



WIPO Arbitration and Mediation Center

ADMINISTRATIVE PANEL DECISION

Estate of Frank Gorshin v. [no name provided in the Whois] aka Terry Martin

Case No. D2005-0803

1. The Parties

Complainant is the Estate of Frank Gorshin, Beverly Hills, California, United States of America, represented by Isaacman, Kaufman & Painter, United States of America.

According to the administrative contact and technical contact information provided in the Whois search report, Respondent is Terry Martin with the email address tmartin@[e-mail address]. No information is provided in the Registrant section of the Whois search report.

2. The Domain Name and Registrar

The disputed domain name <frankgorshin.com> is registered with Go Daddy Software.

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on July 27, 2005. Complainant's inquiries revealed that Terry Martin is located at Time Machine Collectibles, Walla Walla, Washington, United States of America, and the Complaint was sent to Terry Martin at that address. On July 29, 2005, the Center transmitted by email to Go Daddy Software a request for registrar verification in connection with the domain name at issue. On July 29, 2005, Go Daddy Software transmitted by email to the Center its verification response stating that there is no registrant identified for the domain name, and providing the contact details for the administrative, billing, and technical contact which consist only of the email address tmartin@[e-mail address]. The Center verified that the Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the "Policy"), the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules"), and the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the "Supplemental Rules").

In accordance with the Rules, paragraphs 2(a) and 4(a), the Center formally notified Respondent of the Complaint, and the proceedings commenced on August 2, 2005. In accordance with the Rules, paragraph 5(a), the due date for the Response was August 22, 2005. An uncertified Response was filed by e-mail with the Center on August 11, 2005, by Terry Martin.

In the Response, Terry Martin states, “We have received the claim made by the attorney for the Frank Gorshin estate. Since our agreement was with Frank and that agreement now is no longer with Frank, as his widow is his rightful heir we do not have a problem with transferring the name if that is her request.”

Upon receipt of this Response, the Center forwarded a copy to Complainant and asked if Complainant would like to continue the proceedings or suspend the case pending a potential settlement. On August 19, 2005, Complainant’s counsel forwarded an email response to Respondent asking Respondent to transfer the domain name to Complainant’s counsel on behalf of Christina Gorshin, executrix of the estate of Frank Gorshin. There is no record of any response to this email. On August 23, 2005, Complainant notified the Center that it wished to continue the proceedings.

The Center appointed Lynda J. Zadra-Symes as the sole panelist in this matter on September 16, 2005. The Panel finds that it was properly constituted. The Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Center to ensure compliance with the Rules, paragraph 7.

On October 14, 2005, the Center issued Procedural Order No. 1 to the parties requesting further information in support of certain allegations in the Complaint and Response.

On October 17, 2005, Complainant filed a response to Procedural Order No. 1, with supporting documentation.

On October 24, 2005, an apparent representative of Respondent, Ken Melhus, filed a response to Procedural Order No. 1, in which he stated, “I want to reiterate that we are fully willing to transfer the domain.” Like the first Response, this was uncertified and unaccompanied by any supporting documentation.

4. Factual Background

Complainant is the estate of the actor Frank Gorshin whose numerous television roles have included the role of “The Riddler” on the *Batman* program and, just prior to his death on May 17, 2005, playing himself on *CSI Crime Scene Investigation* on CBS-TV. Complainant contends that Mr. Gorshin was a well-known and internationally recognizable actor and impressionist whose high profile and worldwide presence has been seen and heard in television and film for close to the last 50 years.

Upon the death of her late husband in May 2005, Christina Gorshin, the estate’s executrix, determined to register his name as a domain name in order to market and advertise his profile to his fans and other interested persons. At such time, Complainant learned that Respondent had previously registered the Domain Name on or about December 27, 1998.

5. Parties' Contentions

A. Complainant

Complainant contends that Respondent does not have the right to use the name "Frank Gorshin" in respect of Respondent's web site and, in doing so, is in violation of Complainant's rights.

Complainant contends that Respondent is an autograph hound who attends various tradeshows, notably "Star Trek," "Babylon 5" and other science fiction conventions, where he prevails on celebrities to sign autographs and, in some cases, to pose for photographs with him.

