

DOMAIN  
NAME  
DISPUTES

## **UDRP CASE-LAW**

**JUDR. PAVEL LOUČEK, PH.D., BA (HONS)**

# MAIN PRINCIPLE

- **First comes – first served**
- **The domain name is immediately registered**
- **What if the holder of domain name is not the one who should own it?**
- **Cybersquatting, typosquatting, etc.**

# **SQAUTTERS ALLOWED?**



**HOW  
TO  
SQUAT**



**#WWYD**

# EXAMPLE



registered the domain  
m

not use this domain and offers it  
for €200.000

trademark owner claim violation of  
?

trademark owner claim transfer of  
in name?

the owner is based in CZ (GER),  
attorney is US and squatter Russian?

# ICANN & UNIFORM DOMAIN-NAME DISPUTE RESOLUTION POLICY - UDRP (BASIC PRINCIPLE)



- In the beginning, when the party registers the domain name, it agrees to undergo an online dispute settlement if someone files a complaint about his registered domain name in the future
- ICANN as the organization securing generic top – level domain names is the only one responsible for enforcing the rules in this area using UDRP (Uniform Domain-Name Dispute-Resolution Policy)
- **THE ENFORCEMENT**
  - If the complainant loses, the holder of the domain name remains the owner
  - If the complainant wins, the domain name is transferred by ICANN to the complainant (or is cancelled)
  - The court proceeding are possible, but rarely used. The court however follows previous decision made by UDRP arbitration process.

# ICANN & UDRP



- Internet Corporation for Assigned Names and Numbers
- Nonprofit organization responsible for the coordination of maintenance and methodology of databases of unique identifiers (domain names) and ensuring the network's stable and secure operation
- Management of domain names and IP addresses
- ICANN registers top - level generic domain names

# ICANN & UDRP



## Top - level domains (examples):

- *country-code TLD: .cz, .us, .gb, .fr, .de, .at, etc.*
- *generic TLD: .com, .org, .net, .gov, .int, .edu, .mil, .biz, .ceo, .info, .museum, .tel, .travel, etc.*
- **List of all generic domain names (1502):**  
**<http://data.iana.org/TLD/tlds-alpha-by-domain.txt>**



# ICANN & UDRP



## The future of ICANN?

- **ICANN was transferred in September 2016 to the global multi-stakeholder community (international character)**
- **„No one, no government and no organization should control the internet“**
- **The “control” of the internet by states (which is related with the transfer of ICANN) could change the basic open character of the internet, to change „old customs“ and to make it less hospitable**

