



## **WIPO Arbitration and Mediation Center**

### **ADMINISTRATIVE PANEL DECISION**

**Universal City Studios, Inc. v. David Burns and Adam-12 Dot Com**

**Case No. D2001-0784**

#### **1. The Parties**

Complainant is Universal City Studios, Inc. (“Complainant” or “Universal”) a Delaware corporation with its principal place of business in Universal City, California, USA.

Respondents are David Burns and Adam-12 Dot Com, both located at 531 Main Street, #1001, El Segundo, California, 90245 USA (“Respondents”).

#### **2. The Domain Name(s) and Registrar(s)**

The domain names at issue are <adam-12.com> and <adam-12.org> (the “Domain Names”). The registrar is Network Solutions, Inc. (the “Registrar”) located at 505 Huntmar Park Drive, Herndon, Virginia, 20170 USA.

#### **3. Procedural History**

On June 14, 2001, the WIPO Arbitration and Mediation Center (the “Center”) received a copy of the Complaint of Complainant via email. On June 16, 2001, the Center received hardcopy of the Complaint. On June 15, 2001 the Center sent an Acknowledgment of Receipt of Complaint to Complainant. The Complainant paid the required fee.

On June 20, 2001 after the Center sent a Request for Verification to the Registrar requesting verification of registration data, the Registrar confirmed, *inter alia*, that it is the registrar of the Domain Names and that the Domain Names are registered in the Respondent's name.

The Center verified that the Complaint with Amendment satisfies the formal requirements of the ICANN Uniform Domain Name Dispute Resolution Policy (the “Policy”), the Rules for Uniform Domain Name Dispute Resolution Policy (the

“Rules”), and the Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the “Supplemental Rules”).

On June 27, 2001, the Center sent a Notification of Complaint and Commencement of Administrative Proceeding to the Respondents together with copies of the Complaint with Amendment, with a copy to the Complainant. This notification was sent by the methods required under paragraph 2(a) of the Rules.

On June 28, 2001, the Center received the Response of Respondents and then sent its Acknowledgment of Receipt for the Response.

After the Center received completed and signed Statements of Acceptance and Declaration of Impartiality and Independence from each of the panelists, the Center notified the parties of the appointment of a three-arbitrator panel consisting of Terrell C. Birch, Peter L. Michaelson and Richard W. Page (the “Presiding Panelist”).

On August 2, 2001, Complainant filed a Request for Leave to File a Reply Brief with the Center. On August 3, 2001, Respondents sent an email opposing the Reply Brief and requesting permission to file their own supplemental filing if the Panel granted Complainant’s leave to file a Reply Brief. Both requests to file supplemental briefs were forwarded to the Panel for ruling. After due consideration of the requests, the Panel has decided not to grant either request and has not considered the proposed Reply in reaching its decision.

#### **4. Factual Background**

The “Adam-12” television series was portrayal of the day-to-day activities of the officers of the Los Angeles Police Department. Premiering in the fall of 1968, “Adam-12” was an immediate ratings winner, particularly with younger audiences. The success of the television series can be largely attributed to producer Jack Webb's strict attention to detail. As a spin-off of his long-running television series “Dragnet,” Jack Webb ensured that authentic police uniforms, stations and vehicles were used to lend credibility to the program. For example, Mr. Webb employed a real police dispatcher to read the show's signature "One Adam-12...." radio announcements. Mr. Webb also helped developed the "tow shot" to shoot driving scenes instead of using a soundstage and projected background shots. With a three-camera rig mounted on the hood of the vehicle, the cameras could shoot from the front and sides as the car was actually towed down the streets of Los Angeles to film the patrol scenes. From its premiere in 1968, first-run episodes of “Adam-12” aired continuously for seven years, maintaining the series’ critical acclaim and popularity throughout its 171 original episodes.

In addition to the critical and ratings success of the series, the seven-season run of “Adam-12” was also a springboard for new talent, featuring an array of guest stars. Needing a variety of new victims and villains every week, the casting department of “Adam-12” was always on its toes looking for fresh faces to fill the temporary roles. The guest star list reads like a "Who's Who" of entertainment, with one-off performances by actors including Jodie Foster, David Cassidy, Willie Aames, Ed Begley Jr., Karen Black, Robert Conrad, Scatman Crothers, Micky Dolenz, Sharon Gless, Deidre Hall, Mark Harmon, Dick Clark, June Lockhart, Tim Matheson, Andrew Stevens, Lindsay Wagner, Barry Williams and Michael Warren.

During its initial seven-season run, "Adam-12" spawned numerous merchandising products, from lunch boxes and glassware to comic books. After its seven years of initial broadcast, the "Adam-12" television series entered nationwide syndication, and re-runs of the series have since been seen throughout the United States and internationally for 25 years. For the past several years, re-runs of "Adam-12" have been broadcast at least twice a day on the cable television channel, TV Land, providing millions of viewers with episodes from the classic series.

In April 1998, Universal learned that Respondents were operating a commercial website at <sierranet.net/... burnsds/adam12.htm> focused entirely on the "Adam-12" television series, which distributed unauthorized copyrighted material. Specifically, Respondents' website was reproducing and distributing unauthorized audio clips, video clips and images from the "Adam-12" television series, in violation of Universal's copyrights, and did so in conjunction with their sale of merchandise. On April 24, 1998, Universal sent a demand letter to Respondents informing them of Universal's rights in the "Adam-12" television series, and requesting removal of unauthorized "Adam-12" images, audio clips, and video clips. While Respondent David Burns replied to Universal's demand letter suggesting that Respondents would comply with Universal's demands, he thereafter moved the "Adam-12" content to a site located at the Domain Name <adam-12.com>, which Respondents had registered on April 21, 1998.

