



NATIONAL
ARBITRATION
FORUM

Dustin N. Diamond)
c/o Herro & Lamont, LLC)
2070 Wisconsin Avenue)
Grafton, WI 53024)

(Complainant))

v.)

Domain Name In Dispute:
dustindiamond.com

Max Goldberg)
847A Second Avenue 302)
New York, New York 10017)

(Respondent))

**COMPLAINT IN ACCORDANCE WITH
THE UNIFORM DOMAIN NAME DISPUTE RESOLUTION POLICY**

[1.] This Complaint is hereby submitted for decision in accordance with the Uniform Domain Name Dispute Resolution Policy, adopted by the Internet Corporation for Assigned Names and Numbers (ICANN) on August 26, 1999 and approved by ICANN on October 24, 1999 (ICANN Policy), and the Rules for Uniform Domain Name Dispute Resolution Policy (ICANN Rules), adopted by ICANN on August 26, 1999 and approved by ICANN on October 24, 1999, and the National Arbitration Forum (NAF) Supplemental Rules (Supp. Rules). ICANN Rule 3(b)(i).

[2.] COMPLAINANT INFORMATION

- [a.] Name: Dustin N. Diamond
c/o Herro & Lamont, LLC
- [b.] Address: 2070 Wisconsin Avenue
Grafton, WI 53024
- [c.] Telephone: 262-377-9500
- [d.] Fax: 262-377-9700
- [e.] E-Mail: BHerro@herroandlamont.com

Authorized Representative

- [a.] Name: Herro & Lamont, LLC c/o Brian A. Herro, Esq.
- [b.] Address: 2070 Wisconsin Ave, Grafton, WI 53024
- [c.] Telephone: 262-377-9500
- [d.] Fax: 262-377-9700
- [e.] E-Mail: BHerro@herroandlamont.com

Electronic-Only Material

- [a.] Method: Email
- [b.] Address: BHerro@herroandlamont.com
- [c.] Contact: Brian A. Herro, Esq.

Material Including Hard Copy

- [a.] Method: US Mail
- [b.] Address: 2070 Wisconsin Ave, Grafton, WI 53024
- [c.] Contact: Brian A. Herro, Esq.

PANEL

- [a.] The Complainant chooses to have this dispute heard before a single-member administrative panel pursuant to ICANN Rule 3(b)(iv).

[3.] **RESPONDENT INFORMATION**

- [a.] Name: Max Goldberg
- [b.] Address: 847A Second Avenue 302, New York, NY 10017
- [c.] Telephone: Unknown
- [d.] Fax: Unknown
- [e.] E-Mail: max@tnug.com

[4.] **DISPUTED DOMAIN NAME**

- [a.] dustindiamond.com is the domain name that is the subject of this Complaint pursuant to ICANN Rule 3(b)(vi).

- [b.] Registrar Information: ICANN Rule 3(b)(vii).

- [i.] Registrar's Name: CSL Computer Service Langenbach GmbH
joker.com
- [ii.] Registrar Address: Rathausufer 16; 40213 Duesseldorf; Germany
- [iii.] Telephone Number: +49 211 867670
- [iv.] E-Mail Address: info@joker.com

- [c.] Trademark/Service Mark Information: ICANN Rule 3(b)(viii).

The complaint is based upon on Complainant's common law trademark rights with respect to his personal name for performing, acting and other entertainment/media products and services.

[5.] **FACTUAL AND LEGAL GROUNDS**

This Complaint is based on the following factual and legal grounds pursuant to ICANN Rule 3(b)(ix):

Complainant has received notoriety and fame as an actor, in the United States and internationally, for his performances in numerous televisions shows and motion pictures. Complainant is internationally known for playing Samuel "Screech" Powers in the very popular television show *Saved by the Bell* and various related television movies and sequels (*Saved by the Bell-The New Class*; *Saved by the Bell-Hawaiian Style*; *Saved by the Bell Wedding in Las Vegas*; *Saved by the Bell-The College Years*). Complainant has also appeared in a dozen theatrical movies, most recently appearing as himself in the major theatrical release *Dickie Roberts* in 2003. Complainant has also appeared in various print media including magazines and newspapers.

