



**NATIONAL
ARBITRATION
FORUM**

DECISION

Dustin N. Diamond v. Max Goldberg
Claim Number: FA0402000237446

PARTIES

Complainant is **Dustin N. Diamond** (“Complainant”), represented by **Brian A. Herro of Herro & Lamont LLC**, 2070 Wisconsin Ave., Grafton, WI 53024. Respondent is **Max Goldberg** (“Respondent”), 847A Second Avenue, #302, New York, NY 10017.

REGISTRAR AND DISPUTED DOMAIN NAME

The domain name at issue is <**dustindiamond.com**> (the “Domain Name”), registered with **Computer Services Langenbach GmbH d/b/a Joker.com** (hereinafter “Joker.com”).

PANEL

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

Michael Albert as Panelist.

PROCEDURAL HISTORY

Complainant submitted a Complaint to the National Arbitration Forum (the “Forum”) electronically on February 13, 2004; the Forum received a hard copy of the Complaint on February 17, 2004.

On February 17, 2004, Joker.com confirmed by email to the Forum that the Domain Name <**dustindiamond.com**> is registered with Joker.com and that the Respondent is the current registrant of the name. Joker.com has verified that Respondent is bound by the Joker.com registration agreement and has thereby agreed to resolve domain-name disputes brought by third parties in accordance with ICANN’s Uniform Domain Name Dispute Resolution Policy (the “Policy”).

On February 20, 2004, a Notification of Complaint and Commencement of Administrative Proceeding (the “Commencement Notification”), setting a deadline of March 11, 2004 by which Respondent could file a Response to the Complaint, was

transmitted to Respondent via e-mail, post and fax, to all entities and persons listed on Respondent's registration as technical, administrative and billing contacts, and to postmaster@dustindiamond.com by e-mail.

A timely Response was received and determined to be complete on March 11, 2004.

On March 22, 2004, pursuant to Complainant's request to have the dispute decided by a single-member Panel, the Forum appointed Michael Albert as Panelist.

RELIEF SOUGHT

Complainant requests that the Domain Name be transferred from Respondent to Complainant.

PARTIES' CONTENTIONS

A. Complainant asserts as follows:

- Complainant claims common law trademark rights with respect to his personal name for performing, acting and other entertainment/media products and services, based on his leading role in the television show *Saved by the Bell* and related television movies and sequels, as well as his appearance in other movies, magazines, and newspapers and his videotape/DVD entitled *Dustin Diamond Teaches Chess*.
- Respondent operates the website <dustindiamond.com>, and has continually used the website <dustindiamond.com> to portray himself as Complainant.
- Respondent offered, over email, to sell the Domain Name to Complainant for \$1,800. Complainant refused this offer.
- Complainant sent a certified cease and desist letter to Respondent at a California address from the WHOIS database. The letter was returned as undeliverable. Complainant sent another certified cease and desist letter to Respondent at a New York address, which was also returned as undeliverable. Finally, Complainant sent a cease and desist letter to Respondent over email. Respondent refused to comply with the request until he received the letter by certified mail. Complainant mailed certified letters on two separate occasions. Respondent has refused to contact Complainant via phone or U.S. Mail despite several requests.
- Complainant's common law trademark rights in his name have acquired secondary meaning, as evidenced by nationwide sale of his instructional video.
- Complainant's widespread usage of his trademark dates back to 1987, well before the registration of <dustindiamond.com>.
- The Domain Name <dustindiamond.com> is identical to Complainant's trademark.
- Respondent has no rights or legitimate interests in the Domain Name, and has not made any legitimate use of the Domain Name.

