

ALMOST FAMOUS:
PREVENTING USERNAME-SQUATTING ON
SOCIAL NETWORKING WEBSITES ♦

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INTRODUCTION

On May 6th, 2009, Anthony La Russa, manager of the St. Louis Cardinals, sued the social networking website Twitter after an unknown Twitter user created an account under La Russa’s name and posted updates as La Russa at twitter.com/TonyLaRussa.¹ La Russa’s complaint alleged, among other things, that the fake Twitter page constituted cybersquatting,² which has been defined as the “deliberate, bad-faith, and abusive registration of Internet domain names in violation of the

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¹ Douglas MacMillan, *La Russa vs. Twitter Tests Web Anonymity*, BUS. WK., June 10, 2009, *available at* http://www.businessweek.com/technology/content/jun2009/tc2009069_767898.htm.

² Complaint at 4, *La Russa v. Twitter, Inc.*, No. CGC-09-488101 (Cal. Super. Ct. filed May 6, 2009).

rights of trademark owners.”³ La Russa is one of the many people to find that his name has been registered as a username on a social networking website, before having the opportunity to register it himself.⁴ La Russa and Twitter settled the suit,⁵ leaving unanswered several key questions: who should have rights to a username, what kind of protection is available against username-squatting, and how much protection *should* be available?

Username-squatting, as defined by this Note, is the bad-faith⁶ registration of a personal name, other than the registrant’s, as a username on a social networking website. This characterization is based on the well-known definition of cybersquatting.⁷ Trademark owners who find their marks being improperly used in a domain name can seek protection against the cybersquatter by filing suits based on the Anti-cybersquatting Consumer Protection Act (ACPA),⁸ or, alternatively, by filing a complaint under the internationally used Uniform Domain Name Dispute Resolution Policy (UDRP).⁹ However, these protections against cybersquatting are inapplicable to username-squatting, as usernames are not domain names.¹⁰ Nonetheless, many similarities exist between cybersquatting and username-squatting,¹¹ and solutions crafted to resolve cybersquatting disputes, like the ACPA and UDRP, provide a workable framework for username-squatting disputes.

For the purposes of this Note, the discussion on username-squatting will focus specifically on disputes including personal names, as the very nature of social-networking websites suggests that username disputes will most commonly arise over personal names. Username-squatting disputes mirror common cybersquat-

³ S. REP. NO. 106-140, at 4 (1999).

⁴ See MacMillan, *supra* note 1.

⁵ Josh Catone, *Twitter and La Russa Settle Lawsuit; Who’ll Sue Next?*, MASHABLE, June 5, 2009, <http://mashable.com/2009/06/05/twitter-lawsuit-settled>.

⁶ See *infra* Part I.B for a further discussion on “bad-faith” in the context of cybersquatting.

⁷ See S. REP. NO. 106-140, at 4 (1999) for a similar definition, defining “cybersquatting” as the “deliberate, bad-faith, and abusive registration of Internet domain names in violation of the rights of trademark owners.”

⁸ 15 U.S.C. § 1125(d) (2006).

⁹ ICANN, *Uniform Domain Name Dispute Resolution Policy* (1999) [hereinafter UDRP], available at <http://www.icann.org/en/udrp/udrp-policy-24oct99.htm>.

¹⁰ The protection provided by the ACPA does not apply to “screen names, file names, and other identifiers not assigned by a domain name registrar or registry.” S. REP. NO. 106-140, at 17 (1999). As usernames are not registered by a domain name registrar, they are not protected by the ACPA.

¹¹ For example, in the context of cybersquatting, squatters may register the domain name constituting another’s trademark or personal name in an attempt to impersonate that name or mark. See, e.g., *Spears, Leeds, & Kellogg v. Rosado*, 122 F. Supp. 2d 403, 405 (S.D.N.Y. 2000) (“Specifically, the Court finds that . . . Rosado’s site seeks to impersonate SLK’s mark by using the identical REDIBOOK mark.”). Likewise, a user may register the username of another person to impersonate that person.

ting disputes over personal names.¹² For instance, soon after the social networking website Facebook announced that users could customize the URL linking to their page to include their username,¹³ Larry Winget, the author of several finance books, lost the opportunity to register “facebook.com/larrywinget” when a fan beat him to it.¹⁴ The fan was willing to turn the username over to Winget if he would agree to a face-to-face meeting.¹⁵

This Note proposes a solution to the username-squatting problem by using the ACPA and UDRP as models, analyzing what factors should be borrowed from the domain name resolution mechanisms and how the borrowed factors should be applied in the username context. Unlike the ACPA and UDRP, this proposed solution would not be based on trademark law. Under trademark law, personal names are never inherently distinctive and, hence, can only be registered if they have acquired a secondary meaning.¹⁶ In the cybersquatting context, this has led to confused and inconsistent protection for domain names containing individuals’ personal names.¹⁷ The proposed solution to username-squatting established by this Note switches the focus from trademark law to the right of publicity, an intellectual property right that protects the use of individuals’ personas, including their personal names,¹⁸ creating a resolution mechanism suitable to username-squatting disputes.

Part I looks at the ACPA and the UDRP, analyzing how personal name domain name disputes are dealt with under both mechanisms. Part II summarizes the right of publicity. Part III examines the internal policies some social networking websites have enacted in their attempts to curb the username-squatting problem. Part IV focuses on why protection against username-squatting should be available and the extent of rights that should be available, and it briefly considers a framework for such protec-

¹² See *supra*, note 1, for an example of a username-squatter registering the personal name of another person for the purpose of impersonating that person.

¹³ Posting of Blaise DiPersia to Facebook Blog, *Coming Soon: Facebook Usernames*, <http://blog.facebook.com/blog.php?post=90316352130> (June 9, 2009, 14:11 EST). Facebook users’ URLs were previously assigned random numbers, such as www.facebook.com/id=592952074. With this new policy, Facebook users can register their personal names as part of the URL linking to their page, like www.facebook.com/brucepringsteen.

¹⁴ Brad Stone, *Keeping a True Identity Becomes a Battle Online*, N.Y. TIMES, June 17, 2009, at B1, *available at* <http://www.nytimes.com/2009/06/18/technology/internet/18name.html>.

¹⁵ *Id.*

¹⁶ See, e.g., *Herring-Hall-Marvin Safe Co. v. Hall’s Safe Co.*, 208 U.S. 554 (1908).

¹⁷ See, e.g., Jacqueline D. Lipton, *Celebrity in Cyberspace: A Personality Rights Paradigm for Personal Domain Name Disputes*, 65 WASH. & LEE L. REV. 1445 (2008).

¹⁸ See *infra* Part II for a discussion on the right of publicity.

tion. This Note concludes that the protection provided by social networking websites like Twitter and Facebook is insufficient, evincing that legislation similar to the ACPA, or a dispute resolution mechanism similar to the UDRP, that also takes into account the right of publicity should be established to curb username-squatting. Finally, this Note analyzes what should be borrowed from the ACPA and UDRP, and how these borrowed provisions should be applied in a username dispute resolution mechanism.

I. PERSONAL NAME DISPUTES IN DOMAIN NAMES

A. *Personal Names in Trademark Law Generally*

The common law places personal names into the category of “non-inherently distinctive terms,”¹⁹ which require proof, through usage, that the name has acquired secondary meaning, through usage, in order to gain trademark protection.²⁰ There are three traditional rationales for requiring secondary meaning in personal names: (1) a reluctance to forbid a person from using his name in business,²¹ (2) many names are common and would not lead a consumer to assume that two products bearing the same name come from one source,²² and (3) granting trademark rights to a personal name would prevent others who have the same name from using it in their businesses, and would thus deprive consumers of useful descriptive information.²³ However, if in a given situation the purpose of the rule fails, some courts have found that the rule should fail as well.²⁴ These rationales advance one of the

¹⁹ An identifying mark is capable of being protected as a trademark if it is either inherently distinctive or has acquired distinctiveness through secondary meaning. J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 11:2 (4th ed. 2004). Fanciful, arbitrary, and suggestive marks are regarded as being “inherently distinctive.” *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763 (1992). A fanciful mark is a word used for the express purpose of functioning as a trademark. MCCARTHY, *supra*, § 13:4. “An arbitrary mark consists of a word or symbol that is in common usage in the language, but is arbitrarily applied to the goods or services in question in such a way that it is not descriptive or suggestive.” *Id.*

²⁰ MCCARTHY, *supra* note 19, § 13:2, 15:1. A personal name is classified as not being “inherently distinctive,” and hence, to achieve trademark status, it must be proven that the name has acquired distinctiveness as a mark in the buyers’ minds. This is known as “secondary meaning” and requires proof that customers will associate the name with a single, albeit anonymous, commercial source.

²¹ In *re Joint-Stock Company Bail*, 84 U.S.P.Q.2d 1921, 2007 WL 2460997 (T.T.A.B. 2007) (noting that the purpose of the statutory surname bar to registration is to have surnames more readily available for those who want to use their own surnames in business).

²² Prior to acquisition of secondary meaning, consumers will take the personal name as being merely descriptive of the name of the maker or seller of the goods, and not necessarily indicating any one particular source. MCCARTHY, *supra* note 19, § 13:4.

²³ *Peaceable Planet, Inc. v. TY, Inc.*, 362 F.3d 986 (7th Cir. 2004), *cert. denied*, 543 U.S. 869, 125 S. Ct. 275 (2004).

²⁴ *Id.* at 990 (“The ‘rule’ that personal names are not protected as trademarks until they

main justifications for trademark law: avoiding consumer confusion.²⁵

Further, to acquire trademark protection for a name, the name must be used in commerce.²⁶ Specifically, there must be products or services associated with the name, and the name must be used to distinguish the products or services from those sold by others.²⁷ Merely having a famous name is insufficient.²⁸ In the context of Internet domain names, this rule has obvious implications for politicians, celebrities, and public figures, who may have valid reasons to assert some control over their personal names in the domain space, but may not have products or services associated with their names, and hence, would likely fail to gain trademark protection.²⁹

B. *The Anti-cybersquatting Consumer Protection Act*

Cybersquatting comes in many forms.³⁰ Domain name disputes involving *personal names* commonly include either: (1) a squatter that registers the domain name of a person hoping that the person will pay the cybersquatter to recover the name³¹ (2) a

acquire secondary meaning is a generalization, and its application is to be guided by the purposes that we have extracted from the case law. When none of the purposes that animate the 'personal name' rule is present, and application of the 'rule' would impede rather than promote competition and consumer welfare, an exception should be recognized.") (citation omitted).

²⁵ MCCARTHY, *supra* note 19, § 2:8.

²⁶ 15 U.S.C. § 1125(a)(1).

²⁷ See, e.g., Chung, Mong Koo v. Individual, WIPO Arbitration and Mediation Center Case No. D2005-1068, 2005 WL 3841676 (2005), available at <http://www.wipo.int/amc/en/domains/decisions/html/2005/d2005-1068.html>.

²⁸ *Id.*

²⁹ See Lipton *supra* note 17, at 1455-68, for a discussion of the reasons celebrities, politicians, and public figures have for asserting some control over their personal names in the domain name space. Celebrities, for instance, may want to control the domain name that corresponds to their personal name for their own commercial motives, which is in line with current Internet usage norms; they may want to control the domain name to prevent unjust enrichment; or, alternatively, "a celebrity may want to control a <name.com> domain name to avoid any authorized web content about her." *Id.* at 1459-60.