The "Screech" character became a major pop culture icon of 1990s. As a result, Complainant has become an extremely well-known entertainer and personality. This popularity translated into consumer demand for products where Complainant was the source identifier. For example, in 2001 Complainant performed in and branded a videotape/DCD entitled *Dustin Diamond Teaches Chess*.

Respondent registered this domain name on July 6, 2001. *Please See Exhibit A*. Respondent has continually used this website to portray himself as Mr. Diamond. *Please See Exhibit B*. This website also contains a message board where, Mr. Goldberg portrays himself as Complainant via posting messages on the board. *Please See Exhibit C*.

Following the initial registration by Respondent, a representative of Complainant contacted Respondent via email. Respondent offered to sell the domain name to Complainant for \$1800.00. Complainant declined the offer and Respondent continued the use of the domain name.

On or about, June 25, 2003, Respondent was sent a certified cease and desist letter to the following address:1652 Jefferson Street, Napa, CA 94559. This address was taken from the Whois database. *Please See Exhibit D*. This letter was returned to the offices of Herro & Lamont, LLC as undeliverable. *Please See Exhibit E*. After various inquiries by Herro & Lamont, LLC, Respondent provided a new address as follows: 847A Second Avenue 302; New York, New York 10017. *Please See Exhibit F*. On or about September 16, 2003, Herro & Lamont, LLC sent another certified cease and desist letter to Respondent at the New York Address. This Letter was also returned as undeliverable. *Please See Exhibit G*.

Herro & Lamont, LLC was able to contact Respondent via email on several occasions. Respondent was sent a cease and desist letter via email. Herro & Lamont, LLC have asked Respondent and/or Respondent's attorney to contact Herro & Lamont, LLC. However,

Respondent has refused to comply with such requests until he receives the demand via a certified letter. However, Herro & Lamont, LLC has mailed certified letters on two separate times to no avail. Respondent has refused to contact Herro & Lamont, LLC via phone or US Mail despite several requests.

Identical or Confusingly Similar

A. Complainant owns common law trademark rights in the name DUSTIN DIAMOND.

Complainant is a well known actor and entertainer. Respondent's domain name is identical to Complainant's common law trademark. Complainant is the owner of common law trademark rights in and to the mark DUSTIN DIAMOND in connection with entertainment/media products and services. A trademark registration is not necessary for a complainant to have trademark rights under the UDRP. *See Julia Fiona Roberts v. Russell Boyd*, D2000-0210 (WIPO May 29, 2000).

UDRP decisions have routinely held that celebrities have common law trademark rights in their personal names and that these rights are sufficient to support a UDRP complaint. *See, e.g., Rita Rudner v. Internetco Corp.*, D2000-0581 (WIPO Aug. 3, 2000) (comedienne, author, actress); *Kevin Spacey v. Alberta Hot Rods*, FA 114437 (Nat. Arb. Forum Aug. 1, 2002) (actor); *Judy Larson v. Judy Larson Club*, FA 96488 (Nat. Arb. Forum March 13, 2001) (artist); *Julia Fiona Roberts v. Russell Boyd*, D2000-0210 (WIPO May 29, 2000) (actress); *Nicole Kidman v. John Zuccarini, d/b/a Cupcake Party*, D2000-1415 (WIPO Jan. 23, 2001) (actress); *David Gilmour et al. v. Ermanno Cenicolla*, D2000-1459 (WIPO Dec. 15, 2000) (musician); *Julie Brown v. Julie Brown Club*, D2000-1628 (WIPO Feb. 13, 2001) (performer, video producer, author); *Mick Jagger v. Denny Hammerton*, FA95261 (Nat. Arb. Forum Sept. 11, 2000) (singer and performer).

