



## NATIONAL ARBITRATION FORUM

### DECISION

The Elizabeth Taylor Trust, Interplanet Productions Limited and The Elizabeth Taylor Cosmetics Company v. Patrick Fitzgerald  
Claim Number: FA1210001465340

### PARTIES

The Complainants are **The Elizabeth Taylor Trust, Interplanet Productions Limited and The Elizabeth Taylor Cosmetics Company** ("Complainant"), represented by **Stephen J. Strauss** of **FULWIDER PATTON LLP**, California, USA. The Respondent is **Patrick Fitzgerald** ("Respondent"), represented by **Jon D. Cohen** of **Stahl Cowen Crowley Addis LLC**, Illinois, USA.

### REGISTRAR AND DISPUTED DOMAIN NAME

The domain name at issue is **<liztaylor.xxx>**, registered with **Register.com, Inc.**

### 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.

Hon. Sir Ian Barker as Panelist.

### PROCEDURAL HISTORY

Complainant submitted a Complaint to the National Arbitration Forum electronically on October 2, 2012; the National Arbitration Forum received payment on October 2, 2012.

On October 5, 2012, Register.com, Inc. confirmed by e-mail to the National Arbitration Forum that the **<liztaylor.xxx>** domain name is registered with Register.com, Inc. and that Respondent is the current registrant of the name. Register.com, Inc. has verified that Respondent is bound by the Register.com, Inc. registration agreement and has thereby agreed to resolve domain disputes brought by third parties in accordance with ICANN's Uniform Domain Name Dispute Resolution Policy (the "Policy").

On October 9, 2012, the Forum served the Complaint and all Annexes, including a Written Notice of the Complaint, setting a deadline of October 29, 2012 by which Respondent could file a Response to the Complaint, via e-mail to all entities and persons listed on Respondent's registration as technical, administrative, and billing contacts, and to postmaster@liztaylor.xxx. Also on October 9, 2012, the Written Notice of the Complaint, notifying Respondent of the e-mail addresses served and the deadline for a Response, was transmitted to Respondent via post and fax, to all entities and persons listed on Respondent's registration as technical, administrative and billing contacts.

A timely Response was received and determined to be complete on October 29, 2012.

An Additional Submission from Complainant was received and determined to be compliant on November 5, 2012.

On November 9, 2012, pursuant to Complainant's request to have the dispute decided by a single-member Panel, the National Arbitration Forum appointed Hon. Sir Ian Barker as Panelist.

Having reviewed the communications records, the Administrative Panel (the "Panel") finds that the National Arbitration Forum has discharged its responsibility under Paragraph 2(a) of the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules") "*to employ reasonably available means calculated to achieve actual notice to Respondent*" through submission of Electronic and Written Notices, as defined in Rule 1 and Rule 2.

## RELIEF SOUGHT

Complainant requests that the domain name be transferred from Respondent to Complainant.

## PRELIMINARY ISSUE: Multiple Complainants

In the instant proceedings, there are three Complainants. Paragraph 3(a) of the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules") provides that "[a]ny person or entity may initiate an administrative proceeding by submitting a complaint." The National Arbitration Forum's Supplemental Rule 1(e) defines "*The Party Initiating a Complaint Concerning a Domain Name Registration*" as a "single person or entity claiming to have rights in the domain name, or multiple persons or entities who have a sufficient nexus who can each claim to have rights to all domain names listed in the Complaint."

In 1978, the late Dame Elizabeth Taylor, the renowned actress, assigned the rights in her name, likeness and appearance to her company, Interplanet Productions Limited ("Interplanet"). Trademarks in the United States and elsewhere were granted for the name "Elizabeth Taylor" for cosmetic products. Some years later, Elizabeth Taylor and Interplanet licensed the "Elizabeth Taylor" name to the Elizabeth Taylor Cosmetics Company which then produced perfumes under the 'Elizabeth Taylor' trademark. Interplanet has now obtained similar United States trademark registrations for jewellery and headware.

