



NATIONAL ARBITRATION FORUM

DECISION

Katherine Quinn, The Executrix of the Anthony Rudolfo Quinn Estate v. Konstantinos Zournas
Claim Number: FA0512000610713

PARTIES

Complainant is **Katherine Quinn, The Executrix of the Anthony Rudolfo Quinn Estate** (“Complainant”), represented by **Karl S. Kronenberger**, of **Kronenberger & Associates**, 220 Montgomery Street, Suite 1920, San Francisco, CA 94104. Respondent is **Konstantinos Zournas** (“Respondent”), 96 Kallidromiou, Athens 11473, Greece.

REGISTRAR AND DISPUTED DOMAIN NAME

The domain name at issue is <**anthonyquinn.com**>, registered with **Enom, Inc.**

PANEL

The undersigned certifies that he has acted independently and impartially and to the best of his knowledge has no known conflict in serving as Panelist in this proceeding.

Jonas Gulliksson as Panelist.

PROCEDURAL HISTORY

Complainant submitted a Complaint to the National Arbitration Forum electronically on December 15, 2005; the National Arbitration Forum received a hard copy of the Complaint on December 19, 2005.

On December 16, 2005, Enom, Inc. confirmed by e-mail to the National Arbitration Forum that the <**anthonyquinn.com**> domain name is registered with Enom, Inc. and that the Respondent is the current registrant of the name.

Enom, Inc. has verified that Respondent is bound by the Enom, Inc. registration agreement and has thereby agreed to resolve domain-name disputes brought by third parties in accordance with ICANN’s Uniform Domain Name Dispute Resolution Policy (the “Policy”).

On January 9, 2006, a Notification of Complaint and Commencement of Administrative Proceeding (the “Commencement Notification”), setting a deadline of January 30, 2006 by which Respondent could file a Response to the Complaint, was transmitted to Respondent via e-mail, post and fax, to all entities and persons listed on Respondent’s registration as technical, administrative and billing contacts, and to postmaster@anthonyquinn.com by e-mail.

A timely Response was received and determined to be complete on January 27, 2006.

On February 1, 2006, an Additional Submission was received from Complainant. The submission was received in a timely manner according to The Forum’s Supplemental Rule 7. On February 6, 2006, an Additional Submission from Respondent was received. Also this submission was received in a timely

manner.

On February 3, 2006, pursuant to Complainant's request to have the dispute decided by a single-member Panel, the National Arbitration Forum appointed Jonas Gulliksson as Panelist.

RELIEF SOUGHT

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

PARTIES' CONTENTIONS

A. Complainant

Complainant has stated the following in its Complaint:

Factual and legal grounds

Anthony Quinn is a renowned artist and a two-time Oscar-winning actor, and his life clearly reflects parallel careers as both an artist and actor. He died on June 3, 2001 at the age of 86. His fame and success as both an artist and actor have supported the "Anthony Quinn" name and trademark as a mark that is internationally known in multiple categories. These categories include entertainment services, jewelry, watches, award statuettes, and entertainment awards.

Anthony Quinn as Actor

After beginning his career acting on Broadway, Anthony Quinn turned to a career in film starting in 1936. Many of his early roles included bandits and other stereotypical villains and ethnic characters. By the late 1940s, he had finished over fifty films. In 1947, he returned to Broadway for three years where he played Stanley Kowalski in *A Streetcar Named Desire* and other roles. When he returned to film in the 1950s, he found wide-spread success and acclaim with *Viva Zapata!* (1952), in which he appeared with Marlon Brando.

Anthony Quinn's performance won him his first Oscar, for Best Supporting Actor. Afterwards he worked on several films in Italy, including Federico Fellini's *La Strada* (1954). His second Oscar came from playing Gaugin in *Lust for Life* (1956). He was nominated again for an Academy Award for Best Actor for his role in *Wild is the Wind* (1957). In the sixties, his more successful roles included *Lawrence of Arabia* (1962) and *Zorba the Greek* (1964). *Zorba* garnered him yet another Oscar nomination, as well as great and lasting notoriety in the country of Greece, where Respondent resides. His last films in the 1990's include *Jungle Fever* (1991), *The Last Action Hero* (1993), and *A Walk in the Clouds* (1995).

Anthony Quinn as Artist

In addition to an illustrious acting career spanning nearly 60 years, including more than 150 films and many stage roles, Anthony Quinn was also an accomplished visual artist. His talent as an artist was evident at an early age when, at the age of eleven, he won a statewide competition for his sculpture of Abraham Lincoln.

Later, he was awarded a scholarship to study architecture with Frank Lloyd Wright.

Throughout his life, Anthony Quinn continued to further his career as an artist. In the early 1980s, Anthony Quinn earned nearly \$2 million from the first exhibition of his artwork. Mr. Quinn went on to generate over \$1 million per year from the exhibition and sale of his artwork and designs, distributed under the Anthony Quinn name. Through the early 1980s, his artwork was repeatedly featured in such distinguished publications as *Architectural Digest*. *Quinn Decl.*, § 6. Certain

Anthony Quinn artwork is scheduled in November 2006 to be placed into an exhibit that will tour museums in the United States.

The “Anthony Quinn” Trademark

Anthony Quinn’s great fame and notoriety as both an actor and an artist allowed him to begin offering various products under the ANTHONY QUINN trademark. Specifically, Anthony Quinn produced a variety of high-end watches and jewelry based on certain of his artworks, all under the ANTHONY QUINN trademark.

Starting in approximately 1995, the watches were distributed in fine jewelry stores internationally, and sold to consumers for upwards of \$13,000 each. The watches were also sold via television on the Shop NBC channel.

Examples of some of the watches sold bearing the ANTHONY QUINN trademark are attached as **Exhibit F** to the Quinn Declaration.

In addition to watches, Anthony Quinn also produced jewelry and other items under the ANTHONY QUINN trademark, also marketed and sold internationally in stores, through television advertisements and over the Internet.

Examples of cufflinks, earrings, bracelets, pendants, rings and other items sold under the ANTHONY QUINN trademark are attached as **Exhibit G** to the Quinn Decl. Sales of watches and jewelry under the ANTHONY QUINN trademark averaged \$100,000 per year throughout the 1990s, and sales continue today.

In 2001, the Providence Festival of New Latin American Cinema began to bestow an annual award called “The Anthony Quinn Award for Outstanding Achievement in Film,” or “The Anthony Quinn” in short.

The statuette given to recipients of this award is a reproduction of an original sculpture by Anthony Quinn. This award was created pursuant to the explicit permission of Anthony Quinn and his Estate. In connection with this awards program, the Estate of Anthony Quinn submitted two applications for federal registration of the trademark “The Anthony Quinn.” One application regarded the words “The Anthony Quinn,” and the other application regarded the statuette presented to recipients of the award. Copies of both applications are attached as **Exhibit C** to the Quinn Declaration.

The ANTHONY QUINN trademark is representative of high quality watches and jewelry designed by Anthony Quinn, and integrating his artwork. Mr. Quinn used the ANTHONY QUINN trademark in connection with the promotion and sale of his line of watches and jewelry continuously since approximately 1995.

During his lifetime and since his passing, Anthony Quinn and his later Estate, have continuously and exclusively used the ANTHONY QUINN trademark to market and sell watches and jewelry internationally.

Anthony Quinn and the Estate of Anthony Quinn have vigilantly policed the use of the ANTHONY QUINN trademark over the years, dispatching cease and desist letters and taking other legal action as appropriate.

Over the years, the ANTHONY QUINN trademark on watches and jewelry has garnered much unsolicited media attention and coverage. Examples of such are attached as **Exhibit H** to the Quinn Declaration.