Complainant's common law trademark rights are particularly worthy of recognition because "DUSTIN DIAMOND" has acquired secondary meaning, as evidenced by the videotape/DVD "*Dustin Diamond Teaches Chess*," which was sold nationwide in retail stores and on the Internet. *Please See Exhibits H and I*. As the title suggests, consumers were induced to purchase the video/DVD based on the source identification of the product with Complainant's name. Various UDRP decisions have held that celebrities have common law trademark rights in their personal names because of the "widespread recognition of their names as indicators of the single source of the specific quality of services they perform publicly." *See Kevin Garnett v. Trap Block Technologies*, FA 0210000128073 (Nat. Arb. Forum Nov. 21, 2002). Additionally, the panel in *Kevin Spacey v. Alberta Hot Rods*, FA 114437 (Nat. Arb. Forum Aug. 1, 2002) held that "a celebrity's name can serve as a trademark when used to identify the celebrity's performance services." Complainant's well-known name, which he has used as a performer since 1987 and which developed worldwide recognition in the late 1980s and early 1990s, warrants similar treatment. Complainant has used the name DUSTIN DIAMOND as a trademark for acting and other entertainment related services since 1987. Based on Complainant's widespread usage of the DUSTIN DIAMOND mark as a trademark and the widespread consumer recognition of DUSTIN DIAMOND as identifying only Complainant, the mark has acquired secondary meaning sufficient to support this UDRP Complaint. The use of

the DUSTIN DIAMOND mark commenced in 1987, well before the registration by Respondent of dustindiamond.com.

B. The domain name dustindiamond.com is identical to Complainant's trademark DUSTIN DIAMOND.

Respondent has registered the domain name dustindiamond.com. The domain name dustindiamond.com is “self-evidently” identical to Complainant’s trademark DUSTIN DIAMOND. *See, e.g., Julia Fiona Roberts v. Russell Boyd*, D2000-0210 (WIPO May 29, 2000); *Helen Folsade Adu known as SADE v. Quantum Computer Servs. Inc.*, D2000-0794 (WIPO Sept. 26, 2000).

It has well been 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.” *See Kevin Garnett v. Trap Block Technologies*, FA 0210000128073 (Nat. Arb. Forum Nov. 21, 2002); *Judy Larson v. Judy Larson Club*, FA 96488 (Nat. Arb. Forum March 13, 2001) (domain name <judylarson.com> identical and/or confusingly similar to trademark JUDY LARSON); *David Gilmour et al. v. Ermanno Cenicolla*, D2000-1459 (WIPO Dec. 15, 2000) (“The suffix “.com” and the absence of spacing between the words are inconsequential;]” <davidgilmour.com> “virtually identical and confusingly similar to the trademark ‘David Gilmour’”).

Pursuant to the authority cited above, the lack of a space between the terms “DUSTIN” and “DIAMOND” and the presence of the generic top-level domain “.com” are inconsequential in distinguishing dustindiamond.com from the trademark DUSTIN DIAMOND. *See Kevin Garnett v. Trap Block Technologies*, FA 0210000128073 (Nat. Arb. Forum Nov. 21, 2002); *Kevin Spacey v. Alberta Hot Rods*, FA 114437 (Nat. Arb. Forum Aug. 1, 2002) (<kevinspacey.com> identical to KEVIN SPACEY).

Rights or Legitimate Interests

Respondent has no legitimate interest and has not made any legitimate use of the domain name dustindiamond.com in connection with a bona fide offering of goods and services. Respondent is not commonly known by the name “dustindiamond.” Respondent is not making any legitimate noncommercial or fair use of the domain name. Respondent has not registered the domain name to use as a parody. Respondent sole use and registration of the domain name is to misinform internet users, tarnish Complainant’s name and mark and to divert internet users to a guestbook which includes various racist comments and other vulgar messages, including links to pornographic web sites.

