



Domain name ADR

Practical experience

CZECH ARBITRATION COURT

LENKA NÁHLOVSKÁ

CAC

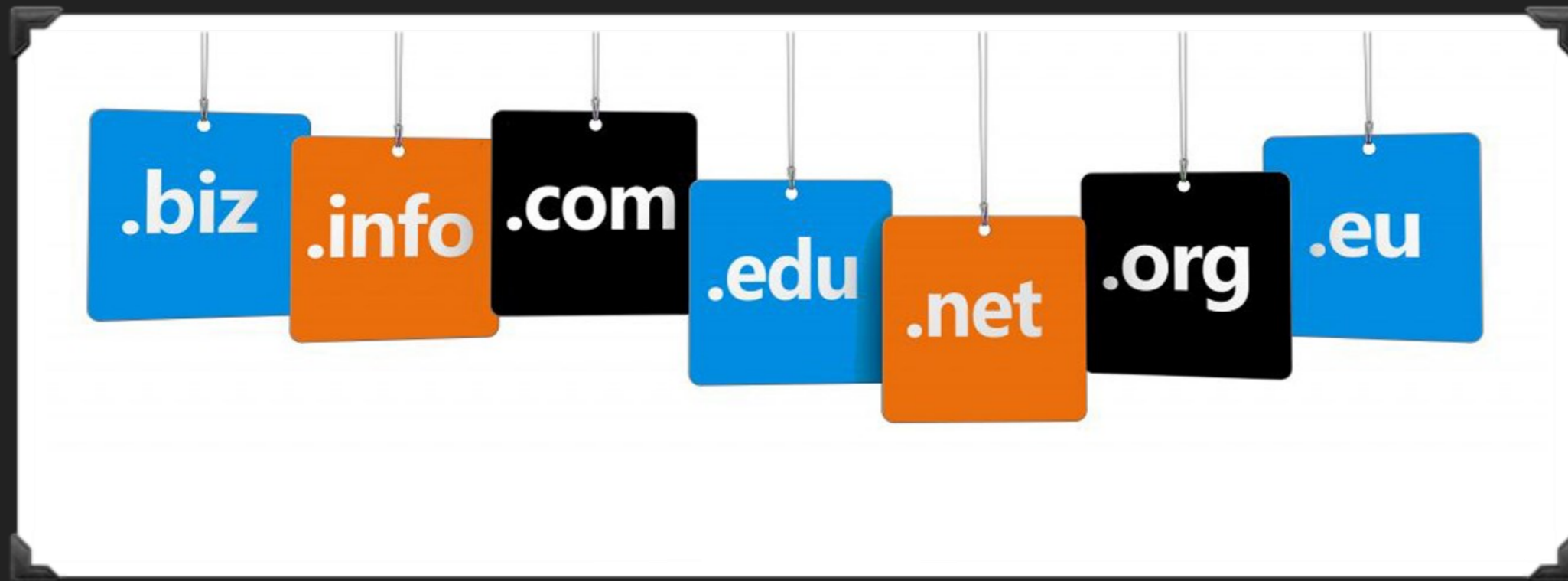
ARBITRATION COURT ATTACHED TO THE CZECH CHAMBER
OF COMMERCE AND THE AGRICULTURAL CHAMBER OF
THE CZECH REPUBLIC

FOUNDED IN 1949

ADR CENTER (2004 CZ, 2006 EU, 2009 UDRP)

UDRP

- ▶ *generic domain names (gTLDs) - com, .net, .org, .info...*
- ▶ *outcome: transfer of the domain name (98%), cancellation of the registration*
- ▶ *cost varies among Providers (6 providers in total)*
- ▶ *duration: 40 – 50 days (the average duration of proceedings in 2020 before CAC was 44 days)*



EU

- .EU
- ELIGIBILITY CRITERIA - ARTICLE 3 REGULATION (EU) 2019/517
 - UNION CITIZEN
 - RESIDENT OF A MEMBER STATE
 - UNDERTAKING THAT IS ESTABLISHED IN THE UNION
 - ORGANISATION THAT IS ESTABLISHED IN THE UNION
- ALL OFFICIAL LANGUAGES
- ONLINE PLATFORM
- 2 PROVIDERS (CAC AND WIPO)
- 2 CRITERIA TEST

CZ

NATIONAL DOMAIN NAME (CCTLD)