On or around May 13, 1998, Respondents posted on their website, located at the <adam-12.com> Domain Name, solicitations for "donations" to support "potential legal costs" and web hosting costs for the <adam-12.com> website. Respondent David Burns offered for sale an 8"x10" image from the "Adam-12" television series in exchange for each \$25 "donation."

On or about June 22, 1998, Respondents offered the <adam-12.com> Domain Name for sale to Universal by posting the following message on the website at the <adam-12.com> Domain Name: "I make you this offer...if you can do better (I hope you can with your unlimited resources), I will sell you the domain name and registry, and the content if you reimburse me for all of my costs for hosting this site for three years."

In February 1999, Respondents published and offered for sale through the website at the <adam-12.com> an unauthorized book containing trivia, an episode guide, and images relating to the "Adam-12" television series, for \$20 per copy.

On June 16, 2000, Respondents listed the <adam-12.com> Domain Name for sale on the online auction site eBay. In the description of the domain name in the auction listing, Respondents claimed that the domain name was of significant value because of the 1.3 million person user base that Respondents had developed through the content on the website at <adam-12.com>. Respondents listed the auction with a reserve bid in excess of \$550, indicating that the Respondents would not sell the domain name unless it received an amount of money, which exceeded its registration costs. Universal became aware of the auction and requested that eBay halt it prior to its completion. The auction listing garnered bids of over \$1,000 prior to eBay's removal of the auction.

On June 18, 2000, Respondents registered the <adam-12.org> Domain Name.

In January 2001, Respondents conducted a survey regarding the possible membership fees for accessing the <adam-12.com> website that users found acceptable.

In a January 16, 2001 newsgroup posting, Respondents again offered the <adam-12.com> Domain Name for sale, along with the website, advertising that "one benefit of ownership that [Respondents] have been fortunate enough to be blessed with is that...it has led to offers of collectibles from the show that [Respondents] might not have ever been privy to." Respondent David Burns further stated, "My collection grew significantly due to the association with the website."

After numerous negotiations with Respondents and their counsel, Universal offered to pay Respondents \$1,000 in exchange for transfer of the <adam-12.com>. Respondents rejected Universal's offer of \$1,000, instead demanding that Universal pay no less than \$7,500 in exchange for both of the Domain Names.

## 5. Parties' Contentions

### A. Complainant's contentions

- i. Complainant contends that it is the sole and exclusive owner of all rights in and to the "Adam-12" television series, including trademark, copyright, licensing, and merchandising rights. In that regard, Universal has filed an application for registration of the ADAM-12 mark with the United States Patent and Trademark Office, Serial No. 75/260384.

Complainant further alleges that as a result of the commercial exploitation of the ADAM-12 mark and the incredible publicity surrounding the "Adam-12" series, Universal has developed tremendous goodwill in the ADAM-12 mark, which has become famous both in the United States and internationally. The ADAM-12 mark is inherently distinctive for Universal's goods and services, including but not limited to the television series and related merchandise.

Based on the success of the "Adam-12" television series, including the enormous publicity and commercial exploitation of the ADAM-12 mark for over 25 years, Universal asserts it has developed valuable goodwill in and strong common law rights to the ADAM-12 trademark. ICANN panels have held that Universal need not possess a registered trademark to ask for relief under the Uniform Domain Names Dispute Resolution Policy (Policy). In *British Broadcasting Corp. v. Renteria*, Case No. D2000-0050, (WIPO), the panel explained that paragraph 4(a)(i) of the Uniform Dispute Resolution Policy does not "expressly limit the application of the Uniform Policy to a registered trademark or service mark of the Universal." See also, *Southern Bank and Trust Company v. Pogrebetsky*, Case No.: FA0002000093673 (NAF) (Complainant's common law rights in its trademark constituted valuable and legally protectable rights); *Cedar Trade Associates, Inc. v. Ricks*, File No.: FA0002000093633 (NAF) (Panel found that Complainant had valuable common law trademark rights); *Winterson v. Hogarth*, Case No. D2000-0235 (WIPO) (The Policy does not require a trademark registration in order for Complainant to claim that an identical or confusingly similar domain name infringes on Complainant's trademark rights), *Roberts v. Boyd*, Case No. D2000-0210 (WIPO) (It is sufficient that the Complainant satisfies the Panel that she has rights in common law), *MatchNet plc. v. MAC*

*Trading*, Case No. D2000-0205 (WIPO) (The Policy does not require that a service mark be registered by a government authority).

- ii. Complainant argues that the Domain Names are confusingly similar to the ADAM-12 mark, pursuant to Paragraph 4(a)(i) of the Policy, because they wholly incorporate the trademark ADAM-12 with the addition of descriptive terms.
- iii. Complainant contends that Respondents have no rights or legitimate interests in the Domain Names, pursuant to Paragraph 4(a)(ii), and that Respondents have failed to demonstrate any of the three circumstances that constitute rights to or legitimate interests in the Domain Names.

Complainant contends that Respondents have no connection or affiliation with Complainant, and has not received any license or consent, express or implied, to use the ADAM-12 mark in a domain name or in any other manner.

Complainant contends that Respondents cannot demonstrate rights or legitimate interest in the Domain Names under Paragraph 4(c)(i) because they have not made use, or demonstrable preparations to use, the Domain Names in connection with the bona fide offering of goods or services.

Respondents cannot demonstrate rights or legitimate interests in the Domain Names under Paragraph 4(c)(ii) because they are not known as “Adam-12”.

Respondents cannot demonstrate rights or legitimate interests in the Domain Names under Paragraph 4(c)(iii) because they are not making a legitimate noncommercial or fair use of the Domain Names without the intent to (a) derive commercial gain, (b) misleadingly divert consumers, or (c) tarnish the trademark at issue. Respondents have deliberately registered the Domain Names containing the ADAM-12 trademark to attract the attention of internet users searching for ADAM-12 information or services. Respondents are using the Domain Names to misleadingly divert consumers and tarnish the ADAM-12 trademark. Respondents’ use of the <adam-12.com> Domain Name to sell merchandise provided them a direct financial benefit through the misappropriation and use of the ADAM-12 mark.

