

LAW OFFICE OF SHERMAN G. FINESILVER

December 31, 2001

VIA FACSIMILE & FEDERAL EXPRESS
FAX #(212) 949-8859

Mr. Allen Glover
Panels Administrator
CPR Institute for Dispute Resolution
366 Madison Avenue
New York, New York 10017-3122

Re: Estate of Shel Silverstein v. CostNet
ShelSilverstein.com
CPR Case No.: CPR0114
Date of Commencement: November 28, 2001

Dear Mr. Glover:

I am herewith enclosing three executed copies of the Administrative Panel Decision by the appointed administrator in this interesting domain-related case.

I sincerely appreciate the opportunity of serving as a neutral in a matter relating to nationally known literary works authored by Shel Silverstein.

Sincerely,

/ s / Sherman G. Finesilver

Judge Sherman G. Finesilver

SGF:tw

Enclosures

C P R Institute for Dispute Resolution

ADMINISTRATIVE PANEL DECISION

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COMPLAINANT

Estate of Shel Silverstein
Ms. Peggy Myers,
Personal Representative
c/o Donald A. Hamburg, Esq.
Golenbock, Eiseman, Assor, Bell & Peskoe
437 Madison Avenue
New York, NY 10022
Telephone: (212) 907-7380
Fax: (212) 754-0330
E-Mail: dhamburg@golenbock.com

File Number: CPR0114
Date of Commencement:
November 28, 2001
Domain Name: ShelSilverstein.com
Registrar: Register.com

RESPONDENT

CostNet
P.O. Box 337-2300
San Jose, Costa Rica
Telephone: (506) 255-2474
Fax: (unknown)
E-Mail: Hubmedia@bigfoot.com

Before: Hon. Sherman G. Finesilver, Arbitrator

Under the ICANN Uniform Domain Name Dispute Resolution Policy
Internet Corporation for Assigned Names and Numbers

Procedural History and Background

The Complaint was received by CPR on November 21, 2001, and after review for administrative compliance, was served on the Respondent. The Respondent failed to file a response within the timeframe permitted under ICANN Rule 5(a). I was appointed as Arbitrator pursuant to the Uniform Domain Name Dispute Resolution Policy (“UDRP”) and Rules promulgated by the Internet Corporation for Domain Names and Numbers (“ICANN”). Upon the written submitted record, including the Domain Name Dispute Complaint Form, Complaint with Exhibits A and B, and careful consideration of certification by counsel as to the completeness and accuracy of recitals in written submissions, I find as follows:

As outlined in Exhibit A, Shel Silverstein’s authorship of literary works is noteworthy. He is a world-known author of books for children and adults, composer of songs (many of which attained national recognition), and an author of short stories, poetry and plays. Mr. Silverstein’s book, The Giving Tree, is a delightful children’s book with illustrations and is found in many homes, schools and public libraries. This recognized literary masterpiece has been nationally honored, selling more than 5.5 million copies. His books and other accomplishments were authored in his entire name, and “Shel Silverstein,” the name, is a registered trademark. All written and audio compositions authored by him were registered with the United States Copyright Office.

Shel Silverstein passed away on May 10, 1999, and Ms. Peggy Myers was appointed Personal Representative of the Estate of Shel Silverstein (the “Estate”) by the Florida Circuit Court of Volusia County.

The “Shel Silverstein” trademark has been used by Mr. Silverstein for more than 40 years with his books, stories, plays, songs and illustrations. During his lifetime, and now through the Estate, there is an intellectual property right in his published works.

Recitals in the Complaint and this proceeding reflect that in October, 2001, the Estate's counsel, Golenbock, Eiseman, Assor, Bell & Peskoe (hereinafter referred to as the "Counsel"), learned that the "ShelSilverstein.com" domain name was registered by an unknown party. Internet users going to the ShelSilverstein.com web site are redirected to its "linkster.com" web site, titled as an "Internet Directory," which in turn redirects users to the "overture.com" web site, a self-titled "pay-for-performance" search provider that provides search results based upon information from subscribing companies and banner advertisements. It is further contended in the Complaint that in October, 2001, Counsel searched the WHOIS director of Register.com and learned that the registrant of ShelSilverstein.com domain name (and the "linkster.com" domain name) was the Respondent. Thereafter, Counsel called a representative of Register.com to confirm the accuracy of the registration of the "ShelSilverstein.com" domain name.

By way of further procedural history, it is represented in the Complaint that Counsel sent a letter to the Registrant (CostNet) by Federal Express International Express Delivery, and by e-mail to the account listed in the WHOIS directory of Register.com, which stated that: (i) the Estate had not consented to the use of the "ShelSilverstein.com" domain name; (ii) the Estate demanded the Respondent's consent to transfer the "ShelSilverstein.com" domain name to the Estate; and (iii) if the Respondent did not signify its consent to said transfer by October 25, 2001, Counsel would commence appropriate proceedings on behalf of the Estate to effectuate such transfer and otherwise protect the Estate's rights. Federal Express confirmed that the letter was delivered to Respondent by Federal Express on October 22, 2001. Respondent failed to respond to the letter.