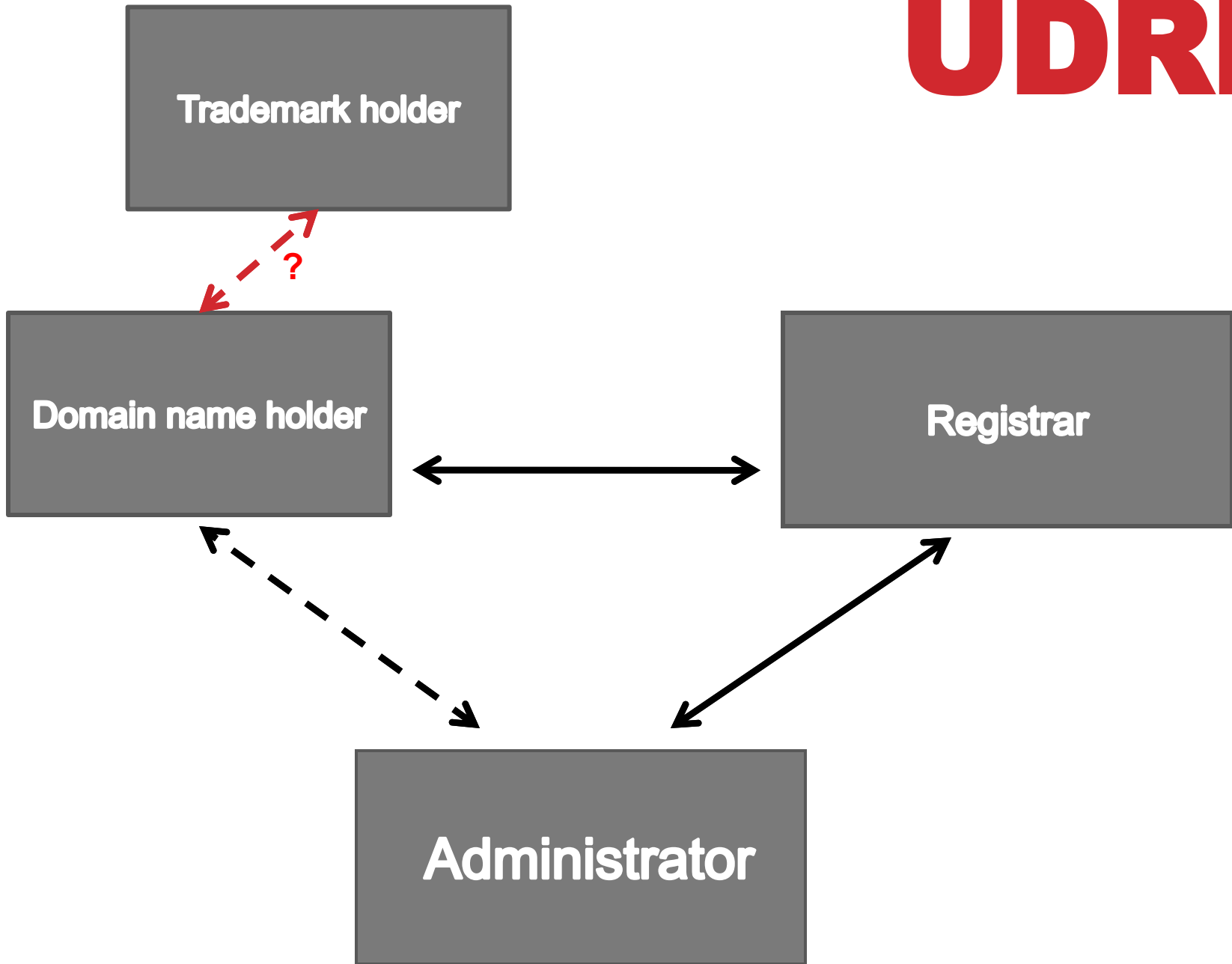
# UDRP

**What is it?**

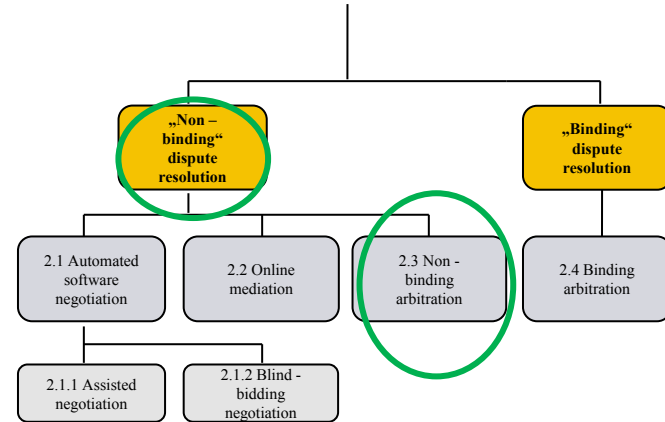
**What it serves for?**

**Why is it binding (or is it)?**

# UDRP



# UDRP PROCESS



- **Uniform domain name Dispute Resolution Policy (UDRP)**
- It is the resolution of the disputes regarding the registration of internet domain names (trademark disputes)
- It applies to:
  - all generic TLD (.aero, .asia, .biz, .cat, .com, .coop, .info, .jobs, .mobi, .museum, .name, .net, .org, .pro, .tel and .travel)
  - some ccTLDs (Australia, Ireland, etc.) - +- 70 states

# UDRP PROCESS



- It was launched at 1999 to deal with „The Trademark Dilemma“ (cybersquatting) - disputes arise from abusive registrations of domain names

**The rules were drafted in close cooperation with WIPO**

**All registrars have to follow UDRP (contract)**

**Disputes are resolved by agreement, court action, or arbitration before a registrar will cancel, suspend, or transfer a domain name**