- iv. Complainant contends that Respondents registered and is using the Domain Names in bad faith in violation of Paragraph 4(a)(iii).

Complainant contends that Respondents did not use the <adam-12.com> Domain Name until after Respondents received a demand letter from Universal regarding Respondents’ ongoing unauthorized reproduction and distribution of Universal’s copyrighted materials at its website located at <www.sierranet.net>. Further, Respondents did not register <adam-12.org> as a domain name until a year after it received demand letters from Universal relating to its unauthorized use of the <adam-12.com> Domain Name.

Complainant argues that ICANN panels have held that registration and use of a domain name incorporating a famous mark is necessarily in bad faith where a respondent knew at the time of the registration that he could not make any actual use of the registered domain name without infringing on the trademark owner’s rights. For example, the panel in *Cellular One Group v. Brien* Case No.

D2000-0028 (WIPO) held that the respondent's registration of the domain name was necessarily in bad faith since the respondent knew about Cellular One's mark and nevertheless registered a domain name that was entirely composed of that trademark and the country name China. The panel found bad faith registration based on the fact that it would have been impossible for the respondent to "use the domain name as the name of any business... or service for which it would be commercially useful without violating the Complainant's rights" in its trademark. *See also, Telstra Corp. Ltd v. Nuclear Marshmallows*, Case No. D2000-0003 (WIPO) (The respondent's registration of domain names incorporating Complainant's famous trademark was necessarily in bad faith because the respondent must have known that it could not legitimately use the domain name.); *Sanrio Co., Ltd. v. Neric Lau*, Case No. D2000-0172 (WIPO) (Panel found that the respondent's registration of several domain names incorporating Complainant's trademark was in bad faith, when there was no plausible circumstance in which the respondent could have used the domain names).

Complainant contends that Respondents did not demand reimbursement of registration costs for the Domain Names, but instead demanded that Universal pay them for all "costs" relating to the website. Respondents' numerous attempts to sell the Infringing Domain Names for amounts in excess of their registration costs provides even more clear evidence of their bad faith intent. Respondents offered the <adam-12.com> Domain Name for sale through their website, through their listing of the <adam-12.com> Domain Name for sale on eBay with a reserve of well over its actual registration costs, and through their offer to sell both the Domain Names to Universal for \$7,500.

Complainant contends that as a result of Respondents' registration of domain names that incorporate the mark ADAM-12, Universal is precluded from reflecting and commercially exploiting its mark in a related domain name. In *Panavision v. Toepfen*, 141 F.3d 1316, 1325 (9<sup>th</sup> Cir.1998), the Ninth Circuit held that defendant's registration of a domain name incorporating plaintiff's trademark was commercial use because the registration prevented plaintiff from using their trademark commercially on the Internet unless they paid a fee. Similarly, in *ISL Marketing AG v. Chung*, Case No. D2000-0034 (WIPO), the panel found that the respondent's warehousing of multiple domain names incorporating the complainants' trademarks prevented the complainants from reflecting their trademark in a corresponding domain name.

Complainant contends that even after being informed by Universal of its rights to the ADAM-12 mark, Respondents registered the <adam-12.org> Domain Name. Such egregious conduct clearly indicates that Respondents are targeting Universal's ADAM-12 mark and that Respondents are engaged in a pattern of registering domain names that incorporate Universal's ADAM-12 mark. Pursuant to the *Anticybersquatting Consumers Protection Act (ACPA)*, codified at 15 U.S.C. 1125(d)(B)(VIII), the federal courts in the jurisdiction where Respondents reside, and paragraphs 4(a)(iii) and 4(b)(ii) of the Rules, Respondents' conduct constitutes bad faith cybersquatting.

Complainant contends that Respondents operated a commercial website through which it sold "Adam-12" products, and were frustrated that Universal demanded that infringing material be removed from that site. Without the availability of copyrighted video clips and audio clips to attract traffic to its commercial

website, Respondents chose to relocate their website to the <adam-12.com> Domain Name, in order to use that mark to attract traffic to increase their online sales of “Adam-12” merchandise. Respondents knew that such use would attract consumers because consumers would naturally believe that any business at this domain name would be authorized, sponsored or approved of by Universal. Respondents could have chosen to continue to operate their commercial website at the <sierranet.net> website, but instead made the conscious decision to engage in domain name infringement upon receipt of an initial demand letter from Universal. Respondents have no legitimate interests in the Domain Names; rather, they used the Domain Names to confuse consumers into visiting their site, and used the ADAM-12 mark as a direct attack on the copyright owner who days before had requested that they stop their ongoing distribution of infringing materials.

**B. Respondents’ contentions**

- i. Respondents contend that the application to the United States Patent and Trademark Office referenced by Complainant at Serial No. 76260384, indicates an application filed by Universal Studios on May 22, 2001 (3 years after Respondents registered the first Domain Name), is under review. Universal currently holds no trademark or service mark issued by the USPTO. No application was filed when the website “The Adam-12 Home Page” was established in 1995, or when the <adam-12com> Domain Name was registered in 1998.

Respondents further contend that Universal does not meet the technical requirement for a service mark or trademark because its has never done business as <Adam-12.com> or <Adam-12.org> and is not widely known or identified as such, Complainant is widely known as “Universal Studios.”