On Elizabeth Taylor's death on March 23, 2011, the Elizabeth Taylor Trust ("ETT") succeeded to all post-mortem publicity rights not previously assigned to Interplanet, including but not limited to her voice, name, photograph and likeness. ETT filed a notice in accordance with Californian law with the California Secretary of State, claiming to be the successor-in-interest to Elizabeth Taylor's persona and publicity rights.

In these circumstances, the Panel considers that the three complainants can demonstrate a link amongst all three of them, namely all are entities involved in the marketing and trademarking of Elizabeth Taylor's persona. See *Vancouver Org. Comm. for the 2010 Olympic & Paralympic Games & Int'l Olympic Com. V. Marlec*, FA 66119 (Nat. Arb. Forum May 12, 2006) and *Tasty Baking Co. & Tastykake Invs. Inc. v. Quality Hosting*, FA 208584 (Nat. Arb. Forum Dec. 28, 2003) .

The Panel notes:

- (a) that the same three complainants were successful in prosecuting an earlier NAF case on June 22, 2012, viz. *The Elizabeth Taylor Trust, Interplanet Productions Ltd & The Elizabeth Taylor Cosmetic Co. v. Hope*, FA1445233 (Nat. Arb. Forum June 22, 2012) ("the *Hope* case").
- (b) The Respondent has not made any submission concerning the fact that there are three Complainants.

Although it was probably not necessary to have filed a Complaint in the name of all three Complainants, the Panel finds there was a necessary connection amongst them and admits the Complaint in terms of NAF Supplemental Rules 1(e) and 3(a). For convenience, throughout this decision, the Complainants will be referred to as "the Complainant".

## PRELIMINARY ISSUE: Applicability of RES and CEDRP to UDRP Proceedings

While the current case was commenced under the UDRP, Complainant makes arguments relating to the Charter Eligibility Dispute Resolution Policy ("CEDRP"). The CEDRP was established for disputes relating to domain names that include the ".xxx" top-level domain. However, cases relating to domain names that include the ".xxx" top-level domain may still be brought under the UDRP, which has occurred in the instant proceeding. The CEDRP contains a provision that allows a panel to use the requirements of that policy in the panel's UDRP analysis.

CEDRP ¶ 8 allows a panel to use the factors under CEDRP ¶¶ 2(a) and (b) as applicable terms of legitimate rights or registration and use under the UDRP. CEDRP ¶ 2(a), "Registration or Use Inconsistent with Community Eligibility," states that "[a] complaint under this section shall be required to show that a registered domain name in the .XXX TLD

has not been registered or used in compliance with the Sponsored Community eligibility criteria as further defined in the Registry-Registrant Agreement.”

CEDRP ¶ 2(b), “Improper Sunrise A Registration,” reads as follows:

A complaint under this section shall be required to:

(i) show that a registered domain name in the .XXX TLD has not been registered in compliance with the provisions the Registry Sunrise Program as they relate to Sponsored Community Adult Trademark Rights Holders (“AT” applicants), or Sponsored Community Existing Domain Name registrants (“AD” applicants); and

(ii) be submitted to the Provider prior to September 1, 2012.

At the Panel’s discretion, the Panel may choose to find that Respondent lacks rights and legitimate interests in the disputed domain name under the UDRP based on the conditions of CEDRP ¶ 2. Additionally, the Panel may utilize the requirements of CEDRP ¶ 2 to determine bad faith registration and use under the UDRP.

Alternatively, the Panel may choose to disregard Complainant’s arguments under the CEDRP and proceed with its analysis solely under the UDRP.

The Panel sees no reason for disregarding the CEDRP, in deciding on the present Complaint. The Panel may consider the requirements of CEDRP to determine bad faith registration and use under UDRP in addition to considering the normal provisions of the UDRP.