**The process is initiated by the holder of trademark - filing a complaint within an approved dispute-resolution service provider**

# UDRP PROCESS



**Disputes are frequently cross – border**

**Need for speed, accessibility**

- Disputes are however not based on trademarks solely – it is the process disengaged from national laws (almost) – bare it in midn and also do not use natinal legislation while filing UDRP complaint

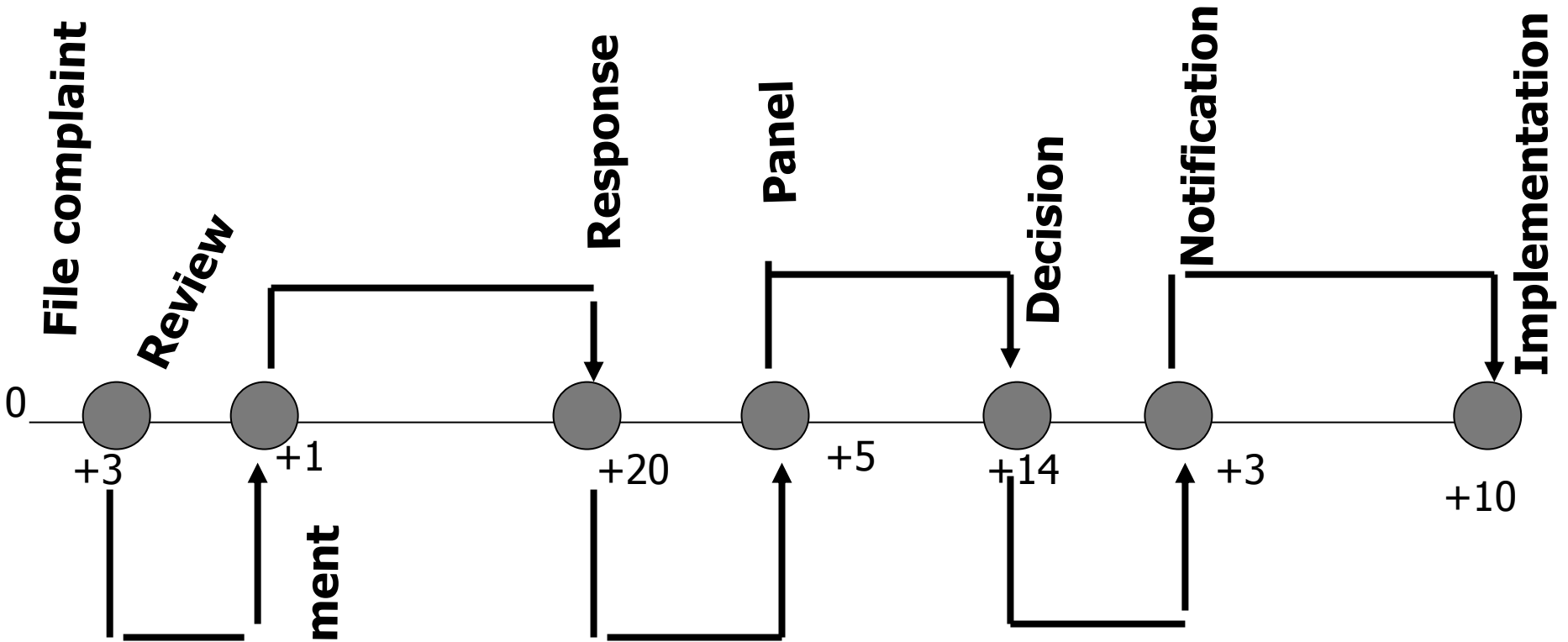
# UDRP PROCESS



## Step - by - step process

- Complainant launches the claim at dispute resolution provider
- Registrant has the opportunity to respond and to decide whether there will be one or three panel members at the process
- Dispute resolution provider assigns panelist(s)
- Panelist(s) render decision based on evidence submitted

