What's In A (Domain) Name? What A Cybersquatter Calls A Web Site By Any Other Name Would Not Sell For A Million Dollars Or Provide A Platform For A Three-Year Old's Artwork

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by Phillip Barengolts, Trademark Attorney

In "one [of] a series of domestic disputes between" Paul Bogoni and Vicdania Gomez, Gomez registered the domain names paulbogoni.org and paulbogoni.com without his authorization.[1] She offered to sell the domain names for $1 million each and posted content on one of them related to certain of her and her daughter's artwork. Bogoni sued under the personal name protection provisions of the Anti-cybersquatting Protection Act, 15 U.S.C. § 8131, seeking a preliminary injunction. He prevailed when Gomez's defense of use in connection with a copyrighted work failed to show her good faith registration. *Bogoni v. Gomez*, No. 11 civ 08093 (S.D.N.Y. Jan. 6, 2012).[2]

Gomez initially populated paulbogoni.org with statements that her three-year old daughter wrote and operated the website, which would donate proceeds to charity from the sale of art objects called "Angel" and "Airplane." A message on the site stated, "Hi, I'm Vittoria and this my [sic] first website that my mommy helped me launch in order to begin my journey in making the world a better place." The web site advised visitors that the two art objects were constructed at an arts institution named "Make Meaning in the Upper West Side of Manhattan." The "Airplane" object was titled "Bogoni." Finally, the web site displayed the following statement: "I will am [sic] also selling this domain name www.PAULBOGONI.ORG and www.PAULBOGONI.COM for $1Million (ONE MILLION DOLLARS) each." A photograph of "Airplane" appeared on the web site a month after the filing of Bogoni's complaint and Gomez never explained the relationship between the name Bogoni and the "Airplane."

Under these facts, Bogoni satisfied his burden to show that Gomez: (1) registered a domain name that consists of his name; (2) did so without the Bogoni's consent; and (3) had the specific intent to profit from Bogoni's name by selling the domain name for financial gain.[3] The court's analysis turned on the availability of a defense to cybersquatting liability for

> "good faith registration of a [personal] domain name . . . if such name is used in, affiliated with, or related to a work of authorship protected under Title 17 . . . and if the person registering the domain name is the copyright owner or licensee of the work [and] the person intends to sell the domain name in conjunction with the lawful exploitation of the work."

15 U.S.C. § 8131(1)(B).

The Court found that Gomez exhibited an absence of good faith based upon the facts in evidence, and her offer to sell the domain names was not "in conjunction" with the sale of the two art objects. Thus, she did not qualify for this copyrighted work defense. The Court's injunction did not require Gomez to transfer the domain names, however, but only required her to stop using them, which she did by removing all content. Currently, paulbogoni.org simply states "underconstruction."

This decision illustrates a key distinction between a claim over the use of a personal name as a domain name under the ACPA versus the Uniform Domain Name Dispute Resolution Policy: the UDRP does not protect personal names that are not trademarks as well, even the names of famous people who do not use their names in connection with a designation for their business. *See* http://www.wipo.int/amc/en/domains/search/overview2.0/ (response to question 1.6). Business executives who find themselves subject to attack or pseudo-extortion through domain names incorporating their personal names may be able to take advantage of this targeted ACPA claim, as well as claims under state laws protecting rights of privacy.

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Phillip Barengolts is a partner with Pattishall, McAuliffe, Newbury, Hilliard & Geraldson LLP, a leading intellectual property law firm based in Chicago, Illinois. Pattishall McAuliffe represents both plaintiffs and defendants in trademark, copyright, and unfair competition trials and appeals, and advises its clients on a broad range of domestic and international intellectual property matters, including brand protection, Internet, and e-commerce issues. Mr. Barengolts' practice focuses on litigation, transactions, and counseling in domestic and international trademark, trade dress, Internet, and copyright law. He teaches trademark and copyright litigation at John Marshall Law School, and co-authored Trademark and Copyright Litigation, published by Oxford University Press.

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[1] Although the Court is vague on specifics, this statement is telling: "[T]he parties made clear to the Court during oral argument that the parties' relationship is, at the very least, contentious."

[2] Available at http://scholar.google.com/scholar_case?case=6245650236069106536.

[3] The Court discussed at some length whether Bogoni satisfied the third prong of this test because of some prior decisions finding that personal name cybersquatting to recover a debt would avoid liability. *See Carl v. BernardJCarl.com*, 409 F. App'x 628, 630 (4th Cir. 2010) (per curium) (unpublished).