

LEGEND OF ZELDA TURNS 30

You might (or you might not) know that Legend of Zelda is an extremely popular video game produced by Nintendo. It was launched on February 21, 1986. That means that on February 21, 2016, it celebrated its 30th birthday. During that time it has become extremely popular and embedded in international popular culture.

But what, I hear you ask, has Legend of Zelda to do with domain names?

Well, a lot. In fact, it figures in one of my favourite domain name cases, *Nintendo of America Inc. v. Alex Jones*. It is WIPO Case No. D2000-0998¹, decided on November 17, 2000, almost 16 years ago.

The decision is particularly interesting as it tells us how a domain name panellist or arbitrator can decide that a domain name was not registered in bad faith, resulting in the decision that the Complainant trademark owner failed to prove all 3 elements under the Uniform Domain Name Dispute Resolution Policy (“the UDRP”) and hence that it has lost the case. The result is that, today, the domain name <legendofzelda.com> is still registered with its original registrant or owner, in this case Alex Jones². Alex was 15 years of age when the case was decided by the panellist, Mr Edward C. Chiasson, Q.C. (as he then was).

Under the UDRP, which applies to disputes about the ICANN domain names like .com (dot com), rather than the Canadian domain names .ca, the Complainant had to prove 3 things. The first was that it had a trademark for LEGEND OF ZELDA and that the domain name, <legendofzelda.com> was identical or confusingly similar to the trademark. Nintendo was able to do this easily, as it had a series of trademarks around the world exactly for LEGEND OF ZELDA, so the panellist who decided the case was able to find that the domain name was “virtually identical” to the trademark.

Nintendo then had to prove the second element, that Alex Jones had no right or legitimate interest in the domain name. Here again, the distinguished panellist decided in favour of Nintendo. This was because Nintendo had the trademark and hence “the right to decide how its mark will be used in the context of the product or products associated with the mark.” Alex Jones said that he was using the domain name for a fan site, i.e. a site for aficionados of the game. In fact if you look at www.legendofzelda.com today, you will find discussion of plot lines, characters, quality of presentation of the series and lots of illustrations from the series.

¹ See <http://www.wipo.int/amc/en/domains/decisions/html/2000/d2000-0998.html>

² See the WHOIS at www.godaddy.com.

But the panellist said that "...a fan site ... promotes the product for which it is named and. ..(if) (it)is used solely in the context of the product of the owner of the name or mark and the owner objects to the use, it is not legitimate. The Complainant has the right to decide how its mark will be used in the promotion of its product. Although the Respondent (Alex Jones) may have a genuine desire to support the Complainant's products, he does not have a legitimate interest in the subject domain name which is identical to the Complainant's mark."

Nintendo had thus won on the first two of the three elements that it had to prove.

But the third element was where Nintendo came unstuck. Under this third element, Nintendo had to prove that Alex Jones had both registered and used the domain name in bad faith. Not only does bad faith registration and use have to be proved under the UDRP, but bad faith registration of the domain name also has to be proved under the Canadian CIRA domain name policy, so the decision is useful for Canadian cases about .ca domain names as well as .com cases.

On this issue, the panellist found that Alex had neither registered nor used the domain name in bad faith. Alex had not tried to sell it, had not engaged in a pattern of registering other parties' trademarks as domain names and had not tried to disrupt Nintendo's business, but that "the opposite appears to be true." Nor had Alex sought any commercial gain from the site although it had links to commercial outlets. The totality of the evidence showed that by registering the domain name and operating the site, Alex had not been motivated by bad faith.

The panellist did not use precisely these words but you could say that on the evidence Alex had been motivated by good faith, not bad faith. He had said in his submission that he ran the site to "maximise the opportunity to contact other fans" and that any links to commercial outlets on the site actually "benefit the Complainant (Nintendo) through the potential for additional sale of its products". Above all, it was a site operated in homage or tribute to the game and not in bad faith.

In fact, Alex may have helped Nintendo boost sales of the game by promoting it through his website. By the time of the decision it had sold 12 million copies, but Wikipedia tells us that by 2011 it had sold 62 million . They should be so lucky.

But the serious point about the case is that "bad faith" is not an empty phrase. It means misleading, fraudulent or deceptive and similar concepts. A young man who is a great fan of a video game and promotes it to fellow admirers and who does not mislead anyone can scarcely be said to be acting in bad faith.

The case shows that all 3 elements under the ICANN Policy have to be proved. Nintendo did not do this... so it lost.

Moreover, the case shows yet again that it is no use just alleging or asserting bad faith or anything else in a domain name case if you are a complainant trying to prise a domain name from the person who has registered it; you have to prove whatever you allege.

Thirty years after the launch of Legend of Zelda and 16 years after the decision, 15 year old Alex Jones' win shows just how true this is...and remains.

Happy Birthday to Legend of Zelda.

The Hon Neil Brown QC

Melbourne, Australia