

World Trademark Review Daily

Lady Gaga fails to obtain transfer of 'fan site' domain name International - Hogan Lovells

Cybersquatting

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In *Germanotta v oranges arecool XD* (Claim No FA1108001403808), singer Stefani Germanotta, known as Lady Gaga, has lost her bid to gain control of the domain name 'ladygaga.org' on the basis that it was pointing towards a non-commercial fan website.

The case was brought under the [Uniform Domain Name Dispute Resolution Policy](#) (UDRP) and filed with the [National Arbitration Forum](#) (NAF), based in Minneapolis, United States. The respondent was listed as oranges arecool XD.

To be successful in a UDRP procedure, a complainant must evidence that:

- the domain name is identical, or confusingly similar, to a trademark or service mark in which it 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.

Gaga had no problem in proving the first requirement, as she had registered three federal LADY GAGA trademarks with the [US Patent and Trademark Office](#) in various classes.

However, the three-member panel found that Gaga had not established that the respondent had no rights or legitimate interests under the second requirement. Given that the three requirements are cumulative, the complaint failed, and it was not necessary for the panel to consider the last requirement in relation to bad faith.

The respondent asserted that she was operating a genuine non-commercial fan website at the domain name 'ladygaga.org', which contained no commercial links and included a prominent disclaimer, as follows:

"Ladygaga.Org is just a unprofitable unofficial fansite, we do not get money from it. We are not affiliated in any way with Lady Gaga herself, her record label, or her management. I am not Lady gaga and I don not know her unfortunately. This is a fansite only, created by and for fans of lady gaga. All the material posted here is owned by the respective owners. We do not claim any kind of copyright on them, Thanks" [sic]

The panel found that the respondent was using the domain name for a good-faith offering of goods or services (in accordance with Paragraph 4(c)(i) of the UDRP) and was making a legitimate non-commercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark at issue (Paragraph 4(c)(iii)).

In view of the website content, the outcome of the case was unsurprising, as previous UDRP panels have also denied cases when faced with genuine fan sites where there is no commercial activity.

However, it is interesting to note that the respondent also owns around 700 other 'celebrity' domain names, such as 'amywinehouse.org', 'benstillier.org' and 'zac-efron.net'. The respondent's business model can be seen at [fanfusion.org](#), where internet users are able to 'adopt' (in other words, licence) domain names for use for their fan sites. This explains why certain domain names owned by the respondent are not pointing anywhere, others are pointing towards genuine fan sites and others appear to be pointing to fan sites which are much less developed. This raises an interesting question in that, although the licensee of the domain name in question may technically not be falling foul of the UDRP by using the domain name to point towards genuine non-commercial content, the actual owner of the domain name is quite likely to be making a commercial gain by renting the domain name out to a third party.

It is difficult to see why Gaga only chose to list 'ladygaga.org' in the complaint when the respondent also owns (or has previously owned) around 20 other 'gaga'-based domain names. Any domain names still in the ownership of the respondent at the time of filing could have been included in the complaint, and this would undoubtedly have made the respondent's defence more difficult. Given the respondent's business model, it is likely that certain of these domain names are being licensed to third parties, but it would not have been possible for the respondent to deny responsibility for the content of any corresponding websites on this basis, as the UDRP applies to the registrant who is publically listed on the WHOIS, regardless of any behind-the-scenes arrangements.

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This illustrates how important it is to carefully research all aspects of a case before filing a UDRP complaint. When it comes to domain names supposedly pointing to non-commercial fan websites, it is advisable to carefully examine the content of such websites. In this regard, there has been a recent increase in 'celebrity' domain names which appear to be pointing towards genuine fan sites; however, upon closer examination, these websites have been merely assembled to look like they might be genuine to the casual observer. For example, content may be taken from automatic feeds from other websites, standard website design templates may be used, and there could be broken links and no comments left in relation to any posts.

It is understandable that a die hard fan may spend hours creating a fan site, and it would, in some circumstances, be manifestly unfair to order transfer of the corresponding domain name. However, it is less apparent that a registrant holding perhaps hundreds of celebrity domain names would cultivate hundreds of corresponding fan sites in the absence of any commercial gain. It is thus very likely that a registrant who registers hundreds of celebrity domain names and points certain of them towards 'sham' fan sites is entirely familiar with the terms of the UDRP and knows that such measures will go a long way towards preventing successful claims. The end result of such conduct is that many celebrities may quietly settle instead.

It is difficult for panels to decide just how genuine a particular fan site is, but the absence of commercial links is only one aspect - the registrant's overall conduct should also be borne in mind, including how many celebrities they purport to be a fan of, and how and when the website in question is updated.

This case also highlights an important procedural difference between the UDRP Supplemental Rules of NAF and those of the [World Intellectual Property Organisation \(WIPO\)](#). Under the WIPO Rules, there is no official procedure for a complainant to file a reply upon receipt of the response, and any submission will be a supplemental filing that a panel may or may not choose to look at. However, the NAF Rules provide that a reply may be filed within five days of any response upon submission of a fee of \$400. Gaga's reply was filed out of time due to "an unintended intervening circumstance over which [she] had no control", but the panel chose to consider it anyway. Many commentators would argue that such procedural differences are not really within the spirit of the UDRP.

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