³⁰ See LISA E. CRISTAL & NEAL S. GREENFIELD, TRADEMARK LAW & THE INTERNET 248 (2d ed. 2001). Cristal and Greenfield outlined several forms of cybersquatting, including:

- (1) extracting payment from the rightful owners of the mark, who find their trademarks "locked up" and are forced to pay for the right to engage in electronic commerce under their brand names;
- (2) offering the domain name for sale to the public or the highest bidder discretely or over the internet;
- (3) misusing domain names to divert customers to pornographic sites or otherwise to engage in unfair competition and to prey on customer confusion;
- (4) registering well-known trademarks by the hundreds and thousands - an activity referred to as "warehousing"; and
- (5) engaging in acts of consumer fraud, including counterfeiting activities[.]

Id.

³¹ See Cynthia A.R. Woollacott, *Name Dropping: Recent Anti-cybersquatting Legislation Offers Some Relief to Trademark Holders*, 23 L.A. LAW 28, 29 (2000) (discussing registration patterns of cybersquatters).

squatter that registers the domain name of a person and uses that person's name in a crude manner, like a pornographic website, in an attempt to incentivize the person to buy the domain name back;³² and (3) a squatter that registers the domain name of a person and does not use it for any commercial purpose, but uses it for expressive purposes instead (i.e., a gripe site).³³ As domain names are one of the "highest prized commodities in the world of intellectual property law,"³⁴ and each domain name can only be registered once,³⁵ the amount of litigation surrounding domain names is unsurprising.³⁶

The ACPA was signed into law on November 29, 1999.³⁷ The act provides for the forfeiture, cancellation, or transfer of the domain name if cybersquatting is proven.³⁸ To prevail on a claim of cybersquatting, a person must establish that: (1) he had a distinctive mark³⁹ at the time of registration of the domain name;⁴⁰ (2) that the registrant had a bad faith intent to profit from another's mark;⁴¹ and (3) that there was registration of, trafficking in, or use of a domain name that is (a) identical or confusingly similar to a trademark that is distinctive at the time the domain name is registered⁴² or (b) identical, confusingly similar to, or dilutive of a trademark that is famous at the time the domain name is registered.⁴³ There is no requirement that a mark be registered and

³² *Id.*

³³ *See, e.g.,* Lamparello v. Falwell, 420 F.3d 309 (4th Cir. 2005) (holding that jerryfalwell.com was used as a gripe site, "or a website dedicated to criticism of the markholder").

³⁴ Benjamin B. Cotton, Comment, *Prospecting or Cybersquatting: Registering Your Name Before Someone Else Does*, 35 J. MARSHALL L. REV. 287, 294 (2002). *See also* Dorer v. Arel, 60 F. Supp. 2d 558, 561 (E.D. Va. 1999) ("Some domain names . . . are valuable assets as *domain names* irrespective of any goodwill which might be attached to them.") (emphasis in original).

³⁵ *See* Marshall Leaffer, *Domain Names, Globalization and Internet Governance*, 6 IND. J. GLOBAL LEGAL STUD. 139, 143 (1998) ("Most importantly, each [Internet] address must be unique so that other computers on the network are able to locate and to route messages to the correct address.").

³⁶ *See, e.g.,* ICANN, STATISTICAL SUMMARY OF PROCEEDINGS UNDER UNIFORM DOMAIN NAME DISPUTE RESOLUTION POLICY (2004), <http://www.icann.org/en/udrp/proceedings-stat.htm> (last updated May 10, 2004). According to ICANN's report, as of 2004, there have been 7,790 arbitration proceedings involving 13,311 domain names under the UDRP. Of those proceedings, 6,215 arbitrations have led to 10,719 domain name transfers, and 1,468 arbitrations have led to 1,892 domain names remaining with the original registrant.

³⁷ ANNE GILSON LALONDE, 2 GILSON ON TRADEMARKS § 7A.01 (2008).

³⁸ 15 U.S.C. § 1125(d)(1)(C).

³⁹ 15 U.S.C. § 1127. The Lanham Act defines "mark" as including "any trademark, service mark, collective mark, or certification mark."

⁴⁰ *Utah Lighthouse Ministry v. Foundation for Apologetic Information and Research*, 527 F.3d 1045, 1057 (10th Cir. 2008).

⁴¹ 15 U.S.C. § 1125(d)(1)(A)(i).

⁴² 15 U.S.C. § 1125(d)(1)(A)(ii)(I).

⁴³ 15 U.S.C. § 1125(d)(1)(A)(ii)(II). Under the Lanham Act, "a mark is famous if it is widely recognized by the general consuming public of the United States as a designation

hence, common law trademarks are also protected by the Act.⁴⁴

The ACPA differed from preexisting law by eliminating obstacles that victims of cybersquatting faced. For example, under the ACPA, to succeed in a claim against a cybersquatter, the parties' goods or services are irrelevant, and traditional likelihood of confusion does not need to be shown, and a party can succeed in recovering a domain name even if the registrant does not use the website for commercial purposes.⁴⁵ Therefore, if a cybersquatter registers another's mark as his domain name and makes no use of it except to offer to sell it to the person who owns the mark, the mark owner will nonetheless be able to recover the domain name.

Once a person has established that their mark or personal name is distinctive or is "famous" as defined by the act,⁴⁶ and that the domain name is sufficiently similar to that mark or name, the most crucial issue in a cybersquatting case is whether the defendant, in bad faith, intended to profit from that mark.⁴⁷ Congress made clear in commentaries and in the text of the statute itself that the ACPA is not meant to apply to "innocent" infringers.⁴⁸ The ACPA provides nine bad-faith "factors" that should be considered in determining whether the domain name was registered in bad faith.⁴⁹ However, this list is not exclusive or dispositive; rather, the most important considerations for finding bad faith can be

of the source of the goods or services of the mark's owner." 15 U.S.C. § 1125(c)(2)(A).

⁴⁴ MCCARTHY, *supra* note 19, § 25:78.

⁴⁵ *Id.* McCarthy explained how in the typical cybersquatting context, the cybersquatter makes no actual use of the domain name on an active Web site or to identify goods or services. Thus, Congress stipulated that the product or service line dimension was not to be considered in determining the existence of cybersquatting. It is only the challenged domain name and the plaintiff's mark that are to be compared. The traditional multi-factor test of a likelihood of confusion is not to be used.

Id.

⁴⁶ See *supra* note 43 for the Lanham Act's explanation of when a mark is famous.

⁴⁷ CRISTAL & GREENFIELD, *supra* note 30, at 250. ("The importance of a finding of 'bad faith' on the part of the defendant in an action under the ACPA cannot be over-emphasized.").

⁴⁸ See *id.*

⁴⁹ 15 U.S.C. § 1125(d)(1)(B)(i). The Statute directs the court to consider: (I) whether the squatter has "trademark or other intellectual property rights" in the domain name; (II) whether the domain name constitutes the squatter's legal name; (III) whether the squatter had previously made use of the domain name in "connection with the bona fide offering of any goods or services;" (IV) whether the squatter has made bona fide noncommercial or fair use of the mark the domain name; (V) whether the squatter intended to "divert consumers from the mark owner's online location to a site accessible under the domain name that could harm the goodwill represented by the mark;" (VI) whether the squatter has offered "to transfer, sell, or otherwise assign the domain name to the mark owner or any third party for financial gain;" (VII) whether the squatter provided faulty contact information when registering the domain name; (VIII) whether the squatter has registered multiple domain names containing trademarks; and (IX) "the extent to which the mark incorporated in the person's domain name registration is or is not distinctive and famous. . . ." *Id.*

“the unique circumstances of [each] case, which [may] not fit neatly into the specific factors enumerated by Congress but may nevertheless be considered under the statute.”⁵⁰

Of particular interest for the purposes of this article is the second factor, which directs courts to consider “the extent to which the domain name consists of” the registrant’s legal name or “a name that is otherwise commonly used to identify that person.”⁵¹ This factor recognizes that with the growing use of personal websites, people should have rights in registering their legal names as domain names.⁵² Thus, in *Nissan Motor Co. v. Nissan Computer Corp.*, the court ruled that a man named Uzi Nissan, who registered nissan.com before the car manufacturer for the purpose of promoting his computer sales and service business, was not a cybersquatter in violation of the ACPA.⁵³ This factor does not give domain name pirates an opportunity to avoid liability by claiming that their nickname is “Burger King,” for example. Ultimately, the court has discretion to determine whether or not a person that registered their name or nickname as a domain name registered that domain name with an absence of bad-faith,⁵⁴ *based on the specific facts of that case*. Thus, if a hypothetical user claims that his nickname is “Burger King,” the Court will make a fact-specific determination as to whether this person acted in good faith when they registered budlight.com, or whether he is just alleging that his nickname is “bud light” to avoid liability.

In the absence of bad faith, domain names are available on a “first come, first served” basis. Thus, if a hypothetical person named John McDonalds registered “mcdonalds.com” *in good faith*, before the fast food chain had a chance to register the domain name itself, the fast food chain would potentially be unsuccessful in recovering the domain name.⁵⁵

Further, registering another’s personal name for expressive purposes may be permissible for First Amendment reasons.⁵⁶

⁵⁰ *Sporty’s Farm L.L.C. v. Sportsman’s Market, Inc.*, 202 F.3d 489 (2d Cir. 2000).

⁵¹ 15 U.S.C. § 1125(d)(1)(B)(i)(II).

⁵² MCCARTHY, *supra* note 19, § 25:78.

⁵³ *Nissan Motor Co. v. Nissan Computer Corp.*, 61 U.S.P.Q.2d 1839 (C.D. 2002) (the claim that defendant was a cybersquatter in violation of the ACPA was dismissed on summary judgment).

⁵⁴ H.R. REP. NO. 106-412, at 10 (1999).

⁵⁵ *See, e.g.*, *Strick Corp. v. Strickland*, 162 F. Supp. 2d 372 (E.D. Pa. 2001) (“[T]here is no suggestion that, in choosing the nickname he used since childhood to be his domain name, defendant intended to confuse or deceive customers.”); *HQM, Ltd. v. Hatfield*, 71 F. Supp. 2d 500 (D. Md. 1999) (holding that William Hatfield’s registration of the domain name hatfield.com is not an act of trademark infringement on the plaintiff’s “Hatfield” trademark for meat products).