Complainant alleges that in order to market such items relating to Frank Gorshin Respondent created a so-called "official Web-site," and in doing so, is and has been cyber-squatting upon the decedent's name, in violation of Complainant's trademark and right of publicity. Complainant contends that the Web site promotes Respondent as the decedent's "Web master" and the items sought to be sold in a false light, without authority.

Complainant alleges that during the decedent's lifetime, the decedent made repeated effort to put an end to the online business which Respondent touts as "The Official Frank Gorshin Web Site." As evidence of such effort, Complainant originally submitted only one email, dated April 17, 2005, from John Stacks, allegedly the builder of the decedent's own Web site when living ("www.therealfrankgorshin.com"). In that email, Mr. Stacks wrote to Respondent Terry Martin asking him to transfer the Domain Name to the decedent (Annex 3 of the Complaint). According to Complainant, this request was ignored.

Complainant contends that Respondent also purports to operate "The Official Web Site[s]" of several other professional actors and that such conduct evidences a pattern of willful infringement of the rights of others.

Complainant has entered into agreements authorizing certain other websites, notably "www.therealfrankgorshin.com", to market products bearing the name and likeness of Frank Gorshin. Complainant contends that this is the only "official" Frank Gorshin Web site.

The Panel's Procedural Order No. 1 requested that Complainant provide further evidence of the alleged repeated efforts made by Frank Gorshin and/or Complainant to have the disputed domain name transferred or canceled by Respondent.

In its response to Procedural Order No. 1, Complainant submitted email correspondence from May and December 2004, and April 2005, between Frank Gorshin's representative and Respondent requesting that the disputed domain be transferred to Frank Gorshin.

B. Respondent

Respondent contends that he entered into an agreement with Frank Gorshin over seven years ago to create the "www.frankgorshin.com" site at the decedent's request and at Respondent's initial and continued expense. Respondent contends that he paid the decedent to sign Respondent's photos that Respondent then merchandised on the "www.frankgorshin.com" site. Respondent contends that all the photos were sent to the

decedent with full payment for each signature, and that Respondent was “in contact with this arrangement with Frank until the month he died.” Respondent further contends that during the seven year duration of Respondent’s contract with the decedent, the decedent signed a contract for additional items, including trading cards, and continually received photos and checks for his autographs. Respondent further contends that, even though a friend of the decedent had created an additional site to sell his figures and drawings, the decedent told Respondent not to transfer the name to anyone, and that the arrangement between the decedent and Respondent was by far the decedent’s best producing site.

Respondent also claims that no one from the estate of Frank Gorshin had contacted Respondent until Respondent received a copy of the filed Complaint.

Finally, Respondent claims that he has never sold a domain name.

The Panel’s Procedural Order No. 1 requested that Respondent substantiate its claims by providing the Panel with copies of documentation evidencing the agreement referred to in the Response. Respondent did not submit any such evidence.

Indeed, neither the original Response nor the subsequent response to Procedural Order No. 1 contain any documentary evidence to support Respondent’s assertions. In addition, Respondent failed to certify either response, despite the request for such certification in Procedural Order No. 1. Thus, there is no evidence in the record to support Respondent’s assertions.

6. Discussion and Findings

According to Paragraph 4(a) of the Policy, Complainant must prove that:

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

A. Identical or Confusingly Similar

Frank Gorshin is the actual birth name of the actor, Frank Gorshin, and was used by him professionally in motion picture and television since the mid 1950’s. Complainant contends that the actor developed common law trademark rights in his name and that the Domain Name bears a confusing similarity to that name.

Complainant contends that persons seeking to reach out to Frank Gorshin have been misled and confused by the similarity of Complainant’s and the decedent’s trademark and the contested Domain Name. Complainant contends that the Domain Name adopted by Respondent infringes upon the name and trademark of Complainant and clearly causes a likelihood of confusion.

The Panel finds that the actor Frank Gorshin developed common law trademark rights in his name and that the Domain Name is identical or confusingly similar to that name.