## **PARTIES' CONTENTIONS**

### **A. Complainant**

The Complainant has rights in the ELIZABETH TAYLOR trade mark registered with the USPTO on March 22, 1994. The Complainant alleges that the disputed domain name is confusingly similar to the ELIZABETH TAYLOR mark and that the short form “Liz” for the name “Elizabeth” does not negate the confusing similarity. Elizabeth Taylor was not only an award-winning actress but an internationally-recognised producer, author and business entrepreneur. The Complainant produced media articles which referred to her as “Liz Taylor”.

The Complainant filed for United States trademark applications covering the mark LIZ TAYLOR for cosmetics, fragrances, jewellery, watches, clothing and footwear in January of 2012.

The Respondent registered the disputed domain name on December 7, 2011 and has never used or developed the disputed domain name in connection with a *bona fide* offering or any goods or services.

The disputed domain name links to a website that incorporates a generic search engine with links to other third party websites selling cosmetics competing with those sold by the Complainant, as well as links to information relating to the life and career of Elizabeth Taylor.

The Complainant has established rights in the ELIZABETH TAYLOR mark through continuous use of the mark. Also, it has shown that the mark is strongly associated with Liz Taylor. See, for example, the *Hope* case, *supra*.

The Complainant has no relationship with the Respondent, nor has he been authorised by the Complainant to register and use the disputed domain name. Nor is he commonly known by that name. He is not a member of a relevant “Sponsored Community “permitted to register .xxx domain names under CEDRP”.

The Complainant submits that the Respondent must have had actual knowledge of the Complainant’s rights in the trademark when he registered the disputed domain name. Moreover, he has made no demonstrable preparations to use the disputed domain name which, as noted earlier, resolves into a website providing links to other websites offering competing products. There is no *bona fide* offering of goods or services

Membership of a ‘Sponsored Community’ entitles registration of a .xxx name to those who provide adult online

entertainment or who represent or provide services for such persons. The Respondent does not meet this requirement and therefore has no right or legitimate interest under CEDRP. See *Branson v. Truman*, FA1423689 (Nat. Arb. Forum Feb. 14, 2012).

The disputed domain name is being used in bad faith by the Respondent since it redirects internet users to other commercial websites and the Respondent derives commercial benefit from click-through fees. The Respondent's passive holding of the disputed domain name constitutes evidence of bad faith) it is improbable that the Respondent was unaware of the Complainant's trademarks at the time of registration.

Moreover the Respondent's defiance of the CEDRP eligibility requirements further demonstrates bad faith.

## **B. Respondent**

The Complainant's trademark rights are narrowly defined and limited to commercial classes for perfume and fragrances, cosmetics and jewellery, hats and caps. The disputed domain name is clearly different from the ELIZABETH TAYLOR trade name; no evidence was submitted in support of the likelihood of confusion between "Liz Taylor" and "Elizabeth Taylor". There is no association in the marketplace between the mark ELIZABETH TAYLOR and adult entertainment. On the other hand, "Liz Taylor" and "Lizz Taylor" have been used as names for actresses in adult entertainment". There are hundreds of pages and dozens of sources of photographs, descriptions, videos and other information about the adult entertainment actresses, Liz Taylor and Lizz Taylor. These persons have allowed sites to post videos of them, often indulging in sexual activity. There is no incidental or potential similarity to the appearance of these adult entertainers and the late Elizabeth Taylor.

Whilst alive, Elizabeth Taylor did not refer to herself as "Liz Taylor" and did not use the name for commercial purposes. She stated once that she hated the name Liz. Accordingly, the argument that the domain name is confusingly similar is without merit.

The Respondent has registered but has not activated the disputed domain name. He has never offered it for sale, has never been asked to sell it, nor does he intend to sell it. He has held the disputed domain name inactive and non-resolving with plans to commercialise the disputed domain name for limited use in the adult entertainment industry.

Since the filing of the Complaint, the Respondent has obtained Sponsored Community status. He requires additional time to create his website which he intends to build around the disputed domain name. He has not received any financial gain in respect of the use. Entry into the domain name field yields no connection to search pages. Users will find links to adult entertainment sites relating to the adult entertainers, Liz Taylor and Lizz Taylor.