CZ.NIC

2 CRITERIA TEST

ONLINE PLATFORM

1 ADR PROVIDER - CAC

URS

THE UNIFORM RAPID SUSPENSION SYSTEM
(URS)

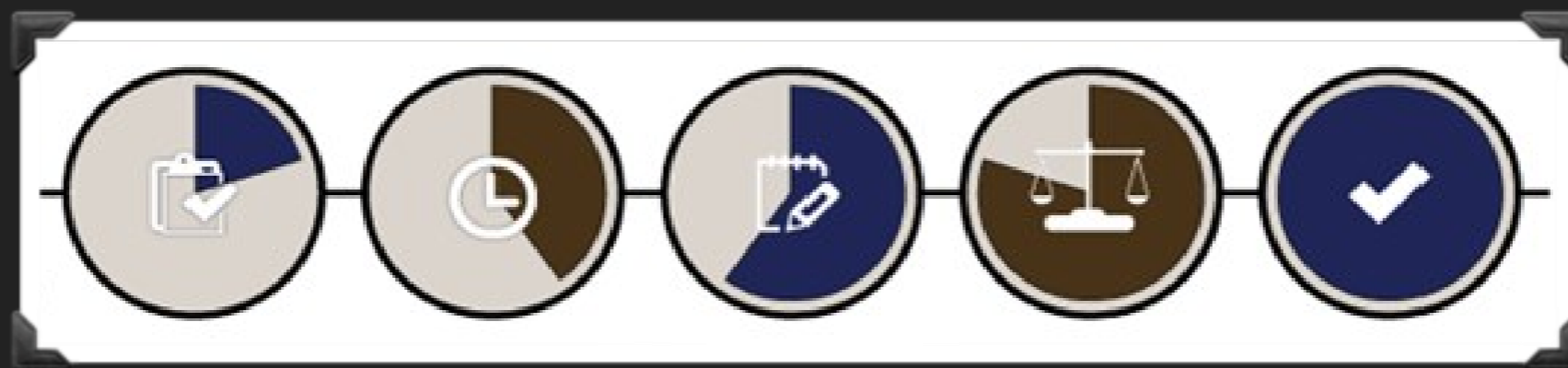
SUSPENSION OF DOMAIN NAME

ABUSIVE USE

ADVANTAGES AND DISADVANTAGES

- ▶ **Fast** resolution of the dispute.
- ▶ **On-line resolution** (efficient, less expensive and COVID-proof).
- ▶ **Cost- efficiency** of the disputes.
- ▶ **Experienced panelists**.
- ▶ **Transparent decision making** (all decisions are publicly available).
- ▶ **Predictable**.
- ▶ **Automatic execution** of decision.

- ▶ **No claim of damages or costs of proceeding**
- ▶ **Great emphasis on the Complaint (no additional fillings)**
- ▶ **Not meant for big business disputes (OUT OF SCOPE OF UDRP)**
- ▶ **Single instance** (no possibility of appeal)



WIPO OVERVIEW OF WIPO PANEL VIEWS ON SELECTED UDRP
QUESTIONS, THIRD EDITION

(“WIPO JURISPRUDENTIAL OVERVIEW 3.0”)

