



WIPO Arbitration and Mediation Center

ADMINISTRATIVE PANEL DECISION

Carmen Electra, a/k/a Tara Leigh Patrick v. Network Operations Center

Case No. D2003-0852

1. The Parties

The Complainant is Carmen Electra, a/k/a Tara Leigh Patrick, C/O Joseph M. Gabriel, Esq., Liner Yankelevitz Sunshine & Regenstreif LLP, Los Angeles, California, United States of America, represented by Liner Yankelevitz Sunshine & Regenstreif LLP, United States of America.

The Respondent is Network Operations Center, High Prairie, Canada.

2. The Domain Name and Registrar

The disputed domain name, <carmenelectra.com> is registered with CORE Internet Council of Registrars.

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on October 28, 2003. On October 29, 2003, the Center transmitted by email to CORE Internet Council of Registrars a request for registrar verification in connection with the domain name in issue. On October 30, 2003, CORE Internet Council of Registrars transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing its contact details.

CORE Internet Council of Registrars also confirmed that the Uniform Domain Name Dispute Resolution Policy was adopted on December 1, 1999. Even though this post dated the registration of the domain name, the registration agreement provides for modification of the Dispute Policy and for deemed acceptance of such modification by continued registration.

CORE Internet Council of Registrars' verification response also showed that the registration was to expire on November 15, 2003. However, given the Registrar's

automatic renewal mechanism as advised to WIPO on November 7, 2003 (the precise details of which are not relevant here), and that the domain name in issue has been placed on “Registrar-lock,” the domain name has not been “deleted.”

In response to a notification by the Center that the Complaint was administratively deficient, the Complainant filed an amendment to the Complaint on November 10, 2003. The Center verified that the Complaint together with the amendment to the Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the “Policy”), the Rules for Uniform Domain Name Dispute Resolution Policy (the “Rules”), and the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the “Supplemental Rules”).

In accordance with the Rules, Paragraphs 2(a) and 4(a), the Center formally notified the Respondent of the Complaint, and the proceedings commenced on November 11, 2003. In accordance with the Rules, Paragraph 5(a), the due date for Response was December 1, 2003. The Respondent did not submit any Response. Accordingly, the Center notified the Respondent’s default on December 3, 2003.

The Center appointed Jon Lang as the Sole Panelist in this matter on December 15, 2003. The Panel finds that it was properly constituted. The Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Center to ensure compliance with the Rules, Paragraph 7.

4. Factual Background

The Complainant has asserted and has provided some evidence to support, *inter alia*, the following facts:

- (a) that she adopted the name Carmen Electra some 10 years ago;
- (b) that by that name she has become an internationally famous film and television actress appearing in over 25 theatrical and motion pictures, in over a dozen television specials and on the cover of internationally distributed magazines as well as frequently featuring in celebrity news and entertainment publications;
- (c) that she promotes various products using her name as a source, sponsor and endorser of such products.

The facts asserted are not challenged by the Respondent. They are perfectly reasonable in nature and having reviewed the information provided in support at Annex 3 to the Complaint, the Panel is entitled to and does find the facts established. (See *Dr. Michael Crichton v. Alberta Hot Rods*, WIPO Case No. D2002-0872).

5. Parties’ Contentions

A. Complainant

The Complainant contends:

- (a) that as a result of her activities, she has become famous throughout the world and the name Carmen Electra has acquired a secondary meaning such that the public associates the Complainant’s services as an actress and model with the name Carmen Electra;

- (b) that she has therefore acquired common law trademark rights in her name and therefore qualifies for protection under the Policy;
- (c) that the Respondent has registered the domain name in issue which uses the Complainant's name making it identical to the Complainant's common law trademark;
- (d) that the Respondent is using the domain name to divert traffic to a commercial website at "www.celebrity1000.com," a commercial website providing biographical information on some actors but apparently not the Complainant, and which also contains banner advertisements and links to numerous online retailers;
- (e) that the Respondent, Network Operations Center is the pseudonym for Jeff Burgar who has carried on the practice of stockpiling celebrity domain names and that in support of that contention two WIPO decisions are relied upon – *Dr. Michael Crichton v. Alberta Hot Rods*, WIPO Case No. D2002-0872 and *Pierce Brosnan v. Network Operations Center*, WIPO Case No. D2003-0519;
- (f) that no Response was received to a letter sent by the Complainant's attorneys to the Respondent alleging infringement and requesting a transfer of the domain name;
- (g) that the Respondent's bad faith is demonstrated by the fact that the domain name is used to divert Internet traffic; previous adverse findings in domain name matters evidencing stockpiling of celebrity names for improper purposes; that given an Internet user's expectation to "find a celebrity" at a domain name comprised of a celebrity's name, the Respondent's practice is likely to lead to confusion and mislead the public into thinking that the Complainant supports, endorses or is affiliated with the Respondent's website;
- (h) the Complainant also relies on previous domain name decisions finding that the Respondent has no legitimate interest in celebrity domain names.