From the totality of the recitals in the Complaint, which remain unrefuted, it appears that Respondent seeks to use international and well-deserved good will and trademarks owned by the Estate of Shel Silverstein for its own commercial purposes, without regard to the legal and

common law proprietary and property interests of Shel Silverstein or his Personal Representative.

Grounds on Which The Complaint is Made

The “ShelSilverstein.com” domain name incorporates the “Shel Silverstein” trademark, and Shel Silverstein’s real name. This personal name is in common usage and is associated with valuable literary works. As the successor-in-interest to the rights of Shel Silverstein, Complainant has common law trademark rights in the Shel Silverstein name. It is clear that Complainant has not licensed or otherwise authorized Respondent to use the mark, and Respondent has neither rights nor legitimate interests with respect to the mark. Respondent’s use of the “ShelSilverstein.com” domain name is, therefore, likely to cause confusion as to the source and endorsement of the Respondent’s web site. Respondent is using ShelSilverstein.com for commercial gain because, through re-direction to its “linkster.com” web site, and as represented in the Complaint, visitors to the ShelSilverstein.com web site are presented with advertisements and hyperlinks to other web sites providing goods and services.

Comment

Shel Silverstein, during his lifetime and now by and through his Estate and Personal Representative, is entitled to protection of a name and identity that has been heralded in the literary world. He is a person who brought beauty and the pleasure of reading and new horizons to children and adults alike. The name is entitled to protection and, in the legal sense, the name and identity is protected by law.

There is a proprietary interest in usage of the name “Shel Silverstein,” and the Estate is entitled to commercial protection in furtherance of documented trademarks and, in this action, in

domain principles. A stranger who seeks to benefit from another's name or identity must, of necessity, have support in law, including appropriate assignments or transfer of name rights. The Complainant correctly seeks to nullify any claimed interest by Respondent in the domain name noted. This proceeding has as its basis the clarification of ownership and rightful establishment of the name "Shel Silverstein." Further, it seeks to quiet domain title and have the domain name transferred from Respondent to the Estate.

On a further note, the signature of the principal attorney signing the Complaint carries with it the imprimatur that the action is well-founded, appropriate inquiry of law and fact has been made, and there is a basis in fact and law for the action or relief requested. Further, the signature of the attorney signing the pleadings also carries with it the spirit and mandate of Rule 11, Fed. R. Civ. Proc., as it deals with the signature of the attorney in a formal document such as the Complaint signed herein.

Conclusion

I conclude that Respondent does not have any legitimate right nor legitimate interest or use with respect to the domain name at issue. In addition, the Complainant has established that Respondent did register and use the domain name in bad faith as that term is used in the ICANN Policy, and it appears that Respondent has attempted and continues to trade on the value of Shel Silverstein's name.

Respondent's use and registration of the name without appropriate authorization for the purpose of directing users to advertisements lends support to the contention of Respondent's bad faith. Respondent's bad faith is shown by Respondent's attempt to create the likelihood of confusion with Complainant's mark as to the source, sponsorship, affiliation or endorsement of Respondent's web site and the activities listed and promoted therein.

In sum, I find and conclude that: (a) the registered domain name is identical or confusingly similar to Complainant's protected mark; (b) Respondent CostNet does not have rights or legitimate interests with respect to the domain name at issue; and (c) Respondent did register and use the domain name in bad faith, as that term is defined in the ICANN Policy, I find in favor of the Complainant, and against the Respondent.

Remedy

Complainant's request to transfer the domain name "ShelSilverstein.com" to the Estate of Shel Silverstein is hereby **GRANTED**. The domain name shall be transferred from CostNet to the Estate of Shel Silverstein. Respondent's claim to the domain name "ShelSilverstein.com" is cancelled, and said Respondent shall have no further claim or benefit from the name "ShelSilverstein.com."

Entered in Denver, Colorado, on the 31st day of December, 2001.

/ s / Sherman G. Finesilver

Honorable Sherman G. Finesilver

Law Office of Judge Sherman G. Finesilver (Ret.)

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Denver, Colorado 80237

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EXHIBIT “A”

The Shel Silverstein” trademark is and has been used by Shel Silverstein and the Estate for more than four decades in connection with books, short stories, plays, songs and illustrations.

Shel Silverstein wrote numerous books which have been translated into more than 30 languages and have sold millions of copies worldwide, generating millions of dollars in revenue, including:

BOOKS: Uncle Shelby’s ABZ Book (1961)
 Lafcadio, the Lion Who Shot Back (1963)
 The Giving Tree (1964)
 A Giraffe and a Half (1964)
 Who Wants a Cheap Rhinoceros? (1964, 1983)
 Where the Sidewalk Ends (1974)
 The Missing Piece (1976)
 Different Dances (1979)
 The Missing Piece Meets the Big O (1981)
 A Light in the Attic (1981)
 Falling Up (1996)

SONGS: Several noteworthy songs, including: Johnny Cash’s hit, “A Boy Named Sue”;
 “I’m Checking Out,” which was written for the motion picture “Postcards from
 the Edge”

OTHER: Numerous short stories, poetry and plays
 More than 200 written and audio compositions (copyrighted and registered
 with the U.S. Copyright Office)