# UDRP



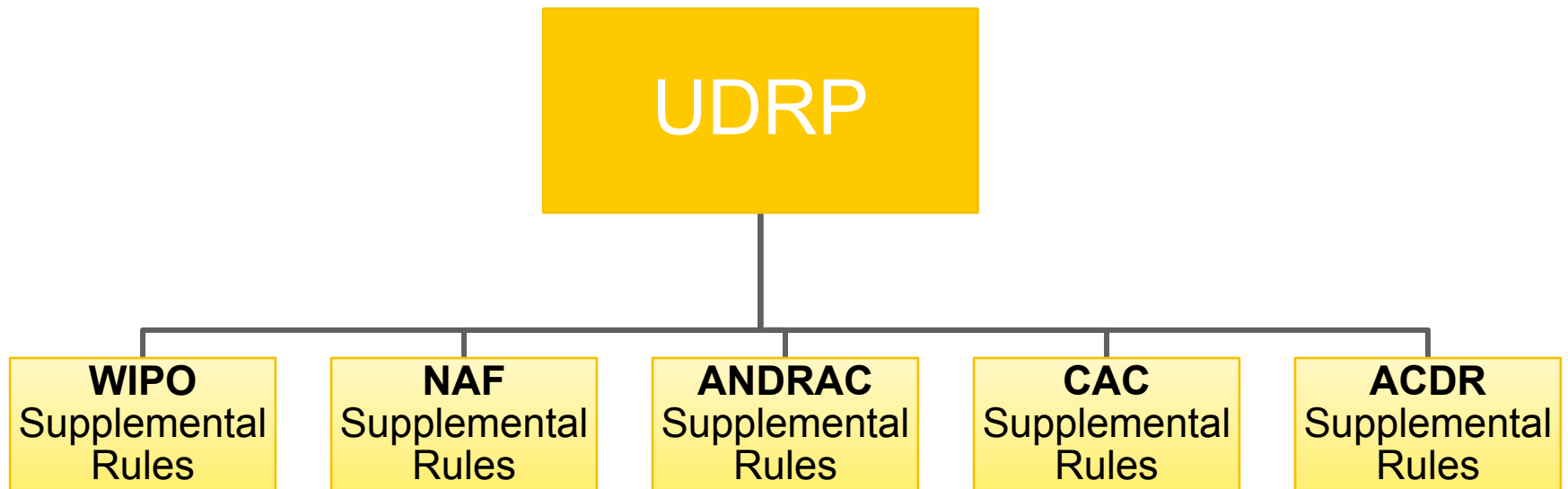
**56 days**



# **AUTHORIZED PROVIDERS OF UDRP**

- **[ADNDRC] Asian Domain Name Dispute Resolution Centre**
- **[NAF] The National Arbitration Forum**
- **[WIPO] World Intellectual Property Organization**
- **[CAC] The Czech Arbitration Court**
- **[ACDR] Arab Center for Domain Name Dispute Resolution**
- **<https://www.icann.org/resources/pages/providers-6d-2012-02-25-en>**

# SPECIFIC RULES FOR EACH PROVIDER



# UDRP PROCESS



## Advantages:

- Fast – the case can be decided within 2 months
- Inexpensive
- Co - existing with local legal systems
- Global solution
- Accessible – decisions are freely available
- Price: <http://www.wipo.int/amc/en/domains/fees/>

# UDRP PROCESS



## Disadvantages:

- Hard to control (are we getting good decisions?)
- Transparency of panellists
- Inconsistent decisions
- Only transfer (cancellation) of the domain name is decided (not damages)

# UDRP PROCESS



## Problems:

## Forum shopping:

- Complainant win percentages:
  - WIPO – 82%
  - NAF – 83%
  - eResolution – 63% (not working any more)

## 2011

- WIPO – 19.123 cases
- NAF – 16.134 cases
- eResolution – 277 cases

# UDRP PROCESS



## Problems

### Case allocation bias:

- One panelist (83% probability to transfer domain name)
- vs**
- Three member – panels (60% probability to transfer domain name)

**!! 3 member panel is more expansive and there is lower probability to win the case !! (however it can be part of the tactics !!)**

# UDRP SHIELDED BY COURT



## **Storey v. Cello Holdings LLC (american court decision)**

- The agreement with UDRP is implemented by chains of contracts and it is involuntary
- ICANN as the only regulator does not offer any other solution
- The decision is contractually binding just between the parties (*no rei iudicata*)
- The parties cannot be prevented from submitting their dispute to the court