⁵⁶ 15 U.S.C. § 1125(c)(4)(c) (“Nothing in this Title shall affect any defense available to a defendant under the Trademark Act of 1946 including any defense under section

Websites that use trademarks for parody, comment, and criticism are typically permissible,⁵⁷ especially if the domain name includes words, like “sucks,” that dispel any potential consumer confusion.⁵⁸ However, some such sites may nevertheless be turned over if the requisite bad faith standard under the ACPA is met.⁵⁹ Fan club web sites that use the famous person’s name as part of their club’s domain name may be permissible on similar grounds.⁶⁰

In passing the ACPA, Congress expressed concern regarding personal names and even called for a study on abusive domain name registration of personal names.⁶¹ Additionally, Congress included a provision in the ACPA dealing specifically with personal names.⁶² However, this provision is intentionally narrow.⁶³ The individual protection provision states:

Any person who registers a domain name that consists of the name of another living person, or a name substantially and confusingly similar thereto, without that person’s consent, with the *specific* intent to profit from such name by selling the domain name for financial gain to that person or any third party, shall be liable in a civil action by such person.⁶⁴

The specific intent element denotes that this provision will apply if the defendant has registered the domain name to profit from the plaintiff’s name *only* by selling the domain name for financial gain to the plaintiff or any third party.⁶⁵ Hence, if a per-

43(c)(4) of such act or relating to fair use or a persons right of free speech or expression under the First Amendment of the United States Constitution.”). *See also* S. REP. NO. 106-140, at 8 (1999) (describing the purposes of the ACPA as protecting “the rights of Internet users and the interests of all Americans in free speech and protected uses of trademarked names for such things as parody, comment, [and] criticism.”).

⁵⁷ *See, e.g.*, *Lamparello v. Falwell*, 420 F.3d 309 (4th Cir. 2005) (holding that the domain name *www.falwell.com*, identifying a non-commercial gripe site criticizing the Reverend Jerry Falwell, was neither an infringement nor an ACPA violation).

⁵⁸ *See, e.g.*, *Taubman Co. v. Webfeats*, 319 F.3d 770 (6th Cir. 2003) (holding that the use of “sucks” in the domain name *taubmansucks.com* eliminates any confusion as to source).

⁵⁹ *See, e.g.*, *Toronto-Dominion Bank v. Karpachev*, 188 F. Supp. 2d 110 (D. Mass. 2002) (canceling defendant’s domain names because defendant acted with intent to “tarnish and disparage” plaintiff’s mark).

⁶⁰ *See* ANNE GILSON LALONDE & JEROME GILSON, BUT I’M YOUR BIGGEST FAN! HANDLING TRADEMARK PROBLEMS POSED BY FAN-CREATED CONTENT 36 (2009) (“The owner of a genuine fan site will probably not have the requisite bad faith intent to profit from a trademark’s good will.”).

⁶¹ GILSON LALONDE, *supra* note 37, § 7A.06[1][f] (“Another section of the ACPA calls for a study by the Secretary of Commerce on abusive domain name registrations involving personal names.”).

⁶² *See* 15 U.S.C. § 8131 (2008).

⁶³ 145 CONG. REC. S14696-03, at S14715 (daily ed. Nov. 17, 1999) (“In sum, this subsection is a narrow provision intended to curtail one form of ‘cybersquatting’—the act of registering someone else’s name as a domain name for the purpose of demanding remuneration from the person in exchange for the domain name.”).

⁶⁴ 15 U.S.C. § 8131 (emphasis added).

⁶⁵ MCCARTHY, *supra* note 19, § 25:78 (“[T]he personal name provisions require proof of a ‘specific intention to profit from such name’ and to do so solely by the method of selling the domain name for financial gain to the plaintiff or any third party.”).

son registers johnsmith.com with the intention of selling the domain name to someone named John Smith, John Smith can sue under this provision to recover the domain name. However, if the person who registered johnsmith.com is making *any* other use of the domain name, no matter how illegitimate, John Smith does not have a cause of action under this provision, even if a similar use would constitute bad faith under the broader ACPA provisions if a trademark were involved. Of course, under this narrow provision, a person who registers a domain name that consists of their own name is not liable to anyone else, even if they have the same name.⁶⁶ In this context, the “first come, first served” rule triumphs.

C. *The Uniform Dispute Resolution Policy*

The Internet Corporation for Assigned Names and Numbers (“ICANN”), a non-profit corporation, manages the Internet domain name system pursuant to an agreement with the U.S. government.⁶⁷ On August 26, 1999, ICANN adopted the Uniform Domain Name Dispute Resolution Policy (“UDRP”)⁶⁸ based on recommendations made by the World Intellectual Property Organization (“WIPO”).⁶⁹ By 2000, most global top-level registrars⁷⁰ had adopted the UDRP.⁷¹ Hence, anyone who registers a domain name in the “.biz, .com, .info, .name, .net, or .org” top-level domains must agree to abide by the UDRP and must submit to a mandatory administrative proceeding in the event that a third party alleges cybersquatting.⁷² The UDRP process is intended solely for the resolution of cybersquatting disputes, and not for

⁶⁶ See, e.g., *HQM, Ltd. v. Hatfield*, 71 F. Supp. 2d 500 (D. Md. 1999).

⁶⁷ DAVID LINDSAY, *INTERNATIONAL DOMAIN NAME LAW: ICANN AND THE UDRP* § 2.12 at 48 (2007).

⁶⁸ UDRP, *supra* note 9.

⁶⁹ In 1998, the U.S. government called upon The World Intellectual Property Organization (“WIPO”) to “develop recommendations for a uniform approach to resolving trademark/domain name disputes involving cyberpiracy.” National Telecommunications and Information Administration (NTIA), *Management of Internet Names and Addresses*, 63 Fed. Reg. 31741 (1998). As a result of its consultative process, WIPO issued a report to ICANN in April 1999 and made several recommendations for dispute resolution procedures to be followed. WIPO, *The Management of Internet Names and Addresses: Intellectual Property Issues*, Report of the WIPO Internet Domain Name Process, Apr. 30, 1999, available at http://www.icann.org/en/wipo/FinalReport_1.html [Hereinafter “WIPO First Report”].

⁷⁰ A registrar is “a person or entity that contracts with second level domain name holders and a registry, collecting registration data about the [second-level domain] holders and submitting zone file information for entry in the registry database.” ICANN, *REGISTRAR ACCREDITATION AGREEMENT* (1999), <http://www.icann.org/en/nsi/icann-raa-04nov99.htm>.

⁷¹ MCCARTHY, *supra* note 19, § 25:74.75. (“That is, the ICANN policy applies to all accredited registrars in the .biz, .com, .info, .name, .net, and.org top-level domains.”).

⁷² UDRP, *supra* note 9, § (4)(a).

other domain name disputes.⁷³

The UDRP is intended to be a simple, quick, and inexpensive alternative to suing under the ACPA.⁷⁴ Like the ACPA, UDRP remedies include forfeiture, cancellation, or transfer of the domain name.⁷⁵ To warrant any of these remedies, the complainant must prove that: (1) the challenged domain name is identical or confusingly similar to a common law or registered trademark or service mark in which the complainant has rights, (2) the domain name holder has no rights or legitimate interest in the domain name, and (3) the domain name was registered and used in bad faith.⁷⁶ The mandatory administrative proceeding under the UDRP does not preclude either party from submitting the dispute to a court of competent jurisdiction, either prior to or at the conclusion of the proceeding and, thus, subsequent court proceedings may yield a different result from that reached in a UDRP proceeding.⁷⁷

The UDRP provides several circumstances that shall evince registration and use in bad faith.⁷⁸ Furthermore, similar to the ACPA, the UDRP provides that you may have legitimate rights to a domain name if “you (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights” in the name used.⁷⁹

The extent to which the UDRP is available to protect personal

⁷³ See, e.g., *Estate of Marlon Brando v. WhoisGuard*, 77 U.S.P.Q.2d 1229 (Nat'l. Arb. F. 2005) (refusing the transfer of marlonbrando.com because this was not a cybersquatting dispute and hence, not appropriate for resolution in a UDRP proceeding).

⁷⁴ See MCCARTHY, *supra* note 19, § 25:74.75. See also *Barcelona.com, Inc. v. Excelentísimo Ayuntamiento de Barcelona*, 330 F.3d 617 (4th Cir. 2003) (“[T]he administrative process prescribed by the UDRP is ‘adjudication lite’ as a result of its streamlined natures and its loose rules regarding applicable law . . .”).

⁷⁵ UDRP *supra* note 9, § 3. Unlike the ACPA, however, the UDRP does not provide for statutory damages.

⁷⁶ MCCARTHY, *supra* note 19, § 25:74.75.

⁷⁷ See, e.g., *Hewlett-Packard Dev. Co. v. Midwest Info. Tech. Group*, No. 04-3055, 2006 U.S. Dist. LEXIS 36380 (C.D. Ill. 2006) (holding that an arbitrator's finding that the respondent in a UDRP proceeding did not register disputed domain names in bad faith has no preclusive effect in a subsequent trademark infringement suit brought in a U.S. court. Hence, the Arbitrator's decision was not a “binding decision.”).

⁷⁸ UDRP, *supra* note 9, § (4)(a). The circumstances that will constitute bad faith registration include: (i) acquiring the “domain name primarily for the purpose of selling, renting, or otherwise transferring” the domain name; (ii) engaging in a pattern of such conduct that evinces efforts to prevent trademark holders from reflecting their trademark in a domain name; (iii) registering the “domain name primarily for the purpose of disrupting the business of a competitor;” (iv) intentionally attempting to “attract, for commercial gain, Internet users to your web site or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of your web site. . . .” *Id.*

⁷⁹ *Id.* at § 4(c)(ii).

names was a controversial issue from the start.⁸⁰ Consequently, WIPO recommended that UDRP protection be limited to personal names that are registered as trademarks or have gained protection as unregistered trademarks.⁸¹ The report outlined a number of relevant factors that UDRP panels have used in deciding whether a personal name should be protected.⁸² Like the ACPA, a name is only subject to protection if it has acquired trademark rights and has been used in commerce,⁸³ and a remedy is available only if the registration was in bad faith.⁸⁴ Therefore, the ACPA and the UDRP provide virtually identical requirements.⁸⁵ Nonetheless, bringing complaints under the UDRP has proved more popular than suing in court under the ACPA for individuals seeking to recover a domain name that includes their personal name,⁸⁶ pre-

⁸⁰ In its first report, WIPO recommended that the dispute resolution procedure be limited to the abusive registration of trademarks and service marks and suggested that personality rights should not fall within the procedure. LINDSAY, *supra* note 67. However, in WIPO's second report, it noted, "the clear weight of authority of many decisions is in favor of the application of the UDRP to the protection of personal names when they constitute trademarks." WIPO, *The Recognition of Rights and Use of Names in the Internet Domain Name System*, Report of the Second WIPO Internet Domain Name Process, at ¶ 179, Sept. 3, 2001, available at <http://www.wipo.int/export/sites/www/amc/en/docs/report-final2.pdf> [hereinafter "WIPO Second Report"]. Many commentators recommended that the UDRP be broadened beyond trademark protection. See, e.g., Comment of Hungary, Hungarian Patent Office, June 13, 2001, available at <http://www.wipo.int/amc/en/processes/process2/rfc/rfc3/comments/msg00097.html> ("The UDRP proved to be an efficient and successful mechanism against abusive registration of trademarks as domain names, therefore it is possible to suggest that its scope be broadened in order to cover other categories -such as personal names -as well.").