- Respondent is not using the Domain Name as a parody or other legitimate noncommercial fair use.
- Respondent's sole use of the Domain Name is to misinform Internet users, tarnish Complainant's name and mark, and divert visitors to the website to a guestbook which includes racist comments, vulgar messages, and links to pornographic websites.
- Respondent has not used and has not made demonstrable preparations to use the Domain Name in connection with a bona fide offering of goods or services.
- Respondent routinely portrays himself as Complainant on the website.
- Respondent uses the email address screech@dustindiamond.com to give the impression that he is Complainant.
- Respondent modified the website to disclaim affiliation with Complainant and suggest that the site is a "fan club," but has on occasion reverted back to the prior text where Respondent portrays himself as Complainant.
- Complainant has never given Respondent permission to use his trademark, and has no affiliation or association with Respondent.
- Respondent has no legitimate, good faith explanation of his use of the Domain Name.
- Respondent has no trademark rights in Complainant's name.
- The following acts on the part of Respondent constitute bad faith:
 - Respondent's registration and use of a Domain Name identical to Complainant's name and mark.
 - Respondent's offer to sell the Domain Name to Complainant for \$1,800.
 - Respondent's providing false contact information in the form of the email address screech@dustindiamond.com and responding to message board postings using Complainant's name.
 - Respondent's dilution by tarnishment of Complainant's mark.
- Respondent's disclaimer of association is insufficient to dispel bad faith.

B. Respondent asserts as follows:

- Respondent is a well known creator of parody websites, including <yourethemannowdog.com>, <getyourasstomars.com>, and the site at issue in this case, <**dustindiamond.com**>. One of Respondent's websites achieved the distinction of the "Worst Web Site" award by <worstwebsites.com>. Respondent's websites have spawned numerous imitations and parodies by other creators.
- Respondent admits that he has never been known by Complainant's trademark.

- Respondent's website is a parody.
- The guestbook on Respondent's website is a "free speech forum," which is an integral part of the parody.
- Respondent operates the website with no intent of commercial gain. The website has no commercial aspect, sells no products, carries no advertising, and yields no income to Respondent.
- Respondent did not register the Domain Name for the purpose of selling, renting, or otherwise transferring the Domain Name to Complainant or to a competitor of Complainant.
- Respondent did not register the Domain Name to prevent Complainant from reflecting his trademark in a corresponding domain name.
- Respondent did not register the Domain Name to disrupt the business of a competitor. Further, Respondent is not a competitor of Complainant.
- Respondent denies ever having offered to sell the Domain Name to Complainant for \$1,800. Respondent further denies that the email exchange concerning this transaction ever took place. Respondent notes that Complainant produced no evidence of such an email exchange.
- Respondent denies that he ever wrote or posted emails posing as Dustin Diamond.
- Respondent denies that he ever portrayed himself as Dustin Diamond. Respondent points to numerous misspellings on the website, specifically of Complainant's name, as evidence that a visitor to the site would be unlikely to think the site was run by Complainant. Respondent further argues that Complainant would never refer to himself as a "FAMOUS SUPERSTAR AND SEX SYMBOL" based on his public persona and thus that a visitor to the site would not come to believe that the site was operated or sponsored by Complainant.
- Respondent's disclaimer of affiliation with Complainant is further evidence that a visitor to the site is unlikely to be confused about the sponsorship or origin of the site. Respondent's prompt addition of the disclaimer after being contacted by Complainant's representative is also evidence of Respondent's good faith.
- Respondent challenges the reliability of evidence offered by Complainant suggesting that the disclaimer has appeared and disappeared periodically from his site. Respondent explains that the Internet Archive is an automated system with no human oversight and is prone to error. Respondent contends that the disclaimer has appeared continuously on the site since it was first added.
- Respondent never posted in the site's guestbook under Complainant's name or any other name. Respondent has never posted any content at all to the guestbook.
- Respondent has never sent any emails from the contact address on his website, screech@dustindiamond.com.

