Einstein has been dead for 47 years. He was one of the most famous people of the 20th century. The name Albert Einstein is universally associated with him. That operates to the disadvantage of Complainant in this case. Internauts entering the disputed domain name would not expect to find a site offering goods or services with which Dr. Einstein was known to have been associated during his lifetime because, on the evidence, he was not known as having any such association. Nor would they expect to find a site associated with Complainant because Complainant has not established that it has any common law trademark rights.

Id.


341. As of the date of writing, they both look like cybersquatting sites perhaps disguised as legitimate sites. One has no commentary at all—just a graphic and the name "einstein.com", while the other contains lists of services unrelated to the domain name <alberteinstein.com>. Each of these sites was last viewed on Oct. 5, 2008.

342. 1 GILSON LALONDE, supra note 5, § 2.16[5] (acknowledging that the right of publicity may be sold and assigned). For an example of a specific state law on the transferability of publicity rights, see IND. CODE § 32-36-1-16 (2002), which provides that "[t]he rights recognized under this chapter are property rights, freely transferable and descendible, in whole or in part . . . ."
assignor or deceased person. If this were to be done, the PDRP would need to allow a complainant to show either that she has a personal name corresponding with the given domain name or that she controls personality rights relating to a person with such a name. This raises some practical difficulties, including the fact that if the beneficiary or transferee of the deceased lives in a jurisdiction that has no personality rights laws, or has personality rights laws that do not allow for transfer or descendibility, there is little plausible basis for bringing a PDRP complaint. In other words, the complainant would not be able to show that she controlled the relevant personality rights.

Additionally, it may be difficult for arbitrators to determine the validity of a claim that a complainant controls personality rights in another person’s name. It is a simple enough task for arbitrators to accept evidence of what a complainant’s personal name actually is under the PDRP as contemplated here. It may be more difficult for them to evaluate evidence of claims about personality rights of deceased persons or persons who have allegedly transferred personality rights to others. The PDRP procedure is intended to achieve the same advantages in terms of time, cost, and procedural simplicity as the UDRP does for trademark-related claims. If arbitrators are asked to evaluate more complex questions than simply what a person claims her name actually is, this could interfere with the operation of the procedure in terms of time, cost and perhaps even predictability of outcome. These might be good reasons to leave out matters relating to transferability and descendibility of personal rights in domain names until a later iteration of the PDRP.

Other arguments against the initial inclusion of a provision allowing assignees and beneficiaries of personality rights to bring complaints under the PDRP include concerns about how long a person’s image should be controlled by her estate after her death. There may also be concerns that the transferability and descendibility of rights in a persona are not universally accepted even within the United States, so it may be a mistake to foist them on a global system for protecting personal name interests in domain names.

343. See Kwall, supra note 57, at 81–86 (arguing that the longer the principal has been dead, the less likely the right of publicity should prevail over free speech concerns).


345. Of course, the same argument could be made more generally in terms of foisting a PDRP on the global economy that is based on unharmonized American state law. However, this Article suggests that it may be less objectionable to base the PDRP on personality rights theory if some of the more contentious aspects of the theory, such as questions of duration and descendibility of rights, can be avoided, at least in the initial iteration of the PDRP.
Further, there may be some question as to how often these issues would arise in practice in the domain name context. As noted above, the estates of many famous people currently hold the domain names corresponding with the relevant names, while celebrities and politicians are now getting better about aggressively fighting for control of relevant domain names during their lifetimes. The result may be that the question of post-mortem personal domain name disputes has minimal practical importance. If a PDRP is established now to help those who want to assert interests in relevant domain names to obtain those names, those people can presumably hold on to the names and pass them to their estates in the future as a matter of contract law. It is a simple matter for a successful complainant to transfer the domain name to anyone she wants, either during her lifetime or presumably post mortem if she executes the transfer formalities prior to her death.

V. Conclusion

This Article has identified why over-reliance on trademark-focused rules, such as the UDRP, to resolve personal domain name disputes leads to inconsistent and arbitrary results. It has suggested that a personality rights model would create a better substantive framework for dealing with these disputes. However, personality rights litigation suffers from cost and procedural disadvantages. It also exists today largely as a matter of unharmonized state law within the United States. The aim of this Article has been to suggest a new procedure for personal domain name disputes—a PDRP—that marries together the procedural and globalization advantages of the UDRP with the substantive theoretical advantages of the right of publicity. This approach potentially achieves the best of both worlds. It maintains the procedural benefits of the UDRP—the avenue most often chosen by complainants in personal domain name disputes today—while basing decisions on a theory that more appropriately protects interests in an individual’s persona than trademark law.