⁸¹ See WIPO Second Report, *supra* note 80, at ¶ 202. (WIPO "recommended that no modification be made to the UDRP to accommodate broader protection for personal names than that which currently exists in the UDRP.") See also WIPO, *WIPO Overview of WIPO Panel Views on Selected UDRP Questions*, available at <http://www.wipo.int/amc/en/domains/search/overview/index.html> (Mar. 23, 2005) [hereinafter "WIPO Overview"]. (While the UDRP does not specifically protect personal names, in situations where an unregistered personal name is being used for trade or commerce, the complainant can establish common law trademark rights in the name. "Personal names that have been trademarked are protected under the UDRP.").

⁸² See WIPO Second Report, *supra* note 80, at ¶ 182. Factors include:
the distinctive character or notoriety of the name and the requirement that the domain name must be "identical or confusingly similar to it,
the relationships between this distinctive character and use of the name in connection with goods or services in commerce, and the location of the parties and the bearing that this may have on the acquisition of unregistered trademark rights.

⁸³ See WIPO Overview, *supra* note 81. ("The name in question should be actually used in trade or commerce to establish unregistered trademark rights. Merely having a famous name . . . is not necessarily sufficient to show unregistered trademark rights.").

⁸⁴ MCCARTHY, *supra* note 19, § 25:74.75.

⁸⁵ See *supra* Part I.B for a discussion on protection of personal names under the ACPA.

⁸⁶ See Lipton, *supra* note 17, at 1484 (referring to the UDRP as "the most popular avenue for personal domain name disputes"); Miriam Claire Beezy, *Good Marksmanship*, 29 L.A. LAW. 20, 23-24 (2006) (noting the high success rate of celebrities in personal domain name proceedings under the UDRP); P. Landon Moreland and Colby Springer, *Celebrity Domain Names: ICANN Arbitration Pitfalls and Pragmatic Advice*, 17 SANTA CLARA COMPUTER

sumably because of the potential for quicker and cheaper resolutions under the UDRP. As so many more disputes are settled under the UDRP than are settled under the ACPA, UDRP panel decisions provide many examples of the application of cybersquatting rules to personal name disputes.

The stringent trademark requirements imposed on personal name disputes in the context of domain names have led to confused and often contradictory results in panel proceedings.⁸⁷ For example, a panel granted Julia Roberts rights to the website *juliaroberts.com*,⁸⁸ while another panel denied Bruce Springsteen rights to the website *bruce.springsteen.com*.⁸⁹ Similarly, it was decided that Hillary Clinton has rights to *hillaryclinton.com*,⁹⁰ while Kathleen Kennedy Townsend did not have rights to *kathleenkennedy-townsend.com*.⁹¹

Conflicting results often arise in the context of personal names *not* registered as trademarks or service marks because of the complexity inherent in determining whether the name has acquired secondary meaning.⁹² Some panels have given weight to the crucial trademark requirement that the name be associated with some commercial goods or services,⁹³ while other panels have concluded that a complainant has established rights in their personal name *merely* because they are famous.⁹⁴ Yet, having rights in

& HIGH TECH. L.J. 385, 394 (2001) ("A plethora of disputes involving personal names have been submitted to ICANN Arbitration.").

⁸⁷ See LINDSAY, *supra* note 67, at 5.20.2. While some panels have applied a "straightforward, orthodox approach to determining whether common law rights arise in a personal name[.]" many UDRP panels have been "perfunctory in the application of US trade mark law in finding rights in personal names" and hence applied a "relatively loose" approach to finding Trademark rights in personal names. *Id.*

⁸⁸ Roberts v. Boyd, WIPO Arbitration and Mediation Center Case No. D2000-0210, 2000 WL 33674395 (May 29, 2000), *available at* <http://ompi.ch/amc/en/domains/decisions/html/2000/d2000-0210.html>.

⁸⁹ Springsteen v. Bugar, WIPO Arbitration and Mediation Center Case No. D2000-1532, 2001 WL 1705212 (Jan. 25, 2001), *available at* <http://www.ompi.ch/amc/en/domains/decisions/html/2000/d2000-1532.html>.

⁹⁰ Clinton v. Dinoia, National Arbitration Forum Claim No. FA0502000414641, 2005 WL 853535 (Mar. 18, 2005) (Atkinson, Arb.) *available at* <http://www.adrforum.com/domains/decisions/414641.htm>.

⁹¹ Townsend v. Birt, WIPO Arbitration and Mediation Center Case No. D20020030, 2002 WL 827005 (July 31, 2002) (Donahy, Davis, & Sellers, Arbs.), *available at* <http://www.wipo.int/amc/en/domains/decisions/html/2002/d2002-0451.html>.

⁹² Registration of a personal name as a trademark or service mark is sufficient to establish rights in the mark. *See e.g.*, Madonna Ciccone v. Dan Parisi, WIPO Case No. D2000-0060 (Oct. 12, 2000), *available at* <http://www.wipo.int/amc/en/domains/decisions/html/2000/d2000-0847.html> (holding that Madonna had rights to the domain name *Madonna.com* because she was the owner of rights in the mark 'Madonna').

⁹³ *See, e.g.*, Planned Parenthood Federation of America v. Chris Hoffman, WIPO Case No. D2002-1073 (Feb. 21, 2003), *available at* <http://www.wipo.int/amc/en/domains/decisions/html/2002/d2002-1073.html> ("The Panel majority asks whether 'Gloria Feldt' has been used 'commercially' in connection with a service.") (Frederick M. Abbott Panelist concurring).

⁹⁴ *See, e.g.*, Johnnie L. Cochran, Jr. v. Brian Wick, NAF Case No. FA198946 (Dec. 9, 2003),

a name merely because it is famous is seemingly prohibited under both the ACPA⁹⁵ and the UDRP.⁹⁶ On its face, the UDRP calls for the same trademark requirements as the ACPA,⁹⁷ even if it seems that the panels will be more lenient in the application of these requirements than the federal courts would be if the same case were before them.

As for fan and gripe sites,⁹⁸ like under the ACPA,⁹⁹ principles of free speech typically permit the use of another person's name to identify the website.¹⁰⁰ However, when there is a commercial aspect to the site, the requisite bad-faith element may be satisfied.¹⁰¹ As with other disputes under the UDRP that concern personal names, the panel decisions are inconsistent.¹⁰² Because the UDRP panels have been inconsistent in applying the bad faith factors set out by the policy, a party seeking to recover a domain name has a greater chance of recovering their name under the UDRP than they would by suing under the ACPA.

II. THE RIGHT OF PUBLICITY

The right of publicity has been defined as the "inherent right of every human being to control the commercial use of his or her identity."¹⁰³ The right of publicity is a state-law-created intellectual

available at <http://www.adrforum.com/domains/decisions/198946.htm> ("Complainant's celebrity status has provided him with common law trademark rights for the 'Johnnie Cochran' mark."); Pierce Brosnan v. Network Operations Center, WIPO Case No. D2003-0519 (Aug. 27, 2003), available at <http://www.wipo.int/amc/en/domains/decisions/html/2003/d2003-0519.html>; Carmen Electra v. Network Operations Center, WIPO Case No. D2003-0852 (Dec. 23, 2003), available at <http://www.wipo.int/amc/en/domains/decisions/html/2003/d2003-0852.html>; Nik Carter v. The Afternoon Fiasco, WIPO Case No. D2000-0658 (Oct. 17, 2000), available at <http://www.wipo.int/amc/en/domains/decisions/html/2000/d2000-0658.html>.

⁹⁵ 15 U.S.C. § 1125(c)(2)(A) ("[A] mark is famous if it is widely recognized by the general consuming public of the United States as a designation of source of the goods or services of the mark's owner.") (emphasis added).

⁹⁶ See WIPO Overview, *supra* note 81 ("Merely having a famous name (such as a businessman, or religious leader) is not necessarily sufficient to show unregistered trademark rights.").

⁹⁷ *Id.* See also MCCARTHY, *supra* note 19, § 25:74.75 (listing the trademark factors a complainant must prove to be successful in proving cybersquatting).

⁹⁸ "A 'gripe site' is a Web site which contains complaints or criticism about some company, person or institution." MCCARTHY, *supra* note 19, § 25:74.75.

⁹⁹ See *infra* Part I.B for a discussion of the permissibility of using another's name in domain names for fan and gripe sites.

¹⁰⁰ See, e.g., Anna Nicole Smith v. DNS Research, Inc., NAF FA0312000220007, 2004 WL 2358216 (Feb. 21, 2004) (holding that the registrant had a free speech right to use Anna Nicole Smith's name for its fan club website).

¹⁰¹ MCCARTHY, *supra* note 19, § 25:74.75. ("most panelists will distinguish between a 'pure' gripe site (which presents no evidence of bad faith beyond a content highly critical of the target) and a 'gripe-plus' site, which presents evidence of bad faith, such as a commercial aspect to the site.").

¹⁰² See W.S. Creasman, *Free Speech and "Sucking" – When is the Use of a Trademark in a Domain Name Fair?*, 95 TRADEMARK REP. 1034, 1043-46 (2005) (noting a split of UDRP panel decisions).

¹⁰³ MCCARTHY, *supra* note 19, § 28:1. See also *Haelan Laboratories, Inc. v. Topps Chewing*

property right, a distinct legal category separate but not unlike trademark law, where the infringement is a tort of unfair competition.¹⁰⁴ To prevail in a claim of infringement of the right of publicity, a plaintiff must prove that: (1) the plaintiff owns an enforceable right in the identity or persona of a human being;¹⁰⁵ (2) the defendant, without permission, used some aspect of the plaintiff's persona "in such a way that plaintiff is identifiable from defendant's use;"¹⁰⁶ and (3) the "[d]efendant's use of plaintiff's persona is likely to cause damage to the commercial value of that persona."¹⁰⁷ Unlike trademark law, "the right of publicity protects aspects of an individual's persona regardless of commercial trademark rights in the person's name."¹⁰⁸

Overall, the right of publicity has protected unauthorized use of a person's name,¹⁰⁹ nickname,¹¹⁰ stage name,¹¹¹ image,¹¹² and even voice.¹¹³ While celebrities make up the majority of right of

Gum, Inc., 202 F.2d 866, 868 (2d Cir. 1953):

[A] man has a right in the publicity value of his photograph, i.e., the right to grant the exclusive privilege of publishing his picture, and that such a grant may validly be made "in gross," i.e., without an accompanying grant of a business or of anything else. . . . This right might be called a "right of publicity." For it is common knowledge that many prominent persons (especially actors and ball-players), far from having their feelings bruised through public exposure of their likenesses, would feel sorely deprived if they no longer received money for authorizing advertisements, popularizing their countenances, displayed in newspapers, magazines, buses, trains and subways.

Id.

¹⁰⁴ J. THOMAS MCCARTHY, 1 RIGHTS OF PUBLICITY AND PRIVACY § 1:3 (2d ed. 2007) [hereinafter, RIGHTS OF PUBLICITY AND PRIVACY].

¹⁰⁵ The first factor is easily satisfied if a plaintiff is asserting rights in his own identity. The first factor will only be an issue if plaintiff is asserting rights of another human's persona, as assignee or exclusive licensee in their right of publicity, or of an entity other than that of a human being, like a corporation, institution or animal. RIGHTS OF PUBLICITY AND PRIVACY, *supra* note 107, § 3:3.