# UDRP CASE STUDY IN GENERAL



## Classmates Online, Inc. v. John Zuccarini

- Possibility to file additional information (an exception)
- No precedent, but the decisions are following previous ones
- *„To avoid any misunderstanding that the decision establishes a **precedent**, we call for caution and recommend to submit complete documentation of the case when filing a complaint.“*



# UDRP CASE STUDY



## **Donald J. Trump v. Mediaking LLC**

The complaint (and the answer) is limited to 5000 words

The panel said, that it has accepted longer complaint, however it only considered the main arguments (not the best argumentation)

## **X Giga Pty Limited v. Elena Sadkovaya**

The complaint had to be shortened and filed again

# UDRP CASE STUDY



## Two Way NV/SA v. Moniker Privacy Services, LLC

- Usual case (registered trademark X cybersquatting)
- **however:**
- The complainant tried to disqualify the panelists (he partly succeeded) because he wanted to have higher probability to win the case
- Obvious decision - Panel denied the complaint and made no finding of reverse domain name hijacking – first comes, first served

# UDRP PROCESS



The Internet Corporation for Assigned Names and Numbers



Know the

rules!

#### 4. Mandatory Administrative Proceeding.

This Paragraph sets forth the type of disputes for which you are required to submit to a mandatory administrative proceeding. These proceedings will be conducted before one of the administrative-dispute-resolution service providers listed at [www.icann.org/en/dndr/udrp/approved-providers.htm](http://www.icann.org/en/dndr/udrp/approved-providers.htm) (each, a "Provider").

**a. Applicable Disputes.** You are required to submit to a mandatory administrative proceeding in the event that a third party (a "complainant") asserts to the applicable Provider, in compliance with the Rules of Procedure, that

- (i) your domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights, and
- (ii) you have no rights or legitimate interests in respect of the domain name, and
- (iii) your domain name has been registered and is being used in bad faith.

**Cumulative condition**

# UDRP PROCESS



## Complainant has to prove (all of it):

- Domain name is **identical or confusingly similar** to a trademark in which complainant has rights
- No rights or **legitimate interests** in respect of current domain name
- Domain name has been registered and is being used in **bad faith**

# 1) IDENTICAL OR CONFUSINGLY SIMILAR



## The test:

- comparison between the trademark and the domain name itself to determine likelihood of Internet user confusion.
- the relevant trademark would generally need to be recognizable as such within the domain name
- the content of website is irrelevant
- E.g. guinness.com



# 1) IDENTICAL OR CONFUSINGLY SIMILAR



- **guinness.com** = Typosquatting!





# COMBINATION OF TRADEMARK AND GENERIC NAME

Pilsner TM

- Pilsnerbeer.com

Audi TM

- Audicars.com

Apple TM

- Applephones.biz

**Is it identical or confusingly similar?**

**WHAT DO YOU THINK?**

# **AT&T CORP. V. JOHN ZUCCARINI D/B/A RAVECLUB BERLIN CASE NO. D2002-0666**

- **A review of the second-level domains**
- **"atttbroadband"**
- **"attbraodband"**
- **"attboradband"**
- **"attbroadban"**
- **"attbrodband"**
- **each domain comprises of the Complainant's mark AT&T or a slight variation thereof as a prefix and the word "broadband" or a misspelling thereof**
- **that corresponds to a term implying communication and that the public would accordingly associate with the Complainant.**

**DOMAIN NAMES  
CONSISTING OF A  
TRADEMARK AND A  
NEGATIVE TERM**

**SUCKS, BLOWS, STINKS**

# CONFUSING SIMILARITY

**Walmartsucks.com, bridgestonesucks.com**

## **Majority view:**

- a trademark and a negative term is confusingly similar, because the domain name contains a trademark and a dictionary word
- For non-commercial use it should be OK

## **Minority view**

- not confusingly similar because Internet users are not likely to associate the trademark holder with a domain name consisting of the trademark and a negative term