A “complainant’s allegation that respondent has no rights or legitimate interests in the domain name at issue shifts the burden to respondent to show by “concrete evidence” that respondent has rights or legitimate interests in respect of the domain name.” *See Kevin Garnett v. Trap Block Technologies*, FA 0210000128073 (Nat. Arb. Forum Nov. 21, 2002); *Kate Spade, LLC v. Darmstadter Designs*, D2001-1384 (WIPO Jan. 3, 2002) citing UDRP Policy ¶ 4(c). Concrete evidence requires documents and/or third party declarations in support of such assertions. Personal assertions are not enough. *See Kate Spade, LLC v. Darmstadter Designs*, D2001-1384 (WIPO Jan. 3, 2002) citing UDRP Policy ¶ 4(c). The failure of respondent to

produce such evidence entitles the panel conclude that the respondent has no such legitimate interests or rights.

A. 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 has used the domain name to misinform and divert internet users to a guest book which serves as a message board. This message board consists of profane, racist and other offensive comments and suggestions. This board also includes links to other web sites including websites containing pornography. Additionally, Respondent appears to have depicted himself as Complainant by using the name “Dustin Diamond” in emails sent from a dustindiamond.com email account.

Further, Respondent has routinely portrayed himself as the Complainant on the website. Respondent has a picture of Complainant on the domain name website and has language that states “I’M FAMOUS ACTOR DUSTIN DIMAOND.” Although the Respondent has clearly misspelled Complainant’s last name, the message gives the false impression that the Complainant is operating the website. *Please See Exhibit B.* Additionally, Respondent has an email link on the website to screech@dustindiamond.com. Respondent encourages internet visitors to contact him by using this email address.

Upon receipt of notice to Respondent from Complainant, Respondent added a message to the website stating that the website is in no way affiliated with Dustin Diamond. Also, Respondent has edited the website to make it look like a fan club for Complainant. These changes were made after Respondent received notice from Complainant. *Please See Exhibit J.* However, archive.org’s records suggests that the website has, at times, reverted back to older text where Respondent has portrayed himself as Complainant without the disclaimer or fan site orientation. *Please See Exhibits K1-K6.*

Complainant has never given Respondent permission to use the mark DUSTIN DIAMOND in a domain name or in any other way. Respondent has no affiliation, or association with Complainant. Moreover, Respondent has no legitimate, good faith explanation of its registration of Complainant’s name as a domain name. Therefore, based on the foregoing, Respondent has no right or legitimate interest in the name dustindiamond.com or the mark DUSTIN DIAMOND.

B. Respondent has never been commonly known by the domain name dustindiamond.com or the mark DUSTIN DIAMOND and has never acquired trademark rights in the name or mark.

Respondent is not and has never commonly been known as “dustindiamond.” Respondent has no relationship with Complainant and has no authorization to use Complainant’s name. *See Kevin Garnett v. Trap Block Technologies*, FA 0210000128073 (Nat. Arb. Forum Nov. 21, 2002); *Charles Jourdan Holding AG v. AAIM*, D2000-0403 (WIPO June 27, 2000) (finding no rights or legitimate interests where (1) Respondent is not a licensee of Complainant; (2) Complainant’s prior rights in the domain name precede Respondent’s registration; (3) Respondent is not commonly known by the domain name in question).

Complainant's use of his unique name and the widespread recognition that is associated with Complainant's use of the name DUSTIN DIAMOND long preceded Respondent's registration of the domain name. Thus, one can only conclude that Respondent registered the domain name because of Complainant's widespread recognition. The domain name was not registered by Respondent because of some right or interest of its own. *See, e.g., Nicole Kidman v. John Zuccarini, d/b/a Cupcake Party*, D2000-1415 (WIPO Jan. 23, 2001).