¹⁰⁶ While the identification requirement would suggest that only celebrities could establish a claim under the right of publicity, some courts have held that evidence of minimal identification will be sufficient to establish infringement. *See, e.g.,* Cohen v. Herbal Concepts, Inc., 63 N.Y.2d 379 (N.Y. 1984) (evidence that plaintiff was identified by one person, her husband, was "prima facie sufficient," in a case of unauthorized advertising use of a photograph of a non-celebrity). McCarthy proposes "that for celebrities the test of identification be that of 'unaided identification,' in which it is necessary that a more than de minimis number of ordinary viewers of defendant's use identify the plaintiff," while for non-celebrities the test should "be that of 'aided identification,' in which all that is necessary is that it be proven that the defendant's use in fact is of the person who is the plaintiff in the lawsuit." RIGHTS OF PUBLICITY AND PRIVACY, *supra* note 104, § 3:17.

¹⁰⁷ RIGHTS OF PUBLICITY AND PRIVACY, *supra* note 104, § 3:2.

¹⁰⁸ Lipton, *supra* note 17, at 1490.

¹⁰⁹ *See, e.g.,* Fairfield v. Am Photocopy Equip Co., 138 Cal. App. 2d 82, 291 P.2d 194 (2d Dist. 1955).

¹¹⁰ *See, e.g.,* Ali v. Playgirl, Inc., 447 F. Supp. 723 (S.D.N.Y. 1978) (finding that Muhammad Ali was identifiable in part by the use of the nickname "The Greatest").

¹¹¹ *See, e.g.,* Cher v. Forum Intern., Ltd., 692 F.2d 634 (9th Cir. 1982) (holding that the use of the stage name "Cher" was enough for the public to identify the celebrity of that name).

¹¹² *See, e.g.,* Grant v. Esquire, Inc., 367 F. Supp. 876 (S.D.N.Y. 1973).

¹¹³ *See, e.g.,* Midler v. Ford Motor Co., 849 F.2d 460 (9th Cir. 1988). *But see* Romantics v.

publicity cases, courts have recognized that a non-celebrity has the right to recover for infringement of the right of publicity.¹¹⁴ As Melville B. Nimmer argued, while celebrities are the clearest example, “the right should be available to everyone.”¹¹⁵

Unsurprisingly, there is inherent tension between an individual's right of publicity and the First Amendment interests of those who use identifying characteristics of others for their own purposes.¹¹⁶ In cases of pure “commercial use” (such as advertising), the First Amendment interests are not strong, and courts tend to hold that the use of an individual's personal name, image, or likeness is a violation of the right of publicity.¹¹⁷ However, if an individual's name, image, or likeness is being used for newsworthy reasons,¹¹⁸ commentary, or for purposes of creative expression, courts may find First Amendment interests sufficient to overcome a person's right of publicity.¹¹⁹ Thus, just as expressive use of a personal name will not be proscribed under trademark law,¹²⁰ First Amendment considerations tend to weigh in favor of such expressive use under the right of publicity.

As the right of publicity is only available in some states, and varies among these states, it has been widely criticized as confusing and inconsistent.¹²¹ Some commentators have argued that because

Activision Pub., Inc., 532 F. Supp. 2d 884, 888 (E.D. Mich. 2008) (holding that the common law right of publicity “has never recognized right of publicity in the sound of a voice, even if distinctive . . .”).

¹¹⁴ See, e.g., *Canessa v. J. I. Kislak, Inc.*, 235 A.2d 62, 75-76 (N.J. Super. Ct. Law. Div. 1967): [H]owever little or much plaintiff's likeness and name may be worth, defendant, who has appropriated them for his commercial benefit, should be made to pay for what he has taken, whatever it may be worth [P]laintiffs' names and likenesses belong to them. As such they are property. They are things of value. Defendant has made them so, for it has taken them for its own commercial benefit.

Id.

¹¹⁵ Melville B. Nimmer, *The Right of Publicity*, 19 LAW & CONTEMP. PROBS. 203, 217 (1954).

¹¹⁶ *ETW Corp. v. Jireh Pub., Inc.*, 332 F.3d 915, 931 (6th Cir. 2003) (“There is an inherent tension between the right of publicity and the right of freedom of expression under the First Amendment.”).

¹¹⁷ *Virginia State Bd. of Pharmacy v. Virginia Citizens Consumer Council*, 425 U.S. 748 (1976).

¹¹⁸ See, e.g., California's Right of Publicity statute, Cal. Civ. Code § 3344(d) (2007) (“use of a name, voice, signature, photograph, or likeness in connection with any news, public affairs, or sports broadcast or account, or any political campaign, shall not constitute a use for which consent is required.”).

¹¹⁹ See, e.g., *Cardtoons, L.C. v. Major League Baseball Players' Ass'n*, 95 F.3d 959 (10th Cir. 1996) (“Thus, parody, both as social criticism and a means of self-expression, is a vital commodity in the marketplace of ideas.”).

¹²⁰ 15 U.S.C. § 1125(c)(4)(c) (“Nothing in this Title shall affect any defense available to a defendant under . . . the first amendment of the United States Constitution.”).

¹²¹ See Alice Haemmerli, *Whose Who? The Case for a Kantian Right of Publicity*, 49 DUKE L.J. 383, 389 (1999) (“Existing doctrine remains in a state of disarray that leaves room for wrongs without remedies.”); *id.* at 389 (“Existing practice [under the right of publicity] is . . . confused, with fifty state regimes protecting differing aspects of identity, for varied terms, and with disparate remedies.”); GILSON LALONDE, *supra* note 37, § 2.16[1] (“The

the right of publicity has no clear legal foundation, it is difficult for courts to limit its reach.¹²² In fact, when the UDRP was being established,¹²³ WIPO recommended that the UDRP not cover personal names under a right of publicity paradigm in the domain name disputes they oversee for these very reasons.¹²⁴ However, as Professor Jacqueline Lipton, author of many articles in the fields of IP and Cyberlaw, and author of *Cyberspace Law: Case and Materials*, noted, “[n]evertheless, publicity rights jurisprudence is the most developed attempt at creating workable interests in individual personas, and balancing those interests against the rights of the public to engage in discourse about famous people.”¹²⁵

III. SOCIAL NETWORKING WEBSITES ATTEMPT TO CURB THE PROBLEM

Social networking websites have attempted to curb username-squatting, making username-squatting a violation of their terms of service. To consider what sites have done, this Note looks at the username-squatting policies of Twitter and Facebook, two of the most popular social networking websites.¹²⁶

A. Twitter

Twitter’s “Name Squatting” policy forbids the “traditional” squatting seen in many domain name disputes, like “username for sale” accounts:¹²⁷ “Attempts to sell or extort other forms of payment in exchange for usernames will result in account suspension.”¹²⁸ While the policy does not define “name squatting,” several factors taken into account when investigating name squatting

publicity right is still developing and the courts are far from unanimous in defining its scope.”).

¹²² See Stacey Dogan & Mark Lemley, *What the Right of Publicity Can Learn from Trademark Law*, 58

STAN. L. REV. 1161, 1162 (2006).

¹²³ See *supra*, Part I.C for a discussion on the UDRP.

¹²⁴ See WIPO Second Report, *supra* note 80, ¶ 200-1:

[W]e believe that the views expressed by the majority of commentators against the modification of the UDRP to [include personal name disputes] are convincing at this stage of the evolution of the DNS and the UDRP. . . . The most cogent of the arguments against modification of the UDRP is, we believe, the lack of an international norm protecting personal names and the consequent diversity of legal approaches deployed to protect personal names at the national level. We consider that this diversity would place parties and panelists in an untenable position and would jeopardize the credibility and efficiency of the UDRP.

¹²⁵ Lipton, *supra* note 17, n.69.

¹²⁶ See, e.g., Facebook Press Room: Statistics, <http://www.facebook.com/press/info.php?statistics> (last visited Mar. 16, 2010) (Facebook has “[m]ore than 400 million active users”).

¹²⁷ Twitter Support: Name Squatting Policy, <http://help.twitter.com/forums/26257/entries/18370> (last visited Mar. 16, 2010).

¹²⁸ *Id.*

are listed, including: (1) “the number of accounts created,” (2) whether the usernames were created “for the purpose of preventing others from using those account names,” (3) whether the usernames were created “for the purpose of selling those accounts,” and (4) whether the alleged squatter used “feeds of third-party content to update and maintain accounts under the names of those third parties.”¹²⁹

Additionally, Twitter has an “Impersonation Policy” that forbids *non-parody* impersonation.¹³⁰ An account may be guilty of impersonation if it confuses or misleads others; “accounts with the clear *intent* to confuse or mislead may be permanently suspended.”¹³¹ Twitter’s standard for defining parody is whether a reasonable person would be aware that the fake profile is a joke.¹³²

Lastly, soon after the La Russa suit was filed, Twitter took another step to prevent “identity confusion” caused by squatting¹³³ by unveiling “Verified Accounts.”¹³⁴ Usernames stamped with the “verified account” insignia indicate that the accounts “are “real” and authentic.”¹³⁵ Twitter has not said much about its procedures for verifying accounts, noting only that if a user is “verified,” Twitter has “been in contact with the person or entity [that] the account is representing and verified that it is approved.”¹³⁶ They have also been unclear as to how someone can have their account verified, suggesting that the user fill out a “feedback form” so that Twitter is aware of the situation.¹³⁷ This message comes with a disclaimer: “we’re not verifying all accounts.”¹³⁸ However, as noted, it is not clear what accounts they *are* verifying, and how they are going about verifying these accounts.¹³⁹

B. Facebook

On June 9, 2009, Facebook announced the forthcoming avail-

¹²⁹ Twitter Support: The Twitter Rules, <http://help.twitter.com/forums/26257/entries/18311> (last visited Mar. 16, 2010).

¹³⁰ Twitter Support: Impersonation Policy, <http://help.twitter.com/forums/26257/entries/18366> (last visited Mar. 16, 2010).

¹³¹ *Id.* Emphasis added.

¹³² *Id.*

¹³³ Twitter Help: Verified Account, <http://twitter.com/help/verified> (last visited Aug. 29, 2009).

¹³⁴ Posting of Biz Stone to Twitter Blog, Not Playing Ball, <http://blog.twitter.com/2009/06/not-playing-ball.html> (June 6, 2009, 11:15 PST).

¹³⁵ Twitter Help: Verified Account, <http://twitter.com/help/verified> (last visited Aug. 29, 2009).

¹³⁶ *Id.*

¹³⁷ *Id.*

¹³⁸ *Id.*

¹³⁹ *Id.*

ability of usernames.¹⁴⁰ When introducing usernames, Facebook took steps to limit username-squatting.¹⁴¹ Only users that were already registered on Facebook before the announcement of the availability of usernames would be able to register a username at first, in an attempt to curb users from signing up to Facebook just to create squatted usernames.¹⁴² Further, “[u]sers will be required to have a verified Facebook account, which may require mobile phone authentication.”¹⁴³ Facebook “also reserved certain names that have been brought to our attention in an effort to help third parties protect their intellectual property and other rights.”¹⁴⁴ In an ongoing attempt to protect against username-squatting, Facebook encourages users to fill out a “username infringement form” available on their website if someone is infringing their rights.¹⁴⁵

Like Twitter, Facebook policy forbids impersonation¹⁴⁶ and reserves “the right to remove or reclaim it if [they] believe appropriate (such as when a trademark owner complains about a username that does not closely relate to a user's actual name).”¹⁴⁷ Likewise, when a “*proper* claim of IP infringement” is raised, Facebook will “promptly” remove or disable the account.¹⁴⁸ Facebook policy does not define what constitutes a “proper” claim, meaning that any celebrity is likely to recover his or her username, as Facebook has a great interest in avoiding law suits, and celebrities are more likely to bring a suit to recover their username than a private individual with a similar claim. Interestingly, while Twitter makes an explicit exception to their impersonation policy for parody usernames, Facebook does not.