CAC: COMMENTATED AND CATEGORIZED .EU DECISIONS, 2ND
EDITION

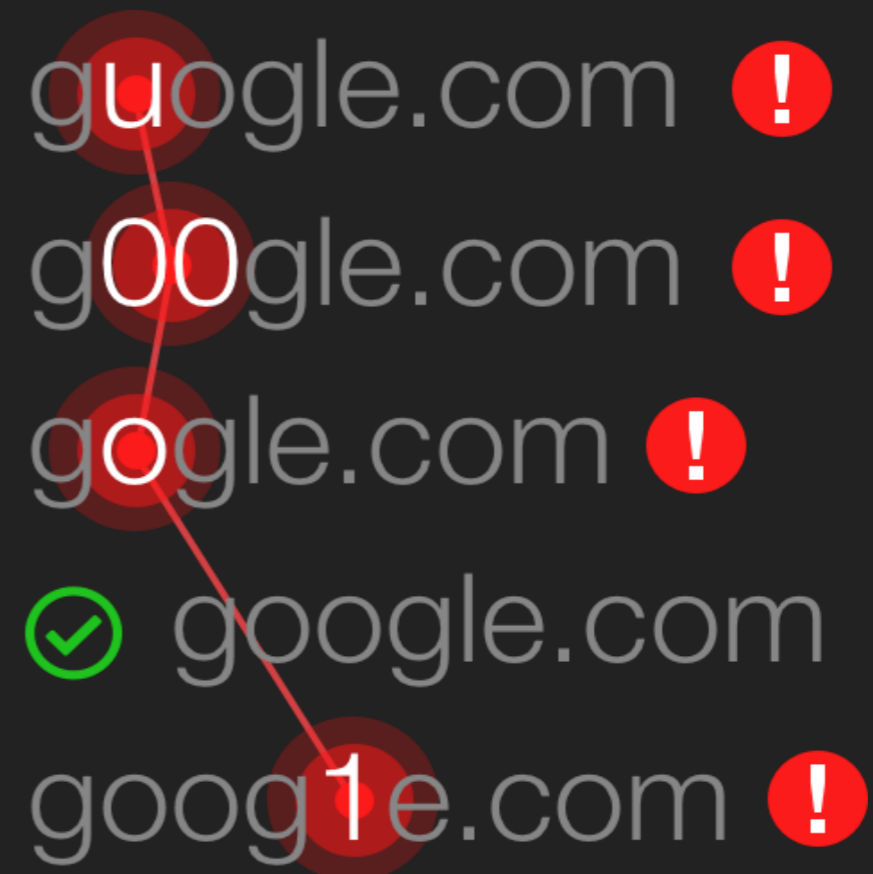
ALL DECISIONS IN EU AND UDRP PUBLICLY AVAILABLE

- 1) COMPLAINANT TRADEMARK RIGHTS
- 2) NO LEGITIMATE INTEREST OR RIGHTS OF THE RESPONDENT
- 3) BAD FAITH OF REGISTRATION AND USE OF THE DOMAIN NAME BY THE RESPONDENT.

THREE PART TEST

TRADEMARK RIGHTS

- ▶ a trademark or service mark
 - Registered anywhere in the world
 - “unregistered mark” or “common law trademark right” - distinctive
- ▶ identical or confusingly similar
- ▶ typosquatting – an intentional misspelling of a trademark
- ▶ COVID cases (<novartiscovid-19vaccine.com> case 103459)
- ▶ Phishing cases (103234 <UNICREDITSERVICE.COM>)



PRIORITY OF RIGHTS, LOCATION

103718:

IN ORDER TO ASSESS THE FIRST REQUIREMENT UNDER THE POLICY IT IS NOT STRICTLY NECESSARY TO VERIFY THE STATUS OF THE OWNER'S RIGHT BEFORE THE DATE OF REGISTRATION OF THE DOMAIN NAME IN DISPUTE. THIS EVALUATION MAY HAVE AN IMPACT ON THE ASSESSMENT OF THE SECOND AND THIRD POLICY REQUIREMENTS, BUT FOR THE PURPOSES OF IDENTITY OR CONFUSINGLY SIMILARITY WITH A COMPLAINANT'S TRADEMARK, UDRP PANELS HAVE CONSTANTLY HELD THAT IT IS SUFFICIENT TO ESTABLISH THAT TRADEMARK RIGHTS ARE IN EXISTENCE AT THE TIME THE COMPLAINT IS FILED

LOCATION

POLICY IT IS NOT A REQUIRED THAT THE COMPLAINANT HOLDS TRADEMARK WITHIN THE TERRITORY WHERE THE RESPONDENT IS LOCATED

DISTINCTIVENESS

AN ORDINARY WORD OR NUMBER CANNOT FUNCTION IN THAT WAY FOR OBVIOUS REASONS. THAT IS, UNLESS THEY HAVE WHAT WE CALL "ACQUIRED DISTINCTIVENESS" OR SECONDARY MEANING SO THAT THEY ARE SO FAMOUS THAT IT IS THE BRAND THAT THE RELEVANT PUBLIC BRING TO MIND AND NOT THE DICTIONARY TERM.

ACRONYMS (AVK.COM)

[HTTPS://WWW.DOMAINTIMES.INFO/POST/ACRONYMS-AS-DOMAIN-NAMES-AS-EASY-AS-ABC-AS-HARD-AS-XYZ-OR-JUST-QED](https://www.domaintimes.info/post/acronyms-as-domain-names-as-easy-as-abc-as-hard-as-xyz-or-just-qed)

BOOKING.COM CASE IN USA

TRADEMARK LAW BARS REGISTRATION OF GENERIC TERMS, BUT IT PERMITS THE REGISTRATION OF MERELY DESCRIPTIVE TERMS IF THEY HAVE ACQUIRED ENOUGH SECONDARY MEANING.