347. See generally Beezy, supra note 143 (discussing developments in trademark practices in the entertainment industry); Moreland & Springer, supra note 4 (examining celebrity use of ICANN arbitration to recover domain names).
Drafting and implementing a new PDRP would be a relatively easy and cost-effective matter. It would require the drafting and adoption of such a procedure by ICANN. Implementation would simply require the incorporation of the new PDRP by reference into <.com> registration agreements in the first instance. The drafting of the PDRP would generally mirror the drafting of the UDRP except for some changes in substance to the text of UDRP’s clause 4 relating to the matters the claimant needs to prove and the nature and scope of the legitimate use defense available to the registrant.

The continued development of personal domain name jurisprudence based on trademark principles threatens to warp the boundaries of trademark law and to unjustifiably extend trademark practice online into areas where the alleged trademarks are mere fictions. Alternatively, it could fail to protect interests that really should be protected as a matter of tort law under the right of publicity.348 In any event, the application of the trademark-based UDRP to personal domain name disputes is clearly creating inconsistent results.349

Another important advantage of a PDRP over the UDRP with respect to personal domain name disputes is that it might refocus judicial attention on the appropriate legal principles when these disputes do end up in court. While the trademark-focused UDRP remains the most frequent first port of call with respect to domain name disputes, litigation also seems to center around the trademark-based provisions of domestic law. The Falwell case, for example, was argued purely with respect to trademarks and did not raise personality rights claims at all.350 The Kathleen Kennedy Townsend complaint would likely have been successful if it had been litigated under § 1129(1)(A) of the Lanham Act, but it was brought under the trademark-based UDRP instead.351 It

348. See supra note 43 and accompanying text (discussing a number of instances in which interests that arguably should have been protected under the right of publicity were not protected).

349. See supra note 98 and accompanying text (questioning the disparate treatment of celebrities’ UDRP claims).

350. See generally Lamparello v. Falwell, 420 F.3d 309 (4th Cir. 2005), cert. denied, 547 U.S. 1069 (2006). This Article does not criticize the holding of the Falwell litigation but merely observes with interest that the entire case was argued under trademark law, rather than the right of publicity, despite the fact that the case revolved around rights in a personal name.


The Panel finds that the protection of an individual politician’s name, no matter how famous, is outside the scope of the Policy since it is not connected with commercial exploitation as set out in the Second WIPO Report. This does not mean that Complainant is without remedy. The ACPA contains express provisions protecting the rights in personal names. Complainant is free to pursue her claims in
may be that if the cost-effective avenue of choice for complainants focuses on more appropriate issues than trademark law, litigants would think to bring judicial proceedings under more appropriate provisions of domestic law in the event that the dispute does end up in court.

This Article has demonstrated the importance of developing a mechanism specifically and appropriately tailored to personal domain name disputes. This would be a simple and easy task for ICANN in practice. If a PDRP could be adopted along the lines described here, it might well result in a more effective resolution of domain name disputes involving personal names. It might also assist more generally with appropriately nuanced developments in cyberlaw, particularly pertaining to the protection of personality rights online. Given that Internet regulators are constantly striving to balance property and property-like rights online against free speech interests, the creation of more sophisticated laws and regulations that more clearly define the scope of relevant interests is of paramount importance. Trademark law in particular is currently under a lot of pressure in cyberspace. If we are truly concerned about identifying the boundaries of trademark law on the Internet, we must be prepared to address situations that do not really involve trademarks by more targeted and effective means. The right of publicity could form the basis for a more well-tailored approach to personal domain name disputes, provided that we can avoid some of the existing practical and theoretical limitations of personality rights jurisprudence. A carefully drafted PDRP might achieve this result in practice.

that forum. And, as mentioned, the committee may have rights in the marks that are sufficiently commercial as to entitle the committee to protection under the Policy. 

Id.

352. See supra note 22 and accompanying text (noting that trademark law has come under attack in recent years and listing a number of commentators’ attacking works).