- In February 2003, Respondent attempted to forward to Complainant email he had received that was apparently intended for Complainant. Complainant's representatives expressed no interest in receiving the email, but instead attempted to threaten and harass Respondent into relinquishing the Domain Name. Respondent offers several email messages received from Complainant's representatives. These communications from Complainant alleged, *inter alia*: that Respondent was "defaming" Complainant; that impersonating an actor was illegal; that Respondent had committed a felony; that Complainant's representative was contacting the police and "would like to press charges"; that Complainant's representative had instructed his attorney to file criminal charges against Respondent; that "THIS IS JUST THE BEGINNING"; that "charges will be files [sic] today."
- Respondent denies any bad faith relating to Complainant's difficulty in sending mail to Respondent. Respondent's original California address was correct at the time the Domain Name was registered, and when Respondent moved to New York he updated the Domain Name record to reflect his new address. Respondent maintains a mailbox at a Mailboxes Etc., and is not at fault for Mailboxes Etc.'s refusal to accept delivery of a certified letter.
- Respondent has never attempted to create consumer confusion by misportraying Complainant or dilution by tarnishment. Respondent offers numerous emails and letters of support as evidence that the public understands the site as a parody. These letters of support and explanation include a letter from a Professor of Cinema Studies who coauthored two well-known books of religious parody among other publications, and a letter from an art correspondent for the Wall Street Journal, New York Times, and the Oxford American. These writers called the website "an electronic art installation of great wit and outstanding merit," a "parody," and an "obvious and clearly affectionate joke."

DISCUSSION AND FINDINGS

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

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

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

Paragraph 4(a)(i) imposes two requirements: (1) that Complainant have rights in a trademark or service mark and (2) that the Domain Name in question be identical or confusingly similar to Complainant's mark. The Panel addresses these two requirements in order.

Common Law Trademark Rights

Panels interpreting the UDRP have consistently held that the Policy affords protection to those having common law trademark rights as well as to those having rights in registered trademarks. *See, Cedar Trade Assocs., Inc., v. Ricks*, FA 93633 (Nat. Arb. Forum Feb. 25, 2000); *see also Bennett Coleman & Co. Ltd. v. Lafwani*, D2000-0014 (WIPO Mar. 11, 2000) ("it is this reputation from actual use which is the nub of the complaint, not the fact of registration as trade marks."). Many of the cases in which common law trademark rights are asserted have involved personal names that have, through use and publicity, acquired the distinctiveness necessary to become trademarks or service marks: *van Hooijdonk v. Tait*, D2000-1068 (WIPO Nov. 4, 2000); *Stam v. Cohen*, D2000-1061 (WIPO Nov. 4, 2000); *MPL Communications Ltd. v. Hammerton*, FA 95633 (Nat. Arb. Forum Oct. 25, 2000); *Feinstein v. PAWS Video Prods.*, D2000-0880 (WIPO Oct. 21, 2000); *Carter v. Afternoon Fiasco*, D2000-0658 (WIPO Oct. 17, 2000); *Ciccone v. Parisi*, D2000-0847 (WIPO Oct. 12, 2000); *Estate of Getz v. Vogel*, D2000-0773 (WIPO Oct. 10, 2000); *Adjani v. Second Orbit Communications, Inc.*, D2000-0867 (WIPO Oct. 4, 2000); *Estate of Shakur v. Shakur Info Page*, AF 0346 (eResolution Sep. 28, 2000), *Estate of Francis v. Magidson Fine Art, Inc.*, D2000-0673 (WIPO Sep. 27, 2000); *Adu v. Quantum Computer Servs. Inc.*, D2000-0794 (WIPO Sep. 26, 2000); *Marino, Jr. v. Video Images Prods.*, D2000-0598 (WIPO Aug. 2, 2000); *Rattner v. BuyThisDomainName*, D2000-0402 (WIPO July 3, 2000); *Monty and Pat Roberts, Inc. v. Keith*, D2000-0299 (WIPO June 9, 2000); *Roberts v. Boyd*, D2000-0210 (WIPO May 29, 2000); *Winterson v. Hogarth*, D2000-0235 (WIPO May 22, 2000); *see also Sean Michaels Inc. v. Mark Allan Online Enm't*, AF 0214 (eResolution July 2, 2000).

Respondent admits that Complainant may have valid trademark rights, but contends that these rights are limited by his own First Amendment rights. In light of the Panel's ultimate finding that Respondent has legitimate noncommercial or fair use rights under Paragraph 4(c)(iii) and has not registered or used the Domain Name in bad faith, the Panel finds it unnecessary to address any potential First Amendment limitations on trademark rights.