THE U.S. PATENT AND TRADEMARK OFFICE REFUSED TO REGISTER BOOKING.COM AS A SERVICE MARK FOR HOTEL RESERVATION SERVICES. THE U.S. COURT OF APPEALS FOR THE 4TH CIRCUIT HELD THAT THE MARK WAS ENTITLED TO REGISTRATION, AND THE SUPREME COURT AGREED TO REVIEW THAT DECISION.

WHETHER A BUSINESS CAN CREATE A REGISTRABLE TRADEMARK OR SERVICE MARK BY COMBINING AN UNPROTECTABLE GENERIC TERM FOR THE SERVICES IT OFFERS WITH THE GENERIC TOP-LEVEL DOMAIN NAME “.COM

(COMMON LAW) TRADEMARK

MARK HAS BECOME A DISTINCTIVE IDENTIFIER WHICH CONSUMERS ASSOCIATE WITH THE COMPLAINANT'S GOODS AND/OR SERVICES

IDENTICAL OR CONFUSINGLY SIMILAR NAME

CONFUSING SIMILARITY TEST UNDER THE UDRP TYPICALLY INVOLVES A STRAIGHTFORWARD VISUAL AND AURAL COMPARISON OF THE TRADEMARK WITH THE DOMAIN NAME IN QUESTION

ADDITION OF DESCRIPTIVE TERMS

TLD'S NOT TAKEN INTO ACCOUNT

LEGITIMATE INTEREST

- ▶ providing information for consumers about the brand,
- ▶ critique of the trademark, brand or its owner (.SUCKS cases 103141 MIRAPEX.SUCKS vs 103142 BIODERMA.SUCKS)
- ▶ legitimate purposes
- ▶ selling of goods or services,
- ▶ blog of articles,
- ▶ passive holding



DOMAIN NAMES AS BUSINESS

NAMESCON GLOBAL 2020

90	directions.com	\$75,000	Reserve Range 50-100k
100	rix.net	\$1,300	No Reserve
110	Jose.com	PASS	Reserve Range 100-500k
120	motorcyclesale.com	\$400	No Reserve
130	cabservice.com	\$2,500	Reserve Range 1-5k
140	airdrop.com	PASS	Reserve Range 100-500k – comes with trademarks 86924005 and 8602343
150	ffvv.com	\$1,400	Reserve Range 1-5k
160	cgnc.com	\$1,700	Reserve Range 0-1k
170	mycar.com	PASS	Reserve Range 500k+
180	ZLKi.com	\$500	No Reserve
190	please.com	\$141,000	Reserve Range 100-500k
200	arcades.com	PASS	Reserve Range 50-100k
210	bicycleshops.com	\$1,600	No Reserve
220	Dancing.com	PASS	Reserve Range 100-500k
230	mgv.com	\$17,000	Reserve Range 5-10k
240	ADD.com	\$800,000	Reserve Range 500k+
250	Med.org	\$8,500	No Reserve
260	irp.com	\$25,000	Reserve Range 10-25k

BAD FAITH

- ▶ Awareness of the trademark right
- ▶ Cybersquatting (passive holding)
- ▶ Registration for abusive purposes
- ▶ Gaining illegitimate profits etc.
- ▶ Cyber criminality
- ▶ Illegal content



THE PANEL BELIEVES THAT OVERALL COMPLEXITY OF THIS CASE PUTS IT OUTSIDE THE UDRP SCOPE.

103423: IF THE COMPLAINANT HAS AN ISSUE WITH ITS REPUTATION IT MUST TAKE IT UP WITH THE COURTS IF IT CROSSES THE LINE INTO DEFAMATION. PANELS HAVE REPEATEDLY HELD THAT A UDRP PROCEEDING IS NOT THE PROPER FORUM FOR ADDRESSING CLAIMS OF DEFAMATION.

