

No fan site for tribute band: use of mark in domain name created implied affiliation with complainant
International - Hogan Lovells

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Internet issues
Domain names

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- **Panel ordered transfer of 'beachboys.org' to Brother Records Inc**
- **Use of complainant's trademark in domain name created implied affiliation, which was not necessary**
- **Respondent intentionally sought to attract, for commercial gain, internet users to its website by creating likelihood of confusion**

In a [recent decision](#) under the Uniform Domain Name Dispute Resolution Policy (UDRP) before the World Intellectual Property Organisation (WIPO), a panel has ordered the transfer of a domain name that exactly matched the name of a famous pop group and belonged to a tribute band.

The complainant was Brother Records Inc, of Beverly Hills, California, a recording company that owned the IP rights relating to the pop group known as The Beach Boys. The Beach Boys were formed in 1961 and had sold an estimated 100 to 350 million records worldwide. The complainant owned a number of registered trademarks in THE BEACH BOYS, the earliest of which was registered in 1978.

The respondent was David J Roberts of Good Vibrations, a tribute band based in the United Kingdom.

The disputed domain name was 'beachboys.org', which was registered on May 14 2002. It was pointing to a website promoting the respondent's services.

To be successful in a complaint under the UDRP, a complainant must satisfy the following three requirements set out at Paragraph 4(a):

- The domain name registered by the respondent is identical, or confusingly similar, to a trademark or service mark in which the complainant has rights;
- The respondent has no rights or legitimate interests in respect of the domain name; and
- The domain name has been registered and is being used in bad faith.

As far as the first limb is concerned, the panel was satisfied that the complainant owned relevant trademark rights in the registered trademark THE BEACH BOYS and that this was confusingly similar to the disputed domain name, because the deletion of the word 'the' was not significant and the trademark was recognisable within the domain name.

In light of the above, the panel ruled that the complainant had satisfied the first element of the UDRP.

As to the second limb and a respondent's rights or legitimate interests (or lack of them), a complainant must prove that a respondent had no rights or legitimate interests in respect of the domain name in question. A complainant is normally required to make out a *prima facie* case and it is for the respondent to demonstrate otherwise. If the respondent fails to do so, then the complainant is deemed to satisfy Paragraph 4(a)(ii) of the UDRP.

In the present case, the panel found that the respondent had not used the domain name in connection with a good-faith offering of goods and services. Although the respondent was a legitimate tribute band, the panel was of the opinion that the respondent's use of the domain name was not legitimate. The complainant argued that the respondent's use of the complainant's trademark in the domain name was an attempt by the respondent to divert internet users looking for information about The Beach Boys to the respondent's website, and the panel agreed. In the panel's view, the fact that the respondent's use of the trademark in the domain name was unauthorised meant that its use could not be considered to be in good faith.

The panel also found that the respondent was not commonly known by the domain name, but by the name Good Vibrations.

Finally, the panel found that the respondent was not making a legitimate non-commercial or fair use of the domain name without intent for commercial gain. In the panel's opinion, the website at the domain name could not be likened to a genuine fan site, the operation of which could confer rights or legitimate interests under some circumstances. Instead, the panel found that the website at the domain name was being used

to promote a tribute band operating for commercial gain. In view of this, the panel decided that the use of the trademark in the domain name was not legitimate, and made reference to Section 2.7 of the [WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition](#) (the WIPO Overview 3.0).

Although it would be clear to some internet users upon accessing the website at the domain name that the respondent was a tribute band and thus not associated with The Beach Boys, the panel found that the use of the complainant's trademark in the domain name created an implied affiliation with the complainant and that this was not necessary. In the panel's opinion, the respondent could have selected another term that would not have carried the same implied affiliation, and that made the respondent's position as a tribute band clearer (as explained in Section 2.5 of the WIPO Overview 3.0).

Given the above *prima facie* case that the respondent did not attempt to rebut, the panel considered that the respondent had no rights or legitimate interests in the domain name and that the complainant had satisfied the second limb of the UDRP.

In relation to the third limb, the panel found that, as the respondent was a tribute band for The Beach Boys, it was clear that the respondent had registered the domain name with the complainant's trademark in mind, with the likely intention of attracting fans of The Beach Boys to the corresponding website.

The panel considered that, by registering and using the disputed domain name, the respondent was intentionally attempting to attract, for commercial gain, internet users to its website by creating a likelihood of confusion as to the source, sponsorship or affiliation of that website or its services, in accordance with Paragraph 4(b)(iv) of the UDRP. The panel underlined that the respondent had been given the opportunity to establish its good-faith use of the domain name, but had chosen not to do so.

In light of the above, the panel found that the complainant had satisfied the third element of the UDRP and therefore ordered the domain name to be transferred.

The decision highlights the fact that genuine fan sites conferring a legitimate interest on the holder of a domain name that is identical, or confusingly similar, to a complainant's trademark are quite rare, especially when the domain name at issue is identical or very similar to the trademark, thus creating an implied sense of affiliation. Whilst previous panels have found that a limited degree of incidental commercial activity may be permissible for a fan site in certain circumstances (eg, to offset registration or hosting costs), where such commercial activity is more than incidental (eg, use to promote a tribute band, as in this case) then respondents are generally unable to rely on the 'fan site' defence.

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