Complainant in the instant case has established common law trademark rights in his name, DUSTIN DIAMOND, arising from his roles in numerous television shows and motion pictures, most notably the television show *Saved by the Bell*. Complainant's common law trademark rights are further strengthened by the use of his name as an indicator of source in his instructional video entitled *Dustin Diamond Teaches Chess*. There can be no dispute that Complainant's use of DUSTIN DIAMOND as a trademark predates Respondent's registration of <dustindiamond.com>.

Identical and/or Confusingly Similar

The Domain Name in question, <**dustindiamond.com**>, is not only confusingly similar to the common law trademark DUSTIN DIAMOND, but in fact nearly identical. It is well established that “[t]he omission of spaces between the words of the trademark and the addition of the gTLD ‘.com’ is not significant in determining whether the domain name is identical or confusingly similar to Complainant’s mark.” *Larson v. Judy Larson Club*, FA 96488 (Nat. Arb. Forum Mar. 13, 2001); *accord Garnett v. Trap Block Techs.*, FA 128073 (Nat. Arb. Forum Nov. 21, 2002); *see also Gilmour v. Cenicolla*, D2000-1459 (WIPO Dec. 15, 2000) (“[t]he suffix ‘.com’ and the absence of spacing between the words are inconsequential”).

Respondent argues that a visitor to the website is unlikely to be confused as to the nature or origin of the site based on its content, which includes “outrageous ugly and low-tech graphics and numerous obvious errors and misspellings,” including a misspelling of Complainant’s name. Respondent does not argue, however, that the Domain Name itself is not identical or confusingly similar to Complainant’s mark, setting aside the content of the site.

The Panel finds the Domain Name <**dustindiamond.com**> is identical or confusingly similar to Complainant’s common law trademark DUSTIN DIAMOND.

Rights or Legitimate Interests

Paragraph 4(a)(ii) requires Complainant to establish that Respondent has no rights or legitimate interests in the domain name, while Paragraph 4(c) provides three alternative means for Respondent to demonstrate rights or legitimate interests in a domain name:

- (1) before any notice to you of the dispute, your use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services; or
- (2) 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; or
- (3) you are making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

Complainant cites *Garnett v. Trap Block Techs.*, FA 128073 (Nat. Arb. Forum Nov. 21, 2002) for the proposition that a mere allegation that Respondent has no rights or legitimate interests under Paragraph 4(a)(ii) shifts the burden to Respondent to show by concrete evidence that respondent has rights or legitimate interests in the Domain Name under Paragraph 4(c). Some panels have held otherwise; *see, e.g., Arcturus Eng’g Inc. v. Arcturus*, AF 0156 (eResolution May 19, 2000) (“The complainant’s contention that the

respondent has not proven it has any legitimate interest is not to the point, since it is the complainant who bears the onus of proof on this issue.”) Because Respondent has met his burden of proof under 4(c)(iii), it is unnecessary for this Panel to decide exactly where the burden under 4(a)(ii) lies.

Respondent is not using the website in connection with a bona fide offering of goods or services, nor has he presented evidence that he intends to do so. Respondent argues that the “service” he offers is a “parody or art installation,” however, this argument is more properly directed to rights or interests under Paragraph 4(c)(iii) (legitimate noncommercial or fair use). The Panel is not aware of any cases in which a parody has been considered a “bona fide offering of goods or services” within the meaning of the UDRP, nor has either party to this arbitration brought any such case to the Panel’s attention. *See, e.g., Oki Data Am., Inc. v. ASD, Inc.*, D2001-0903 (Nat. Arb. Forum Nov. 6, 2001) (to meet bona fide requirement, domain name holder must offer the trademarked goods and use the site only for the sale of the trademarked goods). Thus, Respondent has not demonstrated rights or legitimate interests under Paragraph 4(c)(i).

Respondent admits that he has never been commonly known by the Domain Name. Respondent does not have rights or legitimate interests under Paragraph 4(c)(ii).