REVERSE DOMAIN NAME HIJACKING

BAD FAITH OF THE COMPLAINANT WHILE BRINGING UDRP COMPLAINT

BRINGING TWO UDRP ACTIONS 16 YEARS AFTER THE REGISTRATION OF THE DISPUTED DOMAIN NAME AND FAILING TO CONFORM TO THE SIMPLE UDRP REQUIREMENTS WITHIN THE FIRST PROCEEDING HAS COST THE RESPONDENT SUBSTANTIAL SUMS TO BE PAID FOR THE LEGAL ADVICE OF HIS COUNSEL, WHEN THERE WAS VERY SMALL CHANCE OF PROVING THAT THE RESPONDENT HAD ACTED IN BAD FAITH AND WITHOUT HAVING ANY RIGHTS OR LEGITIMATE INTERESTS IN THE DISPUTED DOMAIN NAME (BECAUSE OF THE EXISTENCE OF THE PREVIOUS DECISIONS OF THE UDRP PANELS AND THE LACK OF THE EVIDENCE PROVING THE EXISTENCE OF RESPONDENT'S BAD FAITH).

STANDARD OF PROOF – BALANCE OF PROBABILITIES

THE ONUS IS ON THE COMPLAINANT X IMPOSSIBLE TO PROOVE
NEGATIVE INFORMATION – IF THE COMPLAINANT PROVIDES
EVIDENCE FOR PRIMA FACIE CASE THE ONUS SHIFTS TO THE
RESPONDENT (TO PROVE ITS RIGHTS AND GOOD FAITH)

CONSOLIDATION

LANGUAGE OF THE PROCEEDINGS

ADDITIONAL SUBMISSIONS

PANEL ACTIVITY IN EVIDENCE SEARCH

DISCUSSION

LOSER PAYS MECHANISM

APPEAL SYSTEM

INTERIM MEASURES

RDNH PENALISATION

AMUNDI TRADEMARK

- ▶ International word trademark "AMUNDI"
- ▶ based on the French trademark, designating under the Madrid Protocol Australia, Bahrein, the EU, Japan, Republic of Korea, Norway, Singapore, Turkey, the US, Switzerland, China, Egypt, Liechtenstein, Morocco, Monaco, Russian Federation, Ukraine, Vietnam.





VOA MUNDI - TO FLY THE WORLD

- ▶ **legitimate business offering of the travel businesses (bona fide offering)**
- ▶ **Brazil - the Complainant had not had any establishment there**
- ▶ **Different from Complainant's business**

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Purchase Selected Domains

ICANN APPROVED THE .SUCKS GTLD IN 2015

<u>Decision No</u>	<u>Type</u>	<u>Respondent</u>	<u>Complainant</u>	<u>Result</u>	<u>Informal English translation</u>
		<u>Disputed domain name(s)</u>		<u>Language of ADR</u>	<u>Published</u> ↓
<u>103423</u>	UDRP	Honey Salt Ltd	Cargotec Oyj; Cargotec Patenter AB	Complaint Accepted	
		CARGOTEC.SUCKS		English	2021-02-25 13:55:00
<u>103142</u>	UDRP	Honey Salt Ltd.	NAOS	Complaint Accepted	
		BIODERMA.SUCKS		English	2020-09-02 16:17:00
<u>103141</u>	UDRP	Honey Salt Ltd.	Boehringer Ingelheim Pharma GmbH & Co. KG	Complaint Rejected	
		MIRAPEX.SUCKS		English	2020-09-02 16:07:00

RESPONDENT HAS NOT ACQUIRED TRADEMARK RIGHTS IN THIS TERM

THE RESPONDENT IS NOT THE PERSON WHO IS SAID TO BE MAKING THE ALLEGEDLY FREE SPEECH COMMENTARY OR CRITICISM. THE RESPONDENT IS A THIRD PARTY

RESPONDENT IS NOT AFFILIATED WITH THE COMPLAINANT NOR AUTHORIZED BY IT IN ANY WAY TO USE THE TRADEMARK

RESPONDENT'S CRITICISM MUST BE GENUINE AND NON-COMMERCIAL

COMMERCIAL USE BY REGISTERING AND OFFERING THE DISPUTED DOMAIN NAME FOR SALE

NOT CONTAINING GENUINE CRITICISM CONTENT BUT ONLY AUTOMATICALLY GENERATED LINKS LOOSELY RELATED TO THE COMPLAINANT'S PRODUCT