Respondents contend that Universal’s claims of common law trademark are not within the jurisdiction of the ICANN Panel under many precedents – see *Love Your Neighbor Corp v. LOVEARTH.NET* - Claim Number: FA0105000097197. “The UDRP is of limited application. While Complainant alleges trademark infringement, this is not the forum to present this argument.” See *Commercial Publishing Co. v. Earthcomm, Inc.*, FA 95013 (Nat. Arb. Forum, July 20, 2000) (stating that the policy is only intended to resolve a narrow class of cases).

Respondents contend that Universal is estopped from asserting confusing similarity by its failure to act in defense of its alleged property interests and rights. Complainant, by its consistent failure to act uniformly, has established a pattern of harassment of the Respondents based on its failure to take action against all other parties using similar or like marks and content in like domains. This argument can be compared to a police officer who observes and allows several individuals to break the laws or rules under his direct supervision and then stops and issues a citation to one person based entirely on a subjective basis. This conduct is not only is reprehensible, discriminatory, and unethical, it is a bias that surely cannot be defended – no civil or criminal jury would ever support such inconsistencies.

Respondents contend that Universal has no exclusive rights to the terms “ADAM” and “12” because the terms are generic or descriptive. See *Energy*

*Source Inc. v. Your Energy Source*, FA 96364 (Nat. Arb. Forum February 19, 2001) (finding Respondent has rights and legitimate interests in the domain name where Respondent has persuasively shown that the domain name is comprised of generic and/or descriptive terms, and, in any event, is not exclusively associated with Complainant's business"). The term "A" or phonetic term "Adam" refers to a 2-man patrol car, and "12" refers to a beat (patrol) assignment that is found within numerous police jurisdictions in the United States. The Los Angeles Police Department, and the City of El Segundo and its Police Department have used "Adam" cars well before Universal's claim of trademark of a generic term. The City of Pleasant Hill, California uses the term "Adam-12" as a designator for the Sergeant's Watch Command Patrol Unit – "Adam" meaning Administrative, and "12" meaning the rank and badge number of the Sergeant.

- ii. Respondents assert that the Domain Names are not identical or confusingly similar to the trademark because Complainant's mark is for "ADAM 12". The Respondents use a hyphen in <adam-12.com> and <adam-12.org>.
- iii. Respondents assert that it has rights to or legitimate interests in the Domain Names because Respondents have operated a non-commercial fan based website that simply highlights the fondness and support of a 30 year-old television show and Respondents' hobby interests. Respondents maintain that it has a legitimate interest in law enforcement – hobbies that include, but are not limited to: information related to memorabilia, collectibles, emergency vehicle restoration, emergency vehicle equipment, and public safety communications devices used in the 1960's and 1970's in the television show and used by law enforcement in that period. Respondents maintain a legitimate, non-commercial and fair use of the Domain Names without intent for commercial gain to misleadingly divert consumers or to tarnish the Complainants trademark.

Respondents' interest dates back 20 years. The individual Respondent has been actively involved in emergency services since 1981. The Respondent's father and uncle previously served as line Police Officers in California and the Respondent has established a close professional relationship with many law enforcement agencies as Emergency Services Manager for the City of El Segundo, including the Los Angeles Police Department (hereinafter LAPD) in promoting causes that benefit the community and are affiliated with the Respondent's hobby interests related to the "Adam-12" television show:

The 1973 Matador police car restored by the Respondents is the only known operational vehicle currently in service that was previously affiliated with the Los Angeles Police Department from the original fleet of over 700 Matador police vehicles purchased by the LAPD from 1972-1973. The restoration of the Matador police vehicle was done in coordination with the Adam-12 television show's Production Assistant (1968-1973) and Producer (1973-1975), Tom Williams, who assisted with the restoration project by providing photos and technical advice for the television cars. Other contributors included many active and retired LAPD Officers, fellow collectors, and friends. This project has substantial interest and was highlighted on the domain

Since 1981, the Respondents have been lawfully and legitimately involved in the collection of vintage law enforcement equipment and memorabilia. The collection includes, but is not limited to: vintage police radios and

communications devices dating back to the 1930's, the Matador Police Vehicle, emergency vehicle signaling equipment, law enforcement patches, and law enforcement promotional items associated with radio, television, and motion pictures – including links to law enforcement related television shows.

On or about 1994, Respondents began researching information pertaining to various television series created and produced by Mr. Jack Webb. After a thorough review of the Internet and major Internet Search Engines, nothing was located in reference to the hobby interests of the Respondents. There was no forum or venue anywhere on the Internet in which the Respondents could actively interact with people who shared like interests in his hobby.

On or about 1994, after a thorough and exhaustive review of the Internet Major Search Engines, and the Universal Studios website <universalstudios.com>, the Respondents decided to develop and create a website that would reflect the Respondents' interests in law enforcement, law enforcement television shows produced in the 60's and 70's, one of which was called "Adam-12", and highlight the Respondents' vast collection of law enforcement memorabilia.

On or about June 1995, "The Adam-12 Home Page" was established on a privately hosted server located at <sierra.net/...burnsds/adam12.htm>. The Adam-12 Home Page ran continuously from June 1995 to on or about April of 1998 containing a "Directory of Services" that grew based on the many suggestions and comments of the regular visitors to the website. On or about March 1998, after visits from over 300,000 visitors, the individual Respondent, after researching the process, registered a formal domain <adam-12.com>, a location that could easily be located and reflected the interests of the Respondents. On or about March 1998, Respondents checked the "WHOIS" database for the domain <Adam-12.com> and checked the official Universal Studios website to determine if an official website related to Adam-12 was in place. No sites existed. On or about March 1998, Respondents searched the United States Patent and Trademark Office (USPTO) - Trademark Electronic Search System (TESS) database for the criteria of "Adam-12" - no record was present. On or about March 1998, Respondents registered the domain <Adam-12.com> in good faith with Network Solutions (NSI) through Sirius Connections.