The Respondent would agree, on request, to post a suitable disclaimer on his under-construction page. The Respondent did not register the disputed domain name in order to prevent the owner of any trademark from reflecting the mark in a corresponding domain name. The Complainant did not seek to obtain a trademark for LIZ TAYLOR until some weeks after the Respondent had registered the disputed domain name, which has never been used for any purpose in commerce.

The Respondent is not a competitor of the Complainant. He is not in the same line of industry, there are no plans to use the disputed domain name with reference to Elizabeth Taylor deceased. He has not intentionally attempted to attract commercial internet users to the website or other online locations. Searches made using the disputed domain name address all return to existing and unrelated adult entertainment websites. There is no commercial gain. The Respondent is an entrepreneur who has developed commercial websites in the past but his primary means of income is not derived from an internet-based business. He has not had time to develop the adult entertainment website but he intends to do this within the next six months. To that end, he has become a member of a Sponsored Community and has caused enquiries to be made of the agent for the adult entertainment performer, Liz Taylor.

He has actively demonstrated preparations to use the disputed domain name in connection with a *bona fide* offering of services as a member of a Sponsored Community.

The Respondent has not acted in bad faith. The Complainant has not discharged the burden of proof in that regard.

The *Hope* case is not binding. It was clear that the respondent in that case had purchased the domain name <liztaylor.com> in bad faith having no intent to develop a website related or unrelated to Elizabeth Taylor but rather with the sole intent to sell the domain name for \$2m.

The Panel's decision in *Hope*, that <liztaylor.com> was confusingly similar to the present Complainant's mark, must be discounted because of the lack of analysis arguments for and against and citation of legal standards or other indications of how the conclusion had been reached. In any respect, <liztaylor.com> is distinguishable from <liz.taylor.xxx> because a search of the former domain name would yield references to the late Dame Elizabeth Taylor but a search of the latter would yield references to the adult entertainment performer, Liz Taylor.

The Respondent is not receiving a commercial benefit through click-through fees by redirecting internet users to other commercial websites. The XXX domain was specifically created for the purpose of providing separate top-level domains for the dissemination of adult entertainment. Such a website would not attract customers seeking perfumes or hats.

The "passive holding" argument is without merit. Inactivity is merely a factor in determining if there is bad faith. There is no specific time limit for registrants to develop a website for every domain they have registered. Bad faith should not be assumed in the absence of a quick development.

The Respondent is a relative, but not wholly inexperienced, novice in the Internet industry. He has meaningful and honest intentions to develop the disputed domain name. The XXX top level domain was only made available in 2011 and many in the "sponsored community" are grappling with the best way to utilize sites for these domains. The Respondent should not be penalized because he is not capable of devoting sufficient time to building the internet site or penalized because he has another full-time job.

It is not necessary to be in a "sponsored community" prior to registering a XXX domain name. The Rules merely provide that until the registrant is in the Sponsored Community, the domain name will not resolve to one's DNS. It will still be a valid domain registration which means it must be renewed at some point and could be transferred. However, functionality such as web-hosting, email URL forward will not work until the domain is associated with a known membership ID.

### **C. Complainant's Additional Submissions**

The Respondent has not contested the Complainant's ownership of the ELIZABETH TAYLOR mark and its fame. Or that "Liz Taylor" is a name associated with the late Dame Elizabeth Taylor.

The Complainant's mark was famous throughout the world long before the Respondent registered the disputed domain name. The Respondent's argument that the disputed domain name is very different and not phonetically the same ignores the evidence that the media and the public have come to associate Liz Taylor with Elizabeth Taylor. That *Hope* decision is to this effect.

The Respondent admits he has not used the disputed domain name for commercial purposes. His argument is that "Liz Taylor" and "Lizz Taylor" are the assumed names of well-known pornographic actresses. It is a frequent practice for porn stars to adopt stage names, derived from or mimicking the names of celebrities. The fact that the Respondent registered and claimed "sponsored community" status after the Complaint was filed, does not constitute demonstrable preparations existing before the Complaint.