Mr. Quinn and his Estate themselves draw considerable attention, and Anthony Quinn is regularly the subject of public interest, to the degree that it often generates commercial interest. As an example, in the early 1990’s, Discover Bank licensed the “Anthony Quinn” name, amongst other celebrities, to be

featured on a Private Issue Discover Card. Mr. Quinn's artistic endeavors are the subject of Bristol House Press' *Anthony Quinn's Eye: A Lifetime of Creating and Collecting Art* by Donald Kuspit, published in 2005 (see <http://www.bristolhousepress.com>). Anthony Quinn's published memoirs include *The Original Sin: A Self Portrait* (1972) and *One Man Tango* (1995).

Offer to Sell the <anthonyquinn.com> Domain Name for \$5001

Two years ago, Katherine Quinn contacted the owner of the <anthonyquinn.com> domain, asserting the rights of Mr. Quinn's Estate and requesting that the owner transfer the domain to her as Executrix.

Katherine Quinn and Respondent engaged in a series of emails, in which Respondent first demanded that Katherine Quinn identify herself as the true representative of the Estate of Anthony Quinn. After Katherine Quinn faxed proof of her identity to this individual, he offered to sell the domain name to Katherine Quinn for \$5001.

According to the WHOIS database records, the same person with whom Katherine Quinn corresponded is still in control of the domain name. **EXHIBIT J.**

There is not nor has there ever been any license or other business relationship between either Anthony Quinn, or the Estate of Anthony Quinn, and Respondent. Accordingly, Respondent has no permission whatsoever to use the ANTHONY QUINN trademark.

Currently, and for a period of years, Respondent is pointing the Disputed Domain to a commercial web page that sells products that are in direct competition to products sold under the ANTHONY QUINN trademark.

Respondent also profits from affiliate pay-per-click advertisements on the Disputed Domain (Affiliate pay-per-click advertising is where the host webpage receives a referral commission from the businesses to whom the advertisements or links on the host webpage refer each time a user clicks on the links or advertisements to access the commission paying business webpage). Screen captures of several of the pages at the Disputed Domain are attached as **Exhibit I** to the Quinn Decl.

A.

The domain name is either identical and/or confusingly similar to a trademark or service mark in which Complainant has rights.

Common Law Trademark Protection

Under common law principles, a protectable trademark right is established upon the mark's acquiring secondary meaning in use with commerce. "Secondary meaning is demonstrated where in the minds of the public, the primary significance of a product feature or term is to identify the source of the product itself." *Citigroup, Inc. v. Parvin*, D2002-0969 (WIPO May 12, 2003) (citing *Sari Rattner Dahl Primo Incense v. Spring.net*, FA 96565 (Nat. Arb. Forum Apr. 12, 2001)). Determining factors as to whether a mark has attained secondary meaning have been held to include the length of use, exclusivity of use, any copying, and actual confusion.

Additionally, the issue of secondary meaning has been extensively addressed by the U.S. Federal Courts.

Federal case law explains that the test for secondary meaning requires a demonstration that the mark, by means of sufficient marketing, sales, usage, and passage of time, has become identified in the public mind with a particular source of the goods or services. *See Big Star Entm't, Inc. v. Next Big Star, Inc.*, 105 F.Supp.2d 185 (S.D.N.Y. 2000); *see also Inwood Labs., Inc. v. Ives Labs., Inc.*, 456 U.S. 844, 851, n. 11, 102 S. Ct. 2182 (1982); *Bristol-Meyers Squibb Co. v. McNeil-P.P.C., Inc.*, 973

F.2d 1033, 1040 (2d Cir. 1992).

For support of this standard, the Courts look to the following factors: 1) advertising expenditures, 2) consumer surveys linking the mark to a source, 3) unsolicited media coverage of the service, 4) sales success, 5) attempts to plagiarize the mark, and 6) length and exclusivity of the mark's use. See *Centaur Commc'n Ltd. v. A\SM\ Commc'ns, Inc.*, 830 F.2d 1217, 1221 (2d Cir. 1987); *Zatarain's, Inc. v. Oak Grove Smokehouse, Inc.*, 698 F.2d 786 (5th Cir. 1983).

Each of these factors will be addressed in turn as they relate to this case:

i. Length of Use.

The name and mark "Anthony Quinn" has been used continuously by Complainant in connection with dramatic performance and entertainment services for nearly seventy years, with great success.

In addition, Complainant has made continuous use of the ANTHONY QUINN trademark since approximately 1995 in connection with the public sale and advertising of its watches and jewelry.

ii. Exclusivity of Use.

Complainant has vigilantly policed the use of its trademark, and as a result, the use of the ANTHONY QUINN trademark by Complainant is and has been exclusive.

iii. Advertising Expenditures.

Complainant has spent significant sums on advertising the ANTHONY QUINN trademark and brand to both customers and distributors worldwide, including print advertising as exemplified in Exhibits F and G, as well as television advertising on the ShopNBC network. This advertising has directly supported and enhanced the worldwide recognition of the ANTHONY QUINN brand on watches and jewelry.

iv. Unsolicited Media Coverage.

The ANTHONY QUINN brand has received unsolicited media coverage in a variety of media outlets over the years, to include industry publications, general distribution newspapers, and general distribution fashion or jewelry magazines.

v. Sales Success.

Sales of watches and jewelry under the ANTHONY QUINN trademark averaged \$100,000 per year throughout the 1990s, and sales continue today.

vi. Identification in the Public Mind.

Most importantly, the trademark, brand, and name "Anthony Quinn" is irrefutably famous worldwide.

In the motion picture, home video, and broadcast industries, the name "Anthony Quinn" is a widely recognized source identifier of quality entertainment and skillful performances.

Furthermore, as evidenced by successful sales, the public has come to identify the ANTHONY QUINN brand as a source of fine jewelry, watches, and artwork, each earning distinction for the mark in its own right.

The significant brand recognition in the public's mind has been a key to the ongoing business success of Complainant.

Regarding actors, Panels have consistently found that celebrity actors' names can serve as trademarks that identify the celebrities' performance services. *Spacey v. Alberta Hot Rods*, FA 114437 (Nat. Arb. Forum Aug. 1, 2002); see also *Roberts v. Boyd*, D2000-0210 (WIPO May 29, 2000) (trademark

registration unnecessary as the name "Julia Roberts" had sufficient secondary association to establish common law rights); *see also Jagger v. Hammerton*, FA 95261 (Nat. Arb. Forum Sept. 11, 2000) (common law rights in name "Mick Jagger"). This inherent secondary meaning is also recognized for musical performers, with UDRP Panels finding common law rights based on the length of use and public association of celebrity names in conjunction with their products of music and entertainment services. *See, e.g., Frampton v. Frampton Enters., Inc.*, D2002-0141 (WIPO Apr. 17, 2002) (use of name "Peter Frampton" for thirty years in conjunction with entertainment services clearly established common law trademark right in name).

Therefore, Anthony Quinn's status as an internationally known Oscar-winning actor, with more than 150 film appearances over the span of nearly sixty years, inheres in that name a common law trade and service mark right.

Furthermore, Complainant's rights in the ANTHONY QUINN mark have been extended beyond entertainment services.

By use in connection with Complainant's marketing and sales of jewelry, watches, and marketable works of art, the ANTHONY QUINN mark has acquired further secondary meaning in the mind of the public as to those markets and goods, and any reasonable extensions thereof.