**<ELECTROLUXSUCKS.COM>**

 **Electrolux**



RNB

*"Nothing sucks like Electrolux"*

# CONFUSING SIMILARITY



**It always has to be decided CASE BY CASE**

# **TRADEMARK REGISTERED BEFORE THE REGISTRATION OF DOMAIN**

**Registration of a domain name before a complainant acquires trademark rights in a name does not prevent a finding of identity or confusing similarity.**

# **REGISTRATION AFTER THE DOMAIN NAME**

**The UDRP makes no specific reference to the date on which the holder of the trademark or service mark acquired rights.**



# REGISTRATION AFTER THE DOMAIN NAME

- Generally speaking, when a domain name is registered before a trademark right is established, the registration of the domain name was not in bad faith
- **BUT!!!!** When the respondent is clearly aware of the complainant, and it is clear that the aim of the registration was to take advantage of the confusion, bad faith can be found
- **garancedore.fr/com**

(Mariline Fiori p/k/a Garance Doré v. Private Registrations Aktien Gesellschaft Case No. D2012-1620)

**However, in such circumstances it may be difficult to prove bad faith**

- Digital Vision, Ltd. v. Advanced Chemill Systems [D2001-0827](#), Denial (it was not registered in bad faith)
- AB Svenska Spel v. Andrey Zacharov [D2003-0527](#), Transfer

# **REGISTRATION AFTER THE DOMAIN NAME**

## **Conclusion:**

**Registration of a domain name before a complainant acquires trademark rights in a name does not prevent a finding of identity or confusing similarity under the UDRP.**

# **GEOGRAPHICAL INDICATION = TRADEMARK?**

- **Brno.com**
- **Czechrepublic.com**
- **Czech-babes.com**
- **Bayern Munchen**

# **GEOGRAPHICAL INDICATION = TRADEMARK?**

**No specific protection to geographical terms under the UDRP.**

**Can be protected under the UDRP, if the complainant has shown that it has rights in the term and that the term is being used as a trademark.**

- FC Bayern München AG v. Peoples Net Services Ltd. [D2003-0464](#), Transfer (<bayernmuenchen.net>)

# GEOGRAPHICAL INDICATION = TRADEMARK?

It has generally proven **difficult** for the legal authority of a geographical area (which has not otherwise obtained a relevant trademark registration) to show unregistered trademark rights in that geographical term on the basis of secondary meaning.

## Cases where local authorities failed

- *Porthelsinki.net* [D2001-0002](#),
- *brisbane.com* [D2001-0069](#)

# TYPOSQATTING



Goggle Mail

*Seeing all your shit.*

# MISPELLED IS CONFUSINGLY SIMILAR

- *Wachovia Corporation v. Peter Carrington*, WIPO Case No. D2002-0775, <wochovia.com>, Transfer
- *Fuji Photo Film U.S.A., Inc. v. LaPorte Holdings*, WIPO Case No. D2004-0971, <fuijifilm.com>, Transfer
- *Express Scripts, Inc. v. Whois Privacy Protection Service, Inc. / Domaindeals, Domain Administrator*, WIPO Case No. D2008-1302, <expressscripts.com>, Transfer

# 2) LEGITIMATE INTEREST



## What is legitimate interest?

- Bona fide offering of goods or services
- Commonly known as domain
- **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.
- Article 4(c) of the rules



# WHO HAS TO PROVE LEGITIMATE INTEREST?

Complainant bears the "general burden of proof" ..... burden shifts to the Respondent once Complainant makes a *prima facie* showing that the Respondent lacks rights or legitimate interests.

- *Neusiedler Aktiengesellschaft v. Kulkarni*, [WIPO Case No. D2000-1769](#);
- *Dow Jones & Company and Dow Jones LP v. The Hephzibah Intro-Net Project Limited*, [WIPO Case No. D2000-0704](#).

# **LEGITIMATE INTERESTS OF RESELLER/DISTRIBUTOR**

**CAR PARTS**

# **MERCEDESSHOP.COM**

- **discussion forum where mechanics and owners of Complainant's products discuss**
- **also offers genuine Mercedes parts and accessories for sale,**
- **were obtained through fully authorized channels of distribution. Respondent also offers clearly identified quality, re-built, and used parts.**
- **disclaimer at Respondent's web site of no affiliation between Complainant and Respondent.**

# MERCEDESSHOP.COM

- It is exceedingly unlikely that any user seeking to find Complainant `<mercedes.com>` would enter `<mercedesshop.com>`.
- Moreover, there is a clear disclaimer at Respondent's web site of any affiliation between Complainant and Respondent.