While Facebook suggests that the infringement form be filled out when a username is being squatted, it is not clear who will be successful in recovering their username once the form is filled out;

¹⁴⁰ Facebook Pages: Facebook Usernames Coming Soon for Pages, http://www.facebook.com/note.php?note_id=91106469821&ref (last visited Mar. 16, 2010).

¹⁴¹ Usernames: General Information, <http://www.facebook.com/help/?page=897#/help/?faq=15099> (last visited Mar. 16, 2010) (“We’ve taken steps to limit [username-squatting].”).

¹⁴² *Id.*

¹⁴³ *Id.*

¹⁴⁴ *Id.*

¹⁴⁵ Usernames: Intellectual Property Rights Holders, <http://www.facebook.com/help/?page=899#!/help/?faq=15101> (last visited Mar. 16, 2010).

¹⁴⁶ Facebook Statement of Rights and Responsibilities, <http://www.facebook.com/terms.php?ref=pf> (last visited Mar. 16, 2010) (“You will not provide any false personal information on Facebook, or create an account for anyone other than yourself without permission.”).

¹⁴⁷ *Id.*

¹⁴⁸ Facebook: About Intellectual Property, <http://www.facebook.com/help/?faq=12002> (last visited Mar. 16, 2010). Emphasis added.

nor is there any statistical information regarding the success in recovering usernames by those that have filled out the form.

IV. CURBING USERNAME-SQUATTING

A. *Establishing Username Rights: Justifications for Granting Rights to Usernames*

Considering the justifications of the right of publicity and the justifications of trademark law demonstrates that many of the same concerns are raised by username disputes, and thus, that people *should* have a right to recover usernames being squatted by others.¹⁴⁹ However, different classes of individuals have differing concerns about the use of their names as usernames. Specifically, public figures, like celebrities, will have different interests than private individuals in their usernames. Consequently, the *extent* of rights that these groups should have in their usernames will likewise differ.

1. Public Figures

*“As it happens, there are particular aspects of my life to which I would like to maintain sole and exclusive rights and privileges.”—Bette Davis as Margo Channing in All About Eve.*¹⁵⁰

A celebrity’s persona can become very valuable, and because that identity is most valuable to the celebrity, many believe that the celebrity is “most likely to conserve its value by fervently policing its use.”¹⁵¹ Courts have suggested that the effort of celebrities should be rewarded by allowing them to enjoy the fruits of their labor.¹⁵² This “natural rights” justification is straightforward; “[p]erhaps nothing is so strongly intuited as the notion that my identity is *mine*—it is my property to control as I see fit.”¹⁵³

Similarly, a person’s username can be justified as his or her own. In this age of Internet identity, when most celebrities have domain names containing their personal name, and an increasing number of celebrities are creating usernames, these websites and

¹⁴⁹ Arguments made by commentators like Lipton for the expansion of domain name disputes to cover personal names further support this conclusion. See Lipton, *supra* note 17, at 1455-68.

¹⁵⁰ ALL ABOUT EVE (Twentieth Century-Fox) (1950).

¹⁵¹ Alain J. Lapter, *How the Other Half Lives (Revisited): Twenty Years Since Midler v. Ford - A Global Perspective on the Right of Publicity*, 15 TEX. INTELL. PROP. L.J. 239, 251 (2007).

¹⁵² See, e.g., *Lombardo v. Doyle, Dane & Bernbach, Inc.*, 58 A.D.2d 620 (N.Y. App. Div. 2007).

¹⁵³ RIGHTS OF PUBLICITY AND PRIVACY, *supra* note 104, § 2:1.

usernames represent the individuals—they become an extension of identity and persona. Celebrity personas have been widely protected in many contexts, and usernames should be as well. Thus, this extension of identity should fit under the umbrella of protected persona.

A primary rationale for the right of publicity is to provide economic incentive for creativity.¹⁵⁴ If a well-known person's name or photo could be used freely for commercial endorsements, the value of that person's likeness would disappear, as any company could use that person's name.¹⁵⁵ The Supreme Court in *Zacchini v. Scripps-Howard Broadcasting Co.*¹⁵⁶ reasoned that without right of publicity protection, a performer would have no economic incentive to further his craft.¹⁵⁷ “The incentive rationale of the right of publicity posits that certain persons should be given an economic incentive to undertake socially useful or enriching activities and thereby enter the public eye.”¹⁵⁸ As used for endorsements, usernames should be protected by the same rationale, since they are just another way to monetize celebrity status (i.e. by linking to a site at which you can purchase the celebrity's new album).

Another policy rationale underpinning both the right of publicity and trademark law is unjust enrichment¹⁵⁹: a person should not be unjustly enriched by profiting off of another person's identity, without sharing those proceeds with the person.¹⁶⁰ With username-squatting, if the squatter uses the celebrity's username for commercial purposes, the same concern arises: the squatter could free-ride on that celebrity's good-will by falsifying a product endorsement. If users click on a product link from the squatter's Facebook account, and subsequently buy the product being falsely endorsed, the squatter becomes unjustly enriched. Granting rights to a username would avoid potential squatters from purporting a celebrity endorsement for products not actually endorsed by the celebrity via a squatted username.

¹⁵⁴ Michael Sloan, Note, *Too Famous for the Right of Publicity: ETW Corp. and the Trend Towards Diminished Protection for Top Celebrities*, 22 CARDOZO ARTS & ENT. L.J. 903 (2005).

¹⁵⁵ *Matthews v. Wozencraft*, 15 F.3d 432 (5th Cir. 1994).

¹⁵⁶ 433 U.S. 562 (1977).

¹⁵⁷ *Id.* at 576.

¹⁵⁸ RIGHTS OF PUBLICITY AND PRIVACY, *supra* note 104, § 2:6.

¹⁵⁹ See Vincent M. Grandpre, *Understanding the Market for Celebrity: An Economic Analysis of the Right of Publicity*, 12 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 73, 77 (2001) (“[C]ase law is replete with references to unjust enrichment.”). See, e.g., *Carson v. Here's Johnny Portable Toilets, Inc.* 698 F.2d 831, 838 (6th Cir. 1983) (Kennedy, J., dissenting); *Factors Etc., Inc. v. Pro Arts, Inc.*, 579 F.2d 215, 221 (2d Cir. 1978).

¹⁶⁰ Lapter, *supra* note 151, at 252 (noting that the concern is that “advertisers could free ride on the celebrity's self-created goodwill, unless the right to appropriate such value was held solely by the work's creator.”).

The policy keystone of trademark law—avoiding consumer confusion¹⁶¹—also applies in the username-squatting context. If a product link on a celebrity’s squatted username leads to a fan gear website, consumers might expect such fan gear to come from a company actually licensed by the celebrity. Critics of the “consumer confusion” rationale argue that existing trademark law sufficiently deals with the issue, as celebrities can register their names as trademarks with the Patent and Trademark office.¹⁶² However, username-squatting often does not fit under trademark law protection,¹⁶³ making this criticism unpersuasive.

Most notably, some public figures, such as politicians, are unlikely to have trademark rights in their names,¹⁶⁴ but may have valid reasons to assert rights in their usernames. Lipton outlined several reasons why a celebrity or politician should have access to the name.com domain name in the context of cybersquatting.¹⁶⁵ These reasons are similarly applicable in the context of username-squatting. For instance, “[c]elebrities may want to control this [username] for their own commercial motives, which seems reasonable, particularly if this is in line with current Internet usage norms.”¹⁶⁶ Politicians will reasonably have similar interests.¹⁶⁷ Further, politicians will want access to their usernames to communicate with the electorate and for fundraising.¹⁶⁸ Since people expect a username to correspond to the named user, political rivals may be motivated to squat the opposing politician’s username to criticize the politician, or alternatively, to confuse the electorate by posting views not held by that politician to the squatted username.¹⁶⁹ As the public interest in political speech is paramount, politicians should have rights to their usernames so they can communicate their views to the electorate.

The cultural significance of celebrities and politicians, which

¹⁶¹ MCCARTHY, *supra* note 19, at 2:33.

¹⁶² See Sloan, *supra* note 154, at 913.

¹⁶³ See *infra* Part IV.B for a discussion of how trademark law does not cover username-squatting.

¹⁶⁴ See Lipton, *supra* note 17, at 1463. (“[P]oliticians are less likely to hold such trademarks. Most politicians do not use their names as source indicators as trademark law requires. Rather, they use their names to raise public awareness about particular issues and, in the case of politicians, often in the context of a political campaign.”).

¹⁶⁵ *Id.* at 1458-65 (“Celebrities may have valid reasons for asserting some control over their personal names in the domain space, particularly in the <name.com> space which is probably viewed by most Internet users as the likely site for a celebrity’s authorized online presence.”).

¹⁶⁶ *Id.* at 1458.

¹⁶⁷ *Id.* at 1465. (“Like celebrities, politicians and public figures will also have concerns about situations where a domain name registrant is not cybersquatting on a given name, but rather wants to use the name herself for some expressive or commercial purpose.”).

¹⁶⁸ *Id.* at 1464-68.

¹⁶⁹ *Id.*

is seldom considered as a justification to granting personality rights, further shows that these individuals should have rights in their usernames. The public identifies with celebrities; one commentator, for example, “sees the celebrity personality as ‘wedding consumer culture with democratic aspirations’ while participating in the ‘active construction of identity in the social world.’”¹⁷⁰ David Tan, author of *Beyond Trademark Law: What the Right of Publicity Can Learn From Cultural Studies*, raised an example of this common phenomenon:

For example, the cultural sign of the African-American Academy-Award winning actress Halle Berry signifies positive attributes that many African-Americans (race and class) and women (gender) identify with. Hence the use of the Halle Berry celebrity personality as an icon in race, class and gender identity formation can [sic] expressed in many ways. African-Americans and women (regardless of color) may want to be identified with Halle Berry as being a black, confident and successful woman through the consumption of products endorsed by Halle Berry.¹⁷¹

Tan argued that because people are using the “celebrity” to forge a sense of individual identity, the law should consider this identity formation and construct a test to determine if an appropriation of a celebrity's identity in a particular commercial context is justified.¹⁷² Taking the cultural significance of celebrities, politicians, and other public figures into account, it is reasonably clear that they should have rights to their usernames, as usernames provide a way for people to identify with these public figures.