RIGHT TO PROTECTED SPEECH SUCH AS CRITICISM AND COMMENTARY

FREEDOM OF EXPRESSION IN DOMAIN LAW CASES

CRITICISM BY THE USERS (NOT DOMAIN NAME HOLDER) - USERS CREATE WIKI PAGES ON THE PLATFORM ON A PARTICULAR SUBJECT/SUBJECT MATTER

THE .SUCKS CLEARLY SIGNALS THAT THE PAGE/SITE TO WHICH IT RESOLVES WILL BE A GRIPE OR SUCKS SITE - PURPOSES OR INTENTIONS OF CRITICISM ARE TYPICAL TO SUCH “.SUCKS” DOMAIN NAMES

COMMERCIAL MOTIVATION IS NOT DETERMINATIVE: A NEWSPAPER PUBLISHER IS ENTITLED TO EARN REMUNERATION AND SO IS A PLATFORM

DOMAIN NAME DISPUTES (BEFORE CAC)

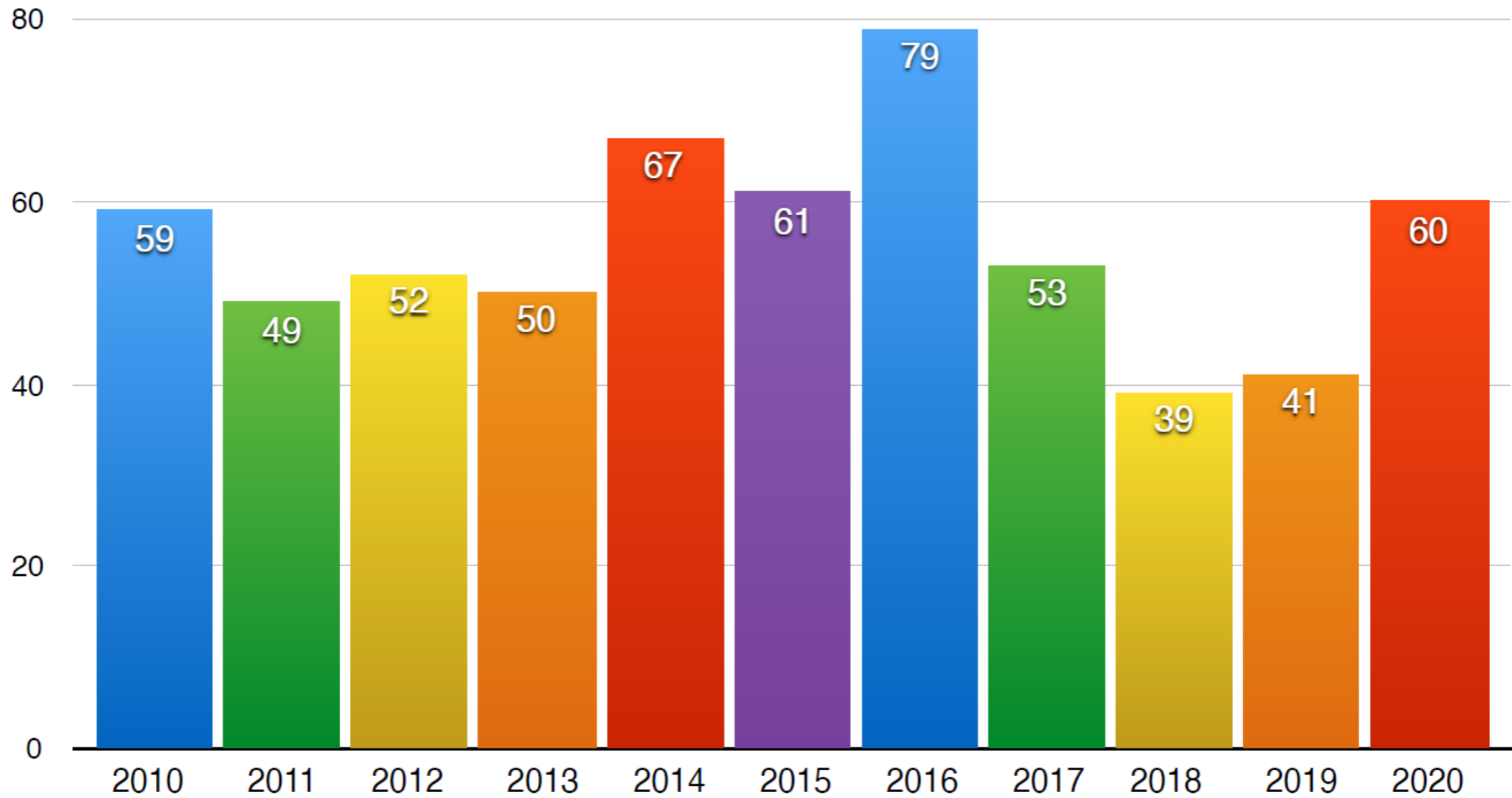
- ▶ CZ – 2004, only ADR provider for .cz domain names
- ▶ EU – 2006 first to operate EU domain name disputes (now two providers CAC and WIPO)
- ▶ UDRP – 2009