B. Rights or Legitimate Interests

Complainant must show that Respondent has no rights or legitimate interests in respect of the Domain Name. Respondent may establish a right or legitimate interest in a disputed Domain Name by demonstrating that, in accordance with Paragraph 4(a)(ii) of the Policy:

- (i) Before any notice to Respondent of the dispute, its 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) Respondent (as an individual, business, or other organization) has been commonly known by the Domain Name, even if it has acquired no trademark or service mark rights; or
- (iii) Respondent is making a legitimate noncommercial or fair use of the Domain Name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

Complainant contends that Respondent has received no license or other grant of authority from the decedent or Complainant to use the mark embodied in the Domain Name.

In his uncertified Response, Respondent contends that he had an agreement with the decedent, Frank Gorshin, to pay for the actor's signatures on photographs and trading cards that were subsequently offered for sale on Respondent's web site. However, despite the Panel's request that Respondent submit evidence of such agreement, Respondent has not submitted any such evidence.

Complainant contends that "decedent made repeated effort to put an end to the [Respondent's] online business" and submitted an email sent to Respondent in April 2005 from John Stacks, "the builder of the decedent's own Web site when living ("www.therealfrankgorshin.com"). In that email, Mr. Stacks states:

"Terry I ask again that you consider the transferring the domain www.frankgorshin.com to Frank. Terry I am sure you are aware of Cyber Squatting and the WIPO Arbitration and Mediation Center <http://arbiter.wipo.int/center/faq/domains.html>. Terry if this can not be resolve with you surrendering the domain, then Frank will file a complaint. Please try to work with him on this, you will find if you have a problem with Frank it could cause more problems with your other clients. Please respond ASAP.. John Stacks"

In response to the Panel's request for further evidence of Complainant's or Frank Gorshin's repeated demands that Respondent transfer the disputed domain name, Complainant submitted additional emails sent to Respondent in May and December 2004, in which Mr. Stacks stated that he was working with Frank Gorshin's family "in trying to get all his things in order" and invited Respondent to contact Frank Gorshin if Respondent had any doubt that Frank Gorshin wanted the domain name to be transferred.

In the event there was a consent from the actor, by filing its Complaint in this dispute, the Estate of Frank Gorshin has revoked such prior consent to use the decedent's name in the Domain Name. The Panel concludes that Respondent has no rights or legitimate

interests in respect of the Domain Name.

C. Registered and Used in Bad Faith

For the purposes of paragraph 4(a)(iii) of the Policy, the following circumstances, in particular, but without limitation, if found by the Panel to be present, shall be evidence of the registration and use of a Domain Name in bad faith:

- (i) circumstances indicating that Respondent has registered or has acquired the Domain Name primarily for the purpose of selling, renting or otherwise transferring the Domain Name registration to Complainant who is the owner of the trademark or service mark or to a competitor of that Complainant, for valuable consideration in excess of Respondent's out-of-pocket costs directly related to the Domain Name; or
- (ii) Respondent has 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 Respondent has engaged in a pattern of such conduct; or
- (iii) Respondent has registered the Domain Name primarily for the purpose of disrupting the business of a competitor; or
- (iv) by using the Domain Name, Respondent has intentionally attempted to attract, for commercial gain, Internet users to its website or other on-line location, by creating a likelihood of confusion with Complainant's mark as to the source, sponsorship, affiliation, or endorsement of Respondent's web site or location or of a product or service on Respondent's web site or location.

The record lacks any evidence to support Respondent's assertions of an agreement with Frank Gorshin allowing Respondent to register and maintain the disputed domain name. The record indicates that Respondent's use of the disputed domain name is causing a likelihood of confusion with Complainant's mark as to the source, sponsorship, affiliation or endorsement of Respondent's web site or location or of products on Respondent's web site or location.

Based on the case file, the Panel finds that Respondent's registration and use of the disputed Domain Name is in bad faith.

7. Decision

For the foregoing reasons, the Panel directs that the disputed domain name be transferred to Complainant.

Lynda J. Zadra-Symes
Sole Panelist

Date: October 31, 2005