Respondent argues that his website constitutes legitimate noncommercial or fair use of the Domain Name, and thus has demonstrated legitimate interests under Paragraph 4(c)(iii). Complainant asserts, with little or no evidentiary support, that the site in question is not fair use or a parody. “Whether the commentary is in good taste, whether it is funny, whether it is effective, all is beside the point.” *Falwell v. Cohn*, D2002-0184 (WIPO June 3, 2002). *See also Springsteen v. Burgur*, D2000-1532 (WIPO Jan. 25, 2001) (no likelihood of confusion between common law mark Bruce Springsteen and domain name <brucepringsteen.com> because even the relatively unsophisticated Internet user would realize that not every domain bearing the name Bruce Springsteen is an official site).

The Panel accepts Respondent’s argument that the “outrageous ugly and low-tech graphics and numerous errors and misspellings” as well as the sheer absurdity of the site’s claim that Dustin Diamond is a “FAMOUS SUPERSTAR AND SEX SYMBOL” clearly signal that the site is not meant to be taken seriously. Whether the site is regarded as parody, satire, or critical commentary, and notwithstanding Respondent’s assertion that “[l]awyers are notoriously bad at understanding how humor works,” this Panel finds that legitimate noncommercial fair use commentary is involved.

Complainant contends that the site’s guestbook shows that Respondent has no rights or legitimate interest in the Domain Name. Complainant also offers the guestbook as evidence of Respondent’s bad faith in registering the Domain Name. The guestbook contains nearly 7,000 entries, some of which include vulgar messages or links to pornographic content. Respondent characterizes the guestbook as an unmoderated “free speech forum,” where visitors to the site can post any content under any name that they

choose. While Complainant alleges that Respondent is responsible for some of the postings to the guestbook, Complainant offers no evidence that Respondent himself has ever posted to the forum. Respondent denies ever having posted to the forum, and offers a list of IP addresses from the site's access log to show that none of the postings came from his system.

While Complainant is correct that some of the statements made by users of the forum are offensive or inappropriate to certain audiences, Complainant has not established that any of these statements were made by, or are otherwise attributable to, the Respondent, or that Respondent edits, moderates, or otherwise takes responsibility for the content of materials posted in the guestbook. It would therefore be inappropriate to hold Respondent responsible for the content of the guestbook. *See, e.g.*, 47 U.S.C. § 230(c)(1) ("No provider or user of an interactive computer service shall be treated as the publisher or speaker of any information provided by another information content provider"); *Zeran v. America Online, Inc.*, 129 F.3d 327 (4th Cir. 1997) (AOL not liable for defamatory statement posted to various AOL bulletin boards by an AOL subscriber), *cert. denied*, 524 U.S. 937 (1998). The Panel finds that the guestbook is not relevant to Respondent's rights or legitimate interests in the Domain Name or to Respondent's bad faith.

Finally, in order to demonstrate rights or legitimate interests under Paragraph 4(c)(iii), Respondent must show he had no intent of commercial gain. Respondent states that the site sells no products, carries no advertising, and generates no revenue. Complainant has made no effort to rebut this claim, but alleges that Respondent offered to sell the Domain Name for \$1,800. Respondent flatly denies ever having made such offer. Complainant has the burden of proof in this case and has offered no evidence that this offer ever occurred. Furthermore, Respondent properly points out that had such an offer been made by email (as alleged by Complainant) there should be some record of the offer. The Panel, agreeing that evidence of any offer for sale is conspicuously absent from Complainant's lengthy submission, finds that Respondent has no intent of commercial gain and thus has demonstrated rights or legitimate interests under Paragraph 4(c)(iii). *See Legal & Gen. Group Plc v. Image Plus*, D2002-1019 (WIPO Dec. 30, 2002) ("the goals of the Policy are limited and do not extend to insulating trademark holders from contrary and critical views when such views are legitimately expressed without an intention for commercial gain.").

Registration and Use in Bad Faith

Complainant must satisfy each and every element of Paragraph 4(a) to prevail. Because Respondent has demonstrated rights under Paragraph 4(c)(iii), this Panel need go no further. The Panel will, however, briefly address Complainant's argument that Respondent acted in bad faith under Paragraph 4(a)(iii).