The website <adam-12.com> audience has grown significantly since 1995. It has an audience over 1.3 million visitors, links to 2 chat groups with over 300 registered members, and many popular areas of mutual interest.

Respondents did make solicitations for donations for legal expenses, which is a non-commercial purpose. Respondents never received any money from the solicitation. Respondents, while offering to provide or give away photos from their private property collection for donations, did not actually provide photos and no donations were ever collected. Complainant offers no evidence to substantiate harm.

Respondents admit that a book was offered for sale on the website, but maintain that Complainant has no basis to assert it can or may authorize the activity of a citizen expressing a free speech rights by publishing an informational booklet. The Booklet was titled as – "The One-Adam-12 Television Companion" - this is not a mark that Universal alleges to own and has submitted no evidence to

substantiate its claim. The booklet contained a complete episode guide and recording checklist, and a technical users guide to assist hobbyists with VHS recording at home using a standard VHS recorder. The booklet contained a total of 4 images that never have been the property of the Complainant. About 125 booklets were privately reproduced at a cost of \$16.85 and shipped for a flat fee of \$3.20 for United States Postal Service Priority Mail charge for a grand total of \$19.85 each – the .15 cents change left over amounted to \$18.75 total. Each order was pre-paid, meaning the booklet was never created directly for sale or profit. The booklets were reproduced solely on the basis of the actual costs for reproduction. The Respondents are not required by any law to seek approval to create a booklet that is a statement of fact and an expression of free speech under the U.S. Constitution.

Respondents (as an individual and newsmagazine) are now commonly known by the Domain Name <adam-12.com> in issue, even if Respondents have acquired no trademark or service mark rights. The basis for this is established by the continuous use of the domain address for over 3 years, and other locations 4 years prior, for a total of 7 years of legitimate use.

- iv. Respondents deny that they registered or used the Domain Names in bad faith. Paragraph 4(b) suggests four types of evidence of bad faith registration, none of which apply:

Respondents assert that no formal offer was ever made to Universal by the Respondents in 1998. Respondents' legitimate out-of-pocket costs invested in the domain content, hosting – server fees, and development exceed well over \$10,000.00. This cost is well within the parameters of ICANN Policy, 4(b)i. Respondents did not register the domains with the purpose of sale, rental, or other transfer. The Respondents do not deny that while it has on occasion, offered the domain for sale to other interested parties to recoup its "out-of-pocket" costs of \$10,500.00 over the past 7 years, it has always been conditional on the issue of providing content.

On June 16, 2000, Respondents listed the <adam-12.com> Domain Name for sale on the online auction site eBay, the Domain Name was offered for sale with a reserve amount of \$7,500.00 to recoup "out-of-pocket costs associated with running the website for the previous 5 years. The site had "out-of-pocket" costs between \$1500.00 and \$2000.00 per year for hosting fees, software, and content development since 1995. Respondents attempted to recoup these costs and offered the site within the rights as the lawful and registered owner of the Domain Names and had conditions attached to ensure "fair use" of the Domain Names if they were sold, which they were not.

Respondents have maintained a disclaimer since its inception. The Respondents assert in a reasonable argument, that nobody realistically believes the site is actually affiliated with Universal, or is endorsed by Universal, or is an "official" site maintained by Universal Studios.

Respondents posted content relating to the "Adam-12" television series at the <adam-12.com> Domain Name immediately after registering the Domain Name earlier on April 12, 1998. It should be noted that no other site provided any content associated with "Adam-12" prior to the Respondents' registration of the Domain Name. Respondents activated the Domain Name on the same day the

service and IP addresses were established. Preparation for the creation and registration of the Domain Name began on or about March 1998.

The <adam-12.org> Domain Name was established and registered in consideration of charitable and/or non-profit associations. Respondents felt that providing content on the <adam-12.org> website designated as “non-profit” without a strong plan to associate with charitable and/or non-profit organizations would demonstrate bad faith. Respondents chose not place content because plans to establish content did not come to fruition.

- v. Respondents ask the Panel to make a finding of reverse domain name hijacking based on inaccurate statements, outright harassment, and a complaint that is based on extreme speculation, theory, and misleading statements submitted in the complaint.

## 6. Discussion and Findings

Paragraph 15(a) of the Rules instructs the Panel as to the principles the Panel is to use in determining the dispute: “A Panel shall 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.”

Because both the Complainant and Respondents are domiciled in the United States and United States courts have recent experience with similar disputes, to the extent that it would assist the Panel in determining whether the Complainant has met its burden as established by Paragraph 4(a) of the Policy, the Panel shall look to rules and principles of law set out in decisions of the courts of the United States. *Tribeca Film Center, Inc. v. Brusasco-Mackenzie*, Case No. D2000-1772 (WIPO April 10, 2001), n. 3.

### Enforceable Trademark Rights

Complainant has not shown that it has any registrations of the ADAM-12 trademark. The pending application before the United States Patent and Trademark Office was made after Respondents had already registered the <adam-12.com> Domain Name and posted content on the <adam-12.com> website.

Complainant asserts that it has common law trademark rights in the phrase “adam-12,” because of its long use of the phrase in conjunction with its television show. Respondents asserts that this Panel lacks the power to find that a common law trademark exists and that the phrase <adam-12.com> is too generic or descriptive for Complainant to claim as a trademark.

An individual or entity may be entitled to a common law trademark or service mark without registering the mark with the appropriate authority. *See, Steven Rattner v. BuyThis Domain Name*, (WIPO D2000-0402); *Jeanette Winterson v. Mark Hogarth*, (WIPO D2000-0235); *Roberts v. Boyd*, (WIPO D2000-0210). To establish common law trademark, the Complainant must show that the name “Adam-12” has achieved sufficient secondary meaning or association with Complainant.