.EU DOMAIN NAMES

.Eu domain names

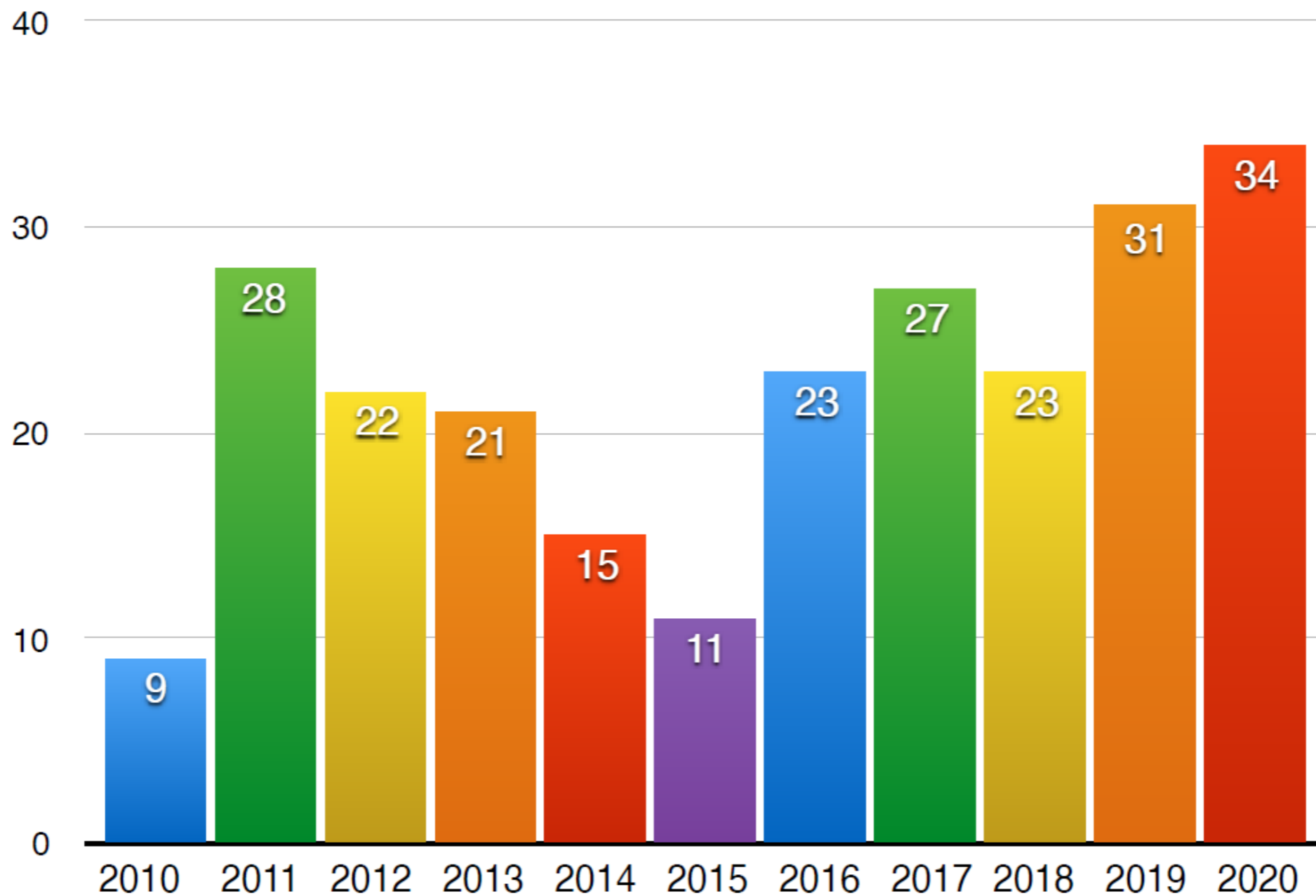
2010 2011 2012 2013 2014 2015 2016 2017 2018 2019 2020