B. Respondent

The Respondent did not reply to the Complainant's contentions.

6. Discussion and Findings

The Complainant must show, for the purposes of Paragraph 4(a) of the Policy, that the domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; that the Respondent has no rights or legitimate interests in respect of the domain name and that it was registered and is being used in bad faith.

A. Identical or Confusingly Similar

The domain name is clearly identical (or confusingly similar) to the Complainant's name, Carmen Electra so the only issue to decide under this limb of the requirements of Paragraph 4(a) of the Policy is whether the Complainant has rights in a trademark or service mark to which the domain name is similar. Paragraph 4(a) of the Policy does not require the Complainant to demonstrate rights in a registered mark; it can be

enough to demonstrate the existence of unregistered common law rights or sufficient rights to ground an action for passing off (*Julia Fiona Roberts v. Russell Boyd*, WIPO Case No. D2000-0210, *Jeannete Winterson v. Mark Hogarth*, WIPO Case No. D2000-0235).

To establish rights in a personal name for the purposes of Paragraph 4(a) of the Policy it is necessary to show that the name has been used as an indication of the source of goods or services supplied in trade or commerce and as a result of such use the name has become distinctive of that source. (*Dr. Michael Crichton v. Alberta Hot Rods*, WIPO Case No. D2002-0872). Thus, a celebrity's name can serve as a trademark or service mark for the purposes of Paragraph 4(a) if it is used to identify the celebrity's performance services (*Kevin Spacey v. Alberta Hot Rods*, NAF Claim No. FA0205000114437).

The Panel is satisfied that the public associates the name Carmen Electra with the Complainant's performance services such that the Complainant has trademark or service mark rights for the purposes of Paragraph 4(a) of the Policy, in the name Carmen Electra.

B. Rights or Legitimate Interests

The Complainant asserts for the purposes of Paragraph 4(a) of the Policy that the Respondent has no rights or legitimate interests in respect of the domain name and relies on the fact that it is diverting Internet traffic to a commercial website at "www.celebrity1000.com" which contains no mention of the Complainant, and past Panel decisions involving the Respondent (or Jeff Burgar). Panels must be cautious not to assume the absence of rights on the part of a Respondent simply because of past adverse decisions and each case must be looked at on the basis of its individual facts. However, it is worthy of mention that the Complainant has attached to the Complaint the decision of *Pierce Brosnan v. Network Operations Center*, WIPO Case No. D2003-0519, in which the Panel ordered the transfer of the domain name and which on the key facts appears more or less identical to this case. In the *Brosnan* case too, the (same) Respondent failed to file a Response. Where a Respondent fails to file a Response, a Panel is entitled to conclude that the Respondent could not have asserted anything that might have demonstrated the existence of "rights or legitimate interests."

Neither the Respondent nor the website "www.celebrity1000.com" appears to have any real connection with the Complainant. The Complainant's name is listed in an "Online Polls" section of the website (along with the names of several other celebrities, including that of Pierce Brosnan) but not in the "Celebrity Sites" section which gives biographical information on and photographs of the celebrities listed. Thus no information appears to be given on the Complainant or goods or services relating to the Complainant offered, and it does therefore appear, as the Complainant asserts, that the name Carmen Electra, in which the Complainant has rights, is being used to divert Internet traffic to the Respondent's website. In the absence of any information from the Respondent by way of a Response or reply to the Complainant's "letter before action" of September 26, 2003, setting out why it has rights to or legitimate interests in the name Carmen Electra, this Panel concludes that the Respondent has no such rights or legitimate interests.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy sets out a non-exhaustive list of circumstances which, if found by the Panel to be present, shall be evidence of the registration and use of the

domain name in bad faith, the final element to be established by a successful Complainant.

The circumstances described in sub Paragraph 4(b)(iv) are that “by using the domain name, you have intentionally attempted to attract, for commercial gain, internet users to your website 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 website or location or of a product or service on your website or location.”

Based on the case file and in the absence of any evidence to the contrary, the Panel finds that the Respondent has intentionally attempted to divert Internet users to its website. Whilst there is no clear evidence of “commercial gain,” it can be assumed, in the absence of any evidence to the contrary, that the Respondent does derive a commercial advantage from the website, particularly in view of the advertisements contained on it. The Panel also finds that use of the domain name by the Respondent creates a likelihood of confusion that its site is sponsored, endorsed or affiliated with the Complainant. Internet users entering a domain name identical to that of a famous celebrity expect to find a site connected with that celebrity, not a site without any connection with that celebrity but other celebrities on whom they are not seeking information.

7. Decision

For all the foregoing reasons, in accordance with Paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the domain name <carmenelectra.com> be transferred to the Complainant.

Jon Lang
Sole Panelist

Dated: December 23, 2003