Based on the above justifications, public figures should be granted rights in their usernames. However, determining the *extent* of these rights requires the balancing of many concerns, such as free speech considerations. After all, these are exclusive rights; if Bruce Springsteen gets that username on Facebook and/or

¹⁷⁰ David Tan, *Beyond Trademark Law: What the Right of Publicity Can Learn From Cultural Studies*, 25 CARDOZO ARTS & ENT. L.J. 913, 971 (2008) (quoting P. DAVID MARSHALL, *CELEBRITY AND POWER: FAME IN CONTEMPORARY CULTURE* 61 (1997)). See also *Id.* at 972 (quoting MCKENZIE WARK, *CELEBRITIES, CULTURE AND CYBERSPACE: THE LIGHT ON THE HILL IN A POSTMODERN WORLD* 33 (1999)):

[Celebrities] embody not just the particular cultures from which they come, they also embody something beyond. We may not like the same celebrities . . . but it is the existence of a population of celebrities, about whom to disagree, that makes it possible to constitute a sense of belonging. Through celebrating (or deriding) celebrities, it is possible to belong to something beyond the particular culture with which each of us might identify.

¹⁷¹ *Id.* at 972.

¹⁷² *Id.* at 974.

Twitter, the URLs facebook.com/brucesteen and twitter.com/brucesteen will be unavailable for other uses.

Just as commentators opposed expansion of domain name protection to personal names because of its potentially chilling effect on free speech, these concerns are seemingly applicable in the username-squatting context as well.¹⁷³ In the context of publicity rights, “the First Amendment invariably triumphs when there is a conflict between the right of publicity and free speech values.”¹⁷⁴ Thus, opponents may argue that a celebrity or politician should not be able to recover her username if the squatter is using it for expressive purposes, in the interest of protecting free speech.

This raises an important question: should squatters have access to the celebrities’ actual names (i.e., twitter.com/brucesteen) when they are using the name for purely expressive purposes or should their expressive squatting be reserved to usernames that clearly indicate their purpose (i.e., twitter.com/brucesteensucks)? Simply put, is there something special about a celebrity’s name such that others should not be able to register it as a username, even if it is for purely expressive purposes?

There are several valid reasons that support granting celebrities and other public figures *exclusive* rights to their *actual* name over even an expressive squatter. Considering potential consumer confusion lends support to this view—consumer confusion would be easily avoided if only the celebrity or public figure had access to the twitter.com/name username corresponding to their actual name. Consumers are accustomed to the social networking world and expect a username to correspond to the actual person. Thus, potential confusion arises because the squatter is using a celebrity’s name, no matter how clearly the actual profile conveys that it is an expressive use. If the squatter has control of this username there is already potential for consumer confusion. Prohibiting such expressive use would eliminate any potential confusion.

A username is a cyber representation of one’s persona; even the most unsophisticated Internet users assume that a username is associated with that person, and by implication, that person’s views and beliefs. Internet users expect that when they visit twitter.com/brucesteen

¹⁷³ See WIPO Second Report, *supra* note 80, ¶ 196 (“[O]ther arguments advanced against including some form of personality right . . . are based on concerns that protecting personality rights under the UDRP would have a chilling effect on free speech.”).

¹⁷⁴ See Tan, *supra* note 170, at 924. For examples of courts erring on the side of First Amendment considerations in denying a right of publicity, see, e.g., *ETW Corp. v. Jireh Pub., Inc.*, 332 F.3d 915 (6th Cir. 2003); *Hoffman v. Capital Cities/ABC, Inc.*, 255 F.3d 1180 (9th Cir. 2001); *Montana v. San Jose Mercury News, Inc.*, 34 Cal. App. 4th 790 (Cal. Ct. App. 1995); *Dora v. Frontline Video, Inc.*, 18 Cal. Rptr. 2d 790 (Cal. Ct. App. 1993).

ter.com/brucespringsteen, they are seeing updates from Bruce Springsteen. Since usernames have become extensions of individuals' personas, any use of that username name by another, even if it is for allegedly expressive purposes, potentially invades and obscures the celebrity's persona. Thus, while free speech protection is rightfully granted in the context of the right of publicity in situations where a celebrity's persona is used for newsworthy or artistic purposes, free speech considerations are not similarly applicable in the context of username-squatting.

Considerations of how expressive use is dealt with under the ACPA and UDRP further supports granting celebrities exclusive rights in their usernames. Websites that use trademarks for parody, comment, and criticism are typically permissible when the domain name includes words like "sucks," that dispel any potential consumer confusion.¹⁷⁵ Similarly, username-squatters should be reserved to usernames that distinguish themselves from the person they are squatting (like twitter.com/brucespringsteensucks). This balance will provide celebrity's rights in their username, while also maintaining the interest of free speech.

Further, the cultural significance the celebrities have garnered¹⁷⁶ supports a finding that celebrities should have exclusive rights to their actual name. Free speech considerations tend to undervalue the cultural significance of celebrities as "[t]he current balancing approaches that present the right of publicity as a competing right to be weighed against the right to free speech do not sufficiently consider the inherent social and cultural significance of the celebrity personality in identity formation."¹⁷⁷ Since individuals identify with the ideals that certain celebrities set forth, celebrities should have the right to further connect with the public via their usernames.

Therefore, while right of publicity precedent would seemingly support injecting free speech considerations into these rights, thus permitting expressive use,¹⁷⁸ celebrities and public figures should have exclusive rights to their usernames, even against expressive users, so that they can communicate directly with the public through their usernames, preserving the cultural significance of their personas.

¹⁷⁵ See, e.g., *Taubman Co. v. Webfeats*, 319 F.3d 770 (6th Cir. 2003) (holding that the use of "sucks" in the domain name taubmansucks.com eliminates any confusion as to source).

¹⁷⁶ See *supra* Part IV.A.i. for a discussion of the cultural significance of celebrities and how it justifies granting rights in usernames.

¹⁷⁷ Tan, *supra* note 170, at 973.

¹⁷⁸ In the context of the right of publicity, for instance, "[t]he truth is, the First Amendment invariably triumphs when there is a conflict between the right of publicity and free speech values." *Id.* at 924-25.

Similarly, celebrities should have protection from “traditional” squatting. Based on the definition of cybersquatting,¹⁷⁹ “traditional” username-squatting constitutes the registering of another person’s name as a username in order to force that person to pay the squatter to recover the username. While the justifications for granting rights in usernames discussed above may not be specifically applicable to this form of username-squatting, the justifications that led to the passage of the ACPA apply here,¹⁸⁰ suggesting that protection against this form of username-squatting is similarly justified. Celebrities should not have to pay for the right to engage in social-networking websites under their own name.

For these reasons, celebrities should have rights to their usernames over all types of squatters, including those who impersonate the celebrity, those who make allegedly expressive use of the squatted name, and those who squat the name only to recover money from the celebrity.

2. Private Individuals

Notably, all of the justifications discussed tend to support protection specifically for public figures and do not have the same weight in the context of non-celebrities.¹⁸¹ In many situations, several private individuals may share the same name, and accordingly desire to possess the username that constitutes that name, even though another user may already possess it. However, as only one username will be available on each social-networking site, the “first come, first served” rule is likely the best solution in these situations. An argument can be made that broader protection should be available to non-celebrities: as the right of publicity has protected non-celebrities,¹⁸² and commentators contend that the right of publicity *should* protect non-celebrities,¹⁸³ non-celebrities should likewise have protection against username-squatting. Nevertheless, many of the username-squatting concerns that public figures face are inapplicable to non-celebrities¹⁸⁴ and broad protection for

¹⁷⁹ See S. REP. NO. 106-140, at 4 (1999).

¹⁸⁰ The ACPA was passed “to protect consumers and American businesses, to promote the growth of online commerce, and to provide clarity in the law for trademark owners by prohibiting bad-faith and abusive registration of distinctive marks as Internet domain names with the intent to profit from the goodwill associated with such marks.” S. REP. NO. 106-140, at 4 (1999).

¹⁸¹ For example, non-celebrities don’t need incentives for creativity, as they are presumably not conducting any socially useful activity that should be rewarded.

¹⁸² See, e.g., *Canessa v. J. I. Kislak, Inc.*, 235 A.2d 62, 75-76 (N.J. Super. Ct. Law Div. 1967).

¹⁸³ See Nimmer, *supra* note 115.

¹⁸⁴ See Lipton, *supra* note 17, at 1469. In her article, Lipton discussed how cybersquatting problems that arise in the context of non-celebrities are unlikely to raise many conflicts as “[t]here is much less profit to be made by cybersquatting on non-famous names, and little

private individuals is unnecessary.

However, private individuals, like celebrities, should have protection against “traditional” username-squatting. As discussed above, while protection to individual personal names was limited under the ACPA and UDRP in many contexts,¹⁸⁵ protection from “traditional” squatting was justified and included in a narrow provision of the ACPA.¹⁸⁶ Similarly, the justifications for passing protection against this narrow form of squatting under the ACPA apply in the context of username-squatting, indicating that protection against this form of username-squatting is similarly justified for private individuals.

B. *Establishing a Framework*

As has been established, celebrities should have exclusive rights in their usernames and private individuals should have narrow protection against “traditional” squatting. Accordingly, it is necessary to consider whether the current policies of social networking sites or available legal remedies provide sufficient protection for these username rights.

Lawsuits regarding username-squatting are sparse, perhaps in part because social networking sites like Twitter and Facebook are so quick to return a username to its apparently rightful owner.¹⁸⁷ Arguably, this evinces that the policies of Facebook and Twitter are sufficient to provide protection against username-squatting. Nevertheless, there are several reasons why the current policies of social-networking websites are not the optimal solution to the username-squatting problem.

First, Twitter and Facebook policies do not provide uniform protection. For instance, while Twitter specifically allows parody squatting, Facebook does not provide similar protection. Further, as social networking sites have a huge interest in avoiding lawsuits based on username-squatting, this driving concern may cloud their judgment when considering the rights of both parties in a username-squatting dispute: if their main concern is avoiding litigation, they may grant username rights to the party most likely to file a law suit. Lastly, both Twitter and Facebook fail to outline who will be successful in recovering a username, nor do they outline the elements a party must establish to recover a username,

reason to set up gripe sites or parody sites about private individuals.” This reasoning is similarly persuasive in the context of usernames.

¹⁸⁵ See *supra* Part I.B, - C..

¹⁸⁶ See 15 U.S.C. § 8131 (granting protection against only those squatters that registered the domain name with the “*specific* intent to profit from such name by selling the domain name for financial gain to that person or any third party. . . .”) (emphasis added).

¹⁸⁷ See *supra*, Part III for a discussion of Twitter and Facebook policies.

showing that their resolution mechanism is entirely subjective with no clear considerations as to who is the rightful owner of a username.

Arguably, state right of publicity laws can be used to resolve username-squatting disputes. However, as the right of publicity protects the *commercial* use of a person's name or likeness,¹⁸⁸ and usernames are not typically used for directly commercial purposes,¹⁸⁹ as they are used merely to share information about the users, the right of publicity would provide insufficient rights to usernames. Further, as the right of publicity is a creature of state law,¹⁹⁰ and thus varies greatly among the states, username-squatting decisions would be inconsistent among jurisdictions. For the same reasons, some squatters may avoid liability if a state does not recognize a right of publicity. While there may be good reason to establish a federal right of publicity,¹⁹¹ no such law exists, and thus, the right of publicity is not an ideal solution to username-squatting disputes.