The Respondent has made no sworn statement nor provided any evidence of his enquiries relating to the adult entertainment performer, Liz Taylor. Nor did he provide any credible evidence satisfying the demonstrable preparations requirement of Policy ¶ 4(c)(i). No business plan, documentary evidence, affidavit or declaration under penalty of perjury was provided.

The lack of evidence of demonstrable preparations is sufficient to combat any claims of right or interest in a domain name. See *Christian Dior Couture & Chloe v. Zourmas*, D2008-1440 (WIPO December 22, 2008). That was a case where there was no evidence the Respondents had any authorization from the adult industry actress, Chloe Dior, to

incorporate her name in a disputed domain name or to use it in any way.

The Respondent produced no evidence that Liz Taylor allowed him to use her name in any way in a disputed domain name. The claim that the site will be used only in relation to that adult entertainer is self-serving, without any supporting evidence and its accuracy is questionable. It makes no sense to wait until the website becomes active which inevitably will cause confusion when it does, given the international fame of the Complainant's trademark and Elizabeth Taylor's nickname of Liz.

The public on seeing the name on search engines will believe that the resulting website will feature the late Dame Elizabeth Taylor instead of being directed to a website featuring an adult entertainer who has chosen to adopt a version of the late Elizabeth Taylor's name. Members of the public would reasonably conclude that an XXX domain name referring to the late Dame Elizabeth Taylor could tarnish the reputation and name of the late Elizabeth Taylor. See *ABB Brown Boverie Limited v. Quicknet*, D2003-0215 (WIPO May 26, 2003), where it was said:

"The use of ABB as part of a domain name offering pornographic material certainly tarnishes the Complainant's existing mark which is also evidence of bad faith."

## FINDINGS

1. The disputed domain name is confusingly similar to a registered trademark in which the Complainant has rights.
2. The Respondent has no rights or legitimate interests to use the disputed domain name.
3. The disputed domain name was registered and is being used in bad faith.

## DISCUSSION

Paragraph 15(a) of 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 Complainant must prove each of the following three elements to obtain an order that a domain name should 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; and
- (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.

## DISCUSSION

### Identical and/or Confusingly Similar

The Panel is in no doubt that the disputed domain name is confusingly similar to the Respondent's trademark. "Liz" is a very common abbreviation of the forename, "Elizabeth". The Complainant has produced evidence that the late Elizabeth Taylor was known, in the media at least, as "Liz" Taylor. Whether she personally liked the shortened version of her full name or not is irrelevant. It does not matter that the trademarks of the Complainant extend only to jewellery, clothing, etc. All that needs to be proved under the Policy is that a complainant has rights in a trademark and that the disputed domain name is identical or confusingly similar to that mark.

The Panel notes that the same conclusion was reached by the very experienced Panelist under the UDRP in the *Hope* case. That Panelist did not need to give extended reasons for his conclusion, as contended for by the Respondent. One would have thought that a finding that "Liz" is a common rendition of the name "Elizabeth" and that the name of Elizabeth Taylor was known worldwide inevitably meant that a finding that the disputed domain name and the

trademark are confusingly similar under Policy ¶ 4(a)(i).

Accordingly, Policy ¶ 4(a)(i) of the Policy is satisfied.

### **Rights or Legitimate Interests**

Complainant gave the Respondent no rights to reflect Complainant's trademark in a domain name. Accordingly, the onus shifts to the Respondent to show that he comes within one of the three situations contemplated by Paragraph 4(c) of the Policy.

The Respondent claims that he wishes to develop a website devoted to a porn star who calls herself "Liz Taylor" or "Lizz Taylor". When one visits the disputed domain name, the Google search shows a whole list of pornographic sites devoted to a porn star who calls herself "Liz Taylor". It seems that some actors in the "adult entertainment" industry take on names of famous actors or actresses or slight variants thereof. One speculates whether the famous people whose names are thus appropriated are happy with this phenomenon. The Respondent claims that he wishes to develop this website but because website development is not his primary occupation, he does not have time to do so. In the meantime, the domain name is inactive or diverts to this particular website.

