

Fla "Apprentice" Trumps Domain Cybersquatter

**FLORIDA** 

But he that filches from me my good name Robs me of that which not enriches him,

--Shakespeare's Othello. Act III, Scene 3.

And makes me poor indeed.

filed a lawsuit.

on Tuesday, November 14, 2006 - 12:57 PM - 5037 Reads

By David Roy Ellis

Attorney at Law, Largo

Who steals my purse steals trash,

For those of you who watch "The Apprentice," Donald Trump's television

reality show, you may remember that Kendra Todd was the winning candidate in the show's third season, the first successful woman

contestant, and the first from Florida. As an instant television celebrity,

Kendra's name immediately became a valuable commodity, and sure enough, someone came along trying to make a few bucks at her expense.

One of Kendra's former associates in the real estate business, Leo Miller,

bought the domain name kendratodd.com, just before Kendra was scheduled to appear on the show and it appeared that a domain name

with a contestant's name in it might prove valuable. The two had had a

business conflict and Miller thought that he could exert pressure on her to extract money from her by holding the domain name hostage. He

demanded that she pay him \$30,000 to relinquish his ownership in the

website, after which he would charge her an additional \$2,000 to sell her the domain name that he claimed he "owned." After that he would "sell

you the website for \$2,000." He further threatened her that if she did not

pay him these amounts, he would "use the website to generate business

After Kendra had her lawyer send Miller a cease and desist letter, he said he would immediately remove the website from the Internet. However, he

did not do so, but instead changed it to add a variety of false, disparaging,

and defamatory statements. The heading of his webpage read "Apprentice

Named in Lawsuit," and the first sentence of the text stated: "Kendra

Todd, now appearing on NBC's 'The Apprentice' has been named in a lawsuit filed by Leo Miller." At the bottom of the web page, the Miller and

his attorney were mentioned, along with information about his radio

program and real estate office and phone number and the attorney's

phone number. The statements were completely false, as the Miller never

After further unsuccessful attempts to obtain rights to the domain name,

Kendra brought a complaint under the provisions of the Uniform Dispute

Resolution Policy (UDRP), a dispute policy implemented by ICANN, the Internet Corporation for Assigned Names and Numbers, a not-for-profit

"APPRENTICE"

CYBERSQUATTER IN DOMAIN NAME DISPUTE

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There are 17 unregistered users and 0 registered users on-line.

You can log-in or register for a user account here.

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> private-sector corporation created in October 1998 by a coalition of Internet business, technical, academic, and user representatives to provide technical coordination for the Internet, including the assignment of Internet domain names. Under the UDRP, when a complaint is filed against the owner of a domain name, the owner must submit to a mandatory administrative proceeding conducted before a dispute resolution service provider approved by

> ICANN. Among these are the World Intellectual Property Organization

(WIPO) and the National Arbitration Forum.

Under the UDRP, a claimant may assert a cause of action against a domain name holder if (1) the domain name is identical or confusingly similar to a trademark or service mark in which the claimant has rights; (2) the domain name holder has no rights or legitimate interest with respect to the domain name; and (3) the domain name has been registered and is being used in bad faith. In the dispute resolution proceeding, the claimant must prove all three elements.

The panel considers several elements to be evidence of registration and use of a domain name in bad faith, including (1) circumstances indicating that the domain name holder has registered or acquired a domain name

primarily for the purpose of selling, renting or otherwise transferring the domain name registration to the claimant; or (2) registration of the domain name to prevent the owner of a trademark or service mark from registering the domain name; or (3) registration of the domain name primarily for the purpose of disrupting the business of a competitor; or (4) use of the domain name to intentionally attract for commercial gain Internet users to a web site or other online location by creating a likelihood of confusion. If the panel finds that the claimant has proved one or more of these elements, the panel may order the transfer of the domain name. The fees charged by the dispute resolution provider must be paid by the

claimant, and all communications are made in writing via e-mail, mail or fax. There are no actual hearings held on the matter. The entire dispute resolution proceeding is designed to cost less than \$1,500 and last for about 45 days.

We submitted Kendra's case to the National Arbitration Forum (NAF) for

adjudication by a single panelist in the summer of 2006. In our complaint we noted that while Miller operated the website, he used it for his own purposes for commercial gain and to confuse and mislead the public, advertising "Kendra Todd Real Estate" and contacting prospective customers directly and through his agents for his own real estate services. We further alleged that the domain name, kendratodd.com, was identical

or confusingly similar to a service mark in which the Kendra has statutory and common law rights. We had obtained a Service Mark Registration with the State of Florida for KENDRA TODD for real estate services and entertainment services, and had also filed for a Federal registration with the U.S. Patent and Trademark Office. In additional, we noted that Kendra had acquired common law rights in her personal name and service mark, having provided real estate services for many years, and is a television personality and celebrity providing entertainment services by virtue of having been named "The Apprentice" on the television program as well as making personal appearances and appearances on television and radio.

proprietary rights in his or her name to satisfy the standing requirement of the UDRP due to the celebrity's fame and association of their name with their persona. That is, a celebrity's name can serve as a trademark when used to identify the celebrity's performance services. These included cases involving Julia Roberts, Mick Jagger, and Kevin Spacey, which ruled that trademark registration was not necessary and that these entertainers had sufficient secondary associations in their names to establish common law trademark rights.

Other UDRP panel had ruled that a celebrity may have sufficient

Hammerton, FA 95261 (NAF, Sept. 11, 2000); Spacey v. Alberta Hot Rods, FA0205000114437 (NAF, Aug. 1, 2002). See also Tupac Shakur v. Shakur Info Page, AF-0346 (eResolution Sept. 28, 2000) ("A person may acquire such a reputation in his or her own name as to give rise to trademark rights in that name at common law"), cited by the arbitrator in Kendra's case. The arbitrator agreed that Kendra had established trademark rights in the

See e.g. Roberts v. Boyd, D2000-0210 (WIPO, May 29, 2000); Jagger v.

KENDRA TODD mark through a state Service Mark registration, an application with the USPTO, and because the mark was Kendra's personal name. He further found that Miller had used the website to display false information about Kendra. In addition, Miller had attempted to use the disputed domain name as leverage in attempting to collect money from Kendra. Miller had also attempted to sell the kendratodd.com domain name to Kendra. The arbitrator ruled that these actions demonstrated that Miller was not using the disputed domain name for either a bona fide offering of goods or services or for a legitimate noncommercial or fair use.

kendratodd.com domain name to Kendra for amounts in excess of his outof-pocket expenses was evidence of his bad faith registration and use of the domain name. Additionally, the arbitrator found that Miller registered the disputed domain name in an attempt to use the disputed domain name against Kendra to create a likelihood of confusion as to the source and affiliation of Kendra with the disputed domain name. Such use of the domain name constituted bad faith registration and use.

Finally, the arbitrator found that that Miller's attempt to sell the

UDRP were satisfied, and he ordered the kendratodd.com domain name transferred from Miller to Kendra. Shortly afterwards, the registrar transferred the domain name to Kendra and she had the full use of the domain name that carried her name.

The arbitrator therefore ruled that all three elements required under the

David Ellis is a Largo attorney practicing copyrights, trademarks, patents, trade secrets, and intellectual property law; computer and cyberspace law; business, entertainment and arts law; and franchise, licensing and contract law. A graduate of M.I.T. and Harvard Law School, he is a registered patent attorney and the author of the book, A Computer Law Primer. He has taught Intellectual Property and Computer Law as an Adjunct Professor at the Law Schools of the University of Florida and Stetson University.

Please direct comments to ellislaw@alum.mit.edu http://www.lawyers.com/davidrellis

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