As for the ACPA or the UDRP, both are inapplicable to username-squatting disputes and would therefore fail to serve as a direct method of protection against username-squatting. The ACPA defines a "domain name" as "any alphanumerical designation which is registered with or assigned by any domain name registrar . . . as part of an electronic address on the Internet."¹⁹² This defi-

¹⁸⁸ RIGHTS OF PUBLICITY AND PRIVACY, *supra* note 104, § 3:2 ("[d]efendant's use of plaintiff's persona is likely to cause damage to the commercial value of that persona.")

¹⁸⁹ In fact, Facebook Policy prohibits the commercial use of a username, showing that the usernames are not being used commercially. Facebook Statement of Rights and Responsibilities, <http://www.facebook.com/terms.php?ref=pf> (last visited Mar. 16, 2010). However, if the view is taken that all Internet conduct is commercial because of the nature of the Internet, this requirement would be satisfied under the right of publicity. See *Planned Parenthood Fed'n of Am., Inc. v. Bucci*, 42 U.S.P.Q.2d 1430, 1434 (S.D.N.Y. 1997) (citing *Intermatic v. Toeppen*, 947 F. Supp. 1227, 1239 (N.D. Ill. 1996)) ("The nature of the Internet indicates that establishing a typical home page on the Internet, for access to all users, would satisfy the Lanham Act's 'in commerce' requirement."). Alternatively, if a person links to commercial websites from their username, this may constitute commercial use, as linking has been sufficient to establish commercial use in the context of domain name disputes. See, e.g., *Taubman Co. v. Webfeats*, 319 F.3d 770, 775 (6th Cir. 2003) (holding that a website was commercial because it contained hyperlinks to two commercial websites).

¹⁹⁰ RIGHTS OF PUBLICITY AND PRIVACY, *supra* note 104, § 1:3.

¹⁹¹ See Sean D. Whaley, Note, "*I'm a Highway Star*": *An Outline For a Federal Right of Publicity*, 31 HASTINGS COMM. & ENT. L.J. 257, 282 (2009):

[A] federal standard will help the public by providing both a foundation of rights for states to emulate, while also specifically outlining the precedence of a right of publicity with other federal intellectual property rights and with other constitutional concepts, such as the freedom of speech. . . . Federal publicity rights can help explain the need for such a right and settle disputes about the scope and characteristics of the right.

¹⁹² 15 U.S.C. § 1127 (2006).

nition includes second-level domain names, the letter or number string to the left of the “.com” generic top-level domain,¹⁹³ but it is meant to exclude “screen names, file names, and other identifiers not assigned by a domain name registrar or registry.”¹⁹⁴ Hence, as a username is neither a second-level domain name nor assigned by a domain name registrar, username disputes do not fit directly under the ACPA.

Using the ACPA and the UDRP as a starting point, a solution to adequately resolve username-squatting disputes may be crafted. Commentators argue that the right of publicity should be injected into domain name disputes to resolve the personal name problems faced in the domain name context.¹⁹⁵ Likewise, injecting the right of publicity should be considered in the context of username-squatting disputes.

The ACPA and UDRP provide a good framework because both apply uniformly across state lines, they get rid of an “in commerce” requirement, and both contain a list of bad-faith factors that cover many situations in which the dispute in question may arise. In particular, the UDRP is a good model because of its quick resolutions and relative low cost.¹⁹⁶

This Note proposes that a uniform dispute resolution mechanism should be established to deal with username-squatting, using the UDRP as a model. Seemingly, social networking websites may be willing to implement this dispute resolution policy as it would potentially reduce lawsuits against the sites. Under this new dispute resolution policy, the complainant should be required to prove that: (1) the challenged name is identical to the complainant’s name, (2) the username was registered and used in bad faith, and (3) the complainant is “famous” within the meaning of this policy.

This policy differs notably from the UDRP by adding a requirement that the complainant be “famous.” As was shown in the previous section, the justifications for granting rights in a username are less applicable to non-celebrities¹⁹⁷ and therefore, broad protection against username-squatting for non-celebrities is unnecessary. Including a requirement that the complainant be “fa-

¹⁹³ GILSON LALONDE, *supra* note 37, § 7A.06[1][a].

¹⁹⁴ S. REP. NO. 106-140, at 17 (1999).

¹⁹⁵ Lipton, *supra* note 17, at 1511 (“Overall, a personality rights based framework for personal domain name disputes that allowed unauthorized expressive uses of <name.com> names, while prohibiting unauthorized commercial uses, might achieve a better theoretical focus than the current UDRP.”).

¹⁹⁶ See MCCARTHY, *supra* note 19, § 25:74.75.

¹⁹⁷ See *supra* note 184 for a discussion of how justifications for granting celebrities rights in usernames are less applicable to non-celebrities.

mous” takes this distinction into account, and makes protection available only to public figures.

The dispute resolution policy may provide “fame” factors to assist in determining whether a complainant is “famous,” and is thus subject to protection. The fame factors used for dilution disputes in trademark may serve as a guide,¹⁹⁸ replacing the emphasis on “marks” with an emphasis on personal names.

Thus, in determining whether a name is famous, the dispute resolution policy may ask that the following factors be considered: (1) the duration, extent, and geographic reach of advertising and publicity using the personal name or persona, whether advertised or publicized by the owner or third parties;¹⁹⁹ (2) the amount, volume, and geographic extent of sales of goods or services offered under the personal name or persona and;²⁰⁰ and (3) the extent of actual recognition of the personal name or persona.²⁰¹ Further, a factor that would consider the “cultural significance” of the name may also be included.

Additionally, the bad faith standard is vital to settling username-squatting disputes, and perhaps the most advantageous factor to take from the ACPA or UDRP when creating a framework. The bad-faith factors will define the scope of what constitutes illegitimate username-squatting. The bad faith standard would be superior to the ill-defined dispute resolution policies and of Twitter Facebook, as, unlike either of those sites, it would outline the elements that must be established to succeed in a username-squatting claim.

In considering username-squatting generally, several bad-faith factors may be borrowed from the ACPA: (1) the person's prior bona fide use, if any, of the username;²⁰² (2) the person's intent to divert users from the site or username of the person whose name they are allegedly squatting;²⁰³ and (3) the person's registration or acquisition of multiple usernames which the person knows are identical or confusingly similar to the personal name of another.²⁰⁴ These bad-faith factors cover several forms of username-

¹⁹⁸ 15 U.S.C. § 1125(c)(2)(a) (2006). “In determining whether a mark possesses the requisite degree of recognition, the court may consider all relevant factors,” including the three that the statute specifically sets out. These factors test the (i) “[D]uration, extent, and geographic reach of advertising and publicity of the mark. . . ,” (ii) “The amount, volume, and geographic extent of sales of goods or services offered under the mark,” and (iii) “The extent of actual recognition of the mark.”

¹⁹⁹ Similar to 15 U.S.C. § 1125(c)(2)(a)(i).

²⁰⁰ Similar to 15 U.S.C. § 1125(c)(2)(a)(ii).

²⁰¹ Similar to 15 U.S.C. § 1125(c)(2)(a)(iii).

²⁰² Similar to 15 U.S.C. § 1125(d)(1)(B)(i)(II) and (III).

²⁰³ Similar to 15 U.S.C. § 1125(d)(1)(B)(i)(V).

²⁰⁴ Similar to 15 U.S.C. § 1125(d)(1)(B)(i)(VIII).

squatting, including squatters who impersonate celebrities. As is true under the ACPA and UDRP, this list is neither exclusive nor dispositive; rather, the most important considerations for finding bad faith can be “the unique circumstances of [each] case, which [may] not fit neatly into the specific factors enumerated . . . but may nevertheless be considered. . . .”²⁰⁵

Bad-faith factors that consider whether the squatter has made an expressive fair use of the name,²⁰⁶ and should thus be protected by free speech considerations, are unnecessary, as the policy will provide celebrities and public figures exclusive rights to their usernames, even against expressive users.²⁰⁷

Further, bad-faith factors must be included to protect against “traditional” squatting. As discussed above, “traditional” username-squatting constitutes the registering of another person’s name as a username in order to force that person to pay for the right to engage in social networking under their own name. Protection against this form of username-squatting can be attained by including bad-faith factors that consider whether the person has offered to transfer, sell, or otherwise assign the username²⁰⁸ and the person’s registration or acquisition of multiple usernames which the person knows are identical or confusingly similar to the personal names of others. Alternatively, protection against this form of username-squatting can be easily obtained by a narrow provision similar to 15 U.S.C. § 8131,²⁰⁹ which would prohibit the bad-faith registration of usernames for the purpose of selling them back to people with those names.

This narrow provision prohibiting “traditional” username-squatting may make more sense in the context of non-celebrities. As discussed above, the justifications for broad protection are seemingly inapplicable to non-celebrities and thus, non-celebrities should not necessarily be protected from other forms of username-squatting. However, protection against “traditional” squatting should still be available to private individuals. After all, this kind of protection was granted in the cybersquatting context,²¹⁰ even though broader protection of personal names is not. Thus,

²⁰⁵ *Sporty’s Farm L.L.C. v. Sportsman’s Market Inc.*, 202 F.3d 489 (2d Cir. 2000).

²⁰⁶ Similar to 15 U.S.C. § 1125(d)(1)(B)(i)(IV), which considers “the person’s bona fide noncommercial or fair use of the mark in a site accessible under the domain name.”

²⁰⁷ See *supra* Part IV.A.i for a discussion of the justifications for granting public figures *exclusive* rights to their usernames.

²⁰⁸ Similar to 15 U.S.C. § 1125(d)(1)(B)(i)(VI).

²⁰⁹ 15 U.S.C. § 8131 grants protection against only those squatters that registered the domain name with the “*specific* intent to profit from such name by selling the domain name for financial gain to that person or any third party. . . .” (emphasis added).

²¹⁰ *Id.*

the policy may include a narrow provision that grants rights to a username, for celebrities and non-celebrities alike, when a squatter registers a username for the purpose of selling it back to a rightful owner.

CONCLUSION

This Note proposes a framework for establishing a solution to the username-squatting problem by using the ACPA and UDRP as models, while also taking into account the right of publicity, in the hopes that social networking websites will implement the resolution policy. More importantly, whatever the solution, this Note establishes that usernames deserve protection.

For instance, usernames are an extension of individual persona, used to inform the world about one's self, which have also become viable commercial and marketing tools. Thus, the policy rationales behind trademark law and, more appropriately, the right of publicity, suggest that the same justifications should protect usernames. For these reasons, the bad faith registration of a username should be prohibited, as social networking websites like Facebook and Twitter have already proclaimed in their policies. However, as these websites are more concerned with preventing their own liability than with a person's individual username rights, the policies of these social networking websites are ill-suited to protect against username-squatting.

Whatever the framework for protecting against username-squatting may be, in our Internet-centric society, a Facebook or Twitter username has become an exceedingly popular medium to identify one's self, to identify with others, and to convey commercial interests. These are the very factors protected by trademark law and the right of publicity. Further, the cultural significance of celebrities suggests that they should have exclusive rights to their usernames, as usernames have become a remarkably handy way for celebrities to convey their personas to the public. Usernames are more than just a factor of one's identity; usernames have become our Internet identities worldwide. This identity must be protected.

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