The Respondent is required to show that he has made demonstrable preparations to offer goods and services using the disputed domain name before he had notice of the Complaint. He claims, for example, to have had some contact with an agent for the star, Liz Taylor, but there is no evidence to support this contention. Nor is there any evidence to show that he had instructed a contractor to prepare a website. Bearing in mind the onus of proof is on the Respondent, the Panel considers that proof of demonstrable preparations has not been shown as required by Paragraph 4(c)(i) of the Policy.

An additional indication of lack of demonstrable preparations before notice of the Complaint stems from the fact that only after the Complaint was filed, did the Respondent apply to join the "Sponsored Community" for persons wishing to develop XXX domain names. One wonders why, if he were so intent on promoting interest in the porn star, Liz Taylor, he did not take this step earlier. He says that it is common practice for those with XXX sites not to seek membership of a sponsored community until after the domain has been registered but then, again, there is no evidence of this.

Nor is there any evidence of a *bona fide* offering of goods and services in a legitimate non-commercial or fair use of the disputed domain name which could bring the Respondent within Paragraph 4(c)(iii) of the Policy. The Respondent uses the resolving website to provide *inter alia* hyperlinks on behalf of companies selling cosmetics in competition with the Complainant. It has often been held in UDRP cases that a Respondent must take responsibility for what is on a website. Passing responsibility on to a "parking site" operator is not good enough. Some links are to sites featuring the late Elizabeth Taylor.

Although it is correct that in some circumstances, a passive holding of a domain name may not necessarily disqualify a respondent from taking advantage of Paragraphs 4(c)(i) and (iii) of the Policy, in many cases where that defence has been successful, there has been evidence of attempts to develop the website, often accompanied by evidential declarations or production of contracts with a website designer or developer.

Under CEDRP Policy, ¶ 8, the arguments concerning the lack of legitimate interest in relation to a XXX domain name may be introduced as complementary to UDRP arguments. There is little need to resort to the CEDRP Policy in this case since the decision under the UDRP criteria is so clear. Accordingly, the Complainant has established Paragraph 4(a)(ii) of the Policy.

### **Registration and Use in Bad Faith**

Considering all the available evidence, the Panel has no difficulty in concluding both bad faith registration and use for the following considerations.

- (a) The fame of the Academy award-winning actress, Elizabeth Taylor, over many years, is worldwide. There was much publicity when she died in March 2011, the disputed domain name was registered some months after her death. It defies belief that the Respondent had never heard of Elizabeth Taylor at the time when he registered the disputed domain name, albeit in a contracted form of her first name, but in a form which is easily recognised as relating to Elizabeth Taylor, the famous actress.
- (b) The disputed domain name clearly tarnishes the Complainant's trademark. There is no evidence that the late Dame Elizabeth Taylor was associated with pornography on the internet. Close association of her name with a pornographic site must surely tarnish the trademark bearing her name.
- (c) Some internet viewers might be confused into thinking that the domain name liztaylor.xxx related to the late Elizabeth Taylor. Some may be surprised that she might have been associated with pornography. Others may be merely curious to see whether she indeed dabbled in that particular predilection.

One can take judicial notice of the fact that the name "Elizabeth Taylor" or its shortening of "Liz Taylor" would be well-known universally. It would be certainly better known than the name "Liz Taylor" assumed by an actress in pornographic videos or downloads. Hence there is a likelihood of confusion to internet users.

- (d) The fact that the Respondent was not at the time of the Complaint a member of a Sponsored Community as envisaged by CEDRP strengthens the inference of bad faith registration and use of which all of the above are indicia.

Accordingly, Paragraph 4(a)(iii) of the Policy is satisfied.

## DECISION

Having established all three elements required under the ICANN Policy, the Panel concludes that relief shall be **GRANTED**.

Accordingly, it is Ordered that the **<liztaylor.xxx>** domain name be **TRANSFERRED** from Respondent to Complainant.

Hon. Sir Ian Barker, Panelist  
Dated: November 20 , 2012

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