Registration and Use in Bad Faith

The domain name should be considered as having been registered and being used in bad faith based on the following:

A. Respondent's registration and use of the *identical* domain name dustindiamond.com with full knowledge of Complainant's rights to the name and mark DUSTIN DIAMOND is bad faith.

Respondent's bad faith is illustrated by its unjustified registration of the identical dustindiamond.com domain name when Respondent knew of Complainant's exclusive rights to the name DUSTIN DIAMOND. Respondent can point to no good faith use or preparations to use the name to justify its registration and use of the domain name.

Either actual knowledge or constructive knowledge by Respondent of Complainant's rights to the DUSTIN DIAMOND mark is sufficient. Various panels have held that "a registrant who knew or should have known of a complainant's trademark rights and without justification, registered a corresponding domain name acts in bad faith." *See, e.g., David Gilmour et al. v. Ermanno Cenicolla*, D2000-1459 (WIPO Dec. 15, 2000) (holding that where respondent knew of former Pink Floyd guitarist's name and reputation when it registered guitarist's name as ".com" domain name was bad faith); *Jaap Stam v. Oliver Cohen*, D2000-1061 (WIPO Nov. 4, 2000) (respondent's registration of <jaapstam.com> domain name when he "would have been aware of Complainant and his reputation as an international football player at the time when Respondent registered the said domain name" was bad faith). Considering Complainant's widespread fame and prior use of DUSTIN DIAMOND as a trademark, Respondent was or should have been fully aware of Complainant's rights in the name. Based on the foregoing, the registration of the identical domain name dustindiamond.com constitutes bad faith.

B. Respondent's offer to sell the domain name to Complainant constitutes bad faith

Respondent's offer to sell the dustindiamond.com domain name for \$1,800.00 is evidence that Respondent registered and used the disputed domain name for the purpose of selling it to Complainant for consideration in excess of out-of-pocket costs. Thus, Respondent has acted in bad faith pursuant to Policy ¶ 4(b)(i). *See Jeanette Lee v. Domain Research and Sales FA0203000105214* (Nat. Arb. Forum Apr. 1, 2002) citing *Booz-Allen & Hamilton Inc. v. Servability Ltd*, D2001-0243 (WIPO Apr. 5, 2001); *see also Technology Prop., Inc v. Hussain*, FA 95411 (Nat. Arb. Forum Sept. 14, 2000) (panel found bad faith where Respondent verbally offered the domain names for sale for \$2,000).

C. Respondent providing false contact information and Respondent's use of Complainant's likeness to pass Respondent off as Complainant constitutes bad faith

Respondent has a link on the domain name website which directs internet users to email the Respondent. The email address is screech@dustindiamond.com. The name "Screech" refers to Respondent's character on "*Saved By The Bell*." Respondent has misrepresented himself as Complainant by replying to these emails and posting messages on the website's message board under the name Dustin Diamond. *See Exhibits C and L*. Thus, internet users are led to believe that this email address and message board postings have some connection with Complainant. This misrepresentation by Respondent clearly constitutes bad faith.

In addition, Respondent has displayed various messages and an image of Complainant on the domain name website. Respondent has a message that states "Hello and welcome to "Dustin Diamond.com" My homepage on the internet!!" Respondent has another message that states that "You may have seen me in hit television shows such as "Saved by the Bell" where I played the crazy character "Schreech." Despite the fact that Respondent has misspelled certain words, the messages on the domain name website clearly show that Respondent is passing himself off as the Complainant. *See Exhibit B*. This misrepresentation and deception clearly constitutes bad faith on behalf of the Respondent.