Applications for Registered Trademark Pending: "The Anthony Quinn"

Complainant has applied for two federal trademarks on the words "The Anthony Quinn" for the categories of (1) statuettes of non-precious metal; and (2) educational services, namely providing recognition and incentives by the way of awards to demonstrate excellence in the field of acting in theater, film, and on television; entertainment services, namely an awards show for presentation of awards to recognize achievement in acting in theater, film, and on television; entertainment services, namely organizing and conducting awards programs to recognize achievements in the field of acting in theater, film, and on television (Serial Numbers 76/489440 and 76/489439 respectively). **Exhibit C** to *Quinn Decl.*

These trademark applications were filed as "intent to use" trademarks, and both applications have been fully published for opposition.

While these marks have not registered as of yet due to their intent to use status, the marks have passed initial muster with the trademark office and completed the publication period. Accordingly, these applications are further evidence in support of the strength of Complainant's common law trademark. *See La Vision Gmbh v. Computers, Parts & Repairs Inc.*, FA 306695 (Nat. Arb. Forum Oct. 25, 2004) (use of mark for a little over ten years combined with pending USPTO and German trademark applications was sufficient to recognize rights in mark in a UDRP proceeding), (citing *SeekAmerica Networks Inc. v. Masood*, D2000-0131 (WIPO Apr. 13, 2000) (finding that the ICANN Rules do not require trademark registration with a government authority for rights to exist; rights in the mark can be established by pending trademark applications)); *British Broad. Corp. v. Renteria*, D2000-0050 (WIPO Mar. 23, 2000) (noting that the Policy also applies to "unregistered trademarks and service marks"); *Great Plains Metromall, LLC v. Creach*, FA 97044 (NAF May 18, 2001) ("The Policy does not require that a trademark be registered by a governmental authority for such rights to exist.").

Domain Identical to Mark – AnthonyQuinn.com

The Disputed Domain, <**anthonyquinn.com**>, contains the exact trademark of Complainant, without the addition of any other words or letters. Accordingly, Complainant has submitted sufficient information to satisfy the first prong of the analysis under the Policy regarding the <**anthonyquinn.com**> domain name.

B. Respondent has no rights or legitimate interests in the Disputed Domain.

i) *Respondent's registration of the Disputed Domain does not establish any rights in the Domain.*

A domain name registrant generally lacks rights or legitimate interests in a domain name where a complainant has prior rights in a mark which precede a respondent's registration of the domain name. *Oki Data Americas, Inc. v. Jackson*, D2004-0087 (WIPO Mar. 24, 2004); *Rockport Co., LLC v. Powell*, D2000-0064 (Apr. 6, WIPO 2000).

Anthony Quinn is an internationally known actor who has appeared in over 150 films over almost sixty years, and who received two Oscar awards. Complainant began using its mark to market and sell watches and jewelry in approximately 1995 and filed its two federal trademark applications on February 12, 2003.

Respondent only registered the Disputed Domain on April 13, 2003 – after decades of international notoriety of Anthony Quinn, after ten years of Complainant's use of the ANTHONY QUINN trademark in selling watches, jewelry, and artwork, and one month after Complainant's federal trademark applications were filed. Thus, Respondent's domain registration cannot give Respondent rights in the Mark due to Complainant's clear prior rights in the mark.

ii)

Respondent has never been known by the Domain name and has never used the name in association with a bona fide offering of goods or services.

Respondent is not nor has he ever been known by the name "Anthony Quinn" and does not have any legitimate interest in being associated with the <**anthonyquinn.com**> domain name. Accordingly, there is no evidence to establish that Respondent has rights or legitimate interests in the disputed domain name pursuant to Policy ¶ 4(c)(ii). See *Broadcom Corp. v. Intellifone Corp.*, FA 96356 (Nat. Arb. Forum Feb. 5, 2001) (finding no rights or legitimate interests because Respondent is not commonly known by the disputed domain name or using the domain name in connection with a legitimate or fair use); see also *Gallup Inc. v. Amish Country Store*, FA 96209 (Nat. Arb. Forum Jan. 23, 2001) (finding that Respondent does not have rights in a domain name when Respondent is not known by the mark).

Furthermore, there is no evidence that Respondent intended to use the Disputed Domain in conjunction with a bona fide offering of goods or services. Instead, Respondent is using the Disputed Domain to link to competitor services (discussed in more detail, *infra* at § 6(C)(i)), from which Respondent likely receives "pay-per-click" commissions.

Importantly, Respondent cannot argue that its use of the web page resolving to <**anthonyquinn.com**> to advertise or promote the products of Complainant's competitors is a legitimate offering of goods or services to establish rights under the UDRP. See *Pitney Bowes Inc. v. Ostanik*, D2000-1611 (WIPO Jan. 24, 2001) (domain name holder's unauthorized use of confusingly similar domain name in connection with offering of goods and services competitive with those of trademark owner Pitney Bowes "cannot be legitimate"); see also *Koppers Chocolate Specialty Co., Inc. v. Leonard*, D2001-0822 (WIPO Aug. 24, 2001) (no bona fide offering of goods or services where domain name established link to website where not only the complainant's products but also those of the complainant's competitors were marketed).

iii)

Respondent's awareness of Complainant's mark prior to registration evidences Respondent's lack of rights or legitimate interest in Disputed Domain.

Respondent was aware of Complainant's mark before Respondent registered the Disputed Domain as detailed, *infra* at § 6(B)(i), 6(B)(ii) and pp. 3-4 of this Complaint. Respondent's prior awareness of another's mark is evidence that Respondent lacks rights and legitimate interest in the Disputed Domain. *See Bayer Aktiengesellschaft v. Dangos & Partners*, D2002-1115 (WIPO Feb. 3, 2003).

iv) Respondent's use of Disputed Domain is not for any legitimate fair use.

Respondent is not making any legitimate, non-commercial or fair use of the <anthonyquinn.com> domain. No non-commercial, fair use information is offered at the website resolving to <anthonyquinn.com>.

Instead, Respondent's website for the Disputed Domain contains primarily of commercial information, including advertisements for products competitive to Complainant's and from which Respondent likely receives pay-per-click commissions. Simply put, Respondent is profiting on the substantial Internet traffic to the <anthonyquinn.com> domain that exists due to the fame and trademark of Complainant.

Since Respondent's website is commercial in nature, it cannot qualify under the safe harbor of Policy ¶ 4(c)(iii) as a legitimate noncommercial fair use without intent for commercial gain.

In the above-cited UDRP decision of *Frampton v. Frampton Enters., Inc.*, D2002-0141 (WIPO Apr. 17, 2002), concerning facts compellingly similar to the present case, the Panel found that where a respondent registers and uses a famous celebrity's name to his financial benefit, "[s]uch use, which at its heart relies on exploiting user confusion, **can not and does not constitute bona fide commercial use**, sufficient to legitimize any rights and interests the Respondent might have in the contested domain name." (emphasis added) (citing *Ciccone v. Parisi*, D2000-0847 (WIPO October 12, 2000).

Additionally, Respondent has no license or other official relationship with the Estate of Anthony Quinn.

In fact, in the only series of communication between Complainant and Respondent, Respondent demanded \$5001 for control of the domain name, as is detailed at p. 4 of this Complaint.

Importantly, Complainant does not bear the burden of producing evidence showing that Respondent lacks rights or legitimate interests in respect to the domain names. *See Citigroup, Inc. v. Parvin*, D2002-0969 (WIPO May 12, 2003).

However, the evidence submitted by Complainant in this Complaint is compelling evidence that Respondent lacks any rights or legitimate interests in the Disputed Domain.