.CZ DOMAIN NAMES

.Cz domain names

2010 2011 2012 2013 2014 2015 2016 2017
2018 2019 2020

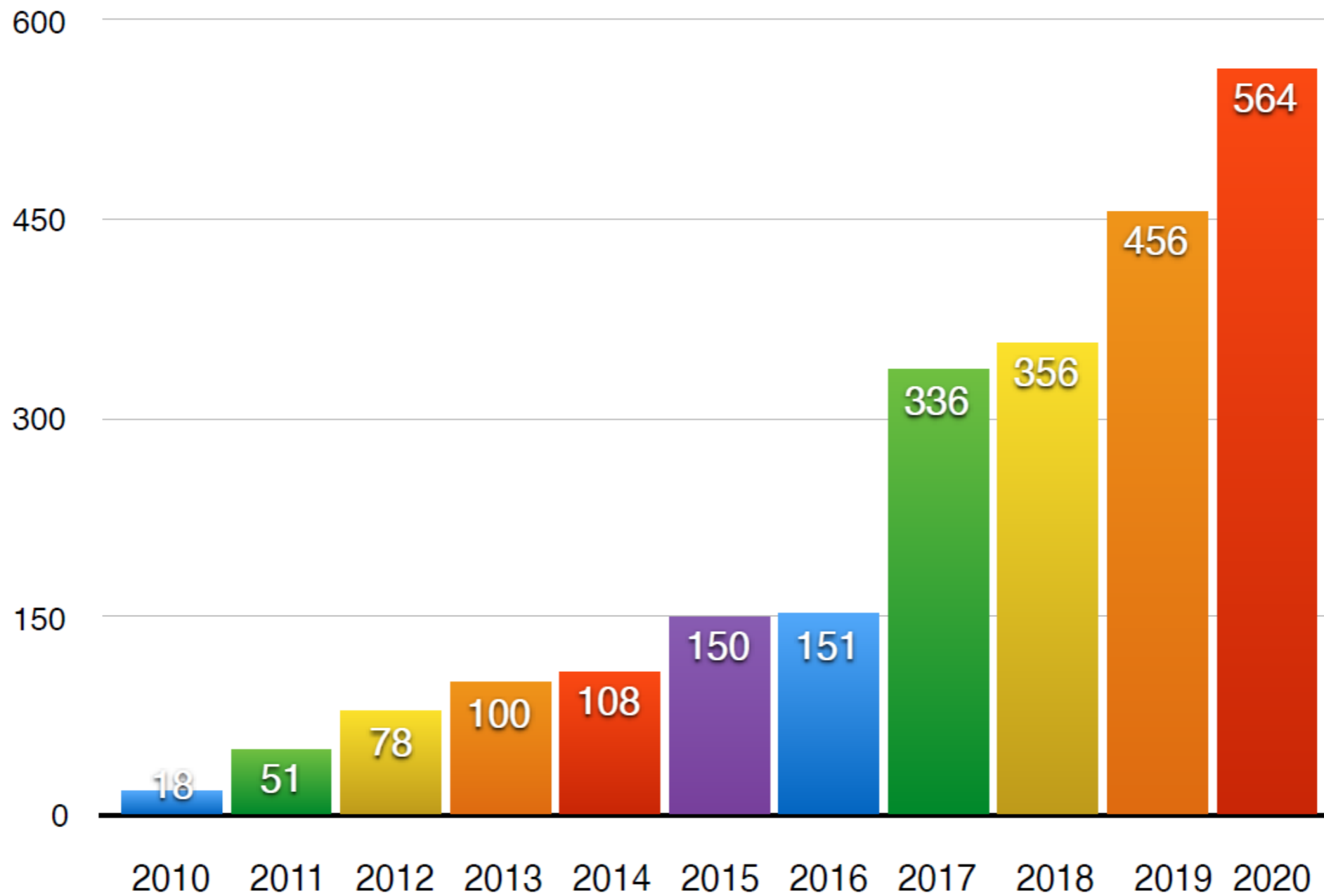


GENERIC DOMAIN NAMES

UDRP

Generic domain names - UDRP

2010 2011 2012 2013 2014 2015 2016 2017 2018 2019 2020



THANK YOU!