Respondent cites a great number of cases in which the registration of a domain name identical to a celebrity's trademark was found to be in bad faith. In all of these cases, however, the respondent had some commercial interest in the domain name, whether it

was using the domain name to sell products, display advertisements, or sell the domain name itself for valuable consideration in excess of documented out-of-pocket costs. *See, e.g., Weil v. Domain Adm'r*, FA 206341 (Nat. Arb. Forum Dec. 8, 2003) (respondent used website to sell complainant's books for personal profit without permission of the trademark holder); *Spacey v. Alberta Hot Rods*, FA 114437 (Nat. Arb. Forum Aug. 1, 2002) (domain name redirected to commercial "Celebrity 1000 site"); *Booz-Allen & Hamilton Inc. v. Servability Ltd*, D2001-0243 (WIPO Apr. 5, 2001) (respondent, domain name dealer, tried to sell domain at higher cost); *Lee v. Domain Research and Sales*, FA 105214 (Nat. Arb. Forum Apr. 1, 2002) (domain name redirected to gambling and pornography site; respondent requested \$2,250 for domain name; respondent engaged in pattern of registering famous marks); *Larson v. Judy Larson Club*, FA 96488 (Nat. Arb. Forum Mar. 13, 2001) (domain name redirected to commercial "Celebrity 1000 site"); *Brown v. Julie Brown Club*, D2000-1628 (WIPO Feb. 13, 2001) (domain name redirected to commercial "Celebrity 1000 site"); *Kidman v. Zuccarini*, D2000-1415 (WIPO Jan. 23, 2001) (website advertised pornographic sites; user was "mousetrapped" upon visiting site; respondent engaged in a pattern of illegitimate registration and use); *Gilmour v. Cenicollo*, D2000-1459 (WIPO Dec. 15, 2000) (respondent intended to use domain name to sell exclusive merchandise or sell domain name itself); *Adu v. Quantum Computer Servs., Inc.*, D2000-0794 (WIPO Sep. 26, 2000) (respondent offered commercial email service at domain name); *Technology Prop., Inc. v. Hussain*, FA 95411 (Nat. Arb. Forum Sep. 14, 2000) (respondent offered domain name for \$2,000); *Jagger v. Hammerton*, FA 95261 (Nat. Arb. Forum Sep. 11, 2000) (pornographic content for commercial gain); *Rudner v. Internetco Corp.*, D2000-0581 (WIPO Aug. 3, 2000) (no content on site, but other sites registered by Respondent linked to pornographic sites); *Charles Jourdan Holding AG v. AAIM*, D2000-0403 (WIPO June 27, 2000) (respondent offered domain name for sale); *Roberts v. Boyd*, D2000-0210 (WIPO May 29, 2000) (respondent registered many domain names of well-known celebrities; tried to sell domain name on eBay for \$2,550); *DaimlerChrysler Corp. v. Bargman*, D2000-0222 (WIPO May 29, 2000) (website contained advertisements; respondent tried to sell domain name on eBay; advertisements constituted "commercial use" regardless of lack of net profit by respondent).

There are also some cases in which Panels have held that "passive" holding of a domain name – no use at all – amounts to bad faith use. *See, e.g., Stam v. Cohen*, D2000-1061 (WIPO Nov. 4, 2000); *Garnett v. Trap Block Techs.*, FA 128073 (Nat. Arb. Forum Nov. 21, 2002); *Albrecht v. Natale*, FA 95465 (Nat. Arb. Forum Sept. 16, 2000). This case, however, does not involve "passive holding."

In sum, Respondent has not cited – and this Panel has not found – a single case in which bad faith was found where the respondent engaged in active use that consisted of pure, noncommercial speech in the nature of parody or critical commentary.

As discussed above, this Panel does not find credible Complainant's assertion that Respondent offered to sell the Domain Name for \$1,800, and there is no other evidence

that Respondent had any commercial intent in registering or using the Domain Name. Thus, the Panel concludes that Respondent did not act in bad faith.

DECISION

The Complainant has failed to establish two of the three elements required under the ICANN Policy. The Panel thus concludes that relief shall be **DENIED**.

A handwritten signature in black ink, appearing to read "Michael A. Albert", written over a horizontal line.

Michael A. Albert, Esq.
Arbitrator

Michael Albert, Panelist
Dated: Monday, April 5, 2004