D. Respondent's use of the domain name creates consumer confusion by mis-portraying Complainant and dilution by tarnishment

Complainant is widely known as the character Screech Powers on "*Saved By The Bell*." Complainant's unique appeal was that he was a recognizable teenage actor. Complainant's character portrayed a "squeaky" clean image. Respondent is misrepresenting himself as Complainant by confusing consumers/fans into believing that the website is operated by Complainant. The message board posted by Respondent harms and dilutes Complainant's trademark by hurting the "squeaky clean" image of Complainant (such as through the racist comments, offensive and profane language, and links to pornographic sites). This depiction creates consumer confusion in that they are led to believe that Complainant endorses or supports the type of communications displayed on Respondent's message board. This further constitutes bad faith on behalf of the Respondent.

Respondent presents an embarrassing website (such as the repeated typos, poor grammar) which for consumers confused about the source of the website, makes them think less of Complainant. Respondent is misrepresenting Complainant as someone who has poor grammar and endorses a guest book that displays vulgar language, messages and links to pornographic websites. This use by Respondent constitutes bad faith by dilution by tarnishment.

E. The inclusion of Respondent's disclaimer is insufficient to dispel likelihood of confusion with Complainant's mark.

Respondent has now posted a disclaimer on dustindiamond.com that the website is in no way affiliated with Dustin Diamond. This disclaimer was added only after the initial cease and desist letter was sent to Respondent by Herro & Lamont, LLC. The attempt by the Respondent to include said disclaimer on the website is insufficient to dispel its likelihood of confusion with Complainant's mark. Where the disclaimer is not included in the domain name, the domain

name attracts an Internet user's initial interest and misdirects the user before the user has had the opportunity to view the disclaimer, if it will be viewed at all. *See Andrew Weil M.D. c/o Polaris Health LLC v Domain Administrator* FA0310000206341 (Nat. Arb. Forum Dec. 8, 2003); *See Ciccone v. Parisi*, D2000-0847 (WIPO Oct. 12, 2000) ("Respondent's use of a disclaimer on its website is insufficient to avoid a finding of bad faith"); *See also See DaimlerChrysler Corp. v. Bargman*, D2000-0222 (WIPO May 29, 2000). Thus, the disclaimer posted by Respondent is insufficient to dispel bad faith.

[6.] REMEDY SOUGHT

The Complainant requests that the Panel issue a decision that the domain-name registration be transferred to Dustin N. Diamond.

[7.] OTHER LEGAL PROCEEDINGS

Pursuant to ICANN Rule 3(b)(xi), there have been no other legal proceedings that have been commenced or terminated in connection with or relating to any of the domain name(s) that are the subject of the complaint.

[8.] COMPLAINT TRANSMISSION

The Complainant asserts that a copy of this Complaint, together with the cover sheet as prescribed by NAF's Supplemental Rules, has been sent or transmitted to the Respondent (domain-name holder), in accordance with ICANN Rule 2(b). ICANN Rule 3(b)(xii); NAF Supp. Rule 4(c).

[9.] MUTUAL JURISDICTION

The Complainant will submit, with respect to any challenges to a decision in the administrative proceeding canceling or transferring the domain name, to where the Respondent is located, as shown by the address(es) given for the domain name holder in the Whois Database at the time of the submission of the Complaint to the National Arbitration Forum. ICANN Rule 3(b)(xiii).

[10.] CERTIFICATION

Complainant agrees that its claims and remedies concerning the registration of the domain name, the dispute, or the dispute's resolution shall be solely against the domain-name holder and waives all such claims and remedies against (a) the National Arbitration Forum and panelists, except in the case of deliberate wrongdoing, (b) the registrar, (c) the registry administrator, and (d) the Internet Corporation for Assigned Names and Numbers, as well as their directors, officers, employees, and agents.

Complainant certifies that the information contained in this Complaint is to the best of Complainant's knowledge complete and accurate, that this Complaint is not being presented for any improper purpose, such as to harass, and that the assertions in this Complaint are warranted under these Rules and under applicable law, as it now exists or as it may be extended by a good-faith and reasonable argument.

Respectfully Submitted on behalf of Complainant,

By: _____

Herro & Lamont, LLC

Brian A. Herro

Dated this ____ day of February, 2004