*DaimlerChrysler A.G. v. Donald Drummonds*, WIPO Case No. [D2001-0160](#), Not transferred

# DISCOUNT-MARLBORO- CIGARETTES.COM

## Discount cigarettes

- Respondent's website is likely to mislead **users of internet** into believing the site is operated or endorsed by or affiliated with Complainant.
- Create a strong impression that the site is an official site of Complainant
- -> **Transfer**

# GENERIC WORDS IN GENERIC DOMAINS

- **Apple.net**
- **Puma.com**
- **Jaguar.com**
- **Husky.com**



# **LACK OF LEGITIMATE INTERESTS IN GENERIC WORDS**

- **What has to be considered?:**
- **The respondent fails to show one of the three circumstances under Paragraph 4(c) of the Policy,**
- **The respondent may lack a legitimate interest in the domain name**

# LACK OF LEGITIMATE INTERESTS IN GENERIC WORDS

**c. How to Demonstrate Your Rights to and Legitimate Interests in the Domain Name in Responding to a Complaint.** When you receive a complaint, you should refer to [Paragraph 5](#) of the Rules of Procedure in determining how your response should be prepared. Any of the following circumstances, in particular but without limitation, if found by the Panel to be proved based on its evaluation of all evidence presented, shall demonstrate your rights or legitimate interests to the domain name for purposes of [Paragraph 4\(a\)\(ii\)](#):

- (i) before any notice to you 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 (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 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.



# GENERIC WORDS AND LEGITIMATE INTERESTS

- **Back to the case of APPLE:**
- respondent may well have a right to a domain name "apple" if it uses it for a genuine site for apples but not if the site is aimed at selling computers or MP3 players (or other similar goods comparing to the products of Apple)

# 3) BAD FAITH



**What is bad faith?**

**Article 4 (b) of the rules**

# 3) BAD FAITH

**b. Evidence of Registration and Use in Bad Faith.** For the purposes of [Paragraph 4\(a\)\(iii\)](#), 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 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 web site 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 web site or location or of a product or service on your web site or location.

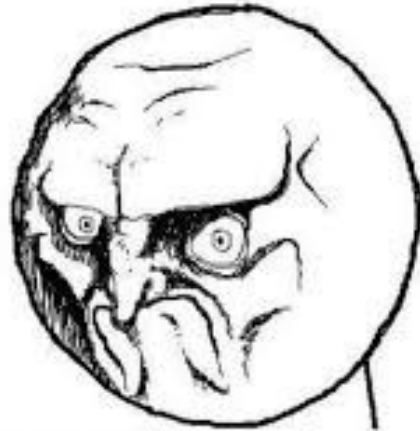
# **BAD FAITH WITHOUT ANY ACTIVE USE**

- **The lack of active use of the domain name does not as such prevent a finding of bad faith.**
- **The panel must examine all the circumstances of the case to determine whether respondent is acting in bad faith**
- **Panels may draw inferences about whether the domain name was used in bad faith given the circumstances surrounding registration, and vice versa.**

# PRESENCE OF DISCLAIMER

- **Eg. domain bmw.com**
- **Website states**
  - this domain is not associated to BMW
  - this domain is for sale
  
- **What do you think? Is it OK?**

# PRESENCE OF DISCLAIMER



**NO.**

- The existence of a disclaimer cannot cure bad faith, when bad faith has been established by other factors.
- A disclaimer can also show that the respondent had prior knowledge of the complainant's trademark.

# DOMAIN NAME DECISION STRUCTURED SEARCH

<http://www.wipo.int/amc/en/domains/search/legalindex.jsp#15050>

# **MUST READ !**

**WIPO Overview of WIPO Panel Views on Selected UDRP  
Questions, Third Edition  
("WIPO Jurisprudential Overview 3.0")**

**<http://www.wipo.int/amc/en/domains/search/overview3.0/>**





**THANK YOU FOR YOUR ATTENTION!**

**QUESTIONS?**