This result is consistent with United States trademark law in which names are protectable as trademarks or service marks upon a showing that the name has become

distinctive through the acquisition of secondary meaning. *See Adray v. Adray-Aart, Inc.*, 68 F.3d 362 (9<sup>th</sup> Cir. 1995), amended on other grounds, 76 F.3d 984 (9<sup>th</sup> Cir. 1996) (personal names are capable of becoming strong trademarks upon a showing of secondary meaning). *See also, McCarthy on Trademarks and Unfair Competition* '13:2 (4<sup>th</sup> ed. 2000). Secondary meaning is the consumers' association of the mark with a particular source or sponsor and is established out of long association of the name with the business, whereby the name and the business have become synonymous in the mind of the public, submerging the primary meaning of the name in favor of its meaning as a word identifying that business. *See Visser v. Macrese et al.*, 214 Cal. App. 2d 249, 253, 29 Cal. Rptr. 367, 369 (Cal. Dist. Ct. App. 4<sup>th</sup> 1963); *see also Levis Strauss & Co. v. Blue Bell, Inc.*, 778 F.2d 1352, 1354 (9<sup>th</sup> Cir. 1991) (en banc). In assessing secondary meaning, one must consider a variety of factors, including, but not limited to, A(1) advertising expenditures, (2) consumer ... linking [of] the mark to the source, (3) unsolicited media coverage of the product, (4) sales success, ... and [(5)] length and exclusivity of the marks use. @ *Paco Sport, Ltd. v. Paco Rabanne Parfums*, 86 F.Supp. 2d 305, 313 (S.D.N.Y. 2000) (quoting *Centaur Communications, Ltd. v. A/S/M Communications, Inc.*, 830 F.2d 1217, 1222 (2d. Cir. 1987).

Complainant has shown that the "Adam-12" television series has generated enormous publicity and public recognition for over 25 years. The evidence offered by Universal is sufficient to show that secondary association exists among the public relating the phrase "Adam-12" to the television show produced by Universal. Therefore, the Panel finds that Universal has developed common law rights to the ADAM-12 trademark. ICANN panels have held that Universal need not possess a registered trademark to ask for relief under the Uniform Domain Names Dispute Resolution Policy (Policy). In *British Broadcasting Corp. v. Renteria*, Case No. D2000-0050, (WIPO), the panel explained that paragraph 4(a)(i) of the Uniform Dispute Resolution Policy does not "expressly limit the application of the Uniform Policy to a registered trademark or service mark of the Universal." *See also, Southern Bank and Trust Company v. Pogrebetsky*, Case No.: A0002000093673 (NAF) (Complainant's common law rights in its trademark constituted valuable and legally protectable rights); *Cedar Trade Associates, Inc. v. Ricks*, File No.: FA0002000093633 (NAF) (Panel found that Complainant had valuable common law trademark rights); *Winterson v. Hogarth*, Case No. D2000-0235 (WIPO) (The Policy does not require a trademark registration in order for Complainant to claim that an identical or confusingly similar domain name infringes on Complainant's trademark rights), *Roberts v. Boyd*, Case No. D2000-0210 (WIPO) (It is sufficient that the Complainant satisfies the Panel that she has rights in common law), *MatchNet plc. v. MAC Trading*, Case No. D2000-0205 (WIPO) (The Policy does not require that a service mark be registered by a government authority).

While the name "adam" and the number "12" may be generic and/or descriptive when used separately, when they are used together they are sufficiently distinctive to support the Panel's finding of secondary association.

Therefore, the Panel finds that it has the power to find that Complainant enjoys the rights of a common law trademark, that the phrase "adam-12" is not so generic or descriptive as to prevent it from being a trademark and that Complainant has shown that the phrase has acquired the status of a common law trademark.

### **Identity or Confusing Similarity**

Complainant further contends that the Domain Names are identical with and confusingly similar to the trademark pursuant to the Policy paragraph 4(a)(i).

Complainant argues that the Domain Names are confusingly similar to the ADAM-12 mark, pursuant to Paragraph 4(a)(i) of the Policy, because they wholly incorporate the trademark ADAM-12 with the addition of descriptive terms.

Respondents assert that the Domain Names are not identical or confusingly similar to the trademark because Complainant's mark is for "ADAM 12". The Respondents use a hyphen in <adam-12.com> and <adam-12.org>.

As numerous courts and prior ICANN panels have recognized, the incorporation of a trademark in its entirety is sufficient to establish that a domain name is identical or confusingly similar to the complainant's registered mark. See *Paccar Inc. v. Telescan Technologies, L.L.C.*, 115 F. Supp. 772 (E.D. Mich. 2000) (finding that <peterbuilttrucks.com>, <kenworthtrucks.com> and similar domain names are not appreciably different from the trademarks PETERBUILT and KENWORTH); *Quixar Investments Inc. v. Dennis Hoffman*, Case No. D2000-0253 (WIPO May 29, 2000) (finding that QUIXTAR and <quixtarmortgage.com> are legally identical). The addition of other terms in the domain name does not affect a finding that the domain name is identical or confusingly similar to the complainant's registered trademark.

The Panel notes that the entirety of the ADAM-12 trademark is included in each of the Domain Names.

Generally, a user of a mark "may not avoid likely confusion by appropriating another's entire mark and adding descriptive or non-distinctive matter to it." 3 J. Thomas McCarthy, *McCarthy on Trademarks & Unfair Competition* § 23:50 (4<sup>th</sup> ed. 1998). *Adaptive Molecular Tech., Inc. v. Woodward*, WIPO Case No. D2000-0006 (February 28, 2000) (finding that a domain name was "undoubtedly" confusingly similar because it incorporated the "primary, distinctive element of both of Complainant's trademarks.") Moreover, in determining the similarity of two marks, points of similarity are weighed more heavily than points of difference. See, *GoTo.com, Inc. v. Walt Disney Co.*, 202 F.3d 1199, 1206 (9th Cir. 2000); *Brookfield Communications, Inc. v. West Coast Entertainment Corp.*, 174 F.3d 1036, 1054-55 (9<sup>th</sup> Cir. 1999).

The addition of the phrase ".com" in the <adam-12.com> Domain Name is non-distinctive because it is a gTLD required for registration of a domain name. Respondents' addition of the gTLD ".org" in the <adam-12.org> Domain Name is non-distinctive because it is also required for registration. Furthermore, Respondents' addition of the hyphen in the Domain Names is non-distinctive. *Teradyne, Inc. v. 4Tel Technology*, WIPO Case No. D2000-0026 (May 9, 2000) ("The addition of a hyphen to the registered mark is an insubstantial change.")

Therefore, the Panel finds that the Domain Name is confusingly similar to the ADAM 12 mark pursuant to the Policy paragraph 4(a)(i).

#### **Rights or Legitimate Interest.**

Complainant contends that Respondents have no rights or legitimate interest in the Domain Names pursuant to the Policy paragraph 4(a)(ii).

Paragraph 4(a)(ii) requires the Complainant to prove that the Respondents have no rights to or legitimate interests in the Domain Names. Once a Complainant establishes a prima facie showing that none of the three circumstances establishing legitimate interests or rights applies, the burden of production on this factor shifts to the Respondents to rebut the showing. The burden of proof, however, remains with Complainant to prove each of the three elements of Paragraph 4(a). *See Document Technologies, Inc. v. International Electronic Communications, Inc.*, Case No. D2000-0270 (WIPO June 6, 2000).

Complainant has shown that Respondents have no relationship with or permission from Complainant for the use of the ADAM-12 mark.

Complainant contends that Respondents have not made a bona fide offering of goods or services because the content of Respondents' website contained video clips and other images from the Adam 12 Television Show, which were infringing upon Complainant's copyrights. Furthermore, Respondents used the website to raise money for their legal fight over the Domain Names and for the sale of merchandise, which constitutes commercial activity.

Finally, Respondents have no corporate name, fictitious business name or other indication that they have been commonly known by the name "Adam-12".

Based upon this showing, Complainant has established a prima facie case that Respondents have no rights or legitimate interest in the Domain Names.

The Policy paragraph 4(c) allows three nonexclusive methods for the Respondents to demonstrate that they have rights or a legitimate interest in the Domain Names:

- (i) before any notice to you [Respondent] 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
- (ii) you [Respondent] (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
- (iii) you [Respondent] 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.

Respondents assert that they have rights to or legitimate interests in the Domain Names because Respondents have operated a non-commercial fan based website that simply highlights the fondness and support of a 30 year-old television show and Respondents' hobby interests. Respondents maintain that they have a legitimate interest in law enforcement – hobbies that include, but are not limited to: information related to memorabilia, collectibles, emergency vehicle restoration, emergency vehicle equipment, and public safety communications devices used in the 1960's and 1970's in the television show and used by law enforcement in that period. Respondents maintain a legitimate, non-commercial and fair use of the domain name without intent for

commercial gain to misleadingly divert consumers or to tarnish the Complainant's trademark.

Complainant's have shown that on or around May 13, 1998, Respondents posted on their website, located at the <adam-12.com> Domain Name, solicitations for "donations" to support "potential legal costs" and web hosting costs for the <adam-12.com> website. Respondent David Burns offered for sale an 8"x10" image from the "Adam-12" television series in exchange for each \$25 "donation."

In February 1999, Respondents published and offered for sale through the website at the <adam-12.com> an unauthorized book containing trivia, an episode guide, and images relating to the "Adam-12" television series, for \$20 per copy.

Although Respondents assert that the Domain Names are being used as a fan site, Complainant has demonstrated sufficient commercial use that the Panel finds Respondents have failed to show the existence of any of the elements for any of the three nonexclusive methods provided for in the Policy paragraph 4(c). The Panel also finds that Respondents have offered no evidence that they have been commonly known as "Adam-12." Therefore, the Panel finds that Respondents have no rights or legitimate interest in the Domain Names pursuant to the Policy paragraph 4(a)(ii).

The Panel also recognizes the "free speech" concerns which the Respondent has raised regarding his use of the domain name <adam12.com> in conjunction with what he views as a fan site for the Adam 12 television show.

Now, let us assume *arguendo* and in a light most favorable to the Respondent that his site constitutes a fan site. In such instances, where free speech issues are raised, i.e. where transfer of a contested domain name is alleged to constitute an unconstitutional prior restraint on a respondent's speech, a panel, under the specific facts presented, must evaluate those issues from the context of any damage that might arise to a respondent if his (her) use of that domain name were to cease, and specifically whether any reasonable alternatives were available or not to that respondent that would afford him (her) an alternate avenue to exercise his free speech rights to post a fan site but without using the contested domain name. Since the respondent is arguing to retain a contested domain name for use with its fan site, it makes clear sense to impose a burden on the respondent to show why it could not maintain its fan site, hence exercise its right of free speech, but for use of the contested domain name. In essence, the respondent is charged with showing that no other reasonable alternatives were then available to him (her) but to use that name in order to fully exercise its rights of free speech to present a fan site. Here, the Respondent made no such showing. In fact, the Respondent has posted its fan site for several years (between approximately June 1985 to on or about April 21, 1998) to a prior web address, <www.sierranet.net/~burnsds/adam12.htm> which did not contain the Complainants' mark as a domain name. Only after he registered the contested domain name <adam12.com> and "on the same day the service and IP addresses were established" (Response, page 6, paragraph 3(a)) did the Respondent change the address of his site from the prior address to <adam12.com>.

Given this, it seems eminently reasonable to this Panel that the Respondent could and did have an ample opportunity to continue his fan site and hence fully exercise his free speech rights without violating the Complainant's "Adam 12" mark by simply maintaining his fan site accessible through its prior web address. The Respondent simply chose not to do so. The record reflects that the Respondent changed the

address of its site to <adam12.com> because that domain name provided "a location that could easily be located and reflected the interests of the Respondent" (Response, page 10, paragraph 3(s)). Convenience-based arguments alone are hardly ever sufficient justification to permit such use, by a fan site owner, of a domain name that is identical or confusingly similar to a complainant's mark. The Respondent must simply show considerably more to justify his retention and use of the contested domain name <adam12.com> as the address of his fan site, and here did not.

In view of the Respondent's stated reason for selecting the contested domain, it is inconceivable that he was unaware of the trademark rights which the Complainant had in its "Adam 12" mark when the Respondent registered the <adam12.com> domain name and then, very shortly thereafter, modified its site so as to be accessible through that particular name.

The Panel expresses no opinion as to whether, by virtue of the Complainant's material, e.g. video clips and other takings, which the Respondent has incorporated into his site, the Respondent has violated any copyrights of the Complainant -- as any such determination is outside of the Panel's purview.

### **Bad Faith.**

Complainant contends that Respondents registered and is using the Domain Names in bad faith in violation of the Policy paragraph 4(a)(iii).

The Policy paragraph 4(b) sets forth four nonexclusive criteria for Complainant to show bad faith registration and use of domain names:

- (i) circumstances indicating that you have registered or you have acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of your documented out-of-pocket costs directly related to the domain name; or
- (ii) you have registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that you have engaged in a pattern of such conduct; or
- (iii) you have registered the domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your website or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of your website or location or of a product

Complainant has alleged that Respondents' actions are sufficient to show the elements of bad faith under the Policy, paragraphs 4(b)(iv), among others.

Attraction for Commercial Gain Through Confusion 4(b)(iv).

Complainant alleges that the Respondents have intentionally attempted to attract Internet users for commercial gain by creating a likelihood of confusion.

Complainant has established that Respondents operated a commercial website through which it sold "Adam-12" products. Respondents have admitted that they made solicitations for donations for legal expenses, but assert that soliciting legal expenses is a non-commercial purpose. Respondents argue that they never received any money from the solicitation. Respondents, while offering to provide or give away photos from their private property collection for donations, did not actually provide photos and no donations were ever collected.

Respondents also admit that a book was offered for sale on the website, but maintain that Complainant has no basis to assert it can or may authorize the activity of a citizen expressing a free speech rights by publishing an informational booklet. The Booklet was titled as – "The One-Adam-12 Television Companion" - this is not a mark that Universal alleges to own and has submitted no evidence to substantiate its claim. The booklet contained a complete episode guide and recording checklist, and a technical users guide to assist hobbyists with VHS recording at home using a standard VHS recorder. The booklet contained a total of 4 images that never have been the property of the Complainant. About 125 booklets were privately reproduced at a cost of \$16.85 and shipped for a flat fee of \$3.20 for United States Postal Service Priority Mail charge for a grand total of \$19.85 each – the .15 cents change left over amounted to \$18.75 total. Each order was pre-paid, meaning the booklet was never created directly for sale or profit. The booklets were reproduced solely on the basis of the actual costs for reproduction. The Respondents are not required by any law to seek approval to create a booklet that is a statement of fact and an expression of free speech under the U.S. Constitution.

The Panel finds that the failure to make a profit is not sufficient to remove the commercial nature of the activities conducted on Respondents' website.

Of critical importance on the Internet is the routing or diversion of traffic to one's website. The use of a well-known trademark in a domain name allows the entity registering the domain name to capture traffic and point or divert it to another website.

However, Courts have recognized that consumers expect to find a company on the Internet at a domain name address comprised of the company's name or trademark. *See Panavision Int'l, L.P. v. Toeppen*, 141 F.3d 1316, 1327 (9th Cir. 1998) ("A customer who is unsure about a company's domain name will often guess that the domain name is also the company's name . . . [A] domain name mirroring a corporate name may be a valuable corporate asset, as it facilitates communication with a customer base." (citations omitted)). Thus, consumers would expect to find an official Adam-12 website sponsored by Universal at a domain name comprised of the ADAM-12 mark.

Respondents also argue that they have included a disclaimer on the website, thus alleviating any likelihood of confusion.

The use of a disclaimer by Respondents are not sufficient to create a defense to bad faith under Paragraph 4(b)(iv) of the Policy. *See Brookfield Communs*, 174 F.3d at 1057 (discussing likelihood of confusion and noting that "Web surfers are more likely to be confused as to the ownership of a website than traditional patrons of a brick-and-mortar store would be of a store's ownership," and that even where people realize, immediately upon accessing the complained-of website, that they have reached a site operated by someone other than the trademark owner, the infringing website will still have gained a customer by appropriating the goodwill of the trademark owner).

The Panel finds that Complainant has demonstrated the existence of the criteria in the Policy paragraph 4(b)(iv) and that Respondents registered and used the Domain Name in bad faith pursuant to the Policy paragraph 4(a)(iii).

Reverse Hijacking.

Complainant has prevailed on its claim and, therefore, has not engaged in reverse hijacking.

**7. Decision**

The Panel concludes (a) that the Domain Names <adam-12.com> and <adam-12.org> are identical with and confusingly similar to Complainant's common law trademark ADAM-12, (b) that Respondents have no rights or legitimate interest in the Domain Names and (c) that Respondents registered and used the Domain Names in bad faith. Therefore, pursuant to paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the Domain Names be transferred to Complainant.

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Richard W. Page, Esq.  
Presiding Panelist

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Terrell C. Birch, Esq.  
Panelist

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Peter L. Michaelson, Esq.  
Panelist

Dated: October 1, 2001