C. The domain name was registered and is being used in bad faith.

Respondent's use of the <anthonyquinn.com> domain constitutes an opportunistic attempt to trade off Complainant's fame. It is clear that Respondent purchased the domain with the knowledge of Complainant's prior fame and commercial success; that Respondent is profiting from the Internet traffic to the domain; that Respondent is selling products that compete with products sold under Complainant's mark; and that Respondent offered to sell the domain to Complainant for \$5001.

As mentioned above, the obvious inferences as to Respondent's motivations have been addressed under the UDRP before.

Incorporating its determination (cited above) regarding the inherent illegitimacy in registering and using a celebrity's name, the Panel in *Frampton* found such acts to establish unquestionably bad faith registration and use:

There can be no question that the Respondent having absolutely no association, relationship or affiliation whatsoever with the Complainant, clearly chose to include the Complainant's mark in the contested domain name with a goal of creating opportunities, to commercially benefit itself. . . . The Panel views such opportunistic registration of the contested domain name as indicative of bad faith registration and the subsequent . . . bad faith use, both collectively actionable under paragraph 4(b)(iv) of the Policy. (emphasis added).

See, e.g., Novus Credit Servs. Inc. v. Personal, D2000-1158 (WIPO Nov.29, 2000) and *Guinness UDV N. Am. v. Lewis*, D2001-0621 (WIPO Aug. 3, 2001).

i)

Placement of advertisements and links to competitors at the Disputed Domain demonstrates that the domain is being used in bad faith.

Respondent's web page for the Disputed Domain contains links to products competitive to those of Complainant, including links to competing jewelry companies like Tiffany.com and discount jewelry sellers like Overstock.com. See screen shots of competing links at **Exhibit I** of the Quinn Decl. Per the UDRP, use of a domain name to attract Internet users to your web site by creating a likelihood of confusion of the mark owner's services with those of its competitors constitutes bad faith. *See Staples, Inc. v. Morgan*, D2004-0537 (WIPO Sept. 20, 2004) (the respondent's linking of the disputed domain to the complainant's main competitor's web site constituted bad faith use of the domain and warranted transfer).

Thus, Respondent's promotion of Complainant's competitors is a clear bad faith use under Policy ¶ 4(b)(iv).

ii)

Respondent was aware or should have been aware of Complainant's prior use of the ANTHONY QUINN mark.

Registration and use in bad faith will be found if a respondent had knowledge of a complainant's prior use of the mark when the respondent registered the mark. *Network Solutions, LLC v. Wang*, D2004-0675 (WIPO Oct. 25, 2004); *Christian Dior Couture S.A. v. Liage Int'l Inc.*, D2000-0098 (Mar. 24, 2000).

Anthony Quinn is known internationally, and especially in Greece, where Respondent resides. In light of Complainant's over ten years of use of the Mark, including the distribution of products internationally in stores and over the Internet, it is nearly impossible to conceive how Respondent did not have knowledge of the ANTHONY QUINN trademark at the time of registration of the Disputed Domain.

iii) ***Respondent's attempt to sell the domain constitutes bad faith use.***

Per the Policy ¶ 4(b)(i), bad faith will be found based upon evidence that a domain name was registered with the intent to sell it to the owner of related rights. Respondent has offered to sell the Disputed Domain to Complainant for \$5001. *See, Exhibit J*. The actions of Respondent are conclusive evidence of bad faith under Policy ¶ 4(b)(i), and the intended culmination of his initial bad faith acquisition and holding of the Domain (*see supra*).

For the forgoing reasons, Respondent's registration of the Disputed Domain was clearly in bad faith

for the purposes of the ICANN Policy.

B. Respondent

Respondent has stated the following in its Response:

Reply to exhibits

(a) Reply to Exhibit C of the complaint

Complainant applied to register a design and not the name "Anthony Quinn". The two trademarks were "Published for Opposition" on May 18, 2004 and on May 11, 2004. This date is **after** the registration of the <**anthonyquinn.com**> domain name that was made on April 13, 2003.

Complainant **failed** to point out that these two ITU (Intent To Use) trademarks have not been registered yet. Instead Complainant has filed for two extensions (six months each) as shown in the "PROSECUTION HISTORY." (**Exhibit B of the response.**)

One can file an ITU application for a mark one is planning to use, in order to save a spot in line to do pre-marketing development. The application will be examined and, if allowable, it will be allowed.

It will NOT proceed to registration, however, until a statement of use is submitted, showing a specimen of how the mark is used in commerce. The deadline can be extended after allowance generally as a matter of course up to a year. After that, the USPTO will want a reason why the mark has not been used.

Here, the fact that Complainant has filed two extensions shows that Complainant hasn't used the mark, because if she had been making actual use, then she would have filed her statement of use by now, instead of filing for the two extensions.

Anthony Quinn is only known in Greece as an actor. I had no knowledge at all of these trademarks, especially since these trademarks have never been used in commerce or in any other application.

For the reasons above I ask the Panel to find that these Trademark applications are irrelevant to this administrative proceeding.

(b) Reply to Exhibits F,G and H of the complaint

Anthony Quinn is only known in Greece as an actor. He has never been known in Greece, where I reside, as an artist or sculptor. Almost all of this material presented in these exhibits is taken from a Canadian website at <mytime.ca> that is NOT online at the moment. I have never visited the before mentioned website, not even after it was brought to my attention in the Complaint, as it is not currently operational. I was never aware that Anthony Quinn was an artist. I am only a fan of his work as an actor in the 200 movies he has appeared in.

(c) Reply to Exhibit I of the complaint

I own the <**anthonyquinn.com**> domain name without making any profit from it commercially or in any other way. I paid \$5000 in 2003 to buy this domain and I am losing money every year by paying renewal fees for this domain name at my current registrar, Enom, Inc.

The links, shown in this exhibit, are not chosen or controlled by me as I haven't used the domain name yet. These links are provided by default by my registrar. Nearly all ICANN registrars are doing the same for

domain names that are not used by the owner. Network Solutions (www.networksolutions.com) (one of Complainant's registrar) is doing the same. There are thousands of domain names in the same "inactive/coming soon" state. E.g. <http://www.url.com> (**Exhibit F of the response**)

Complainant has similar links in two of the domain names that she is not currently using. The domain names are <anthonyquinn.org> and <anthonyquinn.biz>. (**Exhibit D of the response**)

(d) Reply to Exhibit J of the complaint

I never asked Katherine Quinn to buy the <anthonyquinn.com> domain name. I clearly stated that I bought the <anthonyquinn.com> domain for \$5000 from www.namewinner.com after winning an auction for the domain name and gave proof for that by email to Complainant. Complainant contacted me first about this domain name. It can be seen in this exhibit that in my first reply to the complainant I wrote "I am willing to give you this domain name but not for free as I paid a significant amount to win it at the auction." I asked Complainant to compensate me for this purchase. At \$5001, I was losing money, as <http://www.escrow.com> (a secure online escrow service) would charge me \$40 to send me the funds by International wire transfer.

Furthermore, Complainant does not show in the exhibits that she asked me proof that I paid \$5000 and that I provided with that proof. After I sent her the proof by email at her email address, katherinequinn@fctvplus.net, she decided not to compensate me. The proof was an invoice send by Dotster, Inc. dated May 30, 2003. The \$5001 was not an offer to sell but a request to compensate me for my out of pocket costs.

Please note that Complainant **FAILED** to present this particular email (**Exhibit E of the response**) showing proof for the amount I paid to buy the domain name from www.namewinner.com. Namewinner is a Dotster, Inc. company (www.dotster.com).

All these emails in this exhibit (together with **Exhibit E of the response**) show that my clear intention was only to get compensated for my out of pocket costs and not profit from selling this domain name. This domain has not been offered for sale to anyone.

Also, the following quote is from the Federal Rules of Evidence, which applies to any federal lawsuit in the United States:

<http://www.law.cornell.edu/mles/fre/mles.htm#Rule408>

Rule 408. Compromise and Offers to Compromise

Evidence of (1) furnishing or offering or promising to furnish, or (2) accepting or offering or promising to accept, a valuable consideration in compromising or attempting to compromise a claim which was disputed as to either validity or amount, is not admissible to prove liability for or invalidity of the claim or its amount. Evidence of conduct or statements made in compromise negotiations is likewise not admissible. This rule does not require the exclusion of any evidence otherwise discoverable merely because it is presented in the course of compromise negotiations. This rule also does not require exclusion when the evidence is offered for another purpose, such as proving bias or prejudice of a witness, negating a contention of undue delay, or proving an effort to obstruct a criminal investigation or prosecution.

Response in compliance with the rules of procedure

According to the Rules Paragraph 4(a) the complainant has to prove that each of the following elements are present:

(i) my domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights; and

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

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

I will prove the contrary for each element:

(i) The domain name is identical to the name of Anthony Quinn but the complainant has no trademark or service mark. Please also refer to Reply to Exhibit C of the complaint.

Furthermore the complainant failed to note that "Common Law Trademark Rights" are subject to geographical constraints.

Geographic limitation of common law marks

(www.bitlaw.com/trademark/common.html):

"Common law trademark rights are limited to the geographic area in which the mark is used. Thus, if a coffee blend is sold under the name BLASTER in California only, the trademark rights to that name exist only in California. If another coffee retailer begins to market a different blend in New York under the same name (assuming they had no knowledge of the California company), then there would be no trademark infringement. However, if the New York company attempted to sell their coffee blend nation-wide, they would discover that the California company's common law rights to the mark would prevent them from entering the California market."

There is no common law trademark in this case since common law rights require a secondary meaning in commerce and because common law rights extend only to the geographical areas that the party is known by that mark. Anthony Quinn might have been known as an artist in the United States or Canada but he was only known in Greece, where I reside, as an actor.

It should be noted that no evidence has been given of the name "Anthony Quinn" having acquired a secondary meaning in the geographical area that the respondent resides; in other words, a recognition that the name should be associated with activities beyond the primary activities of Anthony Quinn as an actor.

Almost all of the material presented in exhibits F, G and H of the complaint is taken from a Canadian website www.mytime.ca that is NOT online at the moment and that I have never visited before.

McCarthy on Trademarks and Unfair Competition (2nd Edition) at pages 578 and 579 states the U.S. position thus: "Personal names (surnames and first names) have been placed by the common law into that category of non-inherently distinctive terms which require proof of secondary meaning for protection. Thus, since personal names are not regarded as being inherently distinctive marks, they can be protected as trademarks only upon proof that through usage, they have acquired distinctiveness and secondary meaning that is, the public has come to recognize the personal name as a symbol which identifies and distinguishes the goods or services of only one seller." *Turner v. Fahmi*, D2002-0251 (WIPO July 4, 2002).

(ii) I have been a fan of Anthony Quinn since I was 10 years old and first saw him in *Viva Zapata* starring alongside Marlon Brando. I have never been "commonly known by the domain name" but that doesn't mean I don't have rights to the domain as I am a big fan of Anthony Quinn. I have watched most of the 200 movies he acted in.

It is my intention to put up a fan website and I am already preparing it. The website is also ready. A

draft of the designed website is shown in **Exhibit H of the response**.

Quinn's signature character was Zorba, a zesty Greek peasant who teaches a stuffy British writer to find joy in the subtle intricacies of everyday life in *Zorba the Greek* (1964). This movie turned Anthony Quinn into a Greek forever. Based on the book by Nikos Kazantzakis (one of the most famous Greek authors) and filmed in black and white the movie documents a Greece that has almost completely disappeared. With an inspiring soundtrack by Mikis Theodorakis (the best work he has ever done) and the greatest performance of Anthony Quinn's career. The role won him an Oscar nomination and he reprised variations of Zorba in several subsequent roles. This movie made Anthony Quinn an icon in Greece and turned him into a Greek in the hearts of the Greek people.

Anthony Quinn is best known playing Greek characters in movies like *The Guns of Navarone*, *The Greek Tycoon*, *The Richest Man in the World: The Aristotle Onassis Story* and *Zorba*.

The fact that the name Anthony Quinn is used in the domain name does not in and of itself defeat the legitimate noncommercial fair use of the trademark in question. *Springsteen v. Burgar*, D2000-1532 (WIPO Jan. 25, 2001); *Falwell v. Cohn*, D2002-0184 (WIPO June 3, 2002); *Estate of Jennings v. Submachine*, D2001-1042 (WIPO Oct. 25, 2001).

The following decisions under the Policy are in support of my position that I am engaging in legitimate noncommercial or fair use the disputed domain name: *Van Halen v. Morgan*, D2000-1313 (WIPO Dec. 20, 2000), *2001 White Castle Way, Inc. v. Jacobs*, D2004-0001 (WIPO Mar. 26, 2004), *Estate of Jennings v. Submachine*, D2001-1042 (WIPO Oct. 25, 2001), and *Stuart v. Marty Stuart Fan Page*, FA 192600 (Nat. Arb. Forum October 22, 2003).

(iii) There is no evidence of registration and use in bad faith according to the Rules Paragraph 4(b)(ii and iv):

(i) As I discussed in "Reply to Exhibit J of the complaint" earlier in my response I never asked Katherine Quinn to buy the <**anthonyquinn.com**> domain name. She contacted me first and then I asked the complainant to compensate me for the purchase of this domain name. After I gave her evidence for my documented out of pocket costs she refused to provide compensation.

Please note again that the complainant failed to present the email (**Exhibit E of the response**) that is evidence for my documented out of pocket costs.

(ii) I have not registered the domain name in order to prevent anyone from using the name Anthony Quinn.

Katherine Quinn owns the following domain names since: (**Exhibit A of the response**)

<anthonyquinn.org> 13-Mar-2003, <anthonyquinn.biz> 13-Mar-2003 and <anthonyquinn.us> 13-Mar-2003.

Also, the Estate of Anthony Quinn (Anthony Quinn Studio) claims to own <anthonyquinn.net> (**Exhibit C of the response**) since 06-Dec-2002. Katherine Quinn claims to be "The Executrix of the Anthony Rudolfo Quinn Estate". So I will assume she owns <anthonyquinn.net>. The domain name <anthonyquinn.net> is currently operating as the official Anthony Quinn website.

A third party located in Germany owns <anthonyquinn.info> since 14-Sep-2001 (**Exhibit A of the response**)

4(b)(ii) requires a pattern of "blocking" domain name registrations. The complainant's inability to register the one domain name (<**anthonyquinn.com**>) at issue is not itself evidence of bad faith of the respondent. (*Van Halen v. Morgan*, D2000-1313 (WIPO Dec. 20, 2000)).

Paragraph 4(b)(ii) of the UDRP indicates that the registration should have the effect of preventing the owner of a trade mark or service mark from reflecting the mark "in a corresponding domain name." Nothing that has been done by the respondent has prevented the complainant's official website at <anthonyquinn.net> being registered and used in his direct interests. That is surely a "corresponding domain name" for these purposes, as the expression "corresponding domain name" clearly refers back to the words "trade mark or service mark" rather than the domain name at issue referred to in the first line of paragraph 4(b)(ii). *Springsteen v. Burgar*, D2000-1532 (WIPO Jan. 25, 2001)

I clearly did not register the domain name in order to disrupt the business of a competitor. I am not an actor as Anthony Quinn was. I am a fan of his work as an actor.

I own the <anthonyquinn.com> domain name without making any profit from it commercially or in any other way. I paid \$5000 in 2003 to buy this domain and I am losing money every year by paying renewal fees for this domain name at my current registrar Enom, Inc. I haven't used the domain name yet so I haven't misleadingly divert consumers or tarnished Anthony Quinn. It is my intention to put up a fan website will not tarnish Anthony Quinn in any way. The website will praise Anthony Quinn's work as an actor. **(Exhibit H of the response)**

Complainant UDRP Rules violation

The complainant stated in her complaint (11) that "A copy of this Complaint, together with the cover sheet as prescribed by NAF's Supplemental Rules, has been sent or transmitted to the Respondent on December 15, 2005 by postal mail, facsimile and to the email addresses listed below, in accordance with Paragraph 2(b) of the Rules."

I state that I never received their complaint either by postal mail, facsimile or email. This is a violation of Paragraph 2(b) of the UDRP rules. I didn't receive the Exhibits of the complaint until after the commencement of the Administrative Proceeding (20th of December). I received the Exhibits of the complaint on the 21st of December after I asked for them specifically from the National Arbitration Forum.

The complainant also withheld evidence, most probably deliberately, **(Exhibit E of the response)** so she could prove bad faith on my behalf.

In conclusion, the complainant did not tell the truth in their complaint about sending me the complaint and also withheld evidence that was critical for this case.

C. Additional Submissions

Complainant has submitted the following Additional Submission.

“Trademark rights” under the UDRP are not tied to geography

In his Response, Respondent proceeds from the erroneous belief that geography is a legitimate factor in determining the validity of a trademark for the purposes of a UDRP proceeding. For example, on page 3 of his Response, he asserts that, in Greece, Anthony Quinn is known only as an actor, and not as an artist or sculptor. However, there is no authority to support these assertions by Respondent. Complainant need only demonstrate that Respondent registered a domain containing a trademark “in which Complainant has rights...” Policy ¶ 4(a)(i). Such trademark rights may be common law trademark rights, or rights emanating from a mark registered with a federal or state government. *See, e.g., Cedar Trade Assocs., Inc. v. Ricks*, FA 93633 (Nat. Arb. Forum Feb. 25, 2000) (affording protection to those having common law trademark rights as well as to those having rights in registered

trademarks).

In this case, Complainant has gone above and beyond this requirement by submitting proof of strong common law trademark rights in multiple categories for “Anthony Quinn,” based on compelling evidence of secondary meaning emanating from the fact that Anthony Quinn is known internationally as an actor and artist.

As additional support for the showing of trademark rights under the UDRP, Complainant submitted proof of a filing of an application for federal registration, and publication of such registration, related to the ANTHONY QUINN mark. *See La Vision Gmbh v. Computers, Parts & Repairs Inc.*, FA 306695 (Nat. Arb. Forum Oct. 25, 2004) (use of mark for a little over ten years combined with pending USPTO and German trademark applications was sufficient to recognize rights in mark in a UDRP proceeding) (citing *SeekAmerica Networks Inc. v. Masood*, D2000-0131 (WIPO Apr. 13, 2000) (finding that the ICANN Rules do not require trademark registration with a government authority for rights to exist; rights in the mark can be established by pending trademark applications)); *British Broad. Corp. v. Renteria*, D2000-0050 (WIPO Mar. 23, 2000) (noting that the Policy also applies to “unregistered trademarks and service marks”); *Great Plains Metromall, LLC v. Creach*, FA 97044 (Nat. Arb. Forum May 18, 2001) (“The Policy does not require that a trademark be registered by a governmental authority for such rights to exist.”).

For the foregoing reasons, Complainant clearly has trademark rights in “Anthony Quinn” for the purposes of the UDRP.

Respondent was aware of Anthony Quinn’s work as an artist and sculptor

Respondent claims that Anthony Quinn is not known an artist or sculptor in Greece. However, it is difficult to comprehend how Respondent could not have known about Anthony Quinn’s background as an artist, and such claims only serve to diminish Respondent’s credibility.

First, judging by the website associated with Respondent’s email address, Respondent is a professional web designer and is well adept at using the Internet. In the process of building his Fan Site, he must have searched for the term “Anthony Quinn” in major search engines to search for material and content (which we *know* he did, as established in Section 4 below). A search for “Anthony Quinn” in any major search engine returns numerous results, some even on the first page, that identify Anthony Quinn as an artist and sculptor.

Second, by his own admission, Respondent was aware of the <anthonyquinn.net> website (*See* Response at p. 7).

This website’s main page displays examples of Anthony Quinn’s paintings, a paragraph describing Anthony Quinn as an artist, and many links to other pages that showcase and sell Anthony Quinn’s artwork.

Third, the page displayed at Respondent’s own web page at <**anthonyquinn.com**> contains links to sites either discussing or selling Anthony Quinn’s art (*See* Exhibit I of Complaint). Titles for these links included, “Sculpture,” “Art,” and “Anthony Quinn Jewelry.” Respondent must have visited his own website at some point in time.

He must have known that such links were there, and, therefore, must have known that Anthony Quinn was an artist and sculptor.

Fourth, Respondent’s own proposed Fan Site, in the very copy that he submitted to the Panel in this proceeding, explicitly mentions Quinn’s interest in sculpting (*See* Exhibit H of Response, at p. 3).

It is somewhat ironic that Respondent claims that he has been a “fan of Anthony Quinn since he was 10 years old,” but that Respondent did not even have the slightest clue that Anthony Quinn is an internationally known artist.

Certainly, one who does not know that Anthony Quinn was an internationally renowned artist over the course of decades, would not be in a position, or be qualified, to produce a website aimed to provide “the most comprehensive information on the web” about Anthony Quinn – but this is exactly what Respondent claims to do in the brief introduction on his proposed Fan Site (*See Exhibit H, at p. 1*).

Respondent’s claims of his intent to create a fan site are disingenuous

Respondent argues that he has a right and a legitimate interest to the <**anthonyquinn.com**> domain name.

He argues that because he is intending to launch a fan website (“Fan Site”) dedicated to Anthony Quinn, he is engaging in a legitimate non-commercial or fair use of the disputed domain name. However, prior Panel Decisions have held that a mere statement of a future intent to create a fan site does not constitute a legitimate interest in a domain name. *See Garnett v. Trap Block Techs.*, FA 128073

(Nat. Arb. Forum Nov. 21, 2002) (where the Panel ordered the transfer of the domain where the respondent argued that he had the intent to set up a fan site in the future).

WIPO panels are also in accord on this issue. *See, e.g., Gilmour v. Cenicolla*, D2000-1459 (WIPO Dec. 15, 2000) (ordering transfer of <davidgilmour.com>); *Galatasaray Spor Kulubu Dernegi v. Maksimum Iletisim A.S.*, D2002-0726 (WIPO Oct. 15, 2002) (ordering transfer of <galatasaray.com>).

In fact, one WIPO panel held that a “fan” has no legitimate interest in using the a trademark as a domain name because “[i]t is absolutely possible to demonstrate enthusiasm on a website without using others' trademarks as a domain name... ." *Bayerische Motoren Werke AG v. Petaluma Auto Works*, D2005-0941 (WIPO Oct. 20, 2005) (order the transfer of <bmwsauberfl.com>, containing the trademark of a new Formula One racing team).

Furthermore, Respondent’s statement of intent to create a future Fan Site is completely disingenuous and highly questionable.

This insincerity is evidenced by the fact that the content of Respondent’s Fan Site consists primarily of text plagiarized verbatim from third-party Internet websites. In fact, notwithstanding the disclaimer presented in the footer of his proposed Fan Site in which he claims that “every effort has been made to attribute pictures and articles properly,” every line of text can be traced to third-party Internet websites.

Importantly, no citations for any of the text is provided, and the material on the Fan Site is presented as if it were original.

As a result of his plagiarism, Respondent has, through his Fan Site, infringed on the copyrights of five third-party websites.

It goes without saying that this pattern of behavior – plagiarizing material, and representing it as original work – is not only irresponsible, but also inherently deceitful. Attached to this Additional Submission as **Exhibit A**, please find copies of the third-party Internet websites from which Respondent has plagiarized (relevant sections have been highlighted).

Clearly, the Respondent never had the intent to create a legitimate fan site. He only created the proposed Fan Site upon notice of the Complaint filed against him, and the Fan Site was created specifically for the purposes of responding to the Complaint. Respondent’s actions clearly demonstrate that his credibility is highly questionable. Because of his actions, and the claims

advanced in his Response, his credibility in all aspects of his Response should be questioned. Any future assertions and arguments brought forth by Respondent must, accordingly, be taken as suspect, and subjected to the highest level of scrutiny.

In so far as Respondent's proposed Fan Site consists of material that clearly infringes on the copyright of others, and because he never truly intended to create a legitimate fan site for the Disputed Domain Name, his Fan Site is not legitimate and cannot be construed as a legitimate or fair use of the Disputed Domain Name.

Respondent's use of the disputed domain name is in bad faith

Panels have held that use of trademarks in domain names for the purported purpose of a fan website is never proper because it misrepresents the identity of the site and denies the mark owner the opportunity to manage its presence on the Internet. *See Garnett v. Trap Block Techs.*, FA 128073 (Nat. Arb. Forum Nov. 21, 2002) (Panel held that holding the domain name without using it exhibited bad faith). Additionally, Panels have found bad faith from a respondent's mere non-use of a registered domain name.

Respondent has submitted the following Additional Submission:

Reply to: "Trademark rights" under the UDRP are not tied to geography

First of all, it is not the respondent's responsibility under UDRP to prove that the complainant does NOT have "trademark rights" in Greece. The complainant has to prove that they have. The complainant has provided absolutely no proof that Anthony Quinn is known as artist or sculptor in Greece where respondent resides. The complainant has provided NO proof of sales, media coverage or any other proof to support this claim.

Furthermore, the complainant tries to detach a certain part of trademark law from the UDRP proceeding. Trademark law can only be treated as a whole and no one can extract the part that is not on their advantage, as the complainant convincingly does in their additional response. "Common Law Trademark Rights" are subject to geographical constraints and that is not subject to discussion.

Reply to: Respondent was aware of Anthony Quinn's work as an artist and sculptor

- i. Respondent has clearly demonstrated that he was not aware of any other work made by Anthony Quinn apart from his work as an actor. Respondent came to know Anthony Quinn as an actor and continued to admire him as an actor and only as an actor.
- ii. Respondent was not aware of the contents of <anthonyquinn.net> before the complaint was filed at NAF. <anthonyquinn.net> was not used until the 22nd of November 2005 when the whois database was last updated. (See **Exhibit A of the response**). This is the date that the complainant changed the nameservers (NS.AQHOST.COM and NS2.AQHOST.COM) of the domain name so that it could point to the newly designed website made by the complainant. Up until that date the <anthonyquinn.net> domain name had different nameservers (ns.uunet.ca and ns2.uunet.ca) (**Exhibit A of the additional submission response**) attached to it and was not used by the complainant. Respondent noticed this change after the Complaint was filed; just one month after the <anthonyquinn.net> website came online (live). Respondent noticed this change doing research for the UDRP proceeding. So Respondent was not aware of Anthony Quinn being an artist or a sculptor after visiting the <anthonyquinn.net> website. Panel can verify that the <anthonyquinn.net> domain changed nameservers and content on the 22nd of November 2005 by

contacting the .com/.net registry.

- iii. As I discussed in the response ((c) Reply to Exhibit I of the complaint) these links are provided by default by my registrar. The links are changed by my registrar without any notice to me and many times throughout out the year. Currently <anthonyquinn.com> contains no such links. It contains links to "ANTHONY QUINN," "ANTHONY QUINN actor" and several other links that have no relation to "Anthony Quinn" such as Law, Gambling and Travel. These links are chosen by software used by my registrar. **(Exhibit B of the additional submission response)**
- iv. The complainant underestimates the panel's intelligence by claiming that a sculpture made by Anthony Quinn at the age of eleven is proof of Anthony Quinn being known in Greece or worldwide as an artist or sculptor. This is a quote from the <anthonyquinn.com> website draft submitted in the Response: "Anthony Quinn's next artistic venture and success came at age eleven when he won a California state-wide sculpture competition for his entry of Abraham Lincoln."

Respondent claims that he has been a "fan of Anthony Quinn since he was 10 years old," because he is and that is the truth. Finally, <anthonyquinn.com> will be the "the most comprehensive information on the web" after it is finished. And it will be comprehensive in relation to Anthony Quinn's work as an actor and only as an actor, as this is the way the respondent knows him.

Reply to: Respondent's claims of his intent to create a fan site are disingenuous

Prior Panel Decisions have held that a statement of a future intent to create a fan site does not constitute a legitimate interest in a domain name but preparations to do so constitute a legitimate interest. Respondent has clearly demonstrated preparations to build a fan website.

It is contestable and highly suspicious the 'habit' of the complainant presenting half the truth in nearly all their statements. Here is a quote of the NAF case cited by the complainant: "Respondent has not set up a website and has made no preparations to do so." *See Garnett v. Trap Block Techs.*, FA 128073 (Nat. Arb. Forum Nov. 21, 2002); *see also Tribute, Inc. v. dotPartners, LLC*, FA 109702 (Nat. Arb. Forum Aug. 20, 2002).

The draft website of <anthonyquinn.com> contains citations to all text contained in all pages. A website is not a THESIS that is required to give citation to each quote next to the particular quote. Citation in all articles in media is given after the article itself. Especially in the internet citation can be given in any part of the website as all pages are considered as one item. Complete citation is given in the "Links" and "Articles" pages of the draft website. **(Exhibit H of the response)** Also accusing someone of plagiarizing material not yet published and certainly not finished it quite amusing. What is actually ironic is that these accusations are coming from the complainant that withheld evidence, most probably deliberately, **(Exhibit E of the response)** so he/she could prove bad faith on my behalf. The complainant should worry more about his/hers credibility and stop making these unfounded accusations.

Reply to: Respondent's use of the disputed domain name is in bad faith

Policy ¶ 4(b)(ii) requires a pattern of "blocking" domain name registrations. The complainant's inability to register the one domain name (<anthonyquinn.com>) at issue is not itself evidence of bad faith of the respondent. (*Van Halen v. Morgan*, D2000-1313 (WIPO Dec. 20, 2000)).

See also: "... paragraph 4(b)(ii) of the UDRP. That paragraph indicates that the registration should have the effect of preventing the owner of a trade mark or service mark from reflecting the mark "in a corresponding domain name" Nothing that has been done by Mr Burgar has prevented Bruce Springsteen's official website at <bruce springsteen.net>

being registered and used in his direct interests. That is surely a "corresponding domain name" for these purposes, as the expression "corresponding domain name" clearly refers back to the words "trade mark or service mark" rather than the domain name at issue referred to in the first line of paragraph 4(b)(ii)." *Springsteen v. Burgar*, D2000-1532 (WIPO Jan. 25, 2001).

Finally, Panels have found that non-use of a registered domain name does not constitute bad faith from the respondent. *See PHE, Inc. v. Xiaofeng Wei*, DTV2003-0006 (WIPO Feb. 20, 2004) and also see *Neusiedler Aktiengesellschaft v. Kulkarni*, D2000-1769 (WIPO Feb. 5, 2001).

DISCUSSION & FINDINGS

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

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

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

Identical and/or Confusingly Similar

According to the Policy ¶ 4(a)(i), common law rights are sufficient and a complainant thus need not hold a registered trademark to establish rights in a mark. The ICANN dispute resolution policy is thus broad in scope in that the reference to a trademark or service mark in which Complainant has rights means that ownership of a registered mark is not required and unregistered or common law trademark or service mark rights will suffice to support a domain name Complaint under the Policy; *see also British Broad. Corp. v. Renteria*, D2000-0050 (WIPO Mar. 23, 2000).

To establish common law rights in a personal name, it is necessary to show use of that name as an indication of the source of goods or services supplied in trade or commerce and that, as a result of such use, the name has become distinctive of that source. *See Crichton v. In Stealth Mode*, D2002-0874 (WIPO Nov. 25, 2002) (finding that the Policy is not intended to apply to personal names that have not been used commercially and acquired secondary meaning as the source of goods and/or services).

Furthermore, a celebrity's name can serve as a trademark when used to identify the celebrity's performance services. *See Spacey v. Alberta Hot Rods*, FA 114437 (Nat. Arb. Forum Aug. 1, 2002); *see also Roberts v. Boyd*, D2000-0210 (WIPO May 29, 2000) (finding that trademark registration was not necessary and that the name "Julia Roberts" has sufficient secondary association that common law trademark rights exist); *see also Jagger v. Hammerton*, FA 95261 (Nat. Arb. Forum Sept. 11, 2000) (Complainant held common law trademark rights in his famous name Mick Jagger).

Anthony Quinn was an internationally known actor and two-time Oscar award winner with more than 150 film appearances during a span over nearly sixty years. There can be no dispute that there is goodwill in the name "Anthony Quinn."

The Panel therefore finds that Anthony Quinn, before his death had common law trademark rights to his name. Those rights now belong to Complainant. *See CMG Worldwide, Inc. v. Naughty Page*, FA

95641 (Nat. Arb. Forum Nov. 8, 2000) (finding that Princess Diana had common law rights in her name at her death and that those common law rights have since been transferred to the complainant, the representative of Princess Diana's estate).

The ".com" suffix denoting second-level domain status in Respondent's domain name does not affect the fact that the name is identical to Complainant's mark pursuant to Policy ¶ 4(a)(i). *See Roberts v. Boyd*, D2000-0210 (WIPO May 29, 2000) (holding that <juliaroberts.com> is identical to "Julia Roberts"). *See also Rollerblade, Inc. v. McCrady*, D2000-0429 (WIPO June 25, 2000) (finding that the top level of the domain name such as ".net" or ".com" does not affect the domain name for the purpose of determining whether it is identical or confusingly similar).

Rights or Legitimate Interests

As held by Complainant, the Panel finds that Complainant has prior rights in the ANTHONY QUINN trademark, which precede Respondent's registration of the <anthonyquinn.com> domain name. Respondent is not a licensee of Complainant, and Respondent has not received permission or consent from Complainant to use the trademark. Furthermore, it has not been shown that Respondent has been commonly known by the domain name in question. *See RMO, Inc. v. Burbridge*, FA 96949 (Nat. Arb. Forum May 16, 2001) (interpreting Policy § 4(c)(ii) "to require a showing that one has been commonly known by the domain name prior to registration of the domain name to prevail").

Once Complainant makes a *prima facie* case in support of its allegations, the burden shifts to Respondent to show that it does have rights or legitimate interests pursuant to Policy § 4(a)(ii). *See Do The Hustle, LLC v. Tropic Web*, D2000-0624 (WIPO Aug. 21, 2000) (holding that, where the complainant has asserted that the respondent has no rights or legitimate interests with respect to the domain name, it is incumbent on the respondent to come forward with concrete evidence rebutting this assertion because this information is "uniquely within the knowledge and control of the respondent").

Complainant contends that Respondent is pointing the disputed domain to commercial web pages that sell products that are in direct competition to products sold under the ANTHONY QUINN trademark and that Respondent likely receives "pay-per click" commissions for establishing these links. Respondent has alleged, however, that the links are not chosen or controlled by him but are rather provided by default by the registrar, since Respondent has not yet used the site.

On February 13, 2006, the Panel visited the <anthonyquinn.com> website of Respondent in order to investigate whether there could be found any evidence as to Respondent's rights or the legitimacy of the interest of Respondent in the contested domain name. *See Société des Produits Nestlé SA v. Telmex Management Services*, D2002-0070 (WIPO April 2, 2002) (finding that pursuant to Paragraph 10(a) of the Rules a Panel is competent to independently visit the Internet in order to obtain additional light in a default proceeding). What the Panel found supports the allegations of Complainant. On the website are links to various commercial web pages, some of which sell products that are in direct competition to products sold under the ANTHONY QUINN trademark. According to the information on the website, the page is provided to the domain owner freely by a third-party company that provides domain parking services. The company provides the links on the webpage and the domain owner receives revenues per click, just as Complainant contends.

Such diversionary use is neither a *bona fide* offering of goods or services pursuant to Policy ¶ 4(c)(i) nor a legitimate non-commercial or fair use pursuant to Policy ¶ 4(c)(iii). *See TM Acquisition Corp. v. Sign Guards*, FA 132439 (Nat. Arb. Forum Dec. 31, 2002) (finding that the respondent's diversionary use of the complainant's marks to send Internet users to a website which displayed a

series of links, some of which linked to the complainant's competitors, was not a *bona fide* offering of goods or services); *see also Black & Decker Corp. v. Clinical Evaluations*, FA 112629 (Nat. Arb. Forum June 24, 2002).

Respondent also claims to have the intention to put up a fan site celebrating the actor Anthony Quinn. Respondent further claims that the site is ready and has provided the Panel with a short draft of the designed website. As Complainant has pointed out, however, it seems as if most of the materials in the draft have been borrowed from other sites and the draft could very well have been created on a very short notice. Furthermore, Respondent had been the registered owner of the domain for over two and a half years before the submission of the Complaint and thus had ample time to design and introduce a fully functioning web site. In the light of this, the Panel finds that the draft that Respondent has submitted is not sufficient to prove a future intent to create a fan site.

Registration and Use in Bad Faith

Respondent's use of the <**anthonyquinn.com**> domain name to operate a website featuring links to various competing and non-competing commercial websites for Respondent's own commercial gain is evidence of Respondent's bad faith registration and use. The Panel finds that such use is, in fact, evidence of bad faith registration and use pursuant to Policy ¶ 4(b)(iv). *See Associated Newspapers Ltd. v. Domain Manager*, FA 201976 (Nat. Arb. Forum Nov. 19, 2003) ("Respondent's prior use of the <mailonsunday.com> domain name is evidence of bad faith pursuant to Policy § 4(b)(iv) because the domain name provided links to Complainant's competitors and Respondent presumably commercially benefited from the misleading domain name by receiving 'click-through-fees.'"); *see also G.D. Searle & Co. v. Celebrex Drugstore*, FA 123933 (Nat. Arb. Forum Nov. 21, 2002)

Thus, the Panel finds that the domain name at issue has been registered and used in bad faith.

DECISION

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

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

Jonas Gulliksson, Panelist